

O/1032/24

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3634153
BY V1CE LIMITED
TO REGISTER:**

V1CE

V1ce

(SERIES OF TWO)

**AS TRADE MARKS
IN CLASSES 9 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 427254
BY VICE MEDIA CANADA INC.**

Background and Pleadings

1. On 28 April 2021, V1CE Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 2 July 2021 in respect of the following goods and services:

Class 9: *Apparatus and instruments for transmitting personal data; blank digital recording and storage media; data storage devices and media; data storage cards; data cards; encoded printed cards; magnetic printed cards; biometric identity cards; coded identification cards; electronic data carriers; near-field communication data storage cards; near-field communication data storage apparatus; computer software related to the storage of personal data; electronic databases related to personal contact information; content management software related to storage of personal data; web application and server software related to storage of personal data; data communications software related to personal data.*

Class 42: *Software as a service relating to storage of personal data; cloud storage services for electronic files related to personal contact information; cloud storage services for personal data; cloud storage services related to personal contact information; computerised personal information storage; electronic data storage and data back-up services related to personal data; database hosting services related to personal contact information; online data storage services related to personal information.*

2. On 1 October 2021, Vice Media Canada Inc. (“the opponent”) opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at the application in its entirety. The opponent relies on the following trade marks:

VICE TECH

UK registration no. 915371198

Filing date 25 April 2016; registration date 16 December 2016

Priority from the United States of America; priority 21 April 2016

Relying on some services, namely:

Class 41: *Publishing services*

Class 42: *Providing information in the field of technology and software development via an online website.*

("the 198 mark")

VICE NEWS

UK registration no. 916122335

Filing date 1 December 2016; date of entry on the register 21 June 2017.

Relying on some goods and services, namely:

Class 9: *Downloadable software in the nature of mobile application for providing instruction, information, text, audio and video content.*

Class 41: *Providing information in the fields of global news and information, including politics, health, science, technology, war, terrorism, climate change, women's issues, art, culture, music, global events, sports, literature, entertainment, film, TV, travel.*

("the 335 mark")

VICE IMPACT

UK registration no. 916402216

Filing date 23 February 2017; date of entry on the register 9 June 2017

Priority from the United States of America. Priority date 24 August 2016

Relying on some goods, namely:

Class 9: *Downloadable software in the nature of a mobile application for providing instruction, information, text, audio and video content featuring subjects of general human interest.*

("the 216 mark")

VICE VOICES

UK registration no. 917471095

Filing date 17 November 2017; date of entry in register 12 March 2018

Priority from the United States of America. Priority date 30 May 2017.

Relying on some goods and services:

Class 9: Downloadable software in the nature of a mobile application for providing instruction, information, text, audio and video content regarding marketing surveys; downloadable software for creating searchable databases of information and data to allow users to collect and analyze different types of marketing surveys.

Class 35: Marketing services, namely, conducting consumer tracking behaviour research and consumer trends analysis; providing marketing, market research, consumer survey and brand bio websites on a global computer network; market research services; survey panel services, namely, recruiting potential survey respondents, market research panel participants and focus group participants for others; survey panel services, namely, management and administration of potential survey respondents, market research panel participants for others.

("the 095 mark")

3. The opponent submits that there is a likelihood of confusion because the applicant's mark is highly similar aurally and visually to the earlier marks. It also claims that the applicant's mark is conceptually identical to the opponent's mark and the respective goods and services are similar.

4. The applicant filed a defence and counterstatement denying the claims made. In particular, in relation to the goods and services, the applicant submits that the goods and services are entirely unconnected, do not have the same purpose and would not be marketed in the same manner as the opponent's goods and services. In addition, the applicant submits that the marks are aurally, visually and conceptually dissimilar to the earlier marks.

5. The opponent is represented by Venner Shipley LLP and the applicant is represented by Brabners LLP. Neither party filed evidence, but the applicant filed submissions dated 11 December 2023 during the evidence rounds. No hearing was

requested, and both parties filed submissions in lieu of a hearing on 13 February 2024. This decision is taken following a considered review of the papers. I do not propose to summarise the submissions in full at this stage but will refer to them below, where necessary.

