

O/0001/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK REGISTRATIONS

UK00003851301 AND UK00003851290

IN THE NAME OF COACH CUBE LIMITED

AND

THE OPPOSITIONS THERETO UNDER NUMBERS 440717 AND 440719

BY COACHHUB GMBH

Background and Pleadings

1. On 20 November 2022, Coach Cube Limited, ('the Applicant') filed applications to register the following trade marks:

1) **UK00003851301**

COACHCUBE

and

2) **UK00003851290**



For both applications, the specification for which registration is sought is as follows:

Class 9:

Software for online messaging; Software for evaluating customer behaviour in online shops; Software for designing online advertising on websites; Software for operating an online shop; Computer game software for use with on-line interactive games; Software for embedding online advertising on websites; Software for arranging online transactions; Computer software for the administration of on-line games and gaming; Computer programs for accessing, browsing and searching online databases.

Class 35:

Advertising the goods and services of online vendors via a searchable online guide; Providing searchable online advertising guides; Providing a searchable online advertising guide featuring the goods and services of online vendors; Conducting online business management research surveys; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Online marketing; Online

business networking services; Online retail services for downloadable digital music; Online community management services; Business information services provided online from a computer database or the internet; Online advertising services; Compilation of online business directories; Promotion, advertising and marketing of on-line websites; Providing academic course administration services relating to online course registration; Online advertising; On-line advertising and marketing services; Business information services provided online from a global computer network or the internet; Providing on-line auction services; Providing online commercial directory information services; Conducting virtual trade show exhibitions online; Computerized on-line ordering services; Business information services provided on-line from a computer database or the internet; Arranging subscriptions of the online publications of others; Online retail services for downloadable and pre-recorded music and movies; Online ordering services; Online retail services relating to handbags.

Class 36:

Online business banking services; Online banking services; Online banking; Providing online information about insurance from a computer database or the Internet; Providing online information about reinsurance from a computer database or the Internet.

Class 38:

Providing online forums for communication in the field of electronic games; Providing online forums; Providing on-line chat rooms for social networking; Online messaging services; Communication by online blogs; Providing access to multimedia content online; Providing an online interactive bulletin board; Providing online facilities for real-time interaction with other computer users.

Class 41:

Providing online training seminars; Providing online games; Provision of online training; Conducting training sessions on physical fitness online; Career counselling and coaching; Providing online courses of instruction; Personal

coaching [training]; Conducting training courses relating to nutrition online; Sports tuition, coaching and instruction; Conducting training courses relating to diet online; Life coaching (training); Providing online video games; Sports coaching services; Distance learning services provided online; Training or education services in the field of life coaching; Providing an online computer game; Sports coaching; Online sports betting services; Personal coaching services in the field of ballet; Provision of information on fitness training via an online portal; Online computer game services; Providing online information on computer and video game strategies; Providing online entertainment in the nature of game tournaments; Esports coaching; Providing on-line video games; Coaching [training]; On-line game services; Online digital publishing services; Providing online publications, not downloadable; Providing online virtual guided tours; Provision of information relating to physical training via an online web site; Providing on-line interactive computer games; Providing online music, not downloadable; Provision of online tutorials; Provision of online computer games; Online gaming services; Provision of online information relating to game players; Providing on-line computer games; Online education services; Providing online electronic publications; Providing online videos, not downloadable; Coaching services; Online academic library services; Online gambling services; Providing on-line information and news in the field of employment training; Educational services in the nature of coaching; Providing online electronic publications, not downloadable, in the field of music; Providing online electronic publications in the field of music, not downloadable; Online casino services; Providing an on-line computer game; Provision of information relating to physical education via an online web site; Publication of online reviews in the field of entertainment; Providing online comic books, not downloadable; Provision of an online magazine featuring information in the field of computer games; Political speech training and coaching; Game services provided online from a computer network; Providing online electronic publications, not downloadable; Providing information about online education; Provision of online information in the field of computer games entertainment; Providing training courses on business management; Political debate training and coaching; Online game services through mobile devices; Online research

library services; Providing on-line non-downloadable video content; Provision of education on-line from a computer database or via the internet or extranets; Provision of information relating to physical exercises via an online web site; Providing on-line publications; Providing online newsletters in the fields of sports entertainment; Providing on-line music, not downloadable; Computerised training in career counselling; Arranging professional workshop and training courses; Providing on-line publications (not downloadable); Providing on-line publications (non-downloadable); Conducting of educational courses in business management; Providing online entertainment in the nature of game shows.

Class 42:

Hosting online web facilities for others for sharing online content; Hosting of digital content online; Hosting online facilities for conducting interactive discussions; Providing online non-downloadable software for use in communication; Hosting online web facilities for others for conducting interactive discussions; Providing online, non-downloadable software; Programming of software for online advertising; Hosting on-line web facilities for others for managing and sharing on-line content; Programming of software for evaluating customer behaviour in online shops; Providing temporary use of online non-downloadable investment software; Hosting an online website for creating and hosting micro websites for businesses; Hosting on-line facilities for conducting interactive discussions; Providing temporary use of online non-downloadable software; Providing on-line non-downloadable software for database management; Creating electronically stored web pages for online services and the internet; Providing temporary use of on-line non-downloadable software for web site development; Providing on-line support services for computer program users; Providing temporary use of on-line non-downloadable software for database management; Providing online non-downloadable software for use in supply chain management; Providing temporary use of on-line non-downloadable software for inventory management; Providing temporary use of on-line non-downloadable software development tools;

Providing temporary use of on-line non-downloadable software for the management of information.

Both applications were published for opposition purposes on 10 February 2023.

2. CoachHub GmbH ('the Opponent') filed respective oppositions on 10 May 2023, both based on section 5(2)(b) of the Trade Marks Act ('the Act'), and directed against the applications in their entirety.¹
3. For both oppositions, the Opponent relies upon the following 4 earlier trade mark registrations:

i) UK00003656779

CoachHub

Filing date: 17 June 2021

Date of entry in register: 19 November 2021

Priority date: 11 October 2019

Trade Mark from which priority claimed: 0181352268 (EUIPO)

The application to register the earlier mark in the UK was filed pursuant to Article 59 of the 'Withdrawal Agreement'.² As a consequence, it is deemed to have the same filing date as its corresponding trade mark application filed in the EU, i.e. 11 October 2019.

Registered for goods and services in classes 9, 36, 41 and 42, the following of which are relied upon in both oppositions:

¹ Initially, both oppositions were also based on sections 5(3) and 5(4)(a) of the Act. In the absence of any evidence filed in support, the section 5(3) and 5(4)(a) grounds of the claim were struck out on 22 November 2023. The oppositions therefore proceed on the basis of the section 5(2)(b) claims.

² 'Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01)', also known as the 'Withdrawal Agreement'.

Class 9:

Computer software for mobile phones; Computer application software for mobile telephones; Mobile apps; Dashboard software; Collaborative software; Educational software

Class 36:

Financial analysis.

Class 41:

Providing electronic publications; Publication of texts, other than publicity texts; Publication of books.

Class 42:

Server hosting; Off-site data backup; Electronic data storage; Cloud computing; Outsource service providers in the field of information technology; Hosting web portals; Hosting of mobile applications.

ii) UK00003656814

CoachHub

Filing date: 17 June 2021

Date of entry in register: 5 November 2021

Priority date: 11 October 2019

TM from which priority claimed: 018223054 (EUIPO)

The application to register the earlier mark in the UK was filed pursuant to Article 59 of the 'Withdrawal Agreement'. As a consequence, it is deemed to have the same filing date as its corresponding trade mark application filed in the EU, i.e. 11 October 2019.

Registered for services in classes 35 and 38, the following of which are relied upon:

Class 35:

Appointment scheduling services [office functions]; Appointment reminder services [office functions]; Updating and maintenance of information in registries; Providing business information via a web site; Business management assistance; Outsourcing services [business assistance]; Compilation of statistics; Personnel management consultancy; Advisory services for business management; Compilation of information into computer databases; Systemization of information into computer databases; Mediation and conclusion of commercial transactions for others; Provision of an online marketplace for buyers and sellers of goods and services; Outsourced administrative management for companies; Procurement services for others [purchasing goods and services for other businesses]; Price comparison services; Personnel selection using psychological testing; Administrative assistance in responding to calls for tenders; Corporate communications services; Administrative services for medical referrals; Business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; Business project management services for construction projects; Cost price analysis.

Class 38:

Videoconferencing services; Providing internet chatrooms; Streaming of data; Video-on-demand transmission; Video-on-demand transmission services; Transmission of podcasts; Telecommunication services; Interactive telecommunications services; Internet based telecommunication services; Telecommunication services provided via Internet platforms and portals; Streaming of video material on the internet; Streaming of audio material on the internet.

iii) UK00918078446



Filing date: 6 June 2019

Date of entry in register: 9 October 2019

This mark is a comparable mark pursuant to Article 54 of the Withdrawal Agreement, based on EUTM 018078446, which was registered prior to the withdrawal of the UK from the European Union.

Registered for goods and services in classes 9 and 41, the following of which are relied upon:

Class 9:

Mobile apps; Dashboard software; Collaborative software; Downloadable software applications.

Class 41:

Coaching in economic and management matters.

iv) WO0000001645824



Colours claimed: orange and blue.

Date of protection in the UK: 5 May 2022

Designation date: 13 December 2021

International registration date: 13 December 2021

Office of origin: Germany

Priority date: 6 October 2021

Priority country: Germany

TM from which priority claimed: 30 2021 116 559.

Registered for goods and services in classes 9, 35, 36, 38, 41 and 42, the following of which are relied upon:

Class 9:

Computer software for mobile phones; computer application software for mobile telephones; computer software platforms, recorded or downloadable; mobile apps; dashboard software; collaborative software; educational software.

Class 35:

Updating and maintenance of information in registries; providing business information via a web site; business management assistance; outsourcing services [business assistance]; compilation of statistics; personnel management consultancy; advisory services for business management; compilation of information into computer databases; systemization of information into computer databases; mediation and conclusion of commercial transactions for others; provision of an online marketplace for buyers and sellers of goods and services; outsourced administrative management for companies; procurement services for others [purchasing goods and services for other businesses]; price comparison services; administrative assistance in responding to calls for tenders; corporate communications services; business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; business project management services for construction projects; cost price analysis.

Class 38:

Videoconferencing services; providing internet chatrooms; streaming of data; video-on-demand transmission; video-on-demand transmission services; transmission of podcasts; telecommunication services; interactive telecommunications services; internet based telecommunication services; telecommunication services provided via internet platforms and

portals; streaming of video material on the internet; streaming of audio material on the internet.

Class 41:

Training courses in strategic planning relating to advertising, promotion, marketing and business; analyzing educational tests scores and data for others; business training services; training in communication techniques; arranging professional workshop and training courses; computer education training; computer training; production of training films; arranging and conducting of workshops [training]; conducting of instructional seminars; arranging and conducting of seminars; personal training; electronic publishing services; providing electronic publications; arranging and conducting of in-person educational forums; providing online videos, not downloadable; tutoring; vocational guidance [education or training advice]; mobile library services; know-how transfer [training]; practical training [demonstration]; educational examination; education information; publication of texts, other than publicity texts; publication of books; correspondence courses; teaching; academies [education]; coaching [training]; advisory and consultancy services relating to coaching services [personal training].

Class 42:

Platform as a service [PaaS]; development of computer platforms; server-hosting; off-site data backup; electronic data storage; cloud-computing; outsource service providers in the field of information technology; hosting web portals; hosting of mobile applications; hosting multimedia educational content; hosting of interactive applications; hosting of communication platforms on the internet; quality assessment of coaching; providing scientific information in the field of coaching services.

4. For both oppositions, the Opponent claims that the parties' respective marks are similar, and for similar goods and services, leading to a likelihood of confusion.

5. The Applicant filed defences and counterstatements for both oppositions, denying the claims against them in their entirety.
6. The Opponent is represented by Womble Bond Dickinson (UK) LLP. The Applicant is represented by Dynham. Neither party filed evidence or submissions in lieu of a hearing. The following decision has been made after careful consideration of the papers before me.

RELEVANCE OF EU LAW

7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Relevant legislation

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

'5(2) A trade mark shall not be registered if because –

(a) ...

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

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

Earlier marks

9. In accordance with section 6 of the Act, all four of the Opponent's marks are earlier marks by virtue of their respective priority/filing dates, which fell before the filing dates of the applied-for marks.

Section 5(2)(b) case law

10. The following principles are derived from the decisions of the Court of Justice of the European Union (CJEU) 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 C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

11. Section 60A of the Act provides:

(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the 'Nice Classification' means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.

12. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties' goods and services must be taken into account:

'[23] 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'.

13. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

'...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.'

14. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281³, identified the following factors for assessing similarity of the respective goods and services:

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

15. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

‘The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.’

