BL O/0590/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3924687
BY BRIGHT.BLUE CO.
TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS:

bright.blue

IN CLASSES 7, 9 AND 42

-AND-

THE OPPOSITION THERETO UNDER No. 443165
BY BRIGHT HR LIMITED

Background and pleadings

1. On 26 June 2023, Bright.Blue Co. (**"the Applicant"**) applied to register the following series of two trade marks in the UK:

Type of Mark	Representation of Mark
Word mark	bright.blue
Figurative mark	bright.blue

2. The application was accepted and published in the Trade Marks Journal on 21 July 2023. Registration is sought for goods and services in Classes 7, 9 and 42 (these are set out in full at **Annex 1** of this decision).

3. On 21 September 2023, Bright HR Limited (**"the Opponent"**) partially opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (**"the Act"**).[1] The opposition is directed at some of the applied-for goods and services in Classes 9 and 42 (the list of opposed goods and services is set out at paragraph 12 of this decision).

4. The Opponent relies on its UK trade mark registration number 3459025 shown below which is a series of three figurative marks:

5. The Opponent's registration has a filing date of 17 January 2020 and a registration date of 8 August 2020. It is registered in respect of services in Classes 42 and 45. However, for the purposes of this opposition, it only relies on some of its Class 42 services (which are set out at paragraph 12 of this decision). By virtue of its earlier

[1] 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.

filing date, the trade mark registration upon which the Opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act.

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

7. The Applicant filed a defence and counterstatement denying the claims made.

8. Neither party filed evidence nor submissions during the evidence rounds. A hearing was not requested and only the Opponent filed submissions in lieu of a hearing. This decision is therefore taken following a careful consideration of the papers before me.

9. The Opponent is represented by Wilson Gunn and the Applicant is represented by Swindell & Pearson Limited.

DECISION

Legislation and Case Law

10. Section 5(2)(b) and 5A of the Act state:

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

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

Opponent's Specification
Class 42 Software as a service [SaaS]; information, advice and consultancy in relation to all the aforesaid services.
Applicant's specification
Class 9 Machine control software; software development programs; software for product development; software; product engineering software; software for use in advertising; computer software for advertising; search marketing software; computer software packages; e-commerce software ; interactive software; payment software; online payment software; digital solutions provider [dsp] software; software for processing electronic payments to and from others; software for facilitating secure credit card transactions; mobile apps; mobile application software; application software for mobile phones; downloadable smart phone applications (software); downloadable software in the nature of a mobile application; computer software for controlling self-service terminals; reporting software; computer software for use in remote meter monitoring; software for monitoring, analysing, controlling and running physical world operations; cloud network monitoring software; computer software for the monitoring of computer systems; computer software for use in remote meter monitoring; artificial intelligence software; artificial intelligence software for surveillance; artificial intelligence software for analysis; cloud computing software; cloud server software; cloud network monitoring software; software for use in advertising; optical barcode recognition [obr] software; biometric software.

Class 42

Design of computer software; computer software design; rental of computer software; troubleshooting of computer software problems; design and development of computer software; rental of computer software; configuring computer hardware using software; renting out software; diagnosing computer hardware problems using software; software development; development of software; software design and development; computer software development; development of computer software; development and testing of software; software development services; development and maintenance of computer software; software as a service; software as a service [saas]; consulting services in the field of software as a service [saas]; software maintenance services; services for maintenance of computer software; computer software maintenance services; software engineering services; development services relating to computer software application solutions; providing temporary use of on-line non-downloadable software for processing electronic payments; providing user authentication services using biometric hardware and software technology for e-commerce transactions; development of computer software application solutions; application service provider services; user authentication services using technology for e-commerce transactions; design services for data processing systems; monitoring of computer systems to detect breakdowns; computer system monitoring services; maintenance and updating of software for communication systems; diagnosis of faults in computer software; updating of software for data processing; monitoring of network systems; testing services for alarm and monitoring systems; monitoring of computer systems for security purposes; computer security system monitoring services; computer system monitoring services; monitoring of telecommunication signals; hosting of web portals; hosting web portals; user authentication services using single sign-on technology for online software applications; providing user authentication services using single sign-on technology for online software applications; user authentication services using technology for e-commerce transactions; hosting of portals on the internet.

