

o/0713/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATION NOS. 3968935 AND 3995315
TO REGISTER IN THE UNITED KINGDOM:

UKBUY

IN THE NAME OF LONDON KNIGHTSBRIDGE LTD

AND

IN THE MATTER OF AN OPPOSITION THERETO
UNDER NOS. 445623 AND 445647

BY UBUY HOLDING COMPANY SPC (KW)

BACKGROUND AND PLEADINGS

1. On 18 October 2023 and 23 December 2023 respectively, LONDON KNIGHTSBRIDGE LTD (“the applicant”) applied to register “UKBUY” as a trade mark in the United Kingdom, in respect of the following goods and services:

*Business consultancy; Business management; Business marketing services; Advertising; Import-export agencies; Franchising services providing marketing assistance; Retail services relating to food; Online retail store services relating to clothing; Retail services for computer software; Retail services in relation to computer hardware; Retail services in relation to metal hardware; Purchasing of goods and services for other businesses; Sales management services; Demonstration of products; Auctioneering; Organisation and management of business incentive and loyalty schemes; Advertising the goods and services of online vendors via a searchable online guide; Online business networking services; Providing an on-line commercial information directory on the internet (class 35)*¹

*Downloadable software; Downloadable computer software; Downloadable e-wallets; Downloadable applications; Computer software platforms; Computer e-commerce software; Smartphone software; Mobile apps; Communication software; Communications networks; Recorded content; Payment software; Encoded prepaid payment cards; Payment terminals, money dispensing and sorting devices; Computer hardware for facilitating payment transactions by electronic means; Software for processing electronic payments to and from others; Hardware for processing electronic payments to and from others; Payment cards being magnetically encoded; Computer software; Computer hardware; Computer databases; Computer application software for use with wearable computer devices; Computer networks; Computer software for advertising; E-commerce and e-payment software (class 9)*²

The applicant’s ‘935 mark was published for opposition purposes on 3 November 2023 and its ‘315 mark on 12 January 2024.

¹ Application 3968935, applied for on 18 October 2023

² Application 3995315, applied for on 23 December 2023

2. On 31 January 2024 and 2 February 2024 respectively, UBUY HOLDING COMPANY SPC (KW) (“the opponent”) filed a Notice of Opposition claiming that both marks should be refused, in their entirety, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). For the purpose of both oppositions, the opponent relies upon the following mark and all goods and services in classes 9 and 35 for which it is registered, as set out below:

United Kingdom Trade Mark (“UKTM”) 36933143

UBUY

Downloadable applications; Mobile apps; Application software; Retail software; E-commerce software; E-commerce and e-payment software; all of the aforementioned goods not in the field of video games, video gaming computer programs and/or video gaming software applications (class 9)

Business assistance, management and administrative services; Advertising, marketing and promotional services; Business management services relating to electronic commerce; Advertising services for the promotion of e-commerce; Provision of information and advisory services relating to e-commerce; Provision of an online marketplace for buyers and sellers of goods and services; promoting the goods and services of others; Customer loyalty services for commercial, promotional and/or advertising purposes; Customer relationship management; Sales promotion through customer loyalty programs; Arranging business introductions relating to the buying and selling of products; Arranging of contracts for others for the buying and selling of goods; Business intermediary and advisory services in the field of selling products and rendering services; Providing consumer information relating to goods and services; Comparison shopping services; Procurement services; Administrative support and data processing services; Administrative processing of computerized purchase orders; Providing an on-line commercial information directory on the internet; Advertising services; Advertising services relating to the sale of goods; Import and export agencies; Import and export agencies services; Advisory and consultancy services relating to import-export agencies; Database management services; Providing a searchable online advertising guide featuring the goods and services of online vendors; Providing searchable online advertising guides; Wholesale ordering services; Online ordering

services; Arranging commercial transactions, for others, via online shops; Online retail services relating to cosmetics; Online retail services relating to clothing; Online retail services relating to beauty products; Online retail services relating to handbags; Online retail services relating to jewellery; Online retail services relating to toys; Online retail services relating to luggage; Online retail services relating to musical instruments; Retail services in relation to sporting articles; Online retail service relating to tools; Online retail services relating to furniture; Online retail services relating to books; Online retail services relating to pet supplies; Retail services relating to automobile accessories; Retail services in relation to kitchen appliances; Retail services in relation to cookware; Online retail services relating to cell phones and cell phone accessories (class 35)

Filing date: 10 September 2021

Registration date: 11 February 2022

3. The opponent claims that the high degree of similarity between the respective marks and the identity and/or similarity between the parties' goods and services gives rise to a likelihood of confusion, which includes a likelihood of association.