16. In making an assessment between the competing services, I bear in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*.⁴ The General Court held to the effect that goods and services can

³ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

⁴ Case T-133/05

be considered as identical when the goods and services designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

17. Case law establishes that ‘... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise’ but ‘Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.’⁵

18. The goods and services to be compared are set out above at [1] and [3]; and apply to both oppositions. Given that: earlier marks i) and ii) are identical; as are earlier marks iii) and iv), it will not always be necessary to compare the contested terms against *all four* earlier registrations. It will sometimes suffice to compare a contested term against: *either* i) or ii), and *either* iii) or iv). For example: if a contested term is found to be identical to one of the Applicant’s terms under, say, figurative mark iii), it will not be necessary to also compare it to terms under the other figurative mark iv) because to do so would not improve the Opponent’s case. Put simply, I need to compare each of the contested terms twice:

i) against the closest of the Opponent’s comparators under one or other of the earlier word marks (whichever one of that pair it might be from time to time, because it will vary due to the specifications being different);

then

ii) against the closest of the Opponent’s comparators under one or other of the earlier figurative marks (again, whichever one of that pair it might be from time to time, because it will vary due to the specifications being different).

⁵ *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch).

Class 9

19. The Opponent has made a broad general argument according to which all of the goods and services applied for are identical or similar to those protected by the earlier marks, taking account of their natures, end users, methods of use and whether they are competitive or complementary. ⁶ The proposed comparators have been set out as follows, albeit the Opponent has declined to identify where the particular points of similarity/identity lie:⁷

Opponent's marks:	Applicant's mark:
<p>Class 9:</p> <p>i) UK00003656779 <i>Computer software for mobile phones; Computer application software for mobile telephones; Mobile apps; Dashboard software; Collaborative software; Educational software</i></p> <p>iii) UK00918078446 <i>Mobile apps; Dashboard software; Collaborative software; Downloadable software applications.</i></p> <p>iv) WO0000001645824 <i>Computer software for mobile phones; computer application software for mobile telephones; computer software platforms, recorded or downloadable; mobile apps;</i></p>	<p>Class 9:</p> <p><i>Software for online messaging; Software for evaluating customer behaviour in online shops; Software for designing online advertising on websites; Software for operating an online shop; Computer game software for use with on-line interactive games; Software for embedding online advertising on websites; Software for arranging online transactions; Computer software for the administration of on-line games and gaming; Computer programs for accessing, browsing and searching online databases.</i></p>

⁶ Opponent's statement of grounds, paragraphs [21] (OP440717) and [22] (OP440719).

⁷ As above, page [8].

<i>dashboard software; collaborative software; educational software.</i>	
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20. In approaching my comparison, I bear in mind the following dicta of Mr Iain Purvis K.C., sitting as the Appointed Person, in the recent decision of BL O/0911/24 SMART:

'9. In a case like this where the marks cover a multitude of different goods, it is obviously necessary for the Opponent to identify with precision, both in its pleaded case and in any submissions made to the Registry, which goods of its own registrations are alleged to be similar to which goods of the Application. If this is not done, it is unfair to the Applicant and it is extremely difficult if not impossible for the Hearing Officer to decide the case.

[...]

28. [...] As I have said, it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach for which Mr Wood contends would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent.'

21. In the absence of any guidance as to the particular points of similarity, I will make my comparisons based on my own understanding of the terms.

22. Broadly speaking, the Applicant's class 9 goods are types of software. My view is that each of the contested terms would cover downloadable versions of the particular software in question. All of the class 9 goods will be encompassed by the Opponent's term *Downloadable software applications* (earlier registration iii). I therefore find the parties' goods to be identical according to the principle in *Meric*.

23. I will now compare the contested terms to those under the earlier marks i) or ii).

Contested goods: *Software for online messaging*

24. My view is that the Applicant's broad term will encompass the Opponent's *Computer software for mobile phones* (earlier registration i)). The parties' goods are therefore identical according to the principle in *Meric*.

Contested goods: *Software for operating an online shop; Software for evaluating customer behaviour in online shops*

25. It is my understanding that there are various selling platforms to enable users to operate their own online 'shops', which can be used via a mobile phone app; well-known examples being Etsy and Ebay. I consider many such platforms/apps might have the functionality to analyse customer behaviour, e.g. number of views of product listings. I therefore find that the Applicant's terms will be encompassed by the Opponent's broader term *mobile apps* (earlier registration i)). The parties' goods are therefore identical according to the principle in *Meric*.

Contested goods: *Software for arranging online transactions*

26. I consider the Applicant's term to cover 'mobile app' versions of the software in question. For reasons analogous to those provided above at [25], I find the contested goods to be identical to the Opponent's broader term *mobile apps* (earlier registration i)) according to the principle in *Meric*.

Contested goods: *Computer game software for use with on-line interactive games*

27. My view is that 'online interactive games' often involve players interacting with other players who are simultaneously playing the game within the same 'online space'. I consider that the Applicant's term will be encompassed by the Opponent's broader term *Collaborative software*, present in earlier registrations i) and iv) [as well as iii) which has already been addressed]. To my mind, collaborative software

will cover any software whose feature is to enable interaction with other users and will not necessarily be confined to instances of colleagues working together on shared documents. The parties' goods are therefore identical according to the principle in *Meric*.

Contested goods: *Computer programs for accessing, browsing and searching online databases*

28. It is my understanding that the above software can exist in the form of a mobile app and will, therefore, be encompassed by the Opponent's *mobile apps* (earlier registration i)). The parties' goods are therefore identical according to the principle in *Meric*.

Contested goods: *Software for designing online advertising on websites; Software for embedding online advertising on websites*

29. The above contested terms are intended to create advertising content to be used online. It is my understanding that 'embedding' entails the integration of links, images, video and any other content into web media. In the absence of any guidance from the Opponent as to the most appropriate comparator within its specification, I will compare the contested goods to the Opponent's *Collaborative software* (earlier registration i)). 'Collaborative software' will include, *inter alia*, software which enables individuals, teams or companies to work together remotely on a task within the same digital 'space'. The parties' goods therefore have distinct core purposes. Users will overlap to the general extent that both will be used by the professional public. It is conceivable that some users of the Applicant's 'advertising' software goods might also use *collaborative software*. Trade channels may overlap given that some software companies create software for a range of uses and in a variety of fields. I also recognise that there are some software companies with particular specialisms. Methods of use will differ: the contested goods will be used in the act of designing online advertising material/embedding content online, whereas 'collaborative software' will be used by way of a platform/shared digital space. The goods will be similar in nature to the general extent that both parties' offerings are software, which can be provided in digital

form or recorded on some sort of physical medium such as a disk. I do not consider the goods to be in a competitive relationship, neither being substitutable for the other. Despite some trade channel overlap, I do not find complementarity either; neither good being necessary or important for the other. All things considered, I find the parties' goods to have a low level of similarity. I do not consider the overlap in user to be particularly remarkable given that 'collaborative software' can be used in any field. In my view, comparison against any other of the Opponent's goods will unlikely improve the Opponent's position.

Contested goods: *Computer software for the administration of on-line games and gaming*

30. In the absence of any explanation from the parties as to what precisely this term covers, it is my view that the goods in question likely comprise the particular software used by businesses in order to provide online gaming. Such software will, to my mind, function as the 'control centre' from which the business of providing gaming is administered. I find the most appropriate comparator to be the Opponent's *Dashboard software* (earlier registration i)). It is my understanding that 'dashboard software', put simply, is the visual interface on a screen which displays various content to provide the user with an 'at-a-glance' view. In essence, it is a management tool. The competing goods will have distinct specific purposes: the administration of online gaming versus the ability to view various visual data 'at-a-glance'. It is my view that the Applicant's software for 'gaming administration' will, in some instances, incorporate some sort of 'dashboard' interface as part of it. I find that users and trade channels will therefore overlap to this extent. The goods will coincide in nature to the broad extent that both are software; typically in a downloadable format or recorded on a disk or other physical medium. To the extent that the Applicant's term encompasses 'gaming administration' software incorporating 'dashboard' functionality, the parties' goods may be in a competitive relationship. In instances where the Applicant's 'gaming administration software' does *not* include such 'dashboard' functionality, I find the goods to be complementary. The Opponent's dashboard software may be useful or important for the Applicant's software such that the average consumer may presume both

offerings to derive from the same undertaking. In the light of the foregoing, I find the parties' goods to be highly similar.

Class 35

31. I set out the Opponent's comparison in the table below:⁸

Opponent's marks:	Applicant's mark:
<p>i) UK00003656779</p> <p>Class 41: <i>Providing electronic publications; Publication of texts, other than publicity texts; Publication of books.</i></p>	<p>Class 35: <i>Advertising the goods and services of online vendors via a searchable online guide; Providing searchable online advertising guides; Providing a searchable online advertising guide featuring the goods and services of online vendors; Conducting online business management research surveys; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Online marketing; Online business networking services; Online retail services for downloadable digital music; Online community management services; Business information services provided online from a computer database or the internet; Online advertising services; Compilation of online business directories; Promotion, advertising and marketing of on-line websites;</i></p>
<p>ii) UK00003656814</p> <p>Class 35: <i>Appointment scheduling services [office functions]; Appointment reminder services [office functions]; Updating and maintenance of information in registries; Providing business information via a web site; Business management assistance; Outsourcing services [business assistance]; Compilation of statistics; Personnel management consultancy; Advisory services for business management; Compilation of information into computer databases; Systemization of information into</i></p>	<p><i>Advertising the goods and services of online vendors via a searchable online guide; Providing searchable online advertising guides; Providing a searchable online advertising guide featuring the goods and services of online vendors; Conducting online business management research surveys; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Online marketing; Online business networking services; Online retail services for downloadable digital music; Online community management services; Business information services provided online from a computer database or the internet; Online advertising services; Compilation of online business directories; Promotion, advertising and marketing of on-line websites;</i></p>

⁸ Opponent's statement of grounds, pages [8] and [9]

<p>computer databases; Mediation and conclusion of commercial transactions for others; Provision of an online marketplace for buyers and sellers of goods and services; Outsourced administrative management for companies; Procurement services for others [purchasing goods and services for other businesses]; Price comparison services; Personnel selection using psychological testing; Administrative assistance in responding to calls for tenders; Corporate communications services; Administrative services for medical referrals; Business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; Business project management services for construction projects; Cost price analysis.</p>	<p>Providing academic course administration services relating to online course registration; Online advertising; On-line advertising and marketing services; Business information services provided online from a global computer network or the internet; Providing on-line auction services; Providing online commercial directory information services; Conducting virtual trade show exhibitions online; Computerized on-line ordering services; Business information services provided on-line from a computer database or the internet; Arranging subscriptions of the online publications of others; Online retail services for downloadable and pre-recorded music and movies; Online ordering services; Online retail services relating to handbags.</p>
<p>iv) WO0000001645824</p> <p>Class 35: Updating and maintenance of information in registries; providing business information via a web site; business management assistance; outsourcing services [business assistance]; compilation of statistics;</p>	

personnel management consultancy; advisory services for business management; compilation of information into computer databases; systemization of information into computer databases; mediation and conclusion of commercial transactions for others; provision of an online marketplace for buyers and sellers of goods and services; outsourced administrative management for companies; procurement services for others [purchasing goods and services for other businesses]; price comparison services; administrative assistance in responding to calls for tenders; corporate communications services; business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; business project management services for construction projects; cost price analysis.

Class 41:

Electronic publishing services; providing electronic publications; arranging and conducting of in-person educational forums; providing online videos, not downloadable; tutoring.

Contested services: *Business information services provided online from a computer database or the internet; Business information services provided online from a global computer network or the internet; Business information services provided on-line from a computer database or the internet*

32. I consider the above terms to be synonymous. I find that the contested terms are synonymous with the Opponent's *Providing business information via a web site* (earlier registrations ii) and iv)). The parties' goods are therefore identical.

Contested services: *Online business networking services*

33. This term encompasses services aimed at connecting people for business purposes. I compare it to the Opponent's class 35 term *Business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding* (earlier registrations ii) and iv)). I find that the Opponent's services will be encompassed by the Applicant's broader term. The parties' goods are therefore identical according to the principle in *Meric*.

Contested services: *Compilation of online business directories*

34. The core function of this service is the act of compiling online directories of businesses. I compare these services to the Opponent's broader class 35 term *compilation of information into computer databases* (earlier registrations ii) and iv)). I consider online directories to be databases, i.e. virtual repositories of information which are interrogated. I find that the Applicant's services will be encompassed by the Opponent's broader term. The parties' goods are therefore identical according to the principle in *Meric*.

Contested services: *Providing on-line auction services*

35. I find that the Applicant's services will be encompassed by the Opponent's broader class 35 term *Provision of an online marketplace for buyers and sellers of goods and services* (earlier registrations ii) and iv)). The parties' goods are therefore identical according to the principle in *Meric*.

