

BL O/0345/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3982867
BY CODETHINK LIMITED
TO REGISTER THE TRADE MARK:

CTRL

IN CLASSES 9 AND 42

-AND-

THE OPPOSITION THERETO UNDER No. 600003282
BY CTRL COMMERCE LIMITED

Background and pleadings

1. On 22 November 2023, Codethink Limited (“**the Applicant**”) applied to register the trade mark ‘CTRL’ in the UK. It was accepted and published in the Trade Marks Journal on 2 February 2024. Registration is sought for goods and services in Classes 9 and 42. The applied-for specification is set out at paragraph 15 of this decision.¹

2. On 29 April 2024, CTRL Commerce Limited (“**the Opponent**”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”).² The opposition is directed at all the applied-for goods and services.

3. The Opponent relies on its UK trade mark registration ‘CTRL COMMERCE’, trade mark number 3867559, which was filed on 13 January 2023 and became registered on 14 April 2023. It is registered in respect of goods and services in Classes 9 and 42, which are set out at paragraph 15 of this decision. The opponent relies on all the goods and services for which its mark is registered. By virtue of its earlier filing date, the trade mark upon which the Opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act.

4. The Opponent argues that the marks are similar and that the goods and services are identical or similar, giving rise to a likelihood of confusion.

5. The Applicant filed a defence and counterstatement denying that the marks are similar. With regard to the comparison of the respective goods and services the Applicant submitted (my emphasis):³

“The Applicant will by separate correspondence be filing an amendment to its class 9 and 42 goods/services and following the amendment the Applicant denies that the respective goods/services are similar, with the exception that the respective ‘computer software’ goods are admitted as being similar.”

¹ As amended in accordance with the Applicant’s Form TM21B ‘Change of details to an application’, filed on 21 August 2024.

² 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.

³ See the Applicant’s Form TM8 Defence and Counterstatement dated 10 July 2024.

6. On 21 August 2024 the Applicant filed a Form TM21B 'Change of details to an application', thus amending the applied-for list of goods and services. The resultant (amended) specification for which registration is sought is the one detailed at paragraph 15 of this decision. The Opponent however confirmed that notwithstanding the amendments it wished to proceed with the opposition.

7. This is an opposition to which the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013 applies, deemed a 'Fast Track' opposition. The Fast Track procedure does not include the routine filing of evidence nor an oral hearing, this is because the Registrar can usually make an assessment of the likelihood of confusion between competing marks without further evidence and a decision can usually be made from the papers.⁴ Although the Applicant sought leave to file evidence in respect of its contention that 'CTRL' means 'control', its request was denied as the Registrar considered that the nature of that request related to an argument that may be covered by its written submissions.

8. Neither party requested an oral hearing and both elected to file final written submissions. This decision is therefore taken following a careful consideration of the papers before me.

9. The Opponent is represented by Dr Walther Wolff & Co and the Applicant is represented by Wilson Gunn.

DECISION

Legislation and Case Law

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

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

[...]

⁴ See Tribunal Practice Notice 2/2013 in relation to Fast Track Oppositions.

(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”.

11. 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 Office for Harmonisation in the Internal Market (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

12. In *Gérard Meric v OHIM*,⁵ (“*Meric*”), the General Court (“GC”) held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa (this principle equally applies to services).

⁵ Case T- 133/05

13. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia:⁶

- (1) the physical nature of the goods or acts of service;
 - (2) their intended purpose;
 - (3) their method of use / uses;
 - (4) who the users of the goods and services are;
 - (5) the trade channels through which the goods and services reach the market;
 - (6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
 - (7) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);
- or
- (8) whether they are complementary to each other.

14. 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”*.⁷ Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.⁸

15. The goods and services to be compared are shown in the table below:

Opponent’s Specification	Applicant’s Specification
<u>Class 9</u> Computer programs and software; business technology software; electrical, electronic, optical and electromechanical apparatus and instruments; computers; computer	<u>Class 9</u> Computer software, namely computer software operating systems; electronic publications (downloadable).

