O/0711/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003885897

IN THE NAME OF

CHECK POINT SOFTWARE TECHNOLOGIES LTD.

TO REGISTER THE FOLLOWING TRADE MARK:

CHECK POINT

IN CLASSES 9, 16 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000442873

BY MEDIA CHECK POINT SPÓŁA Z
OGRANICZONĄ ODPOWIEDZIALNOŚCIĄ

Background and pleadings

1. On 7 March 2023, Check Point Software Technologies Ltd. ("***the Applicant***") applied to register the trade mark shown on the cover page of this decision in the UK ("***the Contested Mark***"). The application was accepted and published in the Trade Marks Journal on 9 June 2023 in respect of the following goods and services:

   Class 9: Software and / or applications incorporated into computers and / or network systems used in data networks to control network traffic flow, establish trusted links over the network and / or Internet, prevent network attacks (as opposed to physical attacks and / or theft) and to integrate various technologies into a uniform network security policy sold primarily through value added resellers and system integrators, computer and network equipment providers, telecommunications and Internet service providers; excluding machines and apparatus for use in currency exchange, cash dispensing and other financial transactions, automatic teller machines and parts and fitting therefor.

   Class 16: Printed matter in the form of catalogs, brochures, instructional and technical manuals concerning computer software intended to protect computer systems from unauthorized access via computer networks, but excluding credit cards, debit cards, charge cards, top-up cards and money transfer cards.

   Class 42: Services related to the design, implementation and maintenance of computer software for Internet service providers and telecommunications companies for managing network infrastructure, traffic management, IP management and for computer software to protect systems from unauthorized access.

2. On 4 September 2023, Media Check Point Spóła z ograniczoną odpowiedzialnością ("***the Opponent***") opposed the application under section 5(2)(b) of the Trade Marks Act 1994 ("***the Act***"). The opposition is directed against

all of the goods and services in the application. The Opponent relies upon the following trade mark ("***the Earlier Mark***"):

UK Registration no. UK00918226533

Filing date: 16 April 2020

Date of registration: 31 July 2020

3. For the purpose of these proceedings, the Opponent relies upon the following goods and services:

Class 9: Scientific apparatus and instruments; Global positioning instruments; Personal digital assistants [PDAs]; Video devices; Teaching apparatus; Measuring apparatus, excluding wheel positioning indicators; Marine radios; Maritime rescue apparatus; Marine communication apparatus; Surveying apparatus and instruments; Cameras [photography]; Cinematographic cameras; Optical apparatus and instruments; Weighing apparatus and instruments for standard unit; Measuring instruments, excluding wheel positioning indicators; Signalling apparatus and instruments, excluding wheel positioning indicators; Safety, security, protection and signalling devices, excluding wheel safety products and wheel positioning indicators; Monitoring control apparatus [electric]; Electric control apparatus; Mechanical life saving apparatus; Monitoring instruments, excluding wheel positioning indicators; Sensors, detectors and monitoring instruments, excluding wheel positioning indicators; Recording apparatus; Imaging apparatus; Apparatus for the transmission of images; Image analyzers; Apparatus for recording images; Magnetic data carriers, recording discs; Compact discs; DVDs; Coin-operated mechanisms; Cash registers; Computers; Coin counting or sorting machines; Apparatus and instruments for

reproducing of data; Programs for computers; Automatic fire extinguishing apparatus.

Class 16: Cardboard boxes; Cartons of cardboard for packaging; Containerboard; Cardboard packaging; Jotters; Note books; Books; Printed matter; Display banners of paper; Display banners made of cardboard; Posters; Bookbindings; Photographs [printed]; Paper stationery; Office binders; Paper crafts materials; Gums [adhesives] for stationery or household purposes; Artists' materials; Artists' brushes; Typewriters, electric or non-electric; Teaching materials [except apparatus]; Plastic materials for packaging; Type [numerals and letters]; Printing blocks.

Class 35: Advertising; Administrative processing and organising of mail order services; Providing consumer product information via the Internet; Providing commercial information to consumers; Ordering services for third parties; Online ordering services.

4. The Opponent's above registration is a comparable mark.[1] By virtue of its earlier filing date, the Earlier Mark qualifies as an earlier mark within the meaning of section 6 of the Act. As the Earlier Mark had not completed the registration process more than five years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services it has identified without having to demonstrate use.