13. The term *"software as a service [SaaS]"* appears identically in the specifications of both marks. Consequently, I will conduct my assessment on the basis that at least some of the services are identical.

14. I note that 'SaaS', is a cloud-based software delivery model i.e. it is a service which provides non-downloadable, on-demand software that is hosted on the cloud and used over an internet connection. It provides the service user with access to software, usually on payment of a subscription fee, which means that the consumer essentially rents the software instead of buying it.

The average consumer and the nature of the purchasing act

15. 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,[2] 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.[3] It is therefore necessary to determine who the average consumer of the respective goods and services is, and how the consumer is likely to select those goods and services.

16. In the context of ‘SaaS’, there is a wide scope of average consumer, as the consumer would consist of either 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. This demonstrates that the term *‘software’* is of immense breadth,[4] and for that matter so too is ‘SaaS’.

17. 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 services at hand. Where the software provided via ‘SaaS’ is 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 is a member of the general public or a business user for example.

18. The consumer is likely to select the services following perusal of brochures and websites of the service provider, whereby the consumer will be presented with an image of the marks. I do not completely rule out an aural selection, although 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

19. It is clear from *Sabel BV v. Puma AG*[5] 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

[2] *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
[3] *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98
[4] See *Massachusetts Financial Services Company v MFS Africa Limited,* Case O/531/22, paragraph 13, in relation to the comment about *‘computer software’*
[5] *Sabel BV v. Puma AG,* Case C-251/95, paragraph 23.

must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated in *Bimbo SA v OHIM*,[6] 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."

20. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo* on the court's earlier judgment in *Medion v Thomson*[7] with regard to composite trade marks. The judge said:

> "18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

[6] Case C-591/12P, at paragraph 34.
[7] Case C-120/04.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

21. I bear in mind that it would be wrong 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.

22. The marks being compared are shown below:

Earlier marks	Contested marks
Earlier Mark 1:  Earlier Mark 2:  Earlier Mark 3:  	Contested Mark 1: bright.blue Contested Mark 2: bright.blue

23. The Applicant submits that 'bright' means intelligent, which it states is entirely descriptive of the Opponent's services and therefore completely devoid of distinctive character. The Applicant therefore submits that the device element of the earlier marks

is the dominant and distinctive element and as such the comparison should be made between that device and 'bright.blue' i.e. ignoring the word 'bright' in the earlier marks.

24. The Applicant's suggested approach would entail artificial dissection of the earlier marks, which is wrong in law because it does not consider the earlier marks as a whole. I disagree that 'bright' in the earlier marks is descriptive and devoid of distinctive character (a point which I have addressed further in my decision at paragraphs 48 to 53), and even if it were, I note that in *Purity Wellness Group Ltd v Stockroom (Kent) Ltd*, 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 and it would still need to be taken into account when comparing competing marks.

Series of marks

25. The competing marks are series marks. Section 42(2) of the Act states that *"a series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark."* In order to have been accepted for registration as a series, each of the marks in the series must meet these qualifying conditions. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corpn,* [2016] Bus. L.R. 849, the Court of Appeal stated that the requirements imposed by section 42(2) may be summarised as follows (I shall bear this in mind when comparing the marks):

> "58. […] In order to qualify as a series the trade marks must resemble each other in their material particulars. Any differences between the trade marks must be of a non-distinctive character and must leave the visual, aural and conceptual identity of each of the trade marks substantially the same. These matters must be assessed from the perspective of the average consumer of the goods or services in question."

Overall impression – earlier marks

26. The earlier marks consist of the word 'bright' in a stylised lower-case font with a decorative asterisk-like device positioned to the left of the word.