⁶ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “Treat” case

⁷ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

⁸ *Kurt Hesse v OHIM*, Case C-50/15 P

<p>peripheral apparatus; data processing apparatus; calculating apparatus; data recording apparatus; data carriers; modems, printers, scanners, screens, keyboards, mouse and remote control apparatus; computer mouse mats; dictation apparatus; microphones; apparatus for recording, transmitting or reproducing sound and images; control, regulating, answering, checking and signalling apparatus; parts, fittings and accessories for the aforesaid goods.</p>	
<p><u>Class 42</u> Setting up websites on behalf of third parties for Internet sale of office supplies; scientific and technological services; scientific and technological design services; technological consultancy; information technology consulting services; information technology support services; software creation and design; software development; computer software integration; software consulting services; computer software consultancy; software customisation services; development of computer software application solutions; development services relating to computer software application solutions; development of software solutions for internet providers and internet users.</p>	<p><u>Class 42</u> Computer software operating systems design, development, customisation, deployment and consultancy; installation, maintenance and repair of computer software operating systems; advisory and consultancy services in relation to all of the aforesaid.</p>

16. The Opponent makes the following submissions in relation to the comparison of the respective goods and services but it does not advance any specific comparators (my emphasis):⁹

- that the Applicant’s goods and services are *“identical with, closely similar to or otherwise could be thought to be associated with”* its goods and services;
- that *“**computer software’ of whatever kind in Class 9 and/or services which involve ‘computer software’ of whatever kind in Class 42 of the***

⁹ See paragraph 5 of the Opponent’s final submissions in lieu of a hearing.

Application are identical with and/or similar to those of the Opponent's Registration"; and

- that **“the majority - if not all - the Class 9 goods and Class 42 services of [the] Application [...] are concerned with, associated with or operated by ‘computer software’ and, in fact, the Applicant has itself [...] admitted that ‘computer software’ goods are similar to those of the Opponent's Registration [...].”**

17. I have already noted that in its counterstatement, the Applicant admitted that the respective *“computer software goods”* are similar. In its final submissions it makes the following submissions (my emphasis):

“The Applicant **admits** that the Opponent’s registration covers **‘software’ goods and services** without limitation in classes 9 and 42 and that these goods/services are therefore similar to the Applicant’s goods/services. But the Applicant **denies** that any of the **remaining goods/services** in the Opponent’s registration are similar to the Applicant’s goods/services.”

Class 9:

“Computer software, namely computer software operating systems”

18. Albeit the above ‘computer software’ is limited to operating systems, it clearly falls within the broad category of *“computer [...] software”* in the Opponent’s Class 9 specification. These goods are therefore identical under the principles outlined in *Meric*.

“Electronic publications (downloadable)”

19. Comparing the above goods to the Opponent’s *“computer [...] software”*, it is clear that the respective goods differ in nature, method of use and intended purpose to the Opponent’s goods, this is because downloadable electronic publications is a term referring to any publication, such as books, newspapers, magazines etc. that is available in an electronic format rather than on printed paper; whereas ‘software’ is a collection of instructions, data, or computer programs that are used to operate

computers and execute specific tasks i.e. it is a set of instructions or commands that tell a hardware device what to do.

20. That said, the trade channels of the Applicant’s electronic publications and the Opponent’s “*computer [...] software*” may overlap, this is because it is common for the publisher or retailer of downloadable electronic publications to distribute those publications to consumers by means of computer software applications. Consequently, there is also a complementary relationship between computer software and downloadable electronic publications because one is indispensable or important to the other in such a way that the consumer may consider they come from the same undertaking. Indeed, publications such as a digital newspaper may only be available through the downloading of the publisher’s dedicated software application. Therefore, I also find that the user may generally be the same.

21. The Applicant’s “*electronic publications (downloadable)*” are therefore similar to the Opponent’s “*computer [...] software*” to a low degree.

Class 42:

Computer software operating systems design, development, customisation, deployment and consultancy.

22. The above services are self-evidently identical (or at least identical under the principles outlined in *Meric*) to services included in the Opponent’s Class 42 specification as follows:

Opponent’s term	Applicant’s term
Software [...] design.	Computer software operating systems design [...].
Software development.	Computer software operating systems [...] development [...].
Software customisation services.	Computer software operating systems [...] customisation [...].