5. The Opponent submitted, in its statement of grounds, that the marks are visually, aurally and conceptually highly similar, as they both contain the identical words "CHECK POINT", and that the goods and services are identical or highly similar. The Opponent claimed that, as a result, there is a risk of confusion, including a likelihood of association, on the part of the public between the competing marks.

[1] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

For this reason, the Opponent requested the Contested Mark to be refused in its entirety under section 5(2)(b) and award of costs to be made in its favour.

6. On 7 June 2024, the Applicant filed a counterstatement within which it denied all the claims made by the Opponent and requested the opposition to be refused in its entirety. The Applicant submitted that the application should be accepted and registered for all the applied-for goods and services and an order of costs be made in its favour.

7. The Applicant is represented by Withers & Rogers LLP. The Opponent is represented by Stevens Hewlett & Perkins.

Relevance of EU law

8. 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.

Evidence and submissions

9. During the evidence rounds, neither party filed evidence nor submissions. Neither party requested a hearing, but the Applicant filed submissions in lieu of a hearing. I will not summarise the submissions here, but I will refer to them as and where appropriate in this decision. This decision is taken following a careful perusal of the papers.

Decision

Section 5(2)(b)

10. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

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

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

11. Section 5A reads:

"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."

Case law

12. The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa; Page 8 of 20

(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

13. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon,* Case C-39/97, the court stated at paragraph 23 that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.

14. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. In *Gérard Meric v OHIM,* Case T-133/05, the General Court ("GC") stated that:

> "In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

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

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

> "82. [...] 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".

17. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

18. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

19. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

> "365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

20. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

21. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) said at [19]:

> "[…] definitions of services […] are inherently less precise than specifications of goods. […] In my view, specifications for services should be scrutinised

carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

22. For the purposes of considering the issue of similarity of the goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.

23. The goods and services for comparison are as follows:

Opponent's goods and services	**Applicant's goods and services**
Class 9	**Class 9**
Scientific apparatus and instruments; Global positioning instruments; Personal digital assistants [PDAs]; Video devices; Teaching apparatus; Measuring apparatus, excluding wheel positioning indicators; Marine radios; Maritime rescue apparatus; Marine communication apparatus; Surveying apparatus and instruments; Cameras [photography]; Cinematographic cameras; Optical apparatus and instruments; Weighing apparatus and instruments for standard unit; Measuring instruments, excluding wheel positioning indicators; Signalling apparatus and instruments, excluding wheel positioning indicators; Safety, security, protection and signalling devices, excluding wheel safety products and wheel positioning indicators; Monitoring control apparatus [electric]; Electric control apparatus; Mechanical life saving apparatus;	Software and / or applications incorporated into computers and / or network systems used in data networks to control network traffic flow, establish trusted links over the network and / or Internet, prevent network attacks (as opposed to physical attacks and / or theft) and to integrate various technologies into a uniform network security policy sold primarily through value added resellers and system integrators, computer and network equipment providers, telecommunications and Internet service providers; excluding machines and apparatus for use in currency exchange, cash dispensing and other financial transactions, automatic teller machines and parts and fitting therefor.

Monitoring instruments, excluding wheel positioning indicators; Sensors, detectors and monitoring instruments, excluding wheel positioning indicators; Recording apparatus; Imaging apparatus; Apparatus for the transmission of images; Image analyzers; Apparatus for recording images; Magnetic data carriers, recording discs; Compact discs; DVDs; Coin-operated mechanisms; Cash registers; Computers; Coin counting or sorting machines; Apparatus and instruments for reproducing of data; Programs for computers; Automatic fire extinguishing apparatus.	
Class 16	**Class 16**
Cardboard boxes; Cartons of cardboard for packaging; Containerboard; Cardboard packaging; Jotters; Note books; Books; Printed matter; Display banners of paper; Display banners made of cardboard; Posters; Bookbindings; Photographs [printed]; Paper stationery; Office binders; Paper crafts materials; Gums [adhesives] for stationery or household purposes; Artists' materials; Artists' brushes; Typewriters, electric or non-electric; Teaching materials [except apparatus]; Plastic materials for packaging; Type [numerals and letters]; Printing blocks.	Printed matter in the form of catalogs, brochures, instructional and technical manuals concerning computer software intended to protect computer systems from unauthorized access via computer networks, but excluding credit cards, debit cards, charge cards, top-up cards and money transfer cards.