4. The applicant, in turn, contends that the respective trade marks are "sufficiently separated from one another and will not be confused."

5. On 8 May 2024, by way of official letter, the parties were notified of the oppositions' consolidation. The opponent is represented by Stevens Hewlett & Perkins and the applicant by William Kateny Legal. Both parties filed submissions and evidence during the course of the proceedings³. Neither party requested a hearing nor did they file submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

6. 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

³ The applicant was advised in an official letter dated 29 September 2024 that, due to its nature, the evidence it had filed would be viewed as submissions.

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

7. The opponent's evidence comprises a witness statement from Ms Leona Walker, of Stevens Hewlett & Perkins, and supporting exhibits LMW1 and LMW2. Ms Walker's statement is dated 5 July 2024 and the exhibits comprise two extracts from the online Cambridge dictionary. The first shows that there is no dedicated entry for the word "UBUY". The second shows a number of definitions for "U", specifically:

Abbreviation for universal: in the UK, a film or a symbol for a film that is considered suitable for children of any age

Abbreviation for universal: used in the UK to refer to a film that is considered suitable for children of any age

(of behaviour or ways of speaking) acceptable to or expected to be used by people of high social class

[American dictionary]: the 21st letter of the English alphabet

8. The applicant filed evidence in the form of a witness statement from Mr William Wu, director of William Kateny Legal. Mr Wu's statement is dated 3 September 2024 and is accompanied by four exhibits (Attachment Nos. 1-4). The attachments comprise extracts from the Collins online dictionary showing definitions of 'U' and 'UK', example sentences using the word 'BUY' and a page showing "no results" from a search for 'UKBUY'. The second definition for "U" is "*used as an abbreviation for words beginning with 'u', such as 'unit', 'united', or 'University'*".

9. That concludes my summary of the parties' evidence, insofar as I consider it necessary.

DECISION

Section 5(2)(b)

10 Section 5(2)(b) of the Act 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 of the Act reads as follows:

“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.”

12. The opponent’s mark clearly qualifies as an earlier trade mark pursuant to section 6 of the Act. Given that it had not been registered for more than five years before the application date of the opposed marks, it is not, therefore, subject to the proof of use provisions laid out in section 6A of the Act. As a consequence, the opponent may rely upon its mark and all goods and services it has identified without providing evidence of use.⁴

Section 5(2)(b) - case law

13. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03,

⁴ I note that, in its counterstatements, the applicant has asked the opponent to provide evidence of use. For the reasons already set out, the opponent is not required to demonstrate use of its earlier mark.

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

14. The competing goods and services are laid out at paragraphs 1 and 2 to this decision.

15. 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 Court of Justice of the European Union (“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.”

16. In addition to cases of *literal* identity, the General Court (“GC”) set out a further provision as to when goods (though it equally applies to services) can be considered identical in *Gérard Meric v Office for Harmonisation in the Internal Market*⁵. It stated:

⁵ Case T-133/05

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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”.

17. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

18. In *Kurt Hesse v OHIM*,⁶ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In

⁶ Case C-50/15 P

Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),⁷ the GC stated that “complementary” means:

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

19. For the purpose of a comparison, it is permissible to group goods or services together for the purpose of assessment where they are sufficiently comparable to do so. ⁸

20. I keep in mind throughout my assessment that the opponent’s class 9 goods are subject to a limitation: *all of the aforementioned goods not in the field of video games, video gaming computer programs and/or video gaming software applications*, though I do not intend to cite it on every occasion.

The applicant’s goods in class 9

21. Both parties’ specifications include *downloadable applications* and *e-commerce and e-payment software*. These goods are, self-evidently, identical.

Downloadable software; Downloadable computer software; Computer software; Computer software platforms

22. The opponent relies upon *application software* at large. When considered against the above terms, if the goods are not encompassing of one another, I find the goods are at least highly similar. The goods may be utilised for the same, or at least a similar, purpose, and will be accessed by the same users. The goods’ nature is at the least highly similar and I find it likely that they will move through the same trade channels. The goods may play competitive roles and it would not seem unreasonable for the consumer to expect the goods to be offered by the same undertaking.