Contested services: *Advertising the goods and services of online vendors via a searchable online guide; Providing a searchable online advertising guide featuring the goods and services of online vendors; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Providing searchable online advertising guides; Providing online commercial directory information services*

36. I consider the most appropriate comparator to be the Opponent's *Provision of an online marketplace for buyers and sellers of goods and services* (earlier registrations ii) and iv)). The core purpose of the Applicant's services is the advertising of goods and services online in a format that enables users to 'look up' the vendors listed. The core purpose of the Opponent's services is the provision of a virtual space in which goods and services can be bought and sold. Although the provision of an online marketplace inevitably exposes vendors to prospective buyers, I do not consider advertising to be the core purpose of the Opponent's service. My view is that the parties' offerings have distinct core purposes: advertising (Applicant) versus provision of an online space for buying and selling (Opponent). Users will overlap: many buyers and sellers, whether the general or professional public, will access both online marketplaces and online directories for buying/selling. Trade channels may overlap; some undertakings might provide both online marketplaces and advertising by way of online directories. To my mind, the parties' services may, in some instances, be in competition. For example, a vendor might deliberate over whether to sell their goods/services directly via the Opponent's online marketplace or, as an alternative, to have their undertaking listed on the Applicant's directory signposting prospective buyers to the vendor's own website. I also consider the services to be complementary; some online marketplaces will likely incorporate a searchable directory of vendors selling their goods/services via the online marketplace in question. In the light of the foregoing, I find the parties' services to have a high level of similarity.

Contested services: *Online marketing; Online advertising; On-line advertising and marketing services; Online advertising services; Promotion, advertising and marketing of on-line websites.*

37. The core purpose of these broad terms is the promotion of something (goods/services, or perhaps other causes) on behalf of a third party, via online channels of communication. I will compare this term to the Opponent's class 35 term *Corporate communications services* (earlier registrations ii) and iv)). It is my understanding that the Opponent's term will encompass, *inter alia*: outward-facing communications from businesses to their target markets. In my view, the contested terms will be subsumed under the Opponent's broader term. I find the parties' services to be identical according to the principle in *Meric*.

Contested services: *Online community management services*

38. It is my understanding that 'online community management' is the process of managing the interactions that people have with a particular brand online. Such activity is, to my mind, aligned with an area of marketing often referred to as 'customer engagement' strategy. I consider the Applicant's services to be encompassed by the Opponent's broader term *Corporate communications services* (earlier registrations ii) and iv)). I therefore find the parties' services to be identical according to the principle in *Meric*.

Contested services: *Conducting online business management research surveys*

39. In the absence of any assistance from the parties as to what precisely this term covers, I must form my own common-sense view. It is my understanding that the conducting of online surveys will entail various tasks such as, *inter alia*: the online publication of the survey to the relevant audience; the operation of that survey and the recording of the responses from participants in the survey. In the instant case, the aim of the survey is to collect responses on the subject matter 'business management'. I compare the contested services to the Opponent's class 35 term *Compilation of statistics* (earlier registrations ii) and iv)). The Opponent's services will, in my view, entail collecting and analysing data. The competing services may,

at times, overlap in purpose to the extent that the conducting surveys is one such method of data collection that might be used in the compilation of statistics. Accordingly, there will be some user overlap. Trade channels will likely be shared; it is plausible for both services to be provided by the same undertaking. I consider the services to be competitive in some instances; a business might deliberate over whether to commission a survey or engage a provider of 'compilation of statistics' on a particular topic in business management. There may be some overlap in the natures of the acts of service given that the compilation of statistics could encompass, inter alia, collecting data by way of a survey. In the light of the foregoing, I find the parties' services to have a medium to high level of similarity.

Contested services: Online retail services for downloadable digital music; Online retail services for downloadable and pre-recorded music and movies

40. I compare the contested services to the Opponent's class 35 term *Provision of an online marketplace for buyers and sellers of goods and services* (earlier registrations ii) and iv)). It is my understanding that 'retail services', in essence, is the bringing together of a variety of goods enabling customers, from the general public, to conveniently view and purchase those goods. The provision of an online marketplace, however, is akin to a virtual 'shopping centre' in which a variety of retailers (or wholesalers) are brought together in one place. In the instant case, the Applicant's services relate to downloadable or pre-recorded music or films. The Opponent's broad term, which is unlimited in terms of the goods (or services) sold, could also entail the selling of pre-recorded music and movies. There will therefore be some competition between the services from the standpoint of a purchaser. The services will differ somewhat in the acts of service entail; bringing together goods versus the bringing together of different retailers. Trade channels will also be distinct; retail of the music and movies will be provided by a single retailer whereas the Opponent's service entail the provision of a marketplace in which several retail and/or wholesale outfits are brought together. All things considered, I find the parties' services to be similar to a medium degree.

Contested services: Online retail services relating to handbags.

41. I compare the contested services to the Opponent's class 35 term *Provision of an online marketplace for buyers and sellers of goods and services* (earlier registrations ii) and iv)). For reasons analogous to those above at [40], I find the parties' services to be similar to a medium degree.

Contested services: *Providing academic course administration services relating to online course registration*

42. The Applicant's services will entail administrative assistance specifically to deal with the online registration of students onto academic courses. In the absence of identification by the Opponent of the closest comparator within its specification, I will compare the contested services to the class 35 term *Updating and maintenance of information in registries* (earlier registrations ii) and iv)). My view is that the updating and maintenance of information is a necessary part of almost any administrative task involving the recording of information, including registration information. Although the Applicant's service will entail enrolment information being updated and stored in some sort of electronic repository, this is, in my view, incidental rather than the core purpose of the service. I consider the core purpose to be the performance of the administrative aspect of online academic enrolment. The competing services will therefore have distinct specific purposes. Users will overlap to the extent that both services may be engaged by the professional public, specifically academic institutions. Trade channel overlap is possible, given that the same undertaking might provide an array of administrative services. The competing services will differ in terms of the acts of service involved. The services are not competitive, neither being substitutable for the other. I do, however, find complementarity; updating/maintenance of information will be important for the online registration of students onto academic courses, and the average consumer may presume both services to originate from the same undertaking. All things considered, I find the parties' services to have no more than a medium level of similarity.

Contested services: *Conducting virtual trade show exhibitions online*

43. The Applicant's services, to my mind, entail the running of trade show exhibitions via online channels, on behalf of third parties. In my view, this will typically involve the online equivalent of what a physical exhibition centre would provide to an in-person trade show; i.e. provision of the digital space, infrastructure to enable the business to show-case its goods/services, management of attendees etc. I compare the contested services to the Opponent's class 35 term *Provision of an online marketplace for buyers and sellers of goods and services* (earlier registrations ii) and iv)). The purposes of the competing services will overlap somewhat: both online marketplaces and trade show exhibitions are intended to showcase commercial offerings. The competing services will diverge in purpose in so far as online market places have the primary purpose of buying and selling, whereas trade shows are tailored to particular industries and tend to have the primary objective of showcasing their offerings and sharing knowledge and expertise with others in the same field. That said, I understand that trade shows also present opportunities to place orders for products, should attendees wish to commit to purchases at the event. The average consumer of the Applicant's services will be businesses seeking to promote their offerings from a virtual 'trade stand'. Users of the Opponent's online marketplace will be buyers and sellers from both the general and professional public. Users will overlap; many businesses promoting themselves at trade fairs will also use online marketplaces to sell. I consider trade channel overlap to be unlikely, although not impossible. I do not consider the services to be realistic alternatives. They are not, therefore, in competition. I do not find complementarity, either; neither service being necessary or particularly important for the other. All things considered, I find the services to have no more than a medium level of similarity.

Contested terms: *Computerized on-line ordering services;* *Online ordering services*

44. I compare the contested services to the Opponent's class 35 term *Procurement services for others [purchasing goods and services for other businesses]* (earlier registrations ii) and iv)). The purpose of the Applicant services is to enable goods and services to be ordered via an online system. It is my understanding that the act of 'procurement' will encompass the act of placing orders, on behalf of third

parties, for goods/services, albeit the service is broader than that; it extends to locating goods/services and often involves inviting tenders. The parties' services will therefore overlap in purpose to a certain extent. Users will also overlap; both will be engaged by the professional public in order to purchase goods/services. Given the difference in the tasks involved in the delivery of each service, the acts of service will be different. Trade channel overlap is, to my mind, unlikely; I do not consider that an undertaking procuring goods/services on behalf of another business would also be the provider of an online ordering service because online ordering services are ordinarily provided by a vendor, not a buyer. In my view, the services can be considered competitive in some instances; a business might deliberate over whether to order directly from a service-provider via that provider's online ordering system, or whether to instead engage a procurement service to 'shop around' for a better deal or invite tenders. The services are not complementary; neither being necessary or important for the other from the perspective of the consumer. I find the services to have no more than a medium level of similarity.

Contested services: *Arranging subscriptions of the online publications of others*

45. In the absence of submissions from the parties as to precisely what this term covers, to my mind, it likely entails arranging for the publications of third parties to be made available to their readership by way of a subscription. Such service, the core feature being 'arranging', is likely to be engaged by the publishers of the publications which are to be held out for subscription to readers. I consider this term to be distinct from the *provision* of subscriptions for online publications, a service which would be aimed at the *consumers* of the publications as opposed to their *publishers*. I compare the contested services to the Opponent's class 35 term *Provision of an online marketplace for buyers and sellers of goods and services* (earlier registrations ii) and iv)). In my view, the purposes of the respective services will overlap to the very broad extent that the ultimate aim of both is to sell; subscriptions to online publications versus goods and services at large. The specific purposes will, however, differ; enabling online publications to be 'sold' in the form of subscriptions (on behalf of publishers) versus the provision of a selling platform for sellers. The acts of service will therefore be different. Users may

overlap to the extent that a publisher might either sell their subscriptions themselves via the Opponent's online marketplace, or engage the Applicant's service to sell subscriptions on their behalf. I therefore consider the services to be competitive. Trade channel overlap is possible, although, in my view, unlikely. I do not find the parties' offerings to be complementary; neither being necessary or particularly important to the other. I find the parties' services to be similar to a medium degree.

Class 36

46. I set out the Opponent's comparison in the table below:⁹

Opponent's marks:	Applicant's mark:
<p>i) UK00003656779</p> <p>Class 36:</p> <p><i>Financial analysis</i></p> <p>ii) UK00003656814</p> <p>Class 35:</p> <p><i>Business management assistance; Outsourcing services [business assistance]; Compilation of statistics; Personnel management consultancy; Advisory services for business management; Compilation of information into computer databases; Systemization of information into computer databases; Mediation and conclusion of commercial transactions</i></p>	<p>Class 36:</p> <p><i>Online business banking services; Online banking services; Online banking; Providing online information about insurance from a computer database or the Internet; Providing online information about reinsurance from a computer database or the Internet.</i></p>

⁹ Opponent's statement of grounds, pages [9] and [10]

for others; Provision of an online marketplace for buyers and sellers of goods and services; Outsourced administrative management for companies; Procurement services for others [purchasing goods and services for other businesses]; Price comparison services; Personnel selection using psychological testing; Administrative assistance in responding to calls for tenders; Corporate communications services; Administrative services for medical referrals; Business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; Business project management services for construction projects; Cost price analysis.

Class 38:

Internet based telecommunication services; Telecommunication services provided via Internet platforms and portals; Streaming of video material on the internet; Streaming of audio material on the internet.

iii) UK00918078446

Class 41:

<p><i>Coaching in economic and management matters.</i></p> <p>iv) WO0000001645824</p> <p>Class 41: <i>Training courses in strategic planning relating to advertising, promotion, marketing and business; analyzing educational tests scores and data for others; business training services; training in communication techniques; arranging professional workshop and training courses; computer education training; computer training; mobile library services; know-how transfer [training]; practical training [demonstration]; educational examination; education information; publication of texts, other than publicity texts; publication of books; correspondence courses; teaching; academies [education]; coaching [training]; advisory and consultancy services relating to coaching services [personal training].</i></p>	
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Contested services: *Online business banking services; Online banking services; Online banking.*

47. In the absence of identification of the most appropriate comparator by the Opponent, I will first compare the contested services to the Opponent's class 36 term *financial analysis* (earlier registration i)). I understand 'financial analysis' to entail assessing the financial health (i.e. profitability) of a business or situation. For example, financial analysis of a business would entail looking at its ability to generate revenue alongside its capacity to satisfy its debts. This purpose is distinct from that of the Applicant's services, which is to facilitate financial transactions or provide finance online. Users will inevitably overlap, given that the vast majority of businesses (and individuals) likely use online banking. Trade channels will be shared; both parties' offerings will be provided by banks and other financial institutions. The nature of the acts of service will be different, given their different functions. The services are not in a competitive relationship, neither being substitutable for the other. There may be complementarity in some instances given that: trade channels are shared; and assessing the financial health of a business or party is important when considering eligibility for a loan, for example. I find the services to have a medium level of similarity.

