O/0162/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3916286
IN THE NAME OF ALI JAMAL KARIM
TO REGISTER THE FOLLOWING TRADE MARK:

Yobii

IN CLASSES 9 AND 45

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 443011
BY YOOBIC LIMITED

Background and pleadings

1. Ali Jamal Karim ("the applicant") applied to register the trade mark **Yobii** ("the applicant's mark) in the UK on 26 May 2023, under number 3916286. It was accepted and published in the Trade Marks Journal on 23 June 2023 in respect of the following goods:

> Class 9: *Business technology software; Civil engineering software; Science software; Downloadable computer software for blockchain technology; Computer software relating to the medical field; Computer software for use in medical decision support systems; Computer software for inter-network accounting in the telecommunications field; Computer software for education; Virtual reality software for medical teaching; Education software.*
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> Class 45: *Law enforcement; Advisory services relating to the law; Legal services in the field of immigration; Computer software (Licensing of -) [legal services]; Computer software licensing [legal services]; Licensing of computer software [legal services]; Patent licensing [legal services]; Licensing of technology; Provision of legal research; Legal and judicial research services in the field of intellectual property; Providing information in the field of law; Provision of expert legal opinions; Licensing of software [legal services]; Software licensing [legal services];Licensing of patent applications [legal services]; Legal research in the field of environmental protection; Legal consultancy relating to patent mapping; Legal consultation in the field of taxation; Legal advice; Licensing [legal services] in the framework of software publishing; Legal research; Legal research services; Expert consultancy relating to legal issues; Legal consultancy services; Patent attorney services; Advisory services relating to consumers rights [legal advice];Legal advocacy services; Consultancy services in the field of the safety needs of commercial and industrial companies; Legal services relating to business; Intellectual property consultancy services in the field of patents and patent applications; Licensing of intellectual property in the field of copyrights [legal services]; Pro bono legal services.*

2. YOOBIC LIMITED ("the opponent") partially opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed at class 9 only. This is on the basis of its UK trade mark number 918064784, **YOOBIC** ("the opponent's mark").[1] The opponent's mark was filed on 14 May 2019 and became registered on 4 October 2019. It stands registered for goods and services in classes 9, 35, 38 and 42. For the purposes of the opposition, the opponent only relies on the following goods:

> Class 9: *Computer software for use in automating and managing operating procedures; Computer software for controlling and managing access server applications; Interactive computer software; Applications software; Computer software for database management; Computer software for use in the collection, analysis or management of digital data; mobile applications; Downloadable mobile applications for the management of data; Downloadable software applications; Image recognition software.*

3. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods identified without having to establish genuine use.

4. The opponent argues that the respective goods are identical or highly similar and that the marks are highly similar. On this basis, it submits that there is a likelihood of confusion, including the likelihood of association.

5. The applicant filed a counterstatement denying the ground of opposition.

6. The opponent is professionally represented by Marks & Clerk LLP, whereas the applicant is not professionally represented. Neither party chose to file evidence and no hearing was requested. Only the opponent filed written submissions in lieu.[2] These

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[1] The opponent's mark is a comparable mark based upon the opponent's EU trade mark no. 18064784. On 1 January 2021, in accordance with article 54 of the Withdrawal Agreement between the UK and EU, a comparable UK trade mark was automatically created. It is now recorded on the UK register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

[2] I note that the applicant indicated on 21 May 2024 that he would file written submissions before the deadline of 4 June 2024, but did not do so.

will not be summarised but will be referred to as and where appropriate during this decision. This decision is taken following careful consideration of all the papers before me.

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.

Section 5(2)(b)

8. Section 5(2)(b) of the Act is as follows:

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

9. Section 5A states: […] "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

10. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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

11. In *Gérard Meric v OHIM*, the General Court ("GC") confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

12. The goods to be compared are shown in the table below:

The opponent's goods	The applicant's goods
Class 9: *Computer software for use in automating and managing operating procedures; Computer software for controlling and managing access server applications; Interactive computer software; Applications software; Computer software for database management; Computer software for use in the collection, analysis or management of digital data; mobile applications; Downloadable mobile applications for the management of data;*	Class 9: *Business technology software; Civil engineering software; Science software; Downloadable computer software for blockchain technology; Computer software relating to the medical field; Computer software for use in medical decision support systems; Computer software for inter-network accounting in the telecommunications field; Computer software for education; Virtual reality software for medical teaching; Education software*

Downloadable software applications; Image recognition software.	