27. The only real distinguishing feature between the three marks in the series is colour and colour contrast – two of the marks are black and white marks with Earlier Mark 1 comprising of the word and device elements in black on a white background; and Earlier Mark 3 comprising of the word and device elements in white on a black background. Earlier Mark 2 is 'in colour' and is comprised of the word and device elements in blue on a black background. However, little turns on this colour difference since colour is an implicit component of a trade mark registered in black and white i.e. it is not extraneous matter, and the Court of Appeal has stated that registration of a trade mark in black and white covers use of the mark in any colour.[8]

28. Since marks forming part of a series may differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark, it follows logically that the colour and colour contrast differences cannot be regarded as altering the visual, aural nor conceptual identity of the marks and each mark in the series should therefore be assessed as being equivalent i.e. they resemble each other in their material particulars.

29. Thus, in approaching the overall assessment of the earlier marks I take into account the material particulars of the marks which make them qualify as a series, and those material particulars are that they all comprise of the word 'bright' in the same particular stylised lowercase font, all preceded by the same asterisk-like device which lies to the left of that word. Therefore, the overall impression of the earlier series of marks lies in those elements as they are presented, and although the colour does not affect the identity, nor the distinctiveness, of the marks in the series, it is an implicit component of the marks i.e. they could be used in any colour and two of those colours are as shown in Earlier Mark 2.

30. The font in which the word 'bright' is presented is rather plain, and the device is quite banal and appears to be a mere decorative flurry as opposed to an element intended to impart distinctiveness to the mark overall. In this regard I note that where a mark contains words and figurative elements *"the word elements must generally be*

[8] However, it is not appropriate to notionally apply complex colour arrangements to a mark registered in black and white. This is because it is necessary to evaluate the likelihood of confusion on the basis of normal and fair use of the marks, and applying complex colour arrangements to a mark registered, or proposed to be registered, without colour would not represent normal and fair use of the mark. See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements",[9] this is particularly the case where the figurative element has been added for decorative effect and is not intended to be distinctive.[10] In my opinion, the overall impression of the earlier marks is dominated by the word 'bright' itself and the distinctiveness of the marks derives from that word rather than the presentation of it in the particular font in which it is registered.

Overall impression – contested marks

31. The contested marks consist of the word 'bright' followed by the word 'blue' with a full stop between them. The average consumer is unlikely to perceive the full stop as a distinctive feature *per se* and is likely to merely perceive it as an element to separate the two words, used in lieu of a space, therefore it is likely to be accorded less attention than the words themselves, alternatively, it may even be overlooked.

32. Contested Mark 1 is a word-only mark and Contested Mark 2 is a figurative mark. Since word-only marks protect the word or words themselves, Contested Mark 1 is not limited by any features such as capitalisation or the typeface which appears on the Register,[11] nor for that matter is it limited by the colour in which it appears on the Register. Since Contested Mark 2 is a figurative mark, it is to be considered as it appears on the Register, i.e. *"figurative marks are, by nature, exclusively protected in the exact morphology covered by their registration."*[12] Contested Mark 2 has been applied-for in black and white, therefore colour is an implicit component of the mark and the mark may be used in any colour.

33. The words in Contested Mark 1 could notionally be presented in any font (providing that font does not alter the distinctive character of the mark), and since it is part of a series, one of those fonts would be as shown in Contested Mark 2 – although the

[9] *Migros-Genossenschafts-Bund v EUIPO – Luigi Lavazza (CReMESPRESSO)*, Case T-189/16, paragraph 52.
[10] *M & K v EUIPO*, T-171/17, paragraph 41.
[11] See the comments of Iain Purvis KC, sitting as the Appointed Person in the following two cases: *Groupement Des Cartes Bancaires v China Construction Bank Corporation,* Case BL O/281/14, paragraph 21; and *HERNO S.p.A. v Miss Sparrow Ltd,* BL O/954/22, paragraph 37.
[12] *Faber Chimica v OHIM* [2005] ECR II-1297, paragraph 31.

stylisation of the font is minimal and the distinctiveness of Contested Mark 2 derives from the words themselves more than their presentation.