Computer software integration.	Computer software operating systems [...] deployment [...]. ¹⁰
Computer software consultancy.	Computer software operating systems [...] consultancy [...].

“Installation, maintenance and repair of computer software operating systems”

23. To the extent that the broad categories of “[...] *technological services; information technology support services*” in the Opponent’s Class 42 encompass the provision of installation, maintenance and repair of computer software, they are identical to the above applied-for services under the principles outlined in *Merix*.

“Advisory and consultancy services in relation to all of the aforesaid.”

24. The advisory and consultancy services relate to all of the applied-for computer software services, they are therefore identical to the Opponent’s “[...] *technological services; information technology consulting services; software consulting services; computer software consultancy*” under the principles outlined in *Merix*, particularly when taking into account that consultancy services will encompass the provision of advice.

The average consumer and the nature of the purchasing act

25. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods and services in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word “average” merely denotes that the person is typical,¹¹ which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.¹² It is therefore necessary to determine

¹⁰ ‘Deployment’, insofar as it relates to software, is the action of bringing the software into effective action. ‘Software integration’ is the process of combining different software applications to work together, which would encompass software deployment.

¹¹ *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), paragraph 60

¹² *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

who the average consumer of the respective goods and services is, and how the consumer is likely to select those goods and services.

26. The respective goods have a wider scope of average consumer than others. For example, a consumer of 'computer software' could be a business or other form of organisation/undertaking wanting specialist software for their business operations or they could be a member of the general public who is a home PC user wanting computer software merely for word processing (I note this serves to demonstrate that the term "*computer software*' is of immense breadth"¹³).

27. Given the nature of the respective services, it is more likely that the average consumer will be a business or other form of organisation/undertaking (rather than a member of the general public) requiring software to be designed for them for example.

28. Whilst in general terms the average consumer's level of attention is likely to vary according to the category of goods and services in question,¹⁴ such that the average consumer can be deemed to demonstrate a low degree of attention when selecting certain categories of goods and services for instance, given the nature of the goods and services at hand, I do not consider any of them fall into that 'low level of attention' category.

29. Rather, the relevant average consumer (whether they are members of the general public, a professional, or a business, organisation/undertaking) is at the very least, likely to pay a medium level of attention when selecting the respective goods and services. Where the goods and services are of a specialised nature, then the level of attention paid by the relevant average consumer is only likely to increase, this is true whether the consumer of those goods and services is a member of the general public or a business user for example.

30. I consider the goods and services will be predominantly selected visually following perusal of brochures and websites for example, whereby the consumer will be presented with an image of the respective marks. I do not completely rule out an aural selection although given the nature of the goods and services it is unlikely that the

¹³ See *Massachusetts Financial Services Company v MFS Africa Limited*, Case O/531/22, paragraph 13, in relation to the comment about '*computer software*'

¹⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

relevant consumer would select them orally. Even if an order were made orally, the consumer is still likely to have viewed the marks first before placing their order.

Comparison of marks

31. I have already set out the principles gleaned from established case law with regard to comparing competing marks. I also note that the Court of Justice of the European Union (“CJEU”) stated in *Bimbo SA v OHIM*,¹⁵ 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.”

32. 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.

33. The marks being compared are shown below:

Earlier mark	Contested mark
CTRL COMMERCE	CTRL

Overall impression

34. Both are word-only marks, therefore the overall impression of the contested mark rests solely in the four letter sequence ‘CTRL’; and the overall impression of the earlier mark rests in the four letter sequence ‘CTRL’ followed by the word ‘COMMERCE’. The word ‘COMMERCE’ is an ordinary word referring to commercial activities i.e. the activity of buying and selling on a large scale. Accordingly this word has limited relative

¹⁵ Case C-591/12P, at paragraph 34.

weight because it is likely to be perceived as an origin neutral word that could be used by any commercial undertaking engaged in the activity of commerce, as such, the overall impression of the contested mark is dominated by the four letter sequence 'CTRL'.