Class 35	
Advertising; Administrative processing and organising of mail order services; Providing consumer product information via the Internet; Providing commercial information to consumers; Ordering services for third parties; Online ordering services.	
	Class 42
	Services related to the design, implementation and maintenance of computer software for Internet service providers and telecommunications companies for managing network infrastructure, traffic management, IP management and for computer software to protect systems from unauthorized access.

Class 9

- "*Software and / or applications incorporated into computers and / or network systems used in data networks to control network traffic flow, establish trusted links over the network and / or Internet, prevent network attacks (as opposed to physical attacks and / or theft) and to integrate various technologies into a uniform network security policy sold primarily through value added resellers and system integrators, computer and network equipment providers, telecommunications and Internet service providers; excluding machines and apparatus for use in currency exchange, cash dispensing and other financial transactions, automatic teller machines and parts and fitting therefor.*"

24. Only the Applicant provided submissions on the goods' similarity. In its submissions in lieu, it was contended that:

"*26. [..] as previously asserted by the Applicant in their defence, the applied for goods and services in Classes 9 and 42 are not highly similar to the Opponent's relied upon goods and services in Classes 9, 16 and 35.*

27. The majority of the Opponent's goods in Class 9 are apparatus or instruments, these have a different nature, end user, method of use, and they are not in competition with, nor are they complementary to the 'software' products applied for in Class 9 by the Applicant. Moreover, the Applicant's software products are specific for "network systems used in data networks to control network traffic flow, establish trusted links over the network and / or Internet, prevent network attacks (as opposed to physical attacks and / or theft) and to integrate various technologies into a uniform network security policy sold primarily through value added resellers and system integrators, computer and network equipment providers, telecommunications and Internet service providers", which further removes their similarity to the Opponent's Goods in Class 9".

25. The Applicant also argued that:

"28. A*s to the 'computer programs recorded' registered in Class 9 by the Opponent, the nature and distribution of these goods differs to the specific 'software' goods applied for in Class 9 by the Applicant. The Applicant's 'software' goods are integrated into computer and network systems, whereas 'computer programs recorded' are separately stored on physical mediums, like CDs or USB drives*".

26. Regarding the Applicant's argument submitted in paragraph 28, I note that the Opponent's specification in class 9 does not feature the term *'computer programs recorded'* to which the Applicant refers, but it contains the term "*Programs for computers*". This leads to my second consideration that whilst recorded computer programs are usually stored on physical media, as contended by the Applicant, the Opponent's "*Programs for computers*" can exist in various forms (e.g., source code, compiled code, or running in memory).

27. Turning to the similarity assessment, I acknowledge the Applicant's submission above and I find that the Applicant's goods above essentially consist of a network

security software (or application software) incorporated into computers (i.e., computer software) that are provided to technology service providers. This term represents a wider category also encompassing the Opponent's "*Programs for computers*" in class 9 and vice versa. Therefore, I find these goods to be identical in line with the principle outlined in *Meric*.

28. In the eventuality that I am mistaken, I nonetheless find the respective goods to be highly similar. Software (or application software) can be defined as a collection of computer programs to perform specific tasks (on a computer or other devices). Therefore, I find that the contested term above and the Opponent's "*Programs for computers*" share the same nature (i.e., program or combination of programs for computers) and method of use. Whilst I appreciate that the Applicant's software (or application software) has a restricted function and application (i.e., network security software not for use with machines and apparatus for currency exchange, cash dispensing, other financial transactions, and automatic teller machines), the Opponent's "*Programs for computers*" can be used (individually or as part of a software) for different purposes. Thus, the competing goods could also overlap in their intended purpose. The same finding applies to the respective goods' intended users, trade channels and level of competition. This is because, whilst the Applicant's software (or application software) is aimed at specific end users (i.e., Value Added Resellers (VARs) and system integrators, computer and network equipment providers and telecommunications and Internet Service Providers (ISPs)) the Opponent's computer programs can be employed (individually or as part of a software) for various uses. Thus, the Opponent's goods can be aimed at different users, including those of the Applicant's, and the competing goods may also be provided via the same trade channels. In line with this reasoning, I also find that the parties' goods are in competition with each other. Furthermore, since computer programs can be used as an essential part of a software, I find that the competing goods are complementary in so far as the Opponent's "*Programs for computers*" would be indispensable (or important) for the functioning of the Applicant's software (or application software) in such a way that customers may think that the responsibility for those goods lies with the same undertaking.