48. I now compare the contested services to the Opponent's class 41 term *Coaching in economic [...] matters* (earlier registration iii)). The services are in different classes, thus ordinarily precluding a finding of identity. To my mind, the core of the Opponent's service is to develop the capacity of an individual or business to become financially secure/buoyant. This purpose is very different to that of the Applicant's services. Users will overlap. I consider trade channel overlap to be unlikely. The natures of the acts of service will differ. I find the parties' offerings to be neither competitive nor complementary; neither being substitutable or necessary/important for the other. I find the parties' services to be dissimilar. I do not consider that comparison with any other terms would improve the Opponent's position.

Contested services: *Providing online information about insurance from a computer database or the Internet;* *Providing online information about reinsurance from a computer database or the Internet.*

49. The core function of the Applicant's services is the provision of information, about insurance and reinsurance, respectively. I note that none of the terms relied upon by the Opponent are in the field of insurance or reinsurance. However, one of the terms concerns the provision of information, namely the class 41 term *education information* (earlier registration WO0000001645824). Although both parties' offerings entail the provision of information, they relate to different respective subject matters; insurance/reinsurance versus education. It is my view that, taking into account the purposes, users, methods of use, trade channels and natures of the services, together with the matters of competition and complementarity, there is no similarity between the parties' services. In my view, it is difficult to conceive of any service with an online presence that does *not* entail the provision of information of some sort online. For that reason, I do not consider the shared general purpose of 'providing online information' to necessarily support a finding of similarity. The parties' services are dissimilar.

Class 38

50. I set out the Opponent's comparison in the table below:¹⁰

Opponent's marks:	Applicant's mark:
<p>i) UK00003656779</p> <p>Class 42: <i>Server hosting; Off-site data backup; Electronic data storage; Cloud computing; Outsource service providers in the field of information technology; Hosting web portals; Hosting of mobile applications.</i></p> <p>ii) UK00003656814</p>	<p>Class 38: <i>Providing online forums for communication in the field of electronic games; Providing online forums; Providing on-line chat rooms for social networking; Online messaging services; Communication by online blogs; Providing access to multimedia content online; Providing an online</i></p>

¹⁰ Opponent's statement of grounds, page [10].

<p>Class 38: <i>Videoconferencing services; Providing internet chatrooms; Streaming of data; Video-on-demand transmission; Video-on-demand transmission services; Transmission of podcasts; Telecommunication services; Interactive telecommunications services; Internet based telecommunication services; Telecommunication services provided via Internet platforms and portals; Streaming of video material on the internet; Streaming of audio material on the internet.</i></p> <p>iv) WO0000001645824</p> <p>Class 42: <i>Platform as a service [PaaS]; development of computer platforms; server-hosting; off-site data backup; electronic data storage; cloud-computing; outsource service providers in the field of information technology; hosting web portals; hosting of mobile applications; hosting multimedia educational content; hosting of interactive applications; hosting of communication platforms on the internet; quality assessment of coaching; providing scientific</i></p>	<p><i>interactive bulletin board; Providing online facilities for real-time interaction with other computer users.</i></p>
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<i>information in the field of coaching services.</i>	
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Contested services: *Providing online forums for communication in the field of electronic games; Providing online forums; Providing on-line chat rooms for social networking; Online messaging services; Communication by online blogs; Providing an online interactive bulletin board; Providing online facilities for real-time interaction with other computer users.*

51. The Applicant's terms will, in my view, be encompassed by the Opponent's broader class 38 term *Interactive telecommunications services* (earlier registration ii)). The parties' services are therefore identical according to the principle in *Meric*.

52. I now compare the Applicant's terms to the Opponent's class 42 term *hosting of communication platforms on the internet* (earlier registration iv)). Broadly speaking, the contested terms entail the provision of the fundamental infrastructure to enable communications via various channels, whereas I understand the Opponent's services to encompass the provision of the website/portal (i.e. the particular electronic platform) through which online communication occurs. I consider the Applicant's offering to be a service typically provided by an internet service provider, whereas the Opponent's services might be offered by a software provider. The respective offerings will coincide in purpose to the broad extent that both facilitate communication via online channels in some way. Users will necessarily overlap given that the Opponent's online communication platforms will be likely be underpinned by the Opponent's telecommunications services. I consider trade channel overlap to be unlikely. Based on my experience and knowledge as an ordinary member of the public, it is my understanding that 'telecommunications' services are typically provided by 'internet service providers', undertakings which do not typically also host online communication platforms. The respective acts of service will differ; the provision of fundamental infrastructure to enable interaction in the electronic 'realm' versus the provision of a particular online platform. The parties' services are not in a competitive relationship, neither being substitutable for the other. I do not find complementarity. Although the Applicant's service will be

necessary for the Opponent's service, the average consumer would unlikely presume both offerings to originate from the same undertaking. I find the parties' services to be similar to a low degree.

Contested services: *Providing access to multimedia content online*

53. I find that the contested services will be encompassed by the Opponent's broader class 38 term *Internet based telecommunication services* (earlier registration ii)). The parties' services are therefore identical according to the principle in *Meric*.

54. I now compare the contested services to the Opponent's class 42 *hosting multimedia electronic content* (earlier registration iv)). For reasons analogous to those given above at [52], I find the parties' services to be similar to a low degree.

Class 41

55. I set out the Opponent's comparison in the table below:¹¹

Opponent's marks:	Applicant's mark:
ii) UK00003656814 Class 38: <i>Videoconferencing services; providing internet chatrooms; streaming of data; video-on-demand transmission; video-on-demand transmission services; transmission of podcasts; telecommunication services; interactive telecommunications services; internet based telecommunication services; telecommunication</i>	Class 41: <i>Providing online training seminars; Providing online games; Provision of online training; Conducting training sessions on physical fitness online; Career counselling and coaching; Providing online courses of instruction; Personal coaching [training]; Conducting training courses relating to nutrition online; Sports tuition, coaching and instruction; Conducting training</i>

¹¹ Opponent's statement of grounds, pages [10] – [11]

<p><i>services provided via internet platforms and portals; streaming of video material on the internet; streaming of audio material on the internet.</i></p>	<p><i>courses relating to diet online; Life coaching (training); Providing online video games; Sports coaching services; Distance learning services provided online; Training or education services in the field of life coaching; Providing an online computer game; Sports coaching; Online sports betting services; Personal coaching services in the field of ballet; Provision of information on fitness training via an online portal;</i></p>
<p>iii) UK00918078446 Class 41: <i>Coaching in economic and management matters.</i></p>	<p><i>Online computer game services; Providing online information on computer and video game strategies; Providing online entertainment in the nature of game tournaments; Esports coaching; Providing on-line video games; Coaching [training]; On-line game services; Online digital publishing services; Providing online publications, not downloadable; Providing online virtual guided tours; Provision of information relating to physical training via an online web site;</i></p>
<p>iv) WO0000001645824 Class 41: <i>Training courses in strategic planning relating to advertising, promotion, marketing and business; analyzing educational tests scores and data for others; business training services; training in communication techniques; arranging professional workshop and training courses; computer education training; computer training; production of training films; arranging and conducting of workshops [training]; conducting of instructional seminars; arranging and conducting of seminars; personal training; electronic publishing services; providing electronic publications; arranging and conducting of in-person educational forums; providing online videos, not downloadable; tutoring; vocational guidance [education or training advice];</i></p>	<p><i>Providing on-line interactive computer games; Providing online music, not downloadable; Provision of online tutorials; Provision of online computer games; Online gaming services; Provision of online information relating to game players;</i></p>

<p><i>mobile library services; know-how transfer [training]; practical training [demonstration]; educational examination; education information; publication of texts, other than publicity texts; publication of books; correspondence courses; teaching; academies [education]; coaching [training]; advisory and consultancy services relating to coaching services [personal training].</i></p>	<p><i>Providing on-line computer games; Online education services; Providing online electronic publications; Providing online videos, not downloadable; Coaching services; Online academic library services; Online gambling services; Providing on-line information and news in the field of employment training; Educational services in the nature of coaching; Providing online electronic publications, not downloadable, in the field of music; Providing online electronic publications in the field of music, not downloadable; Online casino services; Providing an on-line computer game; Provision of information relating to physical education via an online web site; Publication of online reviews in the field of entertainment; Providing online comic books, not downloadable; Provision of an online magazine featuring information in the field of computer games; Political speech training and coaching; Game services provided online from a computer network; Providing online electronic publications, not downloadable; Providing information about online education; Provision of online information in the</i></p>
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	<p><i>field of computer games entertainment; Providing training courses on business management; Political debate training and coaching; Online game services through mobile devices; Online research library services; Providing on-line non-downloadable video content; Provision of education on-line from a computer database or via the internet or extranets; Provision of information relating to physical exercises via an online web site; Providing on-line publications; Providing online newsletters in the fields of sports entertainment; Providing on-line music, not downloadable; Computerised training in career counselling; Arranging professional workshop and training courses; Providing on-line publications (not downloadable); Providing on-line publications (non-downloadable); Conducting of educational courses in business management; Providing online entertainment in the nature of game shows.</i></p>
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Contested services: Providing online training seminars; Provision of online training; Providing online courses of instruction; Distance learning services provided online;

Provision of online tutorials; Online education services; Provision of education on-line from a computer database or via the internet or extranets;

56. To the extent that the Applicant's services cover training/learning for business, the contested term will be encompassed by the Opponent's broader terms *business training services* (earlier registration iv)) and *coaching in economic and management matters* (earlier registration iii)). The parties' services are therefore identical according to the principle in *Meric*.

57. I now consider the Applicant's term against the class 38 terms relied upon by the Opponent under earlier registration ii). Bearing in mind the purposes, users, trade channels, and natures of the respective acts of service, together with the matters of competition and complementarity, I do not find the Applicant's services to have any similarity to the Opponent's class 38 terms. Whilst I recognise that online training seminars would be impossible without the existence of the Opponent's *telecommunications services*, this necessity is, in my view, of little weight because a vast amount of activity, both professionally and generally, is dependent on the internet. The core functions of the parties' offerings are distinct. I find the parties' services to be dissimilar.

Contested services: Providing training courses on business management; Conducting of educational courses in business management; Providing on-line information and news in the field of employment training

58. The contested terms will be encompassed by the Opponent's *business training services* (earlier registration iv)). The parties' services are therefore identical according to the principle in *Meric*.

59. I now consider the contested services against the Opponent's class 38 terms under earlier registration ii). For reasons analogous to those provided at [57], I do not consider there to be any similarity between the parties' services.

Contested services: Arranging professional workshop and training courses

60. The Applicant's services will be encompassed by the Opponent's term *arranging and conducting of workshops [training]* (earlier registration iv)). The parties' services are therefore identical according to the principle in *Meric*.

61. I now consider whether the contested terms bear any similarity to the Opponent's class 38 terms under earlier registration ii). Bearing in mind the purposes, users, trade channels, and natures of the respective acts of service, together with the matters of competition and complementarity, I do not find the Applicant's services to have any similarity to the Opponent's class 38 terms – they are dissimilar.

Contested services: *Career counselling [...]*

62. The Applicant's services will, in my view, be encompassed by the Opponent's term *vocational guidance [education or training advice]* (earlier registration iv)). The parties' services are therefore identical according to the principle in *Meric*.

63. I now consider the Applicant's terms against the Opponent's class 38 terms under earlier registration ii). My comments above at [61] also apply here. The parties' services are dissimilar.

Contested services: *career [...]* coaching; *Personal coaching [training]*; *Life coaching (training)*; *Sports coaching services*; *Training or education services in the field of life coaching*; *Sports coaching*; *Personal coaching services in the field of ballet*; *Political speech training and coaching*; *Political debate training and coaching*; *Sports tuition, coaching and instruction*; *Esports coaching*

64. I consider the terms 'coaching', 'training' and 'tutoring' to be synonymous. The Applicant's services will be encompassed by the Opponent's term *coaching [training]* (earlier registration iv)). The parties' services are therefore identical according to the principle in *Meric*.

65. I now consider the Applicant's terms against the Opponent's class 38 terms under earlier registration ii). My comments above at [61] also apply here. The parties' services are dissimilar.

Contested services: *Coaching [training]; Coaching services; Educational services in the nature of coaching*

66. The Applicant's terms are synonymous with the Opponent's term *coaching [training]* (earlier registration iv)). The parties' services are therefore identical.

67. I now consider the Applicant's terms against the Opponent's class 38 terms under earlier registration ii). My comments above at [61] also apply here. The parties' services are dissimilar.

Contested services: *Conducting training sessions on physical fitness online; Conducting training courses relating to nutrition online; Conducting training courses relating to diet online; Computerised training in career counselling*

68. The Applicant's terms will be encompassed by the Opponent's term *coaching [training]* (earlier registration iv)). The parties' services are therefore identical according to the principle in *Meric*.