34. A word which is part of a composite mark can be perceived differently when it is used alone. The word ‘bright’ is an adjective (i.e. it is a word naming an attribute of something), and its meaning is altered depending on what other word(s) it is used with. For example, it could mean: shining/ full of light (e.g. bright eyes, bright room, bright light etc.); a vivid or bold shade of a colour (e.g. bright blue, bright red, bright green etc.); a reference to the intelligence of a person or the cleverness of an idea (e.g. a bright girl, a bright spark, a bright idea); a reference to optimism or happiness (e.g. a bright future); or the particular enthusiastic, energetic personality of a person (e.g. a bright personality) etc. ‘Bright’ clearly has multiple meanings without another word to contextualise it.

35. On its own, ‘blue’ references any hue/ shade of blue and can even be a word to describe a person’s mood, but when combined with ‘bright’ the two form a unit to refer to a vibrant, vivid shade of the colour blue, as opposed to a dark blue or light blue for example. In the context of the contested marks, the meaning of ‘bright’ is qualified by the word ‘blue’ i.e. ‘blue’ puts the word ‘bright’ into context and its meaning becomes a description of the vividness of a colour, such that the two words in combination have an inherent semantic link and form a unit,[13] having a different meaning to the meanings of the separate components. I have borne in mind that the two words are separated by a full stop rather than a space, but I find that that dot / full stop may be overlooked and is anyway not sufficient to disrupt the unitary effect of the two words.

36. In conclusion, the overall impression of the marks in the contested series is dominated by the words themselves appearing together, and in that particular semantic order i.e. ‘bright’ followed by ‘blue’, with neither word having a distinctive significance which is independent of the significance of the whole, nor is one word more dominant than the other.

[13] ‘Semantic link’ refers to the connections between words that contribute to their overall meaning and coherence.

Visual comparison

37. Visually the marks coincide with regard to the word 'bright', which is represented in the earlier marks and Contested Mark 2 in lowercase fonts. Whilst Contested Mark 1 can be represented in any font (because word marks protect the words themselves, not any particular presentation of the words),[14] it would be wrong for me to imagine it presented in the same font as the earlier marks. In the *'HERNO'* appeal case,[15] the Appointed Person, confirmed as follows:

> "23. In other words, it is not legitimate to perform a comparison between a word mark and a stylised word mark by considering specific ways in which the word might be presented. […]
>
> "34. […] The point is that the word mark is not limited to any particular script and therefore the script or font in which the device mark is written does not provide a point of distinction in itself. […]"

38. Whilst the respective fonts of the earlier marks and Contested Mark 2 may differ (slightly), given my earlier comments regarding the limited relative weight of the stylisation of the fonts in the overall impression of those marks, that difference is not significant. It is likely that the differences in font will either go unnoticed by the average consumer or the differences will merely fall victim of imperfect recollection, especially when taking into account that the respective fonts are relatively plain, and in essence are not materially dissimilar to each other. The colour difference that arises from the blue colour of Earlier Mark 2, is not a material visual difference since the colour does not provide a point of distinction in itself (when bearing in mind that the contested marks are not limited to any particular colour).

39. The respective marks coincide in the word 'bright', which is the first of the two words that make up the contested marks. The earlier marks contain a device element which is not present in the contested marks and this represents a point of visual dissimilarity; the contested marks contain a full stop which is not present in the earlier marks which represents another point of visual dissimilarity. However, given my

[14] *HERNO S.p.A. v Miss Sparrow Ltd,* BL O/954/22.
[15] *HERNO S.p.A. v Miss Sparrow Ltd,* BL O/954/22, see in particular paragraphs 23, 28 and 34.

assessment of the relative weight the device and the full stop play in the overall impression of the competing marks, these are not significant differences either.

40. The contested marks contain the word ‘blue’. This element is not present in the earlier marks. Given my finding that the words making up the contested marks form a unit, with neither being more dominant or distinctive than the other, this visual difference is significant i.e. the word ‘blue’ would not be overlooked.