Decision

Section 5(2)(b): legislation and case law

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

(2) A trade mark shall not be registered if because –

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

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

7. Section 5A of the Act states as follows:

“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.”

8. The opponent’s registrations qualify as earlier marks within the meaning of Section 6(1) of the Trade Marks Act because they have earlier filing dates than the contested application. The applicant put the opponent to proof of use. However, as the opponent’s registrations completed their registration processes less than five years before the application date of the applicant’s mark, they are not subject to the proof of

use provisions of section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services for which its marks are registered.

9. 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 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

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

(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 impression 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 greater 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 to mind the earlier mark, 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 the goods and services

11. The applicant's goods and services to be compared can be seen below:

The applicant's specification	The opponent's specifications
<p>Class 9: Apparatus and instruments for transmitting personal data; blank digital recording and storage media; data storage devices and media; data storage cards; data cards; encoded printed cards; magnetic printed cards; biometric identity cards; coded identification cards; electronic data carriers; near-field communication data storage cards; near-field communication data storage apparatus; computer software related to the storage of personal data; electronic databases related to personal contact information; content management software related to storage of personal data; web application and server software related to storage of personal data; data communications software related to personal data.</p>	<p><u>198 mark</u></p> <p>Class 41: Publishing services</p> <p>Class 42: Providing information in the field of technology and software development via an online website.</p>
<p>Class 42: Software as a service relating to storage of personal data; cloud storage services for electronic files related to personal contact information;</p>	<p><u>335 mark</u></p> <p>Class 9: Downloadable software in the nature of mobile application for providing instruction, information, text, audio and video content.</p> <p>Class 41: Providing information in the fields of global news and information, including politics, health, science, technology, war, terrorism, climate change, women's issues, art, culture, music, global events, sports, literature, entertainment, film, TV, travel.</p>
<p>cloud storage services for personal data; cloud storage services related to personal contact information; computerised personal information storage; electronic data storage and data back-up services related to personal data; database hosting services related to personal contact</p>	<p><u>216 mark</u></p> <p>Class 9: Downloadable software in the nature of a mobile application for providing instruction, information, text, audio and video content featuring subjects of general human interest.</p>
<p></p>	<p><u>095 mark</u></p>

<p><i>information; online data storage services related to personal information.</i></p>	<p><i>Class 9: Downloadable software in the nature of a mobile application for providing instruction, information, text, audio and video content regarding marketing surveys; downloadable software for creating searchable databases of information and data to allow users to collect and analyze different types of marketing surveys.</i></p> <p><i>Class 35: Marketing services, namely, conducting consumer tracking behaviour research and consumer trends analysis; providing marketing, market research, consumer survey and brand bio websites on a global computer network; market research services; survey panel services, namely, recruiting potential survey respondents, market research panel participants and focus group participants for others; survey panel services, namely, management and administration of potential survey respondents, market research panel participants for others.</i></p>
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12. 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 of its judgment 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”.

13. Guidance on this issue has also come from Jacob J. (as he was then) 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.”

14. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00

Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

15. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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.”

Class 9

17. In its submissions, the opponent submits that the applicant’s class 9 goods are identical to “downloadable software in the nature of a mobile application for providing information” in the 335 mark and “downloadable software for creating searchable databased of information and data to allow users to collect and analyze different types of marketing surveys” in the 095 mark. In the event that the goods are not considered