69. I now consider the Applicant's terms against the Opponent's class 38 terms under earlier registration ii). For reasons analogous to those given at [57], I find the parties' services to be dissimilar.

Contested services: *Online digital publishing services*

70. The Applicant's services are synonymous with the Opponent's *electronic publishing services* (earlier registration iv)). The services are therefore identical.

71. I now consider the Applicant's terms against the Opponent's class 38 terms under earlier registration ii). For reasons analogous to those given at [57], I find the parties' services to be dissimilar.

Contested services: *Providing online publications, not downloadable;*¹² *Providing online electronic publications; Providing online electronic publications, not*

¹² This term appears twice in the Opponent's specification.

downloadable, in the field of music; Providing online electronic publications in the field of music, not downloadable; Provision of an online magazine featuring information in the field of computer games; Providing online comic books, not downloadable; Providing on-line publications; Providing online newsletters in the fields of sports entertainment; Providing on-line publications (not downloadable); Providing on-line publications (non-downloadable)

72. The Applicant's terms will be encompassed by the Opponent's term *providing electronic publications* (earlier registration iv)). The parties' services are therefore identical according to the principle in *Meric*.

73. I now consider the Applicant's terms against the Opponent's class 38 terms under earlier registration ii). For reasons analogous to those given at [57], I find the parties' services to be dissimilar.

Contested services: *Providing online videos, not downloadable; Providing on-line non-downloadable video content; Providing online entertainment in the nature of game shows.*

74. The Applicant's terms will be encompassed by the Opponent's class 41 term *providing online videos, not downloadable* (earlier registration iv)). The parties' services are therefore identical according to the principle in *Meric*.

75. I now compare the contested terms to the Opponent's class 38 term *streaming of video material on the internet* under earlier registration ii). It is my understanding that the streaming of video on the internet, in simple terms, is the process according to which video content is delivered online, enabling consumers to view it on electronic devices. Despite the competing services being in different classes according to the Nice system, it is my view that it is difficult to conceive of providing non-downloadable video material without also necessarily 'streaming' it. I consider the services to be, essentially, two aspects of the same offering. Whereas the *streaming* of the video content might, strictly speaking, refer to the 'mechanism' of transmission, this aspect is, to my mind, inextricably bound up with the act of

providing the video content online. If I am precluded from finding the services to be identical, then they are highly similar.

Contested services: *Publication of online reviews in the field of entertainment*

76. I compare these services to the Opponent's term *promotion, marketing and business* (earlier registration iv)). The core purpose of the Opponent's services is to promote and publicise goods/services or causes with the aim of generating or awareness, as the case may be. My view is that the parties' offerings will overlap in purpose to the extent that, generally, online reviews are published in order to generate interest in the subject matter of the review. Users will likely overlap; a consumer seeking to promote an entertainment event might engage the Opponent to promote it and/or engage the Applicant to publish a review of the event. Trade channels will, in my view, likely be separate; publication of entertainment reviews will likely be provided by online magazines or 'guides'/directories of events, whereas the Opponent's services will likely be provided by advertising/marketing companies. Although both parties' offerings will be intended to 'spread the word' about a particular entertainment/event, I do not consider them to be realistic alternatives for one another. A marketing or advertising service, to my mind, entails a wider-ranging campaign than the publication of a review. I do not consider the services to be in competition. Given my finding of distinct trade channels, I do not find complementarity, either. The natures of the respective acts of services will often differ. All things considered, I find the parties' services to have a medium level of similarity.

77. I now consider the Applicant's terms against the Opponent's class 38 terms under earlier registration ii). For reasons analogous to those given at [57], I find the parties' services to be dissimilar.

Contested services: *Online sports betting services;* *Online gambling services;*
Online casino services

78. Bearing in mind the purposes, users, trade channels, and natures of the parties' respective acts of service, together with the matters of competition and

complementarity, I do not find the Applicant's services to have any similarity to the Opponent's terms. Whilst I recognise that online gambling/betting/casino services (indeed *any* online services) would be impossible without the existence of the Opponent's *telecommunications services*, this necessity is, in my view, of little weight because a vast amount of activity, both professionally and generally, is dependent on the internet. The core functions of the parties' offerings are distinct. I find the parties' services to be dissimilar.

Contested services: *Providing online games; Providing online video games; Providing an online computer game; Online computer game services; Providing on-line video games; On-line game services; Providing on-line interactive computer games; Provision of online computer games; Online gaming services; Providing on-line computer games; Providing an on-line computer game; Game services provided online from a computer network; Online game services through mobile devices; Providing online entertainment in the nature of game tournaments*

79. The Applicant's services entail the provision of online games of some sort. I compare these terms to the Opponent's class 38 term *interactive telecommunications services* (earlier registration ii). I note from the Nice Classification system that class 38 includes mainly services that allow at least one party to communicate with another. The Explanatory Note states that 'This Class does not include, in particular: [...] content or subject matter that may be contained in the communication activity'. The specific purposes of the respective services will be different: the facilitation of interaction in the digital 'realm' (Opponent) versus the provision of online video games. Users will necessarily overlap given that any online gaming depends on telecommunications 'infrastructure' being in place to support it. Trade channels will, to my mind, be distinct; a provider of telecommunications would unlikely also provide gaming services. The parties' offerings will entail different acts of service. There is no competition; neither service being substitutable for the other. I do not find complementarity, either; although the Opponent's telecommunication services will be necessary for the Applicant's services, the average consumer would unlikely attribute them to the same undertaking. In the light of the foregoing, I find the parties' services to be dissimilar.

80. I now compare the Applicant's services to the Opponent's Class 41 services under earlier registration registration iv). I note that there are no gaming-related services in the Opponent's specification. Bearing in mind the purposes, users, trade channels, and natures of the respective acts of service, together with the matters of competition and complementarity, I do not find the Applicant's services to have any similarity to the Opponent's services – they are dissimilar.

Contested services: *Providing information about online education; Provision of information relating to physical education via an online web site*

81. The Applicant's terms will be encompassed by the Opponent's class 41 term *education information* (earlier registration iv)). The parties' services are therefore identical according to the principle in *Meric*.

82. I now consider the Applicant's terms against the Opponent's class 38 terms under earlier registration ii). For reasons analogous to those given at [57], I find the parties' services to be dissimilar.

Contested services: *Provision of information on fitness training via an online portal; Provision of information relating to physical training via an online web site; Provision of information relating to physical exercises via an online web site*

83. I compare the Applicant's terms to the Opponent's class 41 term *personal training* (earlier registration iv)). I consider 'personal training' to include physical/fitness training. The competing services will overlap in purpose to the extent that both will entail instructing the consumer in fitness/physical training. Where the respective purposes may diverge somewhat is in the fact that 'personal training' entails a broader range of instruction; i.e. practical instruction ('know how') as well as providing information. Users and trade channels will necessarily overlap. There will be differences in the acts of service; the Applicant's offering will be delivered online, whereas the Opponent's services will typically be provided in person/'one-to-one'. Although both parties' services will involve the provision of information on fitness/physical exercise, I do not consider the services to be commercially realistic alternatives for one another. I find that they will unlikely be in competition. However,

I do find complementarity; my view is that online fitness information will be useful to the average consumer attending fitness sessions with a personal trainer, and they will likely be presumed to originate from the same undertaking. I find the parties' services to have at least a medium level of similarity.

84. I now consider the contested services against the Opponent's class 38 terms under earlier registration ii). For reasons analogous to those provided at [57], I do not consider there to be any similarity between the parties' services – they are dissimilar.

Contested services: *Online academic library services; Online research library services*

85. I find that the Applicant's terms will be encompassed by the Opponent's class 41 term *providing electronic publications* (earlier registration iv)). The parties' services are therefore identical according to the principle in *Meric*.

86. I now consider the contested services against the Opponent's class 38 terms under earlier registration ii). For reasons analogous to those provided at [57], I do not consider there to be any similarity between the parties' services – they are dissimilar.

Contested services: *Providing online virtual guided tours*

87. I compare the contested term to the Opponent's class 41 term *providing online videos, not downloadable* (earlier registration iv)). The purposes of the services will overlap to the extent that both entail the provision of moving pictures, albeit the Applicant's moving pictures are by way of a guided tour around a location/building. Although both can be said to provide video content of some sort, my view is that the Applicant's services will likely have an interactive quality in that the user is able to virtually navigate around the location being explored, whereas mere videos do not ordinarily have this feature. Users will overlap, albeit to the fairly unremarkable extent that many consumers watch video content online. The respective acts of service will differ to the extent that the purposes and nature of the online viewing

experience diverge (interactive tour versus 'passive' viewing of video content). Trade channel overlap is possible, although, to my mind, unlikely typical. Undertakings whose core business is the provision of online videos (feature films being one example) will not, in my view, typically also provide virtual guided tours of attractions, for example. The parties' offerings are neither competitive nor complementary; neither being substitutable nor necessary for the other from the standpoint of the average consumer. All things considered, I find the parties' services to be similar to a low degree.

88. I now consider the contested services against the Opponent's class 38 terms under earlier registration ii). For reasons analogous to those provided at [57], I do not consider there to be any similarity between the parties' services – they are dissimilar.

Contested services: Providing online music, not downloadable; Providing on-line music, not downloadable

89. I compare the contested term to the Opponent's class 41 term *providing online videos, not downloadable* (earlier registration iv)). The core purposes of the parties' respective services are: the provision of music (Applicant) or video (Opponent) via online channels/platforms. I consider the provision of online videos to encompass music videos, in which case, music and video will be 'two sides of the same coin'. Users and trade channels will therefore overlap. I nevertheless recognise that the overlap will not be total, because many providers of music will provide the audio content without any accompanying video. The services will be in a competitive relationship to the extent that an average consumer might deliberate over whether to listen to a piece of music by way of purely audio content, or whether instead to look up the music video on an online video platform. I do not, however, find complementarity. Although music videos necessarily combine music and video, neither is necessary or particularly important for the other from the perspective of the average consumer; that is to say, a consumer would not find a service providing music purely in audio form useful or important to the service of providing music videos (or indeed any videos). In the light of the foregoing, I find the parties' services to be highly similar.

90. I now consider the contested services against the Opponent's class 38 terms under earlier registration ii). For reasons analogous to those provided at [57], I do not consider there to be any similarity between the parties' services – they are dissimilar.

Contested services: Providing online information on computer and video game strategies; Provision of online information relating to game players; Provision of online information in the field of computer games entertainment

91. Broadly speaking, the Applicant's services entail providing information on the subject of gaming. I compare these services to the Opponent's class 41 term *Education information* (earlier registration iv)). Given the breadth of the Opponent's term, it will cover information provided online as well as via other media. Both parties' offerings entail the provision of information, albeit in disparate subject areas. Given that information can be provided on any subject at all, to find that the services overlap in purpose at such a high level of generality is, in my view, not particularly significant. In my view, the services will have very different specific purposes by virtue of the subject areas of gaming and education being distant from one another. Overlap in user is unremarkable given that a vast number of consumers might read information on education of some sort, irrespective of what information on other subjects they might read about online. Trade channels will most likely be separate. The acts of service will be similar to the unremarkable extent that both entail the provision of information. The services are neither competitive nor complementary, neither being substitutable nor necessary for the other. All things considered, I find the parties' services to be dissimilar. I do consider that comparison against any other class 41 term would improve the Opponent's position.

92. I now consider the contested services against the Opponent's class 38 terms under earlier registration ii). For reasons analogous to those provided at [57], I do not consider there to be any similarity between the parties' services – they are dissimilar.

Class 42

93. I set out the Opponent's comparison as follows:¹³

Opponent's marks:	Applicant's mark:
<p>i) UK00003656779 Class 42: <i>Server hosting; Off-site data backup; Electronic data storage; Cloud computing; Outsource service providers in the field of information technology; Hosting web portals; Hosting of mobile applications.</i></p> <p>iv) WO0000001645824 Class 38: <i>Videoconferencing services; providing internet chatrooms; streaming of data; video-on-demand transmission; video-on-demand transmission services; transmission of podcasts; telecommunication services; interactive telecommunications services; internet based telecommunication services; telecommunication services provided via internet platforms and portals; streaming of video material on the</i></p>	<p>Class 42: <i>Hosting online web facilities for others for sharing online content; Hosting of digital content online; Hosting online facilities for conducting interactive discussions; Providing online non-downloadable software for use in communication; Hosting online web facilities for others for conducting interactive discussions; Providing online, non-downloadable software; Programming of software for online advertising; Hosting on-line web facilities for others for managing and sharing on-line content; Programming of software for evaluating customer behaviour in online shops; Providing temporary use of online non-downloadable investment software; Hosting an online website for creating and hosting micro websites for businesses; Hosting on-line facilities for conducting interactive discussions; Providing temporary use of online non-downloadable software; Providing</i></p>

¹³ Opponent's statement of grounds, pages [12].