29. The Applicant also contended that its goods in class 9 differ from the Opponent's services in class 35.[2] To this end, the Applicant directed me to a prior decision from the Registry (BL O/0087/24). Notwithstanding the fact that I am not bound by previous decisions of the Registry, having already found identity (or high similarity) between the competing goods in the parties' respective class 9, I will not proceed to assess the similarity (or lack thereof) of the Applicant's goods in class 9 and the Opponent's services in class 35.

Class 16

- "*Printed matter in the form of catalogs, brochures, instructional and technical manuals concerning computer software intended to protect computer systems from unauthorized access via computer networks, but excluding credit cards, debit cards, charge cards, top-up cards and money transfer cards*"

30. I appreciate that the Applicant submitted, in its submissions in lieu, that "*the Applicant accepts the Opponent's Goods in Class 16 are similar to the Applicant's applied for goods in Class 16*".[3] However, the Applicant did not clarify further the level of similarity contended (or accepted). Therefore, I will proceed with my own assessment of similarity for the competing goods in class 16 as outlined below.

31. The Applicant's goods all consist of 'printed matter'. Thus, they are *Meric* identical to the Opponent's "*Printed matter*" featured in class 16.

32. The Applicant also contended that its goods in class 16 differ from the Opponent's services in class 35 and directed me to a prior decision from the Registry (BL O/0974/23). [4] I will not proceed to assess such similarity for the same reasons as explained in paragraph 29 above in this decision.

Class 42

- "*Services related to the design, implementation and maintenance of computer software for Internet service providers and telecommunications companies for*

[2] Ibid. [30].
[3] Ibid, [25].
[4] Ibid. [31].

managing network infrastructure, traffic management, IP management and for computer software to protect systems from unauthorized access"

33. In its submissions in lieu, the Applicant contended that:

> "*29. For the same reasons at paragraphs 26 and 27 above* [reported in this decision at paragraph 24 above]*, the Opponent's goods in Class 9 are not similar to the Applicant's applied for services in Class 42. Moreover, the Applicant's Class 42 Services are services, not physical goods. Their method of use and end users will also differ*".
>
> *[…]*
>
> *32. The Opponent's Services relied upon in Class 35 have a different nature, end user, method of use, they are not complementary nor are they in competition with the Applicant's Services in Class 42.*
>
> *[…]*
>
> *35. Furthermore, the Opponent's Goods in Class 16 have a different nature, method of use, end user and are not complementary nor in competition with the Applicant's Services in Class 42*".

34. I note the Applicant's submissions and the alleged dissimilarity between the Applicant's class 42 and the Opponent's classes 16 and 35. I will begin my similarity assessment from the comparison between the Applicant's services in class 42 above and the Opponent's goods in class 9 since it is where a potential degree of similarity is most likely to occur. If no similarity is found, I will move to consider the other classes the Opponent relied on.

35. The contested services above are concerned with the design, implementation and maintenance of network security/administration computer software provided to ISPs and telecommunications companies. Having found above that computer programs are employed in and for software, whilst I appreciate that services are not the same as goods, I consider the Opponent's "*Programs for computers*" (in class 9) to be the end result of the Applicant's design and development services.

36. While some of the Applicant's aforementioned software design/implementation/maintenance services are specified as being for a particular use (i.e., network security and administration), the Opponent's 'computer program' goods are not limited and so could include computer programs (as part of software) designed for the Applicant's specific purposes. As such, it would not be unreasonable for the consumers (e.g., ISPs and telecommunication companies) to expect both goods and services to be provided by the same or economically linked undertakings. There will be some overlap in trade channels, and there may be an element of competition, with the consumers selecting either bespoke software from the designer or choosing specific computer programs already on the market. However, while the services relate to software, the nature, purpose and method of use is different to that of the goods themselves. Overall, I consider the competing goods and services to be similar to a medium degree.

Average consumer and the purchasing act

37. It is necessary to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited*, *The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

38. Accordingly, the average consumer of the category of products and services concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheideand Tusky* [1998] ECR I-4657, paragraph 31).

39. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question.[5]

40. Only the Applicant, in its submissions in lieu, provided arguments regarding the average consumer. These are as follows:

> "*36. The average consumer and their level of attention varies according to the category of goods and services in question. Both the Opponent's Goods and Services and the Applicant's Goods and Services will be primarily purchased by the general public, but they can also be purchased by professionals. The degree of attention will vary, but at least a medium degree of attention will be paid by the consumer.*
>
> *37. In this instance, the purchasing process is likely to be primarily a visual one, where consumers browse the shelves or website of a physical or online environment. Aural considerations are also relevant.*"

41. With regard to the goods and services for which I found similarity in classes 9 and 42, these are types of network security software (including computer programs) and software applications (class 9) and the design, implementation and maintenance of network security/administration computer software (class 42).