13. In the applicant's counterstatement, he argues that the application does not cover identical and/or highly similar goods. He also highlights that YOOBIC appears from its website to be a unique digital workplace that helps businesses to empower their frontline teams. He states that this is fundamentally different to the services offered by Yobii.

14. Firstly, this opposition is based on the parties' class 9 goods, rather than the services, so these comments are not strictly relevant. In any event, as a matter of law, they can have no bearing on the outcome of this opposition. As previously explained, the mark relied upon by the opponent had not been registered for five years at the date on which the application was filed. Consequently, the opponent is not required to prove use for any of the goods for which its mark is registered. The opponent's trade mark is entitled to protection against a likelihood of confusion with the applicant's mark based on its 'notional' use for all the goods listed in the register.

15. The concept of notional use was explained by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 like this:

> "22. […] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

16. So far as the applicant's claimed use of his mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, even though the applicant has suggested the ways in which the mark will be used, and the goods for which it will be used, my assessment must take into account only the applied-for mark – and its specification – and any potential conflict with the opponent's mark. Any differences between the actual goods provided by the parties are not relevant unless those differences are apparent from the applied for and registered marks.

17. In its written submissions, the opponent argues that its broad terms "interactive computer software", "applications software", and "downloadable software applications" encompass the applicant's goods. I agree. The parties' goods are therefore identical under the principle in *Meric*.

Average consumer and the purchasing act

18. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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 in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

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

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

20. The goods are types of software, with some types having a broader purpose and others being more specialised and targeted towards certain types of professions such as the medical or scientific communities, the engineering industry, or IT specialists. The average consumer of the goods is likely to be businesses and professional users for the more specialised software but may also include the public at large. The cost of purchase and frequency of purchase will vary depending on the type of software. Several factors may influence the average consumer when purchasing the goods, such as useability, technical function, and the compatibility of the software with existing systems. Based on these factors, I find that the average consumer will pay at least a medium degree of attention (and potentially slightly higher in respect of some goods).

21. The goods will be available in specialist retailers and general retailers, both in stores and via their online equivalents. They may also be available from app stores. The customer will self-select the goods from the display shelves, or by selecting the image of their desired product if purchasing online. The visual component will therefore dominate the purchasing process, but I do not discount aural considerations, such as word-of-mouth recommendations, discussing the suitability of the products with the provider, or placing telephone orders.

Comparison of marks

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

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

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

24. The respective trade marks are shown below:

The opponent's mark	**The applicant's mark**
YOOBIC	Yobii

25. The opponent's mark is a plain word mark written in uppercase. As a word-only mark with no other elements, the overall impression lies in the word "YOOBIC". The applicant's mark is a plain word mark written in title case. As a word-only mark with no other elements, the overall impression lies in the word "Yobii".

Visual comparison

26. In the counterstatement the applicant states that the marks are not similar as they are spelt differently. The opponent argues that they are visually highly similar on the basis that the first four letters of the applicant's mark are almost identical to the opponent's mark.

27. The competing marks are similar because they both begin with a Y and share the letters O, B, and I in the same order. They are also a similar length, as "YOOBIC" is a six-letter word and "Yobii" is a five-letter word. The applicant's mark is written in title case, whilst the opponent's mark is written in upper case. However, in *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17, the GC held at [39] that word-only marks protect the word or words contained in the mark in whatever case, colour or typeface. The difference in capitalisation between "YOOBIC" and "Yobii" is therefore not significant.

28. The marks differ in that the opponent's mark contains a double "OO" and a single "I", whereas the applicant's mark contains a single "o" and a double "ii". Furthermore, the opponent's mark contains a "C" at the end which is omitted from the applicant's

mark. The beginnings of words tend to have more visual and aural impact than the ends (see paragraph 81 of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02), which, in my view, results in the visual difference created by the letter "C" being less significant. Bearing in mind my analysis of the marks' overall impressions, I am of the view that the marks are visually similar to a medium degree.