<p><i>internet; streaming of audio material on the internet.</i></p>	<p><i>on-line non-downloadable software for database management; Creating electronically stored web pages for online services and the internet; Providing temporary use of on-line non-downloadable software for web site development; Providing on-line support services for computer program users; Providing temporary use of on-line non-downloadable software for database management; Providing online non-downloadable software for use in supply chain management; Providing temporary use of on-line non-downloadable software for inventory management; Providing temporary use of on-line non-downloadable software development tools; Providing temporary use of on-line non-downloadable software for the management of information.</i></p>
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Contested services: Hosting online web facilities for others for sharing online content; Hosting of digital content online; Hosting online facilities for conducting interactive discussions; Hosting online web facilities for others for conducting interactive discussions; Hosting on-line web facilities for others for managing and sharing on-line content; Hosting an online website for creating and hosting micro websites for businesses; Hosting on-line facilities for conducting interactive discussions

94. I consider that the Applicant's services will be encompassed by the Opponent's broader class 42 term *Hosting web portals* (earlier registration i)). The parties' services are therefore identical according to the principle in *Meric*.

95. I now compare the Applicant's services to the Opponent's services in class 38 under registration iv). For reasons analogous to those provided at [57], I do not consider there to be any similarity between the parties' services – they are dissimilar.

Contested services: *Providing online non-downloadable software for use in communication; Providing online, non-downloadable software; Programming of software for online advertising; Programming of software for evaluating customer behaviour in online shops; Providing temporary use of online non-downloadable investment software; Providing temporary use of online non-downloadable software; Providing on-line non-downloadable software for database management; Creating electronically stored web pages for online services and the internet; Providing temporary use of on-line non-downloadable software for web site development; Providing on-line support services for computer program users; Providing temporary use of on-line non-downloadable software for database management; Providing online non-downloadable software for use in supply chain management; Providing temporary use of on-line non-downloadable software for inventory management; Providing temporary use of on-line non-downloadable software development tools; Providing temporary use of on-line non-downloadable software for the management of information.*

96. I compare these services to the Opponent's class 42 term *cloud computing* (earlier registration i)). It is my understanding that 'cloud computing' refers to the delivery of computing services over the internet. The term is broad and will encompass the full gamut of IT services capable of being delivered within the digital 'realm', including the provision of, *inter alia*: data storage, software, servers, programming. My view is that the Applicant's services will be encompassed by the Opponent's

broad term. The parties' services are therefore identical according to the principle in *Meric*.

97. I now compare the Applicant's services to the Opponent's services in class 38 under registration iv). For reasons analogous to those provided at [57], I do not consider there to be any similarity between the parties' services – they are dissimilar.

98. Some similarity between the parties' goods and services is essential in order to find a likelihood of confusion between the parties' marks. In the case of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

'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'.

99. The oppositions against the terms that I have found to have no similarity to goods/services under any of the four earlier registrations therefore fail at this point. For ease of reference, those terms are:

Class 36:	Contested services: <i>Providing online information about insurance from a computer database or the Internet; Providing online information about reinsurance from a computer database or the Internet.</i>
Class 41:	<i>Online sports betting services; Online gambling services; Online casino services; Providing online games; Providing online video games; Providing an online computer game; Online</i>

	<p><i>computer game services; Providing on-line video games; On-line game services; Providing on-line interactive computer games; Provision of online computer games; Online gaming services; Providing on-line computer games; Providing an on-line computer game; Game services provided online from a computer network; Online game services through mobile devices; Providing online entertainment in the nature of game tournaments; Providing online information on computer and video game strategies; Provision of online information relating to game players; Provision of online information in the field of computer games entertainment</i></p>
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100. The oppositions remain live for the remaining goods and services, set out at Annexe 1 to this decision.

Average consumer and the purchasing act

101. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word “average” denotes that the person is typical. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

Class 9

102. The parties’ relevant goods comprise pieces of software, some very broad and general (e.g. the Opponent’s *Downloadable software applications*), and others with more specific functions and/or for use in particular fields of activity. I consider users of the more general goods to be predominantly the general public, although I recognise that they may also be used by the professional public. The remaining goods are, in my view, typically purchased by the professional public. There may

nevertheless be a smaller number of purchasers from the general public. In my view, the purchasing act will be primarily visual in nature; the consumer having first encountered the goods, *inter alia*, online, in a physical store, or advertised on television or in printed matter. I recognise that, for some purchases, there will be an aural aspect. For example, a business seeking to purchase a suite of software for designing online advertising might not conclude a transaction until it has discussed its needs with the supplier. The level of attention paid during the purchasing process will depend on the particular software purchased. Specialist software, for example, *Computer software for the administration of on-line games and gaming*, purchased by professionals in the field of 'gaming', will likely be moderately expensive and purchased with a fairly high level of care. A somewhat more 'general' software, such as that for online messaging, will likely be less costly, and may be purchased with no more than a medium level of attention. I find that the goods will likely be purchased with a level of attention ranging from medium to high.

Class 35

103. I note that some of the relevant services in this class are specialised and will likely be engaged by businesses or other professional organisations, rather than the general public. Examples include, *inter alia*: *Corporate communications services; compilation of statistics*. I find the purchasing act to be primarily visual; the prospective purchaser likely to have first encountered the service-provider online, in printed matter, advertising, or perhaps having noticed the physical premises in the street. There will likely be an aural aspect to the purchasing process in some cases, e.g. by way of word-of-mouth recommendation. My view is that the briefs/projects for which these services will be required will be specific to each purchaser and will therefore be purchased with a measure of prudence. I consider that most transactions would conclude after discussion with the service-provider, rather than being purchased casually at the 'click of a mouse'. I find that the average consumer would pay a fairly high level of attention when engaging the services.

104. I consider that the average consumer of the class 35 services which, essentially, entail the provision of online directories or guides of businesses/buyers and sellers will be predominantly the general public, albeit many business customers will also use them. The purchasing act will necessarily be primarily visual, the services being encountered and engaged within the online 'realm'. I do not discount an aural aspect where a consumer seeks out a particular directory after hearing a recommendation. My view is that when a consumer (whether general or professional) searches for a business or seller etc, as the case may be, they will unlikely pay particular attention to the undertaking providing that directory/guide because they will be more concerned with the business/seller, that they are searching for. I find that the average consumer will likely pay a fairly low level of attention as far as the provider of the directory/guide is concerned. These observations are more or less applicable to the term *Providing online auction services*, in so far as the service is engaged by consumers as *purchasers* of the goods being auctioned. However, where the average consumer is a *seller* seeking an auction service, I consider that the level of attention paid will likely be higher: at least medium and, in some cases, high.

105. I now consider the services whose essential purpose is providing advertising, marketing or promotional services for third parties. I include in this 'group' the term *Online community management services*. These services will most likely be engaged by the professional public, e.g. businesses seeking to promote their goods and services in order to boost sales, or other organisations seeking to raise awareness of a cause. It is my understanding that these services are often moderately expensive. The purchasing act will be primarily visual to the extent that the services will be likely be first encountered online, or in adverts on television or in printed matter. The purchaser will likely pay at least a medium level of attention when deciding whether to engage the service; a high level of attention in some instances.

106. I now turn to the online retail services (for, variously, music, films and handbags) and *computerized on-line ordering services; ordering services*. The average consumer of these services will be the general public. The purchasing act will likely be primarily visual; the retailers, in many cases, being first encountered

online via advertising or after happening upon their online stores while browsing the internet. I acknowledge that there will be an aural component to the purchasing process where, for example, a consumer searches for a particular online store having first heard about it by way of recommendation or through 'word of mouth'. The retail services will be engaged by the acts of, *inter alia*: browsing the retailer's online offering; searching for particular music pieces/tracks, films or handbags. Given that engaging a retail service can include merely casually browsing the range of goods 'curated' and offered for sale, my view is that the level of attention paid by the average consumer will often be fairly low. In some cases, a higher level of attention (perhaps medium) may be paid; for example, when coveting a particular 'high end' handbag or obscure piece of music or film.

107. I consider *online business networking services* and *virtual trade show exhibitions* to be engaged predominantly by businesses seeking to, respectively, make professional contacts and promote their products/services to others in the industry. The purchasing act will likely be primarily visual, the services typically being first encountered online, for example, by way of advertisements in trade publications. My view is that, in many instances, the services will be engaged after recommendations from other professionals or 'buzz' within an industry or field. I consider that consumers would display a measure of care when engaging these services. For example, a business seeking to have a virtual 'trade stand' to promote its offering might be particularly interested in which other businesses might exhibit and/or attend, when deliberating over whether participation in a particular exhibition would be a commercially worthwhile opportunity. In this case, a high level of attention might be paid when deciding whether to engage the service. It is my understanding that online business networking services will encompass 'social media-type' platforms such as LinkedIn, as well as other perhaps more specialised, networking platforms/forums specific to a trade, field or 'calibre' of professional. My view is that the level of attention paid might depend on whether the networking platform is free, or, whether, for example, it entails subscribing to a 'premium' membership allowing various 'enhanced' levels of services, such as access to a certain pool of contacts, to give one example. I find that users of these services will likely pay medium or high levels of attention.

108. I now consider *Providing academic course administration services relating to online course registration*. To my mind, these services will be engaged by the professional public, i.e. institutions providing academic courses. The purchasing act will likely be primarily visual with the services being advertised online or in printed matter. In some instances, there may be an aural aspect where the services are engaged as a result of a recommendation or 'word of mouth'. I find that a high level of attention will likely be paid during the purchasing act because the administration of an enrolment system is crucial to the running of any academic institution.

109. I now consider *Procurement services for others [purchasing goods and services for other businesses]*. The average consumer of these services will be the professional public. The purchasing act will likely be primarily visual in nature; the service-provider will likely be encountered online or in online and printed advertisements. In some instances, there will also be an aural aspect to the purchasing process by way of recommendations and 'word of mouth'. The service would likely be engaged with some measure of care because it concerns obtaining goods and services important for operating a business. I find that a medium to high level of attention would be paid when engaging the service.

110. The average consumer of *Arranging subscriptions of the online publications of others* will be the professional public, i.e. publishers. The purchasing act will be primarily visual, with an aural aspect in some cases, in the manner described above at [109]. My view is that the purchase would likely be a reasonably prudent one. Relevant considerations would likely include what particular tasks were included in the 'package' of services, for example, how would the subscriptions be marketed/promoted? I find that the average consumer would pay a medium to high level of attention when engaging the service.

Class 36

111. The average consumer of the relevant class 36 services will be both the general and professional public. The purchasing act will likely be primarily visual to the extent that consumers will likely first encounter the service providers online or

having seen their premises on the street. There will be an aural aspect to the purchasing process where service providers are consulted for advice prior to concluding a transaction or where recommendations are made 'by word of mouth'. It is my view that when engaging services of a financial nature, the average consumer will often display some measure of prudence. The level of attention paid will likely vary depending on the service sought. For example, an individual seeking to open a current account with a bank might pay a medium level of attention. A business seeking a financial analysis might pay a high level of attention.

Class 38

112. Broadly speaking, the relevant services are concerned with communication online; i.e. internet 'chatrooms' and other electronic forums where users can converse with others in real time. The average consumer will comprise both the general and professional public (albeit the services in the field of electronic games will, to my mind, in almost all cases, be used by the general public). It is my understanding that some of these services will be free, whereas others will be purchased on a subscription basis. The purchasing act will be primarily visual, with the services encountered online or seen advertised in printed matter. An aural aspect to the purchasing process cannot be discounted. The level of attention paid will likely vary. A consumer might pay a fairly low level of attention when 'signing in' to an internet chatroom. On the other hand, a business seeking to subscribe to a suite of software to enable workplace collaboration might make a more considered purchase, in which case a high level of attention might be paid.

Class 41

113. I will first consider the services which entail the provision of videos or music. The purchasing act will be primarily visual, in some instances having an aural aspect, in the manner described above at [112]. Some of these services will be freely available online, in which case I consider that a fairly low level of attention will likely be paid. On the other hand, some services will be engaged on a subscription basis, perhaps costing around £30 to £40 per month. In this case, I

consider that at least a medium level of attention will likely be paid during the purchasing act.

114. The remaining relevant class 41 services comprise the provision of career counselling, various educational services, workshops or tutoring services, and information about them, as well as the provision of online publications. My view is that these services would be engaged by both the general and professional public. The purchasing act will likely be primarily visual, the service-providers encountered, *inter alia*: online, in advertisements and printed matter. I acknowledge an aural aspect to the purchasing process in the case of recommendation or ‘word of mouth’. The level of attention will vary depending on the particular service engaged. For example, enrolling for an online yoga class might entail a fairly low level of attention. On the other hand, an aspiring athlete aiming to perform at a high level will likely take a high level of care in finding a suitable coach, in which case a high level of attention may be paid.