41. Taking account of the differences and of the overall impressions, I find that the degree of visual similarity is medium overall.

Aural comparison

42. The word ‘bright’ is pronounced identically in both marks. The notable aural differences lie in the word ‘blue’. Whilst I do not overlook that the average consumer may articulate the full stop in the contested mark as ‘dot’, given the relative weight of that element in the overall impression of the marks, and given the semantic link between the words bright and blue, I consider it more likely that the average consumer would merely say ‘bright blue’ as opposed to ‘bright dot blue’. Thus the aural similarity is medium overall. (Of course, where the full stop is articulated the degree of aural similarity is diminished such that the marks would be aurally similar to a low to medium degree.)

Conceptual comparison

43. The word ‘bright’ is an ordinary dictionary-defined word. As I have mentioned, ‘bright’ is an adjective, therefore on its own it can have multiple meanings without other words to contextualise it. The meaning of the word ‘bright’ on its own would be understood by the average consumer. Within the context of the Opponent’s services, I accept that the perceived concept could be that the services offer bright (i.e. intelligent) solutions. However, without another word to contextualise it, that is not the only concept that can be attributed to it either and it could equally be seen as having the concept of vivid, light, optimistic etc. In my opinion, ‘bright’ has no singular discernible concept when perceived as a standalone adjective presented in the abstract.

44. I do not consider the device element imparts any conceptual message to the earlier marks. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer.[16] Even if I were to ruminate on a potential concept of that device, that meaning would likely be irrelevant in any event as it would not have been immediately apparent to me, therefore it would unlikely be immediately apparent to the average consumer also.

45. Within the context of the contested marks, the meaning of the word 'bright' is qualified by the word 'blue', such that the conceptual message of the contested marks as a whole (even for a consumer who does not overlook the full-stop) would be immediately understood as referencing a vivid shade of the colour blue, and it would therefore make no allusive references to the goods and services applied for. Given the relative weight of the full stop, I do not consider it alters the immediately discernible concept of the word 'bright' in combination with the word 'blue'.

46. To the extent that one of the meanings of 'bright' can be in reference to the vividness of a colour, I consider the marks share a similar concept (of brightness). However, I assess that similarity as low overall, because the word 'blue' is not present in the earlier marks, therefore the earlier marks do not share that immediately discernible concept of a vivid shade of blue.

47. I acknowledge that the word 'bright' in Earlier Mark 2 is presented in the colour blue. However, I do not consider the concept to be derived from that mark to be that of 'bright blue' and this same conceptual finding cannot be made of the other marks in the earlier series in any event. As I have already noted, the differences between marks in a series cannot be regarded as altering the conceptual identity of the marks. It seems to me that a consequence of this is that a finding cannot be made about one mark in the series if it cannot be made of the others. Therefore, the fact that the word 'bright' is represented in the colour blue in Earlier Mark 2, cannot mean that the concept of the mark is altered to that of 'bright blue'. As I have previously mentioned, the colour represents a non-distinctive feature, otherwise the earlier marks would no longer constitute a series of marks. I consider the average consumer will merely

[16] This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

perceive Earlier Mark 2 as representing the word ‘bright’ in the colour ‘blue’, as opposed to the consumer perceiving that it conveys the concept of ‘bright blue’.

Distinctive character of the earlier mark

48. 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,[17] although it is the distinctive character of a component that is similar between the marks that is particularly relevant.[18]

49. 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.

50. 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.

51. Notwithstanding the earlier marks are figurative and therefore consist of other elements (being the device, the font stylisation and the colour/colour contrast arrangements), given my assessment of the overall impression of the earlier marks, it is the word ‘bright’ which is the distinctive and dominant component of the marks.