to be identical, the opponent submits that the goods are highly similar due to their nature, method of use and intended purpose. I compared *“Electronic databases related to personal contact information”* in the applicant’s specification to *“downloadable software for creating searchable databases of information and data to allow users to collect and analyze different types of marketing surveys”* in the 095 mark’s specification. I consider that the specific nature will differ, as the applicant’s goods are electronic databases and the opponent’s goods are software for the creation of databases. Further, I consider that there will be an overlap in purpose as marketing surveys in the 335 mark may involve the collection of personal contact information. I am of the view that the users of the goods will also differ, this is on the basis that the opponent’s goods might be used by a content creator, whereas the applicant’s goods could be used by any individual as a finished product. I consider that there may be an overlap in trade channels. This is on the basis that there is the possibility that the electronic database may be viewed via the same software that would be downloaded to create a searchable database of information. However, given the difference in the specific purpose and nature between the goods, I do not consider that the goods are in competition. In addition, I am unable to identify any complementarity between the goods. Therefore, I consider the goods to be similar to a low degree.

Web application and server software related to storage of personal data; data communications software related to personal data; computer software related to the storage of personal data; content management software related to storage of personal data.

18. I consider that there is a level of similarity between the applicant’s goods and the term *“downloadable software in the nature of mobile application for providing... information ...”* that appears in the 335 mark’s specification (in class 9). I note that the goods also appear in the 216 and 095 marks but that they specify the goods are in relation to general human interest (the 216 mark) and marketing surveys (the 095 mark). I recognise that the applicant’s and opponent’s goods are all software and, therefore, share the same nature. However, I note that the applicant’s goods provide software for storing personal data and the opponent’s goods provide downloadable software for a mobile application for the provision of information. Whilst I note that the information provided in the opponent’s goods may include reference to personal

information, I consider that the specific purpose of the goods will differ; the applicant's goods will store personal data and the opponent's goods provide information (although it may include personal information), the storing off and provision of information meet different purposes. In addition, the methods of use of the goods will differ. I consider that the user will overlap in general. This is on the basis that the users of software used to collect personal data are likely to be businesses etc. collating information. In addition, I recognise that the opponent's goods may also include applications that collect customer data. Therefore, the goods will coincide in users.

19. Further, I am of the view that there will be no competition between the goods, as an average consumer would not select the opponent's goods for downloadable mobile applications merely to store personal data. However, I do consider that there may be a degree of complementarity between the goods, insofar as it is common for downloadable software for mobile applications to have access to and store personal data, such as real-time location, photographs and health data. In these circumstances, software to store personal data will be an important/indispensable aspect of the downloadable software in the nature of a mobile application in the opponent's specification because application functionality often depends on the capture and storage of various personal data. Further, I consider that the average consumer may think that the responsibility for those goods lies with the same undertaking as a result. Applying the above circumstances, whilst I consider average consumers may be of the view that the goods are provided by the same undertakings; I do not consider that the trade channels will be shared. This is because I consider that the technology industry is very specialised and whilst software/applications, for example, may run alongside one another and be important/ indispensable for one another that does not mean that the same companies will provide the goods in practice, despite the perception by the average consumer. Taking this into account, I consider that the applicant's goods are similar to the opponent's aforementioned goods in the 335 and 095 mark to a low degree. In relation to the 216 goods, I consider that the goods are narrower and this finding does not apply to the goods.

20. The opponent has submitted that consumers will know that data transmitting equipment will often be offered by software providers. However, I have not been provided with any evidence on this point. Further, I do not consider that I can take this on judicial notice. For the goods listed below, I have been unable to identify any

similarity between the applicant's goods and any of the goods and services listed in any of the opponent's mark's specifications. Consequently, I consider that the following goods are dissimilar:

Blank digital recording and storage media; data storage devices and media; near-field communication data storage apparatus; data storage cards; near-field communication data storage cards; Apparatus and instruments for transmitting personal data; data cards; encoded printed cards; magnetic printed cards; biometric identity cards; coded identification cards; electronic data carriers.

Class 42

Software as a service relating to storage of personal data; cloud storage services for electronic files related to personal contact information; cloud storage services for personal data; cloud storage services related to personal contact information; computerised personal information storage; electronic data storage and data back-up services related to personal data; database hosting services related to personal contact information; online data storage services related to personal information.