Class 42

115. Many of the services are fairly specialised and would, in my view, unlikely be engaged by the general consumer. It is convenient to set out the services as follows:

Average consumer likely to be the professional public (general consumers unlikely):	Average consumer comprises both the general and professional public:
<i>Programming of software for online advertising; Programming of software for evaluating customer behaviour in online shops; Providing temporary use of online non-downloadable investment software; Hosting an online website for creating and hosting micro websites for</i>	<i>Hosting online web facilities for others for sharing online content; Hosting of digital content online; Hosting online facilities for conducting interactive discussions; Providing online non-downloadable software for use in communication; Hosting online web facilities for others for conducting</i>

<p><i>businesses; Providing on-line non-downloadable software for database management; Creating electronically stored web pages for online services and the internet; Providing temporary use of on-line non-downloadable software for web site development; Providing temporary use of on-line non-downloadable software for database management; Providing online non-downloadable software for use in supply chain management; Providing temporary use of on-line non-downloadable software for inventory management; Providing temporary use of on-line non-downloadable software development tools; Providing temporary use of on-line non-downloadable software for the management of information.</i></p>	<p><i>interactive discussions; Providing online, non-downloadable software; Hosting on-line web facilities for others for managing and sharing on-line content; Hosting on-line facilities for conducting interactive discussions; Providing temporary use of online non-downloadable software; Providing on-line support services for computer program users; hosting of communication platforms on the internet; cloud computing</i></p>
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116. I consider that the purchasing act will be primarily visual in nature the average consumer likely to have encountered the service provider on a website or directory of services. I recognise that there will also be an aural aspect to the purchasing process, by way of recommendation or ‘word of mouth’. In many cases; e.g. the purchase of a specialist software package of services for use in supply chain management, the commitment to transact might be made only after advice or consultation with the service provider. I find that the attention level will vary according to the service engaged. For example, a one-off purchase of temporary use of a piece of online software might be purchased with no more than a medium level of attention. A subscription to the service *Providing on-line non-downloadable software for database management*, a fairly specific service used for business

purposes, on the other hand, will likely be a more careful purchase. In this case, the average consumer, a professional, might pay a high level of attention. My view is that the services that I have identified as typically engaged by the professional public will likely be purchased with a fairly high level of attention. For the more 'general' hosting and software services, I find that the average consumer may pay no more than a medium level of attention.

Comparison of the marks

117. 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:

118. The marks to be compared are as follows:

Opponent's marks:	Applicant's marks:
i) and ii): CoachHub	<u>OP440717:</u> COACHCUBE
iii) and iv): 	<u>OP440719:</u> 

OP440717

Overall impression of the marks

The earlier marks:

119. Earlier registrations i) and ii) concern the same mark. The mark is a word mark¹⁴ comprising the single word element 'CoachHub' rendered in a plain typeface. The 'H' of the 'Hub' portion of the word is presented in uppercase, which, in my view, accords some measure of separation between 'Coach' and 'Hub', in spite of their coalescence. The overall impression resides solely in the word itself.

120. Earlier registrations iii) and iv) concern the same mark. The mark is a figurative mark comprising both text and a device. The word element 'CoachHub' is rendered in a plain typeface, which appears slightly emboldened and coloured dark blue. The 'H' of the 'Hub' portion of the text element is presented in upper case and accords some separation from 'Coach' in the manner described above at [119]. The device positioned to the left of the text element appears to be three geometric shapes which might be described as the forms which result if a circle is bisected vertically to create a semi-circle on the left, with the semi-circle on the right bisected horizontally to create two quarter-circles. My view is that the 'CoachHub' component will dominate the mark, by virtue of its size and the fact that words generally 'speak louder' than devices. I find that the presence of the figurative element will nevertheless be registered, however it will play a lesser role within the overall impression of the mark.

The contested mark:

121. The mark is a word mark comprising the single word element 'COACHCUBE' rendered in a plain typeface, all characters presented in upper case. The overall impression resides solely in the word itself.

¹⁴ In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

'[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).'

Visual comparison

122. I will first compare the contested mark to earlier marks i) and ii). Both parties' marks are word marks comprising a single 'word' whose first five characters are 'COACH'. The marks have the same structure to the extent that both comprise the word 'COACH' coalesced with another word. I bear in mind the rule of thumb according to which the beginnings of words tend to have more visual and aural impact than their endings.¹⁵ However, I remind myself that this is not an absolute rule. Both marks feature the character pairing 'UB' toward the end of the mark. The points of visual difference are:

- The presence of the word 'Hub' in the earlier marks, absent from the Applicant's mark;
- The presence of the word 'Cube' in the Applicant's mark, absent from the earlier marks.

123. In the light of the foregoing, I find the parties' marks to have a level of visual similarity of above medium but below high.

124. I now compare the contested mark to earlier marks iii) and iv). The marks share 'COACH', as the first portion of the word element. Both marks include the character pairing 'UB' towards the latter portion of the word element. The points of visual difference are:

- The presence of the device in the earlier marks, which is absent from the Applicant's mark;
- The presence of the word 'Hub' in the earlier marks, which is absent from the Applicant's mark;
- The presence of the word 'Cube' in the Applicant's mark, which is absent from the earlier marks.

¹⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, per the General Court at [81] to [83].

125. All things considered, I find the parties' marks to have a medium level of visual similarity.

Aural comparison

126. The respective marks will be articulated in the normal way: 'COACH-HUB' versus 'COACH-CUBE', with the emphasis on the first syllable. Both marks are two syllables in length, their first syllables being aurally identical. The only aural difference resides in the second and final syllables: 'Hub' versus 'Cube'. The aural difference will, in my view, be readily perceived by the average consumer. The word 'hub' has a distinctly different sound to 'cube' owing to the softness of the 'H' versus the harder sound of the 'C'. The 'U' will also sound different in the respective marks; as an 'UH' sound in the earlier marks and a 'YOO' sound in the applied-for mark. I consider the parties' marks to have a medium level of aural similarity.

Conceptual comparison

127. I will consider the earlier mark first. The words 'coach' and 'hub' are commonplace words in the English language with which the UK consumer will be familiar. My view is that the average consumer will ascribe one of two meanings to the word 'coach':

- a verb; synonymous with teach, tutor or train;
- a noun; referring to a bus typically used for long journeys, or a closed carriage pulled by a horse.

128. I consider that the word 'hub' will be understood as some sort of centre of activity, whether a physical location, or an online space. My view is that the earlier mark, as a whole, will likely be perceived by some average consumers as a physical or online centre for training/coaching, e.g. a hub for coaching. Other average consumers might perceive 'CoachHub' as a centre (whether physical or online) for booking coach trips, or, perhaps, although less likely, a reference to hub-caps for coaches. I do not consider the device to add anything conceptual to

the mark over and above the notions described; it will likely merely be seen as some sort of circular arrangement of geometric shapes.

129. I now consider the Applicant's mark. The word 'cube' is an English word with which the average UK consumer will be familiar. It will be understood as a reference to the six-sided three-dimensional shape. The word 'coach' will be understood in the way outlined above at [128]. I consider that the idea conjured by the mark as a whole will likely be either: of a cube for coaching/training, the cube perhaps being some sort of device or 'box' akin to an 'Xbox' or, of a cube for coaches (whatever such an object might be).

130. My view is that the group of average consumers who perceive the word 'coach', in both marks, in the sense of teaching/training will be significant in number. There will be a conceptual nexus between the marks by virtue of this shared concept. In both marks, the word 'coach' will be seen as 'qualifying' the following word ('hub' versus 'cube'). The conceptual messages conveyed by the words 'hub' and 'cube' will, however, diverge. For this group of average consumers, I find there to be no more than a medium level of conceptual similarity.

OP440719

Overall impression of the marks

131. The overall impressions of the earlier marks have been addressed above at [119] – [120].

The contested mark:

132. The mark is a figurative mark comprising both text and a device. The text element consists of the word 'coachcube' rendered in a plain typeface, slightly emboldened, all characters presented in lower case; the 'coach' element coloured dark blue in contrast to the light blue colour of the 'cube' element. Whilst the words are conjoined, this colour contrast, to my mind, accords a divide between the two words. The device positioned to the left of the text element consists of a hexagon

in which a stylised character 'C' appears to have been fashioned by marking 5 of the inner edges of the shape in white to contrast with the remainder of the hexagon which is coloured blue. If the device is intended to depict a cube, it is, in my view, not immediately apparent, and can only be discerned upon close inspection of the mark. I find that the 'C' shape, within what initially appears to be a hexagon, interferes with the ability to see the device as three-dimensional, and, therefore, cubic. My view is that the 'coachcube' component will dominate the mark, by virtue of its size and the fact that words generally 'speak louder' than devices. I find that the presence of the figurative element will nevertheless be registered; however it will play a lesser role within the overall impression of the mark.

Visual comparison

133. I will first compare the contested mark to earlier marks i) and ii). The applied-for mark is a figurative mark, whereas the earlier marks are word marks. Both parties' marks include 'COACH' as the first five characters of the text element, and the character pairing 'UB' towards the latter part of the text. Both marks feature the character pairing 'UB' toward the end of the mark. The points of visual difference are:

- The Opponent's marks are word marks, whereas the Applicant's mark is a figurative mark;
- The presence of the hexagonal 'C' device in the Applicant's mark, which is absent from the earlier marks;
- The presence of the word 'Hub' in the earlier marks, which is absent from the Applicant's mark;
- The presence of the word 'Cube' in the Applicant's mark, which is absent from the earlier marks;
- The dark blue/light blue colour scheme creating contrast between 'coach' and 'cube' in the Applicant's mark, which is absent from the earlier marks. I bear in mind that fair and notional use of the Opponent's word marks allows them to be presented in any colour (although this does not extend to complex colour arrangements).

134. In the light of the foregoing, I find the parties' marks to have a level of visual similarity of above low, but below medium.

135. I now compare the contested mark to earlier marks iii) and iv). Both parties' marks are figurative, including text and device elements. The 'structure' of the marks is similar to the extent that each takes the form of a device followed by a text element comprising the word 'COACH' followed by another word. The points of visual difference are:

- The presence of the semi and quarter-circle device in the earlier marks versus the presence of the 'hexagonal'/'C' device in the Applicant's mark;
- The presence of the word 'Hub' in the earlier marks, which is absent from the Applicant's mark;
- The presence of the word 'Cube' in the Applicant's mark, which is absent from the earlier marks;
- The dark blue/light blue colour scheme creating contrast between 'coach' and 'cube' in the Applicant's mark, which is absent from the earlier marks.

136. All things considered, I find the parties' marks to have a medium level of visual similarity.

Aural comparison

137. Paragraph [126] also applies here. The marks are aurally similar to a medium degree.

Conceptual comparison

138. I do not consider the device elements to add any content over and above the conceptual messages that I have identified at [128] – [129]. My comments in those paragraphs also apply here. I find no more than a medium level of conceptual similarity between the parties' marks.

Distinctive character of the earlier marks

139. *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)’.

140. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services, it tends to be low. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

141. I will first consider earlier marks i) and ii). The words ‘coach’ and ‘hub’ are commonplace words found in the English dictionary. I have found that the earlier marks will, for a significant proportion of average consumers, be perceived as a reference to some sort of hub or centre for coaching. Although the marks cannot

be said to describe any of the goods and services, I consider 'CoachHub' to allude to a number of the terms for which the marks are registered in class 41; broadly speaking, the services that entail education, training or instruction. I find the marks to be highly allusive of the following services:

Class 41:

Providing online training seminars; Provision of online training; Providing online courses of instruction; Distance learning services provided online; Provision of online tutorials; Online education services; Provision of education on-line from a computer database or via the internet or extranets; Providing training courses on business management; Conducting of educational courses in business management; Arranging professional workshop and training courses; Career counselling [...]; career [...] coaching; Personal coaching [training]; Life coaching (training); Sports coaching services; Training or education services in the field of life coaching; Sports coaching; Personal coaching services in the field of ballet; Political speech training and coaching; Political debate training and coaching; ; Sports tuition, coaching and instruction; Esports coaching; Coaching [training]; Coaching services; Educational services in the nature of coaching; Conducting training sessions on physical fitness online; Conducting training courses relating to nutrition online; Conducting training courses relating to diet online; Computerised training in career counselling.

142. I find the marks to be somewhat allusive of the following services which entail the provision of information about education or training:

Class 41:

Providing on-line information and news in the field of employment training; Providing information about online education; Provision of information relating to physical education via an online web site

143. For the class 41 services that I have enumerated above, I find the earlier marks to have a fairly low level of inherent distinctive character.

144. The marks neither describe nor allude to the remainder of the goods and services for which they are registered. For these terms, I find the marks to enjoy a normal or 'average' level of inherent distinctive character.

145. I now consider earlier marks iii) and iv). Conceptually speaking, these figurative marks are identical to the earlier word marks. I do not consider the mild stylisation of the text or the presence of the device to elevate the levels of inherent distinctiveness beyond those found above. My findings at [143] and [144] also apply here

146. In the absence of any evidence from the Opponent, I am unable to consider whether the earlier marks enjoy an enhanced level of distinctive character.