Smartphone software; Mobile apps

⁷ Case T-325/06

⁸ *Separode Trade Mark*, BL O/399/10 (AP)

23. I find the aforementioned goods are likely to be encompassed by the opponent's *application software* which, to my mind, would include software designed for smartphones as well as mobile applications. These goods are identical.

Recorded content

24. To my mind, the above term will naturally include recordings of audio or visual content, for example. When considered in relation to the opponent's *mobile apps* or *downloadable applications*, I find the goods may be utilised for the same or similar purposes, and are likely to be selected by the same consumers. It seems likely that the goods will often move through the same trade channels and may coincide somewhat in nature. When selected for a similar purpose, the goods may be competitive and it would not seem unreasonable for the consumer to expect a single undertaking to offer both parties' goods. I find at least a medium degree of similarity.

Downloadable e-wallets

25. I find the aforementioned is likely to fall within the remit of the opponent's *e-commerce and e-payment software*. If this is too broad a finding, I consider there to be at least a high degree of similarity. The goods will be utilised for a same or similar purpose and are likely to be accessed by the same users. The trade channels are likely to be shared and there may be some general similarity in the nature of the goods to support their intended function. I find there is an element of complementarity to the extent that a single undertaking may offer both sets of goods. Where the goods coincide in purpose or functionality, there may be a degree of competitiveness.

Computer e-commerce software

26. The above term is encompassed by the opponent's *e-commerce software*. These goods are consequently identical.

Payment software

27. The applicant's *payment software* is encompassing of the opponent's *e-payment software*. These goods are identical.

Encoded prepaid payment cards; Payment terminals, money dispensing and sorting devices; Computer hardware for facilitating payment transactions by electronic means; Hardware for processing electronic payments to and from others; Payment cards being magnetically encoded

28. I compare the aforementioned goods to the opponent's *e-commerce and e-payment software*. The goods are utilised for the same purpose, i.e. to facilitate transactions. The goods are likely to be accessed by the same users, though the goods' physical nature is distinct. To my mind, the goods are likely to occupy the same or similar channels of trade and, in some circumstances, there may be a complementary relationship between them insofar as one is indispensable to the other. The goods are not necessarily competitive but are more likely to be used in tandem. Weighing all factors, I find the goods are similar to a fairly high degree.

Software for processing electronic payments to and from others

29. I find the above goods are likely to fall within the scope of the opponent's *e-payment software*. These goods are, therefore, identical.

Computer application software for use with wearable computer devices; Computer software for advertising; Communication software

30. The aforementioned goods, whilst narrower in scope, are likely to be encompassed by the opponent's broader term *application software*, which will naturally cover a range of application software used for various purposes.

Computer networks; Communications networks

31. The opponent relies upon *downloadable applications* and *application software*, also proper to class 9. To my mind, a network refers to a means by which computers or similar devices are able to connect or interact to some extent. The broad nature of the

parties' respective terms are such that there is an opportunity for a similarity in the goods' use and they are likely to be accessed by the same users. The goods may not occupy the same channels of trade, and there is only limited opportunity for the goods to be competitive, though there may be a complementary relationship in which the opponent's goods work alongside, or in conjunction with, the applicant's goods to support a network function. Applying due weight to the relevant factors, I find a low degree of similarity.

Computer hardware

32. I consider the above hardware against the opponent's *downloadable applications* and *application software* which, to my mind, are fairly broad terms. Other than the opportunity for the goods to be used alongside one another in a single exercise, there is not necessarily any similarity in their respective use, though there may be some broad overlap in the goods' respective users. There may be some coincidence in trade channels, though not exclusively, and the goods do not share any physical characteristics. The goods are not competitive, but may be used simultaneously. The applicant's hardware, for example, may be utilised to support or enhance the consumer experience when using the opponent's goods. Whilst the goods may be compatible, they may not be indispensable although, given the potential relationship between the two, the consumer may expect that a single or related undertaking would offer both. On balance, I find the goods are similar to a fairly low degree .

Computer databases

33. When considered against the opponent's *application software*, I find the respective goods are likely to target the same users, may occupy the same channels of trade and could share a complementary relationship on the basis that software is likely to be an incorporated element in the use of *computer databases*. Notwithstanding that the goods' immediate use may differ and the nature is likely distinct, for the reasons already set out I find there is a low degree of similarity.