52. The word ‘bright’ is an ordinary English word (not an invented word) and I have already noted that within the context of the Opponent’s services, ‘bright’ could be perceived as alluding to ‘intelligent’ software solutions, however, I do not think this renders the word devoid of distinctive character. Indeed, ‘bright’ is not a typical word used to refer to those services (the words ‘intelligent’ or ‘smart’ are likely to be the more apt terms). Therefore, although it is conceivable that the word ‘bright’ could be seen as allusive of a quality of the services, it does not mean that it cannot be used as a badge of origin.

[17] *Sabel v Puma*.
[18] *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 38 and 39.

53. I consider the earlier marks to be inherently distinctive to between a low to medium degree.

Conclusions on Likelihood of Confusion

54. 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.[19] I must also consider the average consumer of the services, the nature 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.[20]

55. 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.[21] 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.[22]

56. 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.[23] For example, they conclude that the later mark is another brand of the owner of the earlier mark because they share a common element.[24] In *L.A. Sugar Limited v By Back Beat Inc*,[25] Mr Iain Purvis Q.C., as the Appointed Person, explained that instances where one may

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

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

[21] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

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

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

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

[25] Ibid.

expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:[26]

> "(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)."

57. I have found that at least some of the services are identical.

58. The average consumer is a member of the general public or a business user, who will pay at least a medium degree of attention during the selection process (and whose attention increases where the goods or services are more specialised). The selection/ purchasing process is predominantly visual although I do not completely discount an aural component.

59. There is visual and aural similarity between the marks because they all contain the word 'bright'. The concept of the contested marks is that of a vivid shade of the colour blue. I have therefore found that there is a low degree of conceptual overlap with the earlier marks to the extent that one of the meanings of 'bright' can be in reference to the vividness of a colour.

60. The earlier marks have a low to medium level of inherent distinctive character and their distinctive character is attributable to the word 'bright', which has the potential to allude to the services provided. The concept of 'bright blue' however makes no allusive

[26] 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.

reference to the goods and services applied-for and its meaning is clearly distinguishable from the word 'bright' as a standalone term.

61. Whether the identified similarities give rise to a likelihood of confusion is obviously a separate question. In this regard I note once more that the principle derived from *Medion* and *Bimbo* is that a later composite mark which contains an element which is identical or similar to an earlier mark may lead to a likelihood of confusion, but only if that identical/similar element has an independent distinctive role in the later mark (and even then, the finding of a likelihood of confusion is not automatic and a global assessment of all relevant factors must be taken into account).

62. However, in circumstances where the meaning of that element is altered within the context of the later mark (because the meaning of one of the components is qualified by another component), then the *Medion* principle does not apply. Thus, in *Whyte and Mackay*, the mark 'ORIGIN' was being relied on in opposition to the trade mark 'JURA ORIGIN' for alcoholic drinks. The judge found that there was no likelihood of confusion because the word 'ORIGIN', as part of the composite 'JURA ORIGIN' mark, would not play an independent distinctive role in the eyes of the relevant consumers. The expression would instead be understood as a unit, essentially because when used after the name of the Scottish island Jura, the word 'ORIGIN' would simply be taken as indicating that the product in question came from the island of Jura, rather than having any independent trade mark significance within the context of the 'JURA' mark.

63. The respective marks coincide in the word 'bright', which is the first of the two words that make up the contested marks. Whilst I acknowledge the case law surrounding the assessment of identical 'beginnings of marks' giving rise to a strong visual similarity,[27] this is not a rule of law and each case must be assessed on its own facts, and that involves applying a multi-factorial assessment. Indeed, it is this multifactorial assessment that has led to decisions where marks are deemed to not be similar, despite their shared identical beginnings.[28]

64. I have found that the overall impression of the contested marks is not dominated by one particular word, and that the word 'bright' does not have an independent distinctive significance within the contested marks. Rather, the word 'bright' followed

[27] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[28] See *CureVac GmbH v OHIM,* T-80/08, paragraph 41.

by ‘blue’ (in that particular semantic order) forms a unit, having a different meaning to the meanings of the separate components, this is because the meaning of ‘bright’ is qualified by the word ‘blue’. I note that in *Calvin Klein Trademark Trust v OHIM,*[29] the Court of Justice of the European Union found that:

> “56. […] the existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. […]”

65. Taking all the foregoing into account, it is my opinion that notwithstanding the shared similarities between the marks owing to the word ‘bright’, that overall, the average consumer would not confuse one series of marks for the other, particularly on account of the presence of ‘blue’ in the contested marks. Since the word ‘bright’ is not a standalone term within the contested marks (because ‘blue’ qualifies ‘bright’), the principles of *Medion* and *Bimbo* do not apply and therefore I find that there is no likelihood of direct confusion. I make this finding despite having found that at least some of the respective services are identical.