Likelihood of confusion

147. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*¹⁶. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹⁷, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or an economically linked undertaking.

148. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [12]. When

¹⁶ Case BL O/375/10 at [16].

¹⁷ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

Opposition 440717

149. I have found a number of the opposed goods and services to be identical with, or to have at least some level of similarity to, those in respect of which the earlier marks are registered.¹⁸ I will first consider the matter of likelihood of confusion in respect of terms that I have found to be identical. I have found the class 9 term *Software for online messaging* to be identical to the Opponent’s goods under two of earlier marks relied upon; one being the word mark and the other being the figurative mark. Visually speaking, the Opponent’s word marks (earlier registrations i) and ii)) have a closer level of similarity to the Applicant’s mark than the Opponent’s figurative marks. An analysis based on the earlier word marks will therefore give the Opponent its best case.

150. I have found the parties’ marks to be visually similar to a level above medium but not reaching the threshold for high. The shared element ‘COACH’ appears at the beginning of each mark. I bear in mind the rule of thumb according to which the beginnings of words tend to have more visual and aural impact than their endings.¹⁹ I remind myself that this is not an absolute rule. The marks have a medium level of aural similarity and no more than a medium level of conceptual similarity. My view is that the net effect of the differences that I have identified, along all three ‘planes’ of comparison, is sufficient to prevent one party’s mark from being mistaken for the other. Although the marks share the first five characters ‘COACH’, I find that the visual and aural differences in the latter portions of the marks (‘HUB’ versus ‘CUBE’) will unlikely escape the attention of the average consumer. Both marks comprise a single text element (albeit comprised of two words coalesced) and are fairly short marks. The ‘HUB’ and ‘CUBE’ elements are markedly different in visual form. I have found the purchasing act to be primarily visual in most instances.

¹⁸ These are set out in Annexe 1 to this decision.

¹⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, per the General Court at [81] to [83].

Aurally speaking, the average consumer will likely discern the contrasts between: the 'soft' 'H' in 'HUB' and the 'hard' 'C' in 'Cube'; and the respective 'middle' sounds 'uh' and 'yoo'. Although there is a conceptual nexus between the marks by virtue of the shared 'Coach' element, the meanings of 'hub' and 'cube' are very different. I have found the earlier mark to have a 'normal'/average level of inherent distinctive character. That distinctive character derives from the coalescence of the words 'coach' and 'hub' which neither describes nor alludes to the relevant goods (software goods). The Applicant's mark is neither descriptive nor allusive for software goods, either. However, the distinctive character enjoyed by the Applicant's mark derives from the coalescence of 'coach' and 'cube', a pairing which elicits a different conceptual message to that conjured by the earlier mark.

151. Taking all of the relevant matters into consideration, I find that there is no likelihood of confusion between the parties' marks. I find this to be the case even where the average consumer displays only a medium level of attention during the purchasing act. I have considered the matter of whether the identity between the goods would mitigate the visual, aural and conceptual distinctions between the marks. I conclude that the differences that I have identified are sufficiently marked that, even where the parties' offerings are identical, the perception of those differences would unlikely be muted. There is no likelihood of confusion between the marks. (I consider the matter of indirect confusion in respect of each of the oppositions later at [155]).

152. Given that my finding is based on: the parties' identical goods; the closest of the earlier marks by way of a comparator, and the higher of the levels of distinctiveness ascribed to it, it is unnecessary to consider the remaining goods or the other of the Opponent's earlier marks.

Opposition 440719

153. The application in this opposition seeks registration for the same specification as that contested in opposition 440717. I will therefore approach my assessment in the same manner as set out above at [149], based on the class 9 term *Software for online messaging*, which I have found to be identical to the Opponent's goods

under both its word (earlier registrations i) and ii)) and figurative marks (earlier registrations iii) and iv)). Visually speaking, the Opponent's figurative marks (earlier registrations iii) and iv)) have a closer level of similarity to the Applicant's mark than the Opponent's word marks. An analysis based on the earlier figurative marks will therefore give the Opponent its best case.

154. I have found a medium level of visual similarity between the parties' marks. Although the 'text' components of the marks share the first five characters 'COACH', the differences between the word elements, outlined above at [150], will not go unnoticed here. Furthermore, in this case, I consider that the contrasting shades of blue in 'coach' and 'cube' in the Applicant's mark may amplify the differences in spelling between the respective marks. Although both parties' marks include a device, of similar size and positioning, my view is that these elements play a secondary role to those of the word elements. My earlier remarks on the purchasing act and aural aspect of the marks, set out above at [150], apply equally here. Conceptually speaking, I have found the marks to have no more than a medium level of similarity. The devices, to my mind, do not make an appreciable contribution to the conceptual messages conveyed by the marks. For a significant proportion of average consumers, they will likely be perceived and/or recalled as mere arrangements of geometric shapes adding no particular semantic dimension to the marks. I find that the net effect of the differences that I have identified between the marks is such that the average consumer would unlikely confuse one mark for the other. My earlier comments, at [151] and [152] above, also apply here. There is no likelihood of confusion between the marks.

155. I now consider whether there is a likelihood of indirect confusion. I note that in the recent case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

156. In *L.A. Sugar Limited v By Back Beat Inc*²⁰ Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained that [my words in parentheses]:

“17. Instances where one may expect the average consumer to reach such a conclusion [i.e. to conclude that marks relate to the same or economically linked undertakings] tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

157. My view is that neither of the two instant cases fall within any of the categories identified above. It is appreciated that these categories are not intended to be exhaustive. Nevertheless, I do not consider that the parties marks could plausibly be perceived as deriving from the same or economically-related undertakings. I cannot conceive of any commercially realistic rationale for the ‘CoachHub’ marks²¹ to be brand extensions of the Applicant’s ‘Coachcube’ marks (or vice versa). I have found that the distinctive characters of the parties’ respective marks reside in the coalescence of ‘Coach’ with, respectively, ‘Hub’ and ‘Coach’. In my view, the resulting conceptual distinctions between the parties’ marks are such that the average consumer would unlikely presume that both marks derive from the

²⁰ Case BL O/375/10

²¹ All four earlier marks.

same/economically linked undertakings. I have also considered whether the similarities between the marks are such that an average consumer might overlook the differences in spellings, by reason of imperfect recollection, leading to a mistaken perception of the marks as variant marks. However, I consider this possibility to be too great a mental ‘leap’ to be a realistic possibility. I have also borne in mind the interdependency principle. It is my view that the net effect of the differences between the marks is such that those differences will unlikely be muted even where the goods/services are identical. I find that there is no proper basis for a finding of a likelihood of indirect confusion.

Conclusion

158. Both oppositions have failed in their entirety. Subject to a successful appeal, applications UK00003851301 and UK00003851290 may proceed to registration in full.

Costs

159. The Applicant is the successful party and is therefore entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 1/2023 calculated as follows:

Consideration of the Oppositions and preparation of Defence and Counterstatements (x 2 oppositions): £300 for OP440717 £100 for OP440719	£400
Total:	£400

160. Given the consolidation of the two oppositions and the fact that the opposed specification is the same for each claim, I have declined to award the minimum sum for each of the two Defences and Counterstatements filed.


161. I therefore order CoachHub GmbH to pay to Coach Cube Limited the sum of £400. This sum is to be paid within twenty-one days of the expiry of the appeal

period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of January 2025

N. R. Morris
For the Registrar,
the Comptroller-General

Annexe 1 – Contested terms found to have identity/some level of similarity with the terms under the earlier registrations:

Contested terms:	Earlier registrations:			
	i) 3656779	ii) 3656814	iii) 918078446	iv) 1645824
	CoachHub			
<p>Class 9: [all contested terms]</p> <p><i>Software for online messaging;</i></p> <p><i>Software for operating an online shop; Software for evaluating customer behaviour in online shops; Software for arranging online transactions; Computer game software for use with on-line interactive games; Computer programs for accessing, browsing and searching online databases;</i></p> <p><i>Software for designing online advertising on websites; Software for embedding online advertising on websites;</i></p> <p><i>Computer software for the administration of on-line games and gaming</i></p>	<p><i>Meric identical</i></p> <p><i>Meric identical</i></p> <p>Low similarity</p> <p>Highly similar</p>		<p><i>Meric identical</i></p>	

<p>Class 35: <i>Business information services provided online from a computer database or the internet; Business information services provided online from a global computer network or the internet; Business information services provided on-line from a computer database or the internet;</i></p> <p><i>Online community management services; Online business networking services; Compilation of online business directories; Providing on-line auction services; Online marketing; Online advertising; On-line advertising and marketing services; Online advertising services; Promotion, advertising and marketing of on-line websites;</i></p> <p><i>Online retail services for downloadable digital music; Online retail services for downloadable and pre-recorded music and movies;</i></p>		<p>Identical</p> <p><i>Meri</i> identical</p> <p>Medium similarity</p>		<p>Identical</p> <p><i>Meri</i> identical</p> <p>Medium similarity</p>

<p><i>Online retail services relating to handbags.</i></p>				
<p><i>Advertising the goods and services of online vendors via a searchable online guide; Providing a searchable online advertising guide featuring the goods and services of online vendors; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Providing searchable online advertising guides; Providing online commercial directory information services;</i></p>		<p>Highly similar</p>		<p>Highly similar</p>
<p><i>Providing academic course administration services relating to online course registration; Conducting virtual trade show exhibitions online; Computerized on-line ordering services; Online ordering services;</i></p>		<p>No more than medium similarity</p>		<p>No more than medium similarity</p>
<p><i>Arranging subscriptions of the online publications of others</i></p>		<p>Medium similarity</p>		<p>Medium similarity</p>

<p>Class 36: <i>Online business banking services; Online banking services; Online banking.</i></p>	<p>medium similarity</p>			<p>Dissimilar</p>
<p>Class 38: <i>Providing online forums for communication in the field of electronic games; Providing online forums; Providing on-line chat rooms for social networking; Online messaging services; Communication by online blogs; Providing an online interactive bulletin board; Providing online facilities for real-time interaction with other computer users; Providing access to multimedia content online</i></p>		<p><i>Meric identical</i></p>		<p>Low similarity</p>
<p>Class 41: <i>Providing online training seminars; Provision of online training; Providing online courses of instruction; Distance learning services provided online; Provision of online tutorials; Online education services; Provision of education on-line from a computer database or via the internet or extranets;</i></p>		<p>Dissimilar</p>	<p><i>Meric identical</i></p>	<p><i>Meric identical</i></p>

<p><i>Providing training courses on business management; Conducting of educational courses in business management; Providing on-line information and news in the field of employment training; Arranging professional workshop and training courses; Career counselling [...];career [...] coaching; Personal coaching [training]; Life coaching (training); Sports coaching services; Training or education services in the field of life coaching; Sports coaching; Personal coaching services in the field of ballet; Political speech training and coaching; Political debate training and coaching; Sports tuition, coaching and instruction; Esports coaching; Coaching [training]; Coaching services; Educational services in the nature of coaching; Conducting training sessions on physical fitness online; Conducting training courses relating to nutrition online; Conducting training courses</i></p>		Dissimilar		Merically identical
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<p><i>relating to diet online; Computerised training in career counselling; Providing online publications, not downloadable; Providing online electronic publications; Providing online electronic publications, not downloadable, in the field of music; Providing online electronic publications in the field of music, not downloadable; Provision of an online magazine featuring information in the field of computer games; Providing online comic books, not downloadable; Providing on-line publications; Providing online newsletters in the fields of sports entertainment; Providing on-line publications (not downloadable); Providing on-line publications (non-downloadable) ; Providing information about online education; Provision of information relating to physical education via an online web site; Online academic library services; Online research library services</i></p>				
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<p><i>Online digital publishing services;</i></p> <p><i>Providing online videos, not downloadable; Providing on-line non-downloadable video content; Providing online entertainment in the nature of game shows.</i></p> <p><i>Publication of online reviews in the field of entertainment;</i></p> <p><i>Providing online virtual guided tours</i></p> <p><i>Provision of information on fitness training via an online portal; Provision of information relating to physical training via an online web site; Provision of information relating to physical exercises via an online web site;</i></p> <p><i>Providing online music, not downloadable; Providing on-line music, not downloadable</i></p>		<p>Dissimilar</p> <p>Highly similar</p> <p>Dissimilar</p> <p>Dissimilar</p> <p>Dissimilar</p> <p>Dissimilar</p>		<p>Identical</p> <p>Medium similar</p> <p>Medium similarity</p> <p>Low similarity</p> <p>At least medium similarity</p> <p>Highly similar</p>
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<i>Conducting online business management research surveys</i>		Medium to high similarity		Medium to high similarity
Class 42: [all contested terms]		<i>Meric</i> identical		Dissimilar