21. The opponent submits that the class 42 services are similar to “downloadable software in the nature of a mobile application for providing information” (in class 9) in the 335 mark and “downloadable software for creating searchable databases of information and data to allow users to collect and analyze different types of marketing surveys” (in class 9) in the 095 mark. It is submitted that this is on the basis that they will share the same purpose, be provided by the same undertaking, have the same users and are complementary. I consider that all of the above services in the applicant's specification are different forms of data storage software as a service, via the cloud, online or hosting. I do not consider that the goods and services will overlap in nature, as one will provide goods and the other services. I consider that the applicant's services will store personal data but the opponent's goods will either provide mobile applications that provide information or data or create searchable databases of information and data to allow users to collect and analyse data for marketing surveys. On that basis, I consider that the purpose of the goods and services differs. Further, I am of the view that the method of use will differ as the

applicant's services will be accessed by consumers online, via the cloud or hosting but the opponent's software will be purchased and downloaded to a device. Trade channel overlap is possible; the same undertaking might provide both software as goods and software as a service in the specified fields. There will also be an overlap in users. I do not consider that there will be competition between the goods and services, as a user looking for an application to provide information will not select that over cloud services to store personal data, for example. Further, I do not consider that there is any complementarity between the goods and services and note that no guidance has been provided by the opponent as to why it considers there to be complementarity between the goods and services. Taking all of the above into account, I consider the goods and services to be similar to a low degree.

22. As some degree of similarity between the goods and services is necessary to engage the test for the likelihood of confusion, my findings above mean that the opposition aimed against those goods that I have found to be dissimilar will fail. They are as follows:

Class 9: *blank digital recording and storage media; data storage devices and media; near-field communication data storage apparatus; data storage cards; near-field communication data storage cards; Apparatus and instruments for transmitting personal data; data cards; encoded printed cards; magnetic printed cards; biometric identity cards; coded identification cards; electronic data carriers.*

23. The opponent has not provided any specific submissions on similarity for the goods and services covered by the 216 and 198 marks. I am unable to see any further similarity between the goods and services and remind myself of the appeal to the Appointed Person in *SMARTX BL O/0911/24*:

. "... it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach for which Mr Wood contends would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods

which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent."

Subsequently, I will continue with these proceedings focusing on the 335 and 095 marks.

THE AVERAGE CONSUMER AND THE PURCHASING PROCESS

24. It is necessary for me to determine who the average customer is for the parties' goods and services. I must then determine the manner in which the goods and services 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*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

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

25. The average consumer of the goods and services at issue will be a member of the general public and businesses. The cost of the goods and services in question is likely to vary, as will the frequency of purchase/selection. In my opinion, the average consumer will select/purchase the goods and services by visual means. However, due to the complexity of some of the goods, for example, databases, I consider that the consumer will wish to ensure that the goods will suit their computer and its operating

system. Thus, even though these goods may be researched by the average consumer they may also be discussed with a member of staff, therefore, aural considerations will also be important. In relation to the services, for both members of the general public and business users, the selection of the services will be the same as for the goods. In addition, I consider that the consumer of the services will want to ensure that the services selected meet their business needs. The average consumer may attend trade shows or open up opportunities to a tendering process to select the services. Consequently, the selection process will be primarily visual, although aural considerations will also be important.

26. Whilst goods will be sold in, inter alia, catalogues and on the internet, the goods may also, be purchased after discussions with the provider to ensure that the providers of the goods are capable of meeting the requirements of the consumer. The services available will be listed on pamphlets, placards or via online menus.

27. In relation to the goods, to my mind, the average consumer is likely to pay a slightly higher than medium (but not the highest) degree of attention to the selection of such goods, given their nature as mentioned earlier. In relation to the services, the business users are likely to pay a higher degree of attention in the selection process due to the potential impact of the services on their company's reputation and so the selection process is likely to be more involved. For example, when seeking services relating to the marketing of their business or its products, the consumers will pay attention to a number of factors such as the cost, the reputational standing of the provider and the suitability of the services for their specific needs. Consequently, the level of attention paid during the purchasing process for the services will be a medium degree of attention where the average consumer is a member of the general public, and between a medium and higher than medium (but not the highest degree) where the average consumer is a business.