42. The relevant consumer for the goods in class 9 is likely to be part of the general public, for example, users downloading a software or software application onto their devices to protect their online network (similar to an anti-virus). However, the relevant consumers may also be businesses or other form of organisation/undertaking wanting specialist software for their business operations (e.g., technology service providers, ISPs or telecommunication companies).

43. The cost and frequency of purchase for the goods in class 9 will vary depending on the type of software and it is likely to range from relatively low for simple security network software (e.g., antivirus) to relatively high (but not the highest) for more technical software. Several factors may influence the average consumer when purchasing the goods, such as suitability, technical function, and the compatibility

[5] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

of the software with existing systems. Based on these factors, I find that the average consumer for the software goods in class 9 will pay at least a medium degree of attention with a higher degree of attention for the professional public.

44. The goods are likely to be obtained by self-selection from websites, e-commerce platforms, or app stores. The goods may also be purchased following advertisements on social media or other specialised online platforms. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase of the goods through advice sought from a sales assistant or representative, and word-of-mouth recommendations.

45. Turning to the services in class 42, these are likely to be purchased by professionals (e.g., technology service providers, ISPs or telecommunication companies). When purchasing the services the consumers will take into account various factors such as the compatibility of the software with the customers' current IT systems, the technical capability and reputation of the service provider (e.g., software developer) and the suitability to satisfy any specific business requirements. Some of the services will be fairly specialised and therefore likely to be expensive (including with regard to the software applications). This will depend on the specific needs of the customer (who is likely to be a business) considering the purchase of a more sophisticated software package which may require a more bespoke approach. The level of attention taken by the prospective purchaser may be influenced by their own requirements. Consequently, I consider that these services will likely be purchased with a high level of attention.

46. The purchasing process is likely to be mainly visual. The consumers are likely to consult websites or catalogues and will have access to advertising material in print and online. However, I do consider that aural considerations may also play a part, for example through word of mouth or consultations with the service provider.

47. Turning to the goods in class 16 for which I found similarity (i.e., printed matter), in my view, the average consumer for the competing goods will most likely be the general public, although I acknowledge that the goods may also be aimed at businesses, especially regarding goods like 'technical manuals concerning computer software'. I will assess the likelihood of confusion from the perspective

of the general public since they are the group who will pay the lower degree of attention.[6]

48. Although the price of the goods can vary, on balance, the cost of the goods is likely to be fairly low and the goods will be purchased reasonably frequently with consumers considering the subject matter/type of paper and the goods' suitability for their needs.

49. Both parties' goods are sold through a range of channels including supermarkets, department stores and stationers, as well as online. In retail and wholesale outlets, the goods will be displayed on shelves where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a web page. The selection process will, in my view, be a predominantly visual one, although aural considerations will play a part. Considered overall, I find that the level of attention will be no more than medium when selecting the goods.

Comparison of the marks

50. The respective trade marks pleaded under section 5(2)(b) are shown below:

Earlier trade mark	Contested trade mark
	**CHECK POINT**

Overall impression

51. The Earlier Mark features, on the left-hand side, the letters 'MCP' disposed vertically one on top of the other and partially overlapping. These letters are styled to resemble ink-pen handwriting, with varying line thickness suggesting ink flow. On the right-hand side, the mark displays the lowercase words "media" and "check point" arranged vertically over three lines. The word "media" is represented in smaller font in comparison to "check point", and it is stretched to align with the

[6] Case T-356/14, [25] – [26].

words “check point” below. “Check point” is represented in the same font as the word “media” but in a larger size. A red line separates vertically the stylised letters ‘MCP’, on one side, and the words “media check point” on the other side.

52. To my mind, it is the words “check point” in standard typeface which mainly stand out. Although the relevant consumers may understand the stylised device on the mark’s left-hand side as the three-letter combination ‘MCP’, given its stylisation and the overlap between the letters (especially between ‘C’ and ‘P’), I find that the relevant consumers will perceive ‘MCP’ as more of a decorative nature. As such ‘MCP’ likely makes a lesser contribution to the mark’s overall impression.