34. In the alternative, notwithstanding the inevitable distinction in nature, I find it likely that the above goods will at least share users and a complementary relationship with

the opponent's *database management services*. There is also a likely overlap in user, broadly speaking. I find a medium degree of similarity.

The applicant's services in class 35

35. *Advertising; business management and providing an on-line commercial information directory on the internet* are included in both parties' specifications. These services are clearly identical.

36. The applicant's *import-export agencies* is identical to the opponent's *import and export agencies*.

Business consultancy

37. The opponent relies upon *business assistance, management and administrative services*. There may be a distinction in the services' immediate use and nature, though they are likely to be accessed, generally, by the same users and there may be a complementary relationship whereby the services are used alongside one another as part of a wider business initiative, and it would not seem unreasonable for the consumer to expect the services to originate from a single undertaking. I find the services are similar to a fairly high degree.

38. The applicant's *business marketing services* is encompassed by the opponent's *marketing services*. These services are identical.

Advertising the goods and services of online vendors via a searchable online guide

39. These services are caught within the scope of the opponent's *advertising services* and are, therefore, identical.

Franchising services providing marketing assistance

40. The opponent relies upon *marketing services* at large. To my knowledge, franchising services would not naturally fall within the scope of marketing services, nor naturally be

described as a 'marketing' service. However, the above term makes specific reference to the provision of marketing assistance. If *Meric* is not applicable, I find there is nonetheless an opportunity for coincidence in the services' nature and a complementary relationship. The goods may not be utilised for the same immediate use and will not exclusively be accessed by the same users. The services may not be competitive in light of the franchising element in the applicant's term, though both incorporate a marketing element. Weighing all factors, I find the similarity is of at least a low to medium degree.

Retail services relating to food; Retail services for computer software; Retail services in relation to computer hardware; Retail services in relation to metal hardware

41. The opponent relies upon *online ordering services* which, to my mind, whilst a fairly broad term, may naturally incorporate a 'purchasing' element whereby the consumer places an order online (for unspecified goods or services). In my view, the retail services for which the applicant seeks registration are likely to incorporate *online* retail services in respect of the specified goods. In that case, given that the opponent's ordering services may be offered in respect of the same or similar goods, there may be an overlapping purpose between the parties' respective services insofar as each offers an environment in which the consumer can make a purchase or place an order. The services are likely to be accessed by the same users and there may be an element of similarity in their nature. The same trade channels may be utilised and there may be a competitive relationship in play. In certain circumstances, it would also not seem unreasonable for the consumer to expect the services to originate from a shared or related undertaking. Having regard to the respective terms' natural and ordinary meanings, and keeping in mind the opportunities for coincidence outlined above, I find a low degree of similarity between the parties' services.

Online retail store services relating to clothing

42. The above term is encompassed by the opponent's *online retail services relating to clothing*. These services are identical.

Purchasing of goods and services for other businesses

43. I find the above services are identical to the opponent's *procurement services* which would, to my mind, naturally encompass transactions such as those detailed in the applicant's term.

Sales management services

44. The opponent relies upon several services which incorporate a *sales* element; *the arranging of contracts for others for the... selling of goods; business intermediary and advisory services in the field of selling products*, as well as *procurement services* at large. If the respective services are not encompassing of, or encompassed by, one another in accordance with *Meric*, I find there is at least a medium degree of similarity. There is a broad similarity in the services' use insofar as they are intended to facilitate sales to some extent, and they are likely to be selected by the same consumers. There may be some coincidence in the services' nature, again on a fairly broad level, and they may utilise the same trade channels. In some circumstances the services may be competitive and, to my mind, it would not seem unreasonable to expect the respective services to be offered by a single undertaking.

Demonstration of products

45. The opponent relies upon *promotional services*. To my mind, the *demonstration of products* can be undertaken as a means of promotion, to encourage the consumer to purchase the products at hand. Consequently, I find the services are identical, with the applied-for services encompassed by those relied upon.

Auctioneering

46. I find a high degree of similarity between the applicant's *auctioneering* and the opponent's *provision of an online marketplace for buyers and sellers of goods and services*. The services share the same, if not a similar, purpose insofar as they are intended to create an environment to facilitate purchases. The services are likely to be accessed by the same consumer and, given that it would not seem unusual for an online marketplace to incorporate an 'auction' or bidding element, there may be some similarity

in the services' nature. The services would likely be offered by at least a related undertaking and there may be a competitive dynamic between the two.