66. I also do not consider that there would be indirect confusion, since there is no *“proper basis”* for such a finding.[30] Firstly, I cannot see any scenario in which the contested marks would fall into any of the *‘L.A. Sugar*’ categories of indirect confusion, particularly as ‘bright’ is not so strikingly distinctive that any addition to it would lead to consumer confusion; nor is the word ‘blue’ the sort of element which the consumer would dismiss or overlook as an origin neutral element within the context of the contested marks.

67. The Opponent has not claimed that it has a family of ‘bright’ marks (nor has it produced any evidence to establish any such claim), and I cannot see how ‘blue’ could be seen as a logical addition consistent with a brand extension. For example, it is not as though the Opponent has a family of marks such as ‘bright white’, ‘bright red’, ‘bright green’ etc. and therefore ‘blue’ could arguably be seen as a logical brand extension within that family.

[29] Case C-254/09 P.
[30] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 16

68. Furthermore, whilst the *'L.A. Sugar*' categories are not exhaustive,[31] I have not been presented with submissions to explain a *"proper basis"* on which the average consumer would be indirectly confused as to the origin of the goods and services. The fact that the marks share the word 'bright' may result in one mark calling the other to mind but that does not constitute confusion – this is mere association and is not sufficient in itself for a finding of confusion. Indeed, a finding of indirect confusion is not *"a consolation prize"* where direct confusion is not established, and should not be made merely because the two marks share a common element.[32] I therefore conclude that there is no likelihood of indirect confusion either.

Final remarks

69. As the outcome is no likelihood of confusion where the respective services are identical, it follows that the outcome would also be the same where the competing goods and services are only similar, therefore there is no need to return to consider the remainder of the opposed specification.

OUTCOME

70. The opposition under section 5(2)(b) of the Act fails. Subject to appeal, the application shall proceed to registration for all the goods and services applied for.

COSTS

71. The Applicant has been successful and is entitled to a contribution towards its costs based on the contributory scale set out in Tribunal Practice Notice 1/2023. In the circumstances, I award the Applicant the sum of £250 for considering the notice of opposition and filing a counterstatement.

72. I therefore order **Bright HR Limited** to pay **Bright.Blue Co.** the sum of **£250** which should be paid within twenty-one days of the expiry of the appeal period or, if there is

[31] In '*Liverpool Gin'*, Arnold LJ approved Mr Purvis's formulation in *'L.A. Sugar*' 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.
[32] See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81.