53. Turning to the word “media”, since in combination with “check point” it does not create a unitary meaning, the relevant consumers are likely to focus their attention primarily to those verbal components that occupy a more predominant position in comparison to the smaller-sized word “media”. Thus, I find that “media” makes a lesser contribution to the mark’s overall impression, although it would not go completely unnoticed.

54. Considered overall, it is the words “check point” which make the greatest contribution to the overall impression of the mark, with the letters ‘MCP’ making a lesser, but still relevant, contribution. The word “media”, makes the least contribution to the mark’s impression given its size and representation within the mark.

55. The Contested Mark consists of the words “CHECK POINT” all capitalised and in standard typeface. Since the combination of the words “CHECK POINT” conveys a dictionary meaning, as it will be further discussed below in this decision, I find that both words form a unitary meaning within the mark and equally contribute to the mark’s overall impression.

Visual similarity

56. In its submissions in lieu the Applicant submitted that (original emphasis):

> *“11. The Applicant’s Mark and the Opponent’s Mark both contain the element CHECK POINT. Nevertheless, the Applicant’s Mark is made up of <u>two</u> word elements, namely CHECK POINT. Whereas the Opponent’s Mark is made up*

of <u>four</u> word elements, namely MCP MEDIA CHECK POINT. The Opponent's Mark is twice the length when read by the consumer.

12. Moreover, when the consumer reads the Opponent's Mark, and as the English language is read left to right, it is the MCP element that will be read first and will be considered the dominant and distinctive element of the Opponent's Mark. It is well-established that it is the initial element of a trade mark that is most memorable in the mind of the consumer. On the other hand, it will be the CHECK element of the Applicant's Mark, as the initial element, that will be remembered and, as a result, will also be considered the dominant and distinctive element. Comparing the MCP and CHECK elements, they are not visually similar.

13. What is more, the Opponent's Mark is stylised in a distinctive manner with the MCP appearing to the left of the words MEDIA CHECK POINT, with a red line between them. The stylisation of the three letters, MCP is also distinct and unusual given that the letters are intertwined. In view of this, given the distinctive configuration of the Opponent's Mark, it is this that will also be recalled by the consumer when visualising the Opponent's Mark. In comparison, the Applicant's Mark is plain text, and it will be the words that are recalled, rather that [sic] the configuration.

14. Considering the above, the respective marks are visually similar to a very low degree."

57. I note the Applicant's submissions and appreciate that whilst the competing marks share the same words "check point", the Earlier Mark contains two additional elements ('MCP' and "media"), for a total of eight letters, in contrast to the Contested Mark (i.e., CHECK POINT).

58. I also acknowledge the Applicant's submission that the additional letters 'MCP' are placed at the beginning of the Earlier Mark and, as consumers read left to right (and from top to bottom) and are likely to pay more attention to the beginnings of marks,[7] they will likely notice the difference between the letters 'MCP' in the

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

Contested Mark and “CHECK” in the Earlier Mark. To this regard, I must remind myself that the principle laid down in *El Corte Inglés* (and other case law) is not a hard and fast rule of law. Rather, it is a practical rule of thumb, based on experience and observation. It amounts to no more than “All else being equal, the average consumer will tend to pay more attention to the beginnings of marks than other parts of marks, because consumers read from left to right”.[8] Accordingly, in the case at hand, I found that “CHECK POINT” in the Contested Mark forms its own conceptual unit and that the relevant consumer, when confronted with the Earlier Mark, is likely to pay more attention to the words “check point” rather than the initialism ‘MCP’ due to its position within the mark and the clearer (and more immediate) meaning the words “check point” convey. It is my view that this finding militates, at least to some extent, against the *El Corté Ingles* principle.[9]

59. The Applicant also contended that the competing marks are visually dissimilar, firstly, because the relevant consumers will read ‘MCP’ first and will consider this letter combination as the dominant and distinctive element of the Earlier Mark. Secondly, because the Earlier Mark’s stylisation creates even further visual dissimilarity. I disagree that consumers will concentrate on ‘MCP’ due to its position in the mark, as explained in the paragraph above; I also disagree that they will consider this letter combination as the distinctive element in the mark as outlined above at paragraphs [51] – [54]. I agree with the Applicant, though, that the Earlier Mark’s stylisation (i.e., the stylised font of ‘MCP’, the vertical red line placed in the middle of the mark and the general arrangement of the words within the mark) detracts from the marks’ visual similarity.

60. Overall, following from the above considerations, and absent further submissions from the Opponent, I find the marks to have a below-medium degree of visual similarity.