Aural comparison

29. The applicant states that the marks are pronounced differently to each other. The opponent however argues that the signs only differ in their endings, stating that "Yobii" and "YOOBI" would both be pronounced "yo-bee". The opponent also argues that the marks have a high level of aural similarity on the basis that "phonetically, the signs differ only in their endings".

30. The marks are of a similar length as that they both contain two syllables. They both begin with the letter 'y' which precedes the letter 'o'. However, it is my view that the first syllable is likely to be pronounced slightly differently. Due to the double 'oo' within the opponent's mark, I believe that the average consumer will pronounce the opponent's mark as "you-bic" with a lengthened 'o' sound (akin to the words 'too' or 'moo'). It is my view that the applicant's mark is most likely to be pronounced with a short 'o' sound (as in 'pod' or 'bob') as "yob-ee" or "yoh-bee. The addition of the letter 'c' in the opponent's mark "YOOBIC" is a further point of difference between the marks, though it does appear at the end. Overall, it is my view that the marks are aurally similar to a medium degree.

Conceptual comparison

31. The opponent's mark "YOOBIC" is not a dictionary-defined word and is unlikely to be understood by the average consumer in the UK. It does not appear to be allusive or descriptive in relation to the goods. It is therefore likely to be perceived as a neologism. The applicant's mark "Yobii" is also not defined in the dictionary and is likely to be perceived as a neologism. On this basis, I find that the marks are conceptually neutral.

Distinctive character of the earlier trade mark

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

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

33. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

34. Although the distinctiveness of a mark can be enhanced by virtue of the use made of it, the opponent has not filed any evidence. As such, I have only the inherent position to consider.

35. As stated in paragraph 31 above, the average consumer is likely to perceive "YOOBIC" as an invented word. It does not appear to be allusive in any way or descriptive of the goods. It therefore has a high level of inherent distinctiveness.

Global assessment – conclusions on likelihood of confusion

36. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no set formula for establishing a likelihood of confusion between marks; it is a global assessment where a number of factors need to be borne in mind.

37. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

38. In the counterstatement, the applicant claims that there is no similarity between the marks and that his mark does not cover identical and/or highly similar goods, and on this basis there is no likelihood of confusion including no likelihood of association with the opponent's mark. In its written submissions, the opponent argues that a likelihood of confusion exists between the competing marks especially for identical goods.

39. Earlier in this decision I found that the goods are identical. The average consumer will pay at least a medium degree of attention when purchasing the goods. The average consumer may be a business or professional user, or a member of the general public. The goods will primarily be selected through visual means, although I do not discount an aural element to the selection process. I have found the marks to be visually similar to a medium degree, aurally similar to a medium degree, and conceptually neutral. The opponent's mark is a word-only mark and its overall impression lies in the word "YOOBIC". The applicant's mark is also a word-only mark

and its overall impression lies in the word “Yobii”. The opponent’s mark has a high level of inherent distinctiveness.

40. Taking all these factors into account and being mindful of the role that imperfect recollection may play, I consider that the marks are likely to be misremembered or inaccurately recalled for one another. It is my view that the average consumer (even paying a slightly higher level of attention) may overlook the points of difference between the marks, which would lead to direct confusion. It is considered that the marks’ visual and aural similarities, the high level of distinctiveness of the opponent’s mark, and the identical nature of the goods are factors which support this finding. It is my view therefore that, notwithstanding the differences between the competing marks, there exists a likelihood of confusion.

Final remarks

41. The opposition under section 5(2)(b) has been successful in its entirety. Subject to any successful appeal, the application will be refused registration for the class 9 goods. It may proceed to registration for the class 45 services which were not opposed.

Costs

42. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances I award the opponent the sum of £750 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side’s statement: £250

Preparing submissions-in-lieu: £400

Official fees: £100

43. I therefore order Ali Jamal Karim to pay YOOBIC LIMITED the sum of £750. The above sum should be paid within twenty-one days of the expiry of the appeal period

or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 21st day of February 2025

K SERRAVALLE

For the Registrar