Organisation and management of business incentive and loyalty schemes

47. I find at least a high degree of similarity between the above services and the opponent's *customer loyalty services for commercial, promotional and/or advertising purposes and/or sales promotion through customer loyalty programs*. The services are likely to be accessed for at least a similar purpose and will likely be selected by the same consumer. It also seems likely that the nature in the services will share some elements of similarity. The trade channels are likely to be the same and the services may occupy competitive roles. Given the closeness between the services, they may also share a degree of complementarity.

Online business networking services

48. I consider the aforementioned services against the opponent's *arranging business introductions relating to the buying and selling of goods*. Though the opponent's services may be narrower in scope, there is an opportunity for coincidence in the services' use and in their respective users. The opponent's services would naturally include the arrangement of introductions online, which would create a meaningful similarity in the services' nature. The services could make use of the same trade channels and, in some circumstances, the services may be competitive. The services may not be indispensable but may be offered by the same undertaking. I find there is at least a medium degree of similarity.

The average consumer and the nature of the purchasing act

49. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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*⁹, Birss J (as he then was) described the average consumer in these terms:

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

50. The average consumer of the goods and services at issue is likely to comprise, for the most part, members of the general public, though I keep in mind that some of the services in particular are likely to predominantly target the professional consumer (services aimed at businesses, for example). The costs of the various goods and services at issue is likely to vary fairly significantly, as will the frequency of the associated purchase. The goods are likely to be advertised primarily via visual means either via a website, for example, or catalogues. The services, equally, are likely to be selected in visual measures predominantly, either via a traditional retail outlet or an online resource. I keep in mind, however, that consumers may rely, in part, on word-of-mouth recommendations or professional advice. Consequently, I do not discount the relevance of the marks’ aural impression to the selection of both the goods and services at issue. In approaching its selection, consumers are likely to be alive to considerations such as compatibility and/or the provider’s reputation. Weighing all factors, I find the average consumer is likely to apply between a medium to fairly high degree of attention to its purchase.

Comparison of trade marks

51. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions

⁹ [2014] EWHC 439 (Ch)

created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in *Bimbo SA v OHIM*,¹⁰ 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.”

52. It would be wrong, therefore, to artificially dissect the trade marks, 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.

53. The parties' marks are laid out in the table below:

Opponent's trade mark	Applicant's trade mark
UBUY	UKBUY

54. The opponent's mark comprises a single word of four letters. Its overall impression resides in its sole element; UBUY.

55. The applicant's mark comprises a five-letter word; UKBUY. There are no other elements within the mark to contribute to its overall impression.

56. Visually, the parties' marks coincide in their first letter 'U' and their final three letters 'B-U-Y'. Acting as a point of difference is the second letter in the applicant's mark ('K'). Given where the additional letter is positioned, and having kept in mind that the

¹⁰ Case C-591/12P

respective marks are not particularly lengthy, I find the visual similarity is of a fairly high degree.

57. The opponent's mark is likely to be articulated in two syllables; YOO-BY. The applicant's mark will likely comprise three syllables; YOO-KAY-BY. The marks share two identical syllables, though these are separated by a third syllable ('KAY') in the middle of the applicant's mark. On balance, and having taken into account that the marks are relatively short, I find the marks aurally similar to at least a medium degree.

58. The marks' conceptual impressions must be considered from the perspective of the average consumer. I have kept in mind the parties' considerations of the marks' conceptual positions, and the dictionary definitions exhibited in the respective evidence. Beginning with the opponent's mark, whilst 'UBUY' is, to my knowledge, not an ordinary dictionary word, I find the average consumer will readily identify the word 'BUY' within the mark, which will be attributed its ordinary meaning (i.e. to make a purchase). The preceding 'U' element, in this context, I find is most likely to be perceived as a deliberate, colloquial shortening of dictionary word 'YOU'. Taken together, the elements are likely to evoke a concept whereby the consumer is almost instructed to make a purchase. In the applicant's mark, I find it likely, again, that the consumer will identify 'BUY' in the latter part of the mark. The letters at the beginning, 'UK', are likely to be understood as a common abbreviation for the United Kingdom. The combination of these elements is likely to convey a concept of purchases made, or goods available to purchase, in the United Kingdom. Whilst the marks' 'BUY' element is identical, the concepts evoked by the respective preceding 'U(/YOU)' and 'UK' elements create a point of distinction. Weighing all considerations, I find the marks are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

59. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹¹, the CJEU stated that:

¹¹ Case C-342/97

“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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of 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).”

60. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

61. In the absence of any evidence showing the use made of the earlier mark, I have only its inherent position to consider. Whilst the word ‘UBUY’ is, in theory, an invented word, the elements which the average consumer is likely to perceive (U/YOU-BUY) are common and readily identifiable terms. The concept created by these elements, in the context of the procurement of various goods and services, is not particularly imaginative (even less so in the case of goods or services which specifically concern a purchasing process, for example). Whilst the mark is awarded some distinctiveness on account of its use of ‘U’ (rather than YOU), and the combining of ‘U’ and ‘BUY’ to

create a single word, generally speaking I find the mark is inherently distinctive to a fairly low degree.

Likelihood of confusion

62. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and/or services, and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. Conversely, the less distinctive it is, the lower the likelihood of confusion.

63. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

64. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*¹², where he explained that:

“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

¹² Case BL O/375/10

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”).

65. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,¹³ Arnold LJ approved Mr Purvis's formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

¹³ [2021] EWCA Civ 1207

66. As for the significance of the marks' conceptual impressions, in *The Picasso Estate v OHIM*,¹⁴ the CJEU of the European Union found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

67. In *Nokia Oyj v OHIM*,¹⁵ the General Court stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

68. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

69. Throughout the course of my decision, I have found the marks are visually similar to a fairly high degree, aurally similar to at least a medium degree and they are conceptually similar to a medium degree. The average consumer is likely to be a member of the general public or a professional entity who will apply between a medium and fairly high degree of attention to its purchase. The marks' visual impressions are likely to play the greatest role in the selection process, though I do not discount the relevance of the marks' aural impressions. I have found the earlier mark inherently distinctive to a fairly low degree and I have found the similarity between the parties' respective goods and services ranges from a low degree to those which are identical.

¹⁴ Case C-361/04 P

¹⁵ Case T-460/07

70. I begin by considering a likelihood of direct confusion. In my view, this is the only 'type' of confusion I need consider. I see no meaningful reason as to why the average consumer, upon acknowledging that the marks are different, would nonetheless attribute their similarities to a shared or related origin. The consumer will either directly confuse the marks, or not confuse them at all. I keep in mind when making this consideration that the marks differ by only one letter and that the marks' visual weight is likely to play the greatest role in the selection process. Still, the marks in their entirety are not particularly lengthy (four or five letters), meaning that any differences in their make-up are more likely to be identified, generally speaking. I am also mindful that the degree of attention which is likely to be applied by the average consumer is of at least a medium degree. Weighing these considerations, I find the average consumer will readily identify the difference between the marks, namely the presence and/or absence of the letter 'K', and consequently the distinction in the respective concepts which are immediately evoked as a result. One mark simply gives an instruction ("YOU BUY") whereas the other incorporates a geographical indication ("UK"), creating a tangible distinction. I find this likely to apply even in respect of identical goods or services. I therefore dismiss a likelihood of direct confusion.

71. As indicated above, as I do not consider the similarities between the competing marks consistent with what will be perceived a sub-brand or brand extension, I see no reason as to why there would be a likelihood of indirect confusion. The shared element "BUY" is lowly distinctive, such that the consumer will not naturally be inclined to attribute its shared use to a single or related undertaking.

Conclusion

72. The opposition under section 5(2)(b) is unsuccessful. Subject to any successful appeal against my decision, the applications will proceed to registration.

Costs

73. The applicant has been successful and is entitled to a contribution toward its costs. Awards of costs commenced on or after 1 February 2023 are governed by Annex A of

Tribunal Practice Notice (“TPN”) 1/2023. In accordance with that TPN, I award the costs to the opponent as follows:

Reviewing the Notices of Opposition
and preparing a counterstatement (x2): £300

Reviewing the opponent’s evidence and
preparing evidence and written submissions: £400¹⁶

Total: £700

74. I hereby order UBUY HOLDING COMPANY SPC (KW) to pay LONDON KNIGHTSBRIDGE LTD the sum of £700. 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

**Laura Stephens
For the Registrar**

¹⁶ I have taken into account the substantiveness and helpfulness of the applicant’s evidence