Aural similarity

61. The Applicant submitted that:

[8] See decision from the Appointed Person (AP) in BL O/0976/23 at [22].
[9] For a similar conclusion on this point, see the decision from the AP in BL O/0648/24 at [22].

"*16. Furthermore, when speaking about the respective marks or pronouncing the respective marks, they are very different in length, with the Opponent's Mark being four times the length of the Applicant's Mark: the Applicant's Mark is only 2 syllables in length (check-point), whereas the Opponent's Mark is 8 syllables in length (M-C-P-me-di-a-check-point).*

17. Additionally, whilst MCP will be understood by the consumer as being an acronym for MEDIA CHECK POINT, as MCP is the initial element and given the overall length of the Opponent's Mark, it is this dominant and distinctive initial element that the consumer will refer to when speaking about the Opponent's Mark. Whereas the consumer will refer to the Applicant's mark as 'Check Point'. MCP and 'Check Point' share no aural similarities.

18. Overall, the Applicant's Mark and the Opponent's Mark are aurally similar to a very low degree."

62. The Opponent did not provide me with further comments on the marks' aural similarity.

63. The Earlier Mark contains the three-syllable word "media" and two syllables in the words "check point". These are English dictionary words, and the relevant consumer will voice them accordingly. The mark also contains the letter combination 'MCP'. Given the stylisation and arrangement of the letters composing the initialism 'MCP', the relevant consumers are likely to see this element more as decorative in nature and, as a result, it will not be pronounced.

64. The relevant consumers will not voice the red line in the Earlier Mark.

65. The Contested Mark features two syllables in the words "CHECK POINT" consisting of ordinary English dictionary words which would be read accordingly.

66. The relevant consumers will read "check point" identically in both marks.

67. I agree with the Applicant's submissions that the Earlier Mark contains, along with "check point", two additional elements (i.e., 'MCP' and "media") and that these elements, if voiced in the Earlier Mark, will take the respective marks' similarity further apart.

68. To this regard, it is my view that the general public, when confronted with a mark which includes several words (or verbal elements), is likely not to voice all the verbal elements contained in the mark and tends to focus its attention (and read) primarily those words with which it is familiar and that convey an immediate and clear meaning. For this reason, I find that a significant proportion of the relevant consumers will likely voice the dictionary words "media check point" and disregard the initialism 'MCP'. In this case the respective marks will have a medium degree of aural similarity.

69. I also find that another, separate, significant proportion of the relevant consumers, when reading the marks, will exclusively focus on the words "check point". First, because they would pay less attention to 'MCP' as stated above, second, because, given the reduced size of "media" within the mark, such group of relevant consumers is likely to overlook it from an aural perspective. In this case I find the marks to have a high degree of aural similarity.

Conceptual similarity

70. The Applicant, in its submissions in lieu, contended that:

> "*19. The Applicant's Mark, CHECK POINT, is used in everyday English language, and will be understood by the consumer to be a point where a check of some kind occurs.*
>
> *20. On the other hand, the Opponent's mark is comprised of an acronym, MCP, which will be understood to stand for MEDIA CHECK POINT. As to the MEDIA CHECK POINT element, as a whole this has no meaning. However, if you were to break down the elements further to MEDIA and CHECK POINT, these are both words that are used in everyday English language with the MEDIA element being understood as a means of mass communication and the CHECK POINT element being given the same meaning as at paragraph 19. Overall, MEDIA CHECK POINT would be considered to mean a point where means of mass communication are checked."*

71. The Opponent did not provide me with any submissions on this point.

72. It is my view that the relevant consumers may or may not be aware of the exact dictionary meaning for "checkpoint" (i.e., 'a place, as at a frontier […], where vehicles or travellers are stopped for official identification, inspection, etc'),[10] nonetheless I agree with the Applicant that the relevant consumers are likely to understand "check point" in both marks at least with the general meaning of 'a point where a check of some kind occurs'. Thus, relevant consumers will understand "check point" in both marks identically.

73. Turning to the additional elements in the Earlier Mark (i.e., 'MCP' and 'media'), I agree with the Applicant that the relevant consumers will understand 'media' with its ordinary meaning of 'means of mass communication' and that it will be perceived as a separate word from "check point". I also agree that 'MCP' may be understood as referring to the first letters of "media check point".

74. Therefore, having regard to all of the above, as the competing marks share the meaning of "checkpoint", I find they have at least a medium degree of conceptual similarity.