an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of June 2025

Daniela Ferrari

For the Registrar

Annex 1

Full list of applied-for goods and services

Class 7	Dispensing machines [other than vending machines]; vending machines; automated vending machines; automatic vending machines; dispensing machines.
Class 9	Electronic control apparatus; electronic control circuits; electronic control systems; electrical control boards; control circuits; electrical control panels; electronic control units; computer circuit boards; touch sensitive control panels; machine control software; computer hardware; microchips [computer hardware]; computer hardware for use in computer-assisted software engineering; software development programs; software for product development; software; product engineering software; software for use in advertising; computer software for advertising; search marketing software; computer software packages; e-commerce software; interactive software; payment software; online payment software; digital solutions provider [dsp] software; electronic payment terminals; software for processing electronic payments to and from others; hardware for processing electronic payments to and from others; software for facilitating secure credit card transactions; apparatus for electronic payment processing; terminals for electronically processing credit card payments; mobile apps; mobile application software; application software for mobile phones; downloadable smart phone applications (software); downloadable software in the nature of a mobile application; point of sale terminals; point of sale [pos] systems; point of sale apparatus; data exchange units; electronic point of sale [epos] systems; electronic displays; electronic advertising displays; electronic display panels; electronic panels for displaying messages; electronic display interfaces; electronic numeric displays; electronic display boards; electronic visual display units; machine control software; computer software for controlling self-service terminals; reporting software; measuring, detecting, monitoring and controlling devices; computer software for use in remote meter monitoring; software for monitoring, analysing, controlling and running physical world operations; cloud network monitoring software; remote monitoring apparatus; monitoring instruments; computer software for the monitoring of computer systems; network management control apparatus; sensors, detectors and monitoring instruments; electric monitoring apparatus; electronic measurement sensors; temperature control apparatus [thermostats] for machines; instruments for temperature control; computer software for use in remote meter monitoring; sensors for monitoring physical movements; video cameras adapted for monitoring purposes; motion-activated cameras; monitoring apparatus and instruments; artificial intelligence software; artificial intelligence apparatus; artificial intelligence software for surveillance; artificial intelligence software for analysis; cloud servers; cloud computing software; cloud server software; cloud network monitoring software; electronic advertising displays; illuminated advertising signs; advertising display signs [mechanical or luminous]; advertising display apparatus [mechanical or luminous]; advertising signboards [luminous]; electronic panels for displaying messages; software for use in advertising; advertising signboards [mechanical]; optical barcode

	recognition [obr] software; biometric software; charging docks; electric-car chargers; electrical charge controllers; charging stations for electric vehicles; electronic control apparatus for charging docks, electric-car chargers, electrical charge controllers, charging stations for electric vehicles; electronic control systems for charging docks, electric-car chargers, electrical charge controllers, charging stations for electric vehicles.
Class 42	Hardware design; computer hardware (design of -); computer hardware design; design of computer hardware; design of computer hardware and software; computer hardware and software design; computer hardware development; development of computer hardware; rental of computer hardware and software; computer hardware leasing; leasing of computer hardware; computer hardware design services; design services for computer hardware; designing of computer hardware; computer hardware rental; rental of computer hardware; troubleshooting of computer hardware and software problems; design and development of computer hardware and software; design and development of computer hardware; customized design of computer hardware; rental of computer hardware and computer software; rental of computer hardware and computer peripherals; configuring computer hardware using software; renting out hardware and software; design of computer hardware for the manufacturing industries; design and development of computer hardware architecture; design services relating to computer hardware; rental of computer hardware and facilities; diagnosing computer hardware problems using software; development of computer hardware for the manufacturing industries; design and development of computer hardware for the manufacturing industry; technical consultancy relating to the use of computer hardware; software development; development of software; software design and development; computer software development; development of computer software; development and testing of software; software development services; development and maintenance of computer software; software as a service; software as a service [saas]; consulting services in the field of software as a service [saas]; software maintenance services; services for maintenance of computer software; computer software maintenance services; software engineering services; development services relating to computer software application solutions; providing temporary use of on-line non-downloadable software for processing electronic payments; providing user authentication services using biometric hardware and software technology for e-commerce transactions; development of computer software application solutions; application service provider services; user authentication services using technology for e-commerce transactions; design services for data processing systems; monitoring of computer systems to detect breakdowns; computer system monitoring services; maintenance and updating of software for communication systems; diagnosis of faults in computer software; updating of software for data processing; monitoring of network systems; testing services for alarm and monitoring systems; monitoring of computer systems for security purposes; monitoring of computer systems to detect breakdowns; computer security system monitoring services; computer system monitoring services; monitoring of telecommunication signals; hosting of web portals; hosting web portals; user authentication services using single sign-on technology for online software applications; providing user authentication services

	using single sign-on technology for online software applications; user authentication services using technology for e-commerce transactions; hosting of portals on the internet; providing user authentication services using biometric hardware and software technology for e-commerce transactions.