Visual comparison

35. The four letter sequence 'CTRL' is wholly reproduced in the contested mark and therefore is identical to the first element of the earlier mark.

36. Bearing in mind the generally accepted rule of thumb derived from the GC in *El Corte Inglés*,¹⁶ i.e. that the first part of a word mark is the part which is likely to retain the consumer's attention, the fact that the identity lies at the beginning carries a greater significance. Therefore, notwithstanding the presence of the word 'COMMERCE' in the earlier mark which represents a point of dissimilarity, and bearing in my earlier comments regarding the limited relative weight of that word in the overall impression of the earlier mark, I assess the visual similarity as medium to high overall.¹⁷

Aural comparison

37. Aurally the marks coincide in the four letter sequence 'CTRL'. Whether the letters are articulated separately (as 'SEE-TEE-ARE-ELL') or even as the ordinary word 'control' (bearing in mind that the Applicant submits that 'CTRL' would be perceived as meaning 'control'), the marks will either way share the identical pronunciation with regard to 'CTRL' and that the identity lies at the beginning of the earlier mark.¹⁸ The word 'COMMERCE' in the earlier mark represents a point of aural dissimilarity between the competing marks. Given my assessment of the relative weight that word plays in the overall impression of the earlier mark, this difference is not significant. Overall, I assess the degree of aural similarity as medium to high.¹⁹

¹⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

¹⁷ In *Purity Wellness Group Ltd v Stockroom (Kent) Ltd*, Case BL-O/115/22, the Appointed Person determined that even where an element is descriptive that does not of itself render an element negligible or invisible.

¹⁸ *El Corte Inglés*.

¹⁹ *Purity Wellness* (BL-O/115/22).

Conceptual comparison

38. The Applicant submits that 'CTRL' would be immediately recognised by the average consumer of the goods and services as meaning 'control' and that the concept derived from the earlier mark is therefore 'control commerce'.

39. The Oxford English Dictionary entry for 'CTRL' in reference to computing is that it is an abbreviation appearing on the 'control' key of a computer keyboard. This accords with my experience of where I have encountered that sequence of letters i.e. on the control key of a computer keyboard, but I cannot say that contrary to my own experience, it is a common abbreviation for the word 'control' in more general terms, as it appears to be specific to a computer keyboard. Therefore I do not rule out that it is also possible that 'CTRL' could merely be perceived as a sequence of letters with no real meaning that will have no immediately discernible concept, in which case the marks would be conceptually neutral with regard to that element.

40. To the extent that 'CTRL' would be perceived as an abbreviation for the word 'control' the marks share that identical concept. I also bear in mind that even if the average consumer is not aware of 'CTRL' being an abbreviation for 'control' they may nonetheless perceive it as denoting a specific key on a computer keyboard and attribute that concept to it. Either way, the marks share the identical concept with regard to that element.

41. I consider the meaning of the word 'COMMERCE' (an ordinary word referring to the activity of buying and selling on a large scale) is likely to be commonly understood by the average consumer, or at the very least the average consumer will perceive that it is a word relating to commercial activities. The presence of the word 'COMMERCE' in the earlier mark has no counterpart in the contested mark and it therefore represents a point of conceptual dissimilarity, although that concept is not particularly distinctive and would unlikely be a distinguishing feature since the average consumer is likely to perceive it as an origin neutral indication that an undertaking is engaged in the activity of commerce. Therefore the concept derived from that word in conjunction with 'CTRL' is nothing more than that of 'CTRL' being a commercial enterprise engaged in commerce.

Distinctive character of the earlier mark

42. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be,²⁰ although it is the distinctive character of a component that is similar between the marks that is particularly relevant.²¹

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

44. The Opponent makes no claim to enhanced distinctiveness through the use made of the earlier mark, and has filed no evidence of use, therefore I only have the inherent distinctiveness of the mark to consider.