Distinctive character of the earlier trade mark

75. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, the CJEU stated that:

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

[10] https://www.collinsdictionary.com/dictionary/english/checkpoint.

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

76. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods and services, to those with high inherent distinctive character, such as invented words.

77. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the Opponent has filed no evidence of use of its mark. Accordingly, I have only the inherent position to consider.

78. The Applicant submitted that "*the Opponent's Mark has a normal level of distinctiveness*".[11] The Opponent did not provide submissions on the Earlier Mark's distinctiveness.

79. The Earlier Mark contains the words "media check point" arranged on three lines and reproduced in a standard typeface; the mark also features the letters 'MCP' arranged vertically and represented in a stylised fashion. These two groups of elements are separated by a vertical red line cutting across the mark. The mark does not have a clear semantic correlation with the goods and services at hand. Neither party has provided further clarification in this regard. Taking into consideration the Applicant's submissions and the mark's stylisation, I find the Earlier Mark has an above-medium degree of inherent distinctive character.

[11] Applicant's submissions in lieu dated 9 December 2024, [39].

Likelihood of confusion

80. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

81. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).

82. I have found the degree of similarity of the respective goods and services to range from medium to identical (or highly similar). In their selection the relevant consumer is likely to pay at least a medium level of attention for the goods in class 9 with the professional public paying a higher level of attention. However, I will assess the likelihood of confusion from the perspective of the general public since they are the group who will pay the lower degree of attention. The relevant consumer is likely to pay no more than a medium level of attention for the goods in class 16 and the level of attention for the professional public (e.g., businesses) is likely to be high for the services in class 42. The distinctiveness of the Earlier Mark is above medium. The visual similarity is below medium, and the aural similarity is either medium or high depending on how the relevant consumer reads the Earlier Mark. The marks are conceptually similar to a medium degree. The purchase of the contested goods and services is considered to be mainly visual but the potential for aural use is borne in mind. The Earlier Mark fully contains the Contested Mark, however it also contains additional elements ('MCP' and "media") with 'MCP' being stylised and "media" being smaller in size than the other elements in the mark. The Earlier Mark also contains a red line cutting across the mark and visually separating 'MCP' and "media check point". All the above considered, I find that the marks are

unlikely to be mistakenly recalled or misremembered as each other and I do not consider there to be a likelihood of direct confusion.

83. It now falls to me to consider the likelihood of indirect confusion. The concept of indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

84. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.[12] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[13] The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.[14]

85. I found above that the competing marks share the same words "check point" and that the relevant consumers will understand this term identically in both marks. I also found that the relevant consumers, when confronted with the Earlier Mark are likely to focus on the main element in the mark (being "check point") as such words occupy a dominant position in the mark and are readily understandable (being dictionary words) and convey a clear message. I also found that whilst "media" is a dictionary word with a clear meaning, the relevant consumer is less likely to pay attention to it given its relatively small size within the mark. Nonetheless, I found that a significant proportion of relevant consumers is likely to read "media" along with "check point" when confronted with the Earlier Mark. However, the word "media" would be perceived as a non-distinctive element, and the Earlier Mark could be interpreted as a logical sub-brand or brand extension, particularly in relation to goods and services connected to digital products or those involving communication or image transmission. Similarly, the initialism 'MCP' would also be seen as non-distinctive. Owing to its stylisation and overlapping letter arrangement, it is likely to be perceived by the relevant consumer as having a primarily decorative nature. Building on these considerations and also taking into account the Earlier Mark's overall impression, it follows that a significant proportion of relevant consumers is likely to perceive the Contested Mark as a more straightforward

[12] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.
[13] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.
[14] *Liverpool Gin Distillery*.

version of the "check point" mark (i.e., derived from the Earlier Mark) and will likely believe that both marks originate from the same or economically linked undertakings, with the Earlier Mark representing a sub-brand or brand extension of the Contested Mark. As a result, I find that there is a likelihood of indirect confusion.

Conclusion

86. The opposition under section 5(2)(b) succeeds in its entirety and, subject to any appeal, the application will be refused for all the goods and services.

Costs

87. The Opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice ("TPN") 1/2023. Bearing that scale in mind, I award costs to the Opponent as follows:

Official fee	£100
Preparing the notice of opposition and the statement of grounds	£250
Total:	**£350**

88. I order Check Point Software Technologies Ltd. to pay Media Check Point Spóła z ograniczoną odpowiedzialnością the sum of **£350**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of July 2025

Andrea Rossi
For the Registrar