45. The Applicant has submitted that *“the term CTRL [...] is not an invented or highly distinctive term.”* It submits that the earlier mark will therefore be immediately perceived as meaning ‘control commerce’ and that the two words *“hang together, and each is as important as the other in the mark. There is no basis for the Opponent to claim that the word ‘commerce’ carries any less weight or significance in the mark.”*

46. The Opponent on the other hand submits that whilst *“COMMERCE’ may be considered to be quasi descriptive in relation to the goods and services of the Opponent’s registration, i.e. “the exchange of goods and services between two or more entities”, there is no connection - either in concept or by perception on the part of a consumer - between the letter combination CTRL and the word COMMERCE. The Applicant’s contention that the two elements CTRL and COMMERCE “hang together and are inextricably linked because of this immediate concept/perception” has no obvious justification.”*

47. I have already indicated that the dictionary definition of ‘CTRL’ is that it is an abbreviation used on the ‘control’ key of a computer keyboard and that this definition

²⁰ *Sabel v Puma.*

²¹ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 38 and 39.

accords with my understanding. Whilst I have not overlooked that 'CTRL' could be perceived as a meaningless sequence of letters (therefore its resultant distinctiveness would be higher as a result), I think it more likely that the average consumer of the goods and services at hand would be *au fait* with the term 'CTRL' in the context of a computer keyboard command.

48. However, that does not negate the fact that 'CTRL' or even the word 'control' is not descriptive nor is it allusive of the goods and services covered by the Opponent's terms which I have found to be identical to the Applicant's specification. Whilst the Opponent's Class 9 specification contains the term "*keyboards*", those are not the goods which I have found to be identical to the Applicant's goods, and the term 'CTRL' does not describe "*keyboards*" in any event. Therefore, although the term is capable of being used descriptively in relation to a specific key on a computer keyboard, that does not mean that it cannot in fact be used distinctively as a badge of origin in relation to the relevant goods and services. That said its distinctiveness is not particularly high either, given its attributable meaning.

49. I have already found that the word 'COMMERCE' is likely to be understood and would therefore be perceived as an origin neutral word, therefore 'COMMERCE' is likely to be viewed as a non-distinctive element. Consequently I find that the distinctive character of the mark is dominated by 'CTRL' with 'COMMERCE' having limited weight relative to that four letter combination; and that the 'CTRL' element has an independent distinctive role in the mark.²²

50. I find that the earlier mark is inherently distinctive to between a low to medium degree.

Conclusions on Likelihood of Confusion

51. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.²³ I must also consider the average consumer of the services, the nature

²² See *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*, [2015] EWHC 1271 (Ch), paragraphs 19 – 21 with regard to the assessment of composite marks.

²³ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

of the purchasing process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.²⁴

52. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.²⁵ The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.²⁶

53. It is well established that confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect. Indirect confusion arises where the consumer recognises that one mark is different from the other, but because of the marks' similarities, believes that the goods or services bearing the later mark come from the same undertaking or from an economically linked undertaking.²⁷ For example, they conclude that the later mark is another brand of the owner of the earlier mark because they share a common element.²⁸ In *L.A. Sugar Limited v By Back Beat Inc*,²⁹ Mr Iain Purvis Q.C., as the Appointed Person, explained that instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:³⁰

“(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

²⁴ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

²⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

²⁶ See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

²⁷ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10

²⁸ *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16-17

²⁹ *Ibid.*

³⁰ In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added at [12] that it is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

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)."

54. Confusion can also be 'right way round' or 'wrong way round', which in essence is nothing more meaningful than the order in which the consumer happened to come across the earlier mark and the later mark,³¹ i.e. 'wrong way round' confusion embraces situations where the average consumer comes across the later mark first and believes that the services denoted by the earlier trade mark come from the same undertaking.³²

55. With the exception of the Applicant's downloadable electronic publications (which I have found to be similar to a low degree), I have found that the applied-for goods and services are identical to the Opponent's goods and services and that they are likely to be predominantly selected visually by an average consumer who is paying at least a medium degree of attention when selecting them (and whose attention increases where the goods are more specialised).

56. The 'CTRL' element forms the first part of the earlier mark (which is where the consumer tends to focus their attention) and the marks are visually and aurally identical with regard to the 'CTRL' element. However, owing to the presence of the word 'COMMERCE' in the earlier mark, the marks are visually and aurally similar to a medium to high degree overall, since the word 'COMMERCE' cannot be overlooked even if it has limited weight relative to 'CTRL'.³³

³¹ *Comic Enterprises v Twentieth Century Fox* [2016] EWCA 41, paragraph 80.

³² *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 paragraph 14.

³³ *Purity Wellness*.

57. The word 'COMMERCE' has a clear concept which is not present in the contested mark although that concept is not particularly distinguishing as to trade origin. The marks share the identical concept with regard to 'CTRL' where the average consumer perceives it as an abbreviation (and, although less likely, they are conceptually neutral with regard to that element where the average consumer does not derive any meaning from 'CTRL').

58. I found that 'CTRL' is an abbreviation of the ordinary word 'control', specific to a key on a computer keyboard, and although the average consumer will likely know this, 'CTRL' nor the word 'control' would describe the relevant goods and services in any event, nor would they describe a 'keyboard' either. I have found that 'CTRL' has an independent distinctive role within the earlier mark and that it is capable of being used as a badge of origin in relation to the goods and services at hand despite its attributable meaning; and that the word 'COMMERCE' is likely to be perceived as a non-distinctive, origin neutral word. I have found that the earlier mark is inherently distinctive to between a low to medium degree.

59. The Applicant places much emphasis on the 'CTRL' element being of low distinctiveness and it submits that the distinctiveness of the earlier mark therefore rests in the 'CTRL' and 'COMMERCE' elements in combination. However, the distinctive character of the earlier mark is only a single factor in the multifactorial assessment in any event, and the Applicant's approach would have me disregard the similarity between the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance.³⁴ In this regard, the CJEU in *L'Oréal SA v OHIM*,³⁵ (a case in which the earlier mark 'FLEX' was compared to the later mark 'FLEXI AIR') stated that:

"42. [...] the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

³⁴ See *L'Oréal SA v OHIM*, C-235/05 P at paragraph 45

³⁵ *Ibid.*, paragraph 42.

43. It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.”

60. As I have mentioned, distinctiveness of the earlier mark is only one element in the multifactorial assessment, therefore bearing in mind some of those other factors, I note that fundamentally the marks are identical with regard to the ‘CTRL’ element, and the fact that the identity rests with the first element of the earlier mark is significant according to *El Corte Inglés*. This identity would unlikely be overlooked by the average consumer of identical goods and services even where they are paying a higher degree of attention.

61. Taking all the above factors into account, and allowing for imperfect recollection, whilst bearing in mind the principle of interdependency, I find that the average consumer, or a significant proportion thereof would be indirectly confused as to the origin of the goods and services. This is because the average consumer will clearly see that the earlier mark is different from the contested mark, but also that the marks share the identical element ‘CTRL’. The inclusion of the word ‘COMMERCE’ would be perceived as an origin neutral element of the kind that a consumer would expect to find in a sub-brand (which accords with category (b) in *L.A. Sugar*).

62. Consequently, I find that the identity of the shared element will lead consumers to believe that the goods and services come from the same undertaking or from an economically linked undertaking and not that the difference owing to the word ‘COMMERCE’ denotes goods and services from different undertakings. Bearing in mind that confusion can be ‘wrong way round’, the average consumer may consider that ‘CTRL COMMERCE’ is a sub-brand of ‘CTRL’ for example. Either way, the average consumer would be indirectly confused.

OUTCOME

63. The opposition under section 5(2)(b) of the Act is successful. Subject to any appeal, contested trade mark application number 3982867 shall be refused registration.

COSTS

64. The Opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Opponent the sum of £500 based on the contributory scale set out in Tribunal Practice Notice 1/2023, as adapted for trade mark fast track opposition proceedings.³⁶ The sum is calculated as follows:

Official fee for filing Form TM7F	£100
Preparing the Statement of Grounds and considering the Counterstatement	£250
Preparing written submissions	£150
TOTAL	£500

65. I therefore order Codethink Limited to pay CTRL Commerce Limited the sum of **£500**. This 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 10th day of April 2025

Daniela Ferrari

For the Registrar

³⁶ The adaptations are contained in paragraph 13 of TPN 1/2023.