COMPARISON OF THE MARKS

28. As I proceed with the comparison of the marks, I will only proceed and compare the marks where I found similarity between the parties' goods and services.

The applicant's mark	The opponent's marks
<p style="text-align: center;">V1CE V1ce (series of two)</p>	<p style="text-align: center;">VICE NEWS (opponent's second mark) VICE VOICES (opponent's fourth mark)</p>

29. 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 trade marks must be assessed by reference to all the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

30. 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.

31. The applicant's mark consists of a series of two marks which are made up of the letter ‘V’, followed by the number ‘1’, followed by the letters ‘CE’. In one of the marks the letters are in upper case and the other mark the letters are in lower case.

These are plain word marks, so they are protected in whatever form, colour or typeface they are used.¹ I consider that some consumers will see the mark as the word 'VICE', especially when the mark is presented in a simple typeface where the numeral 1 appears in the same style as a capital letter 'I'. Other average consumers may identify that the text contains the number '1'; in my experience, it is fairly common for numbers to replace letters in words used in trade marks. There are no other elements that contribute to the overall impression of the mark; the overall impression lies in the mark as a whole.

The 335 mark

32. The 335 mark is made up of 'VICE NEWS', VICE is distinctive for all of the goods at issue, but 'NEWS' is allusive for the goods, as it may be the case that some of the information provided by the application would be described as news content. For the goods, for which 'NEWS' is allusive, 'VICE' plays a greater role in the overall impression of the mark.

The 095 mark

33. The 095 mark is made up of 'VICE VOICES'. 'VICE' is distinctive for all of the goods at issue, but 'VOICES' is mildly allusive for the goods. The word 'VOICES' will be viewed as a particular opinion or a place where opinions are expressed. Thus, 'VICE' plays a greater role in the overall impression of the mark.

Visual comparison

34. In relation to the 335 and 095 marks, visually, the marks share the letters 'V-C-E' which appear as the first, third and fourth letter in the applicant's mark and in the first word in the opponent's mark. The points of difference between the marks are the words 'NEWS' and 'VOICES' at the end of the opponent's marks respectively and the

¹ La Superquímica v EUIPO, Case T-24/17, paragraph 39.

number '1' which appears as the second character in the applicant's mark. Consequently, I consider the marks to be visually similar to a medium degree.

Aural comparison

35. Aurally, the words in the opponent's 335 and 095 marks will be given their ordinary pronunciation. In relation to the applicant's mark, whilst I recognise that the mark contains the number '1'; as stated above in paragraph 31, in my experience, it is fairly common for numbers to replace letters in words used in trade marks and that the number '1' will be viewed as the letter 'l'. Subsequently, I consider that the applicant's mark will be pronounced as 'VICE'. I consider this to be the case, even for consumers that identify the number '1' in the applicant's mark. The pronunciation of the words 'NEWS' and 'VOICES' will be a point of difference. Therefore, I find the marks to be aurally similar to a medium degree.

Conceptual comparison

36. I note that in its submissions, the applicant argues that the incorporation of '1' in its mark rather than 'l' causes the marks to differ significantly on a conceptual basis, however, no clarification as to why this is the case has been provided by the applicant. Following on from my view above that the number '1' will be perceived as the letter 'l' in the applicant's mark, conceptually I consider that the term 'VICE' will be given its ordinary dictionary meaning; being an immoral, wicked or evil habit, action or trait.² The opponent's 335 and 095 marks will share the concept of 'VICE'. I consider that they will convey the concept of being 'NEWS' and 'VOICES', respectively, that are immoral, wicked or evil habits, actions or traits. . All of the opponent's marks and the applicant's mark will share the concept of 'VICE'. Taking this into account, I consider the marks to be conceptually similar to a medium degree.

DISTINCTIVE CHARACTER OF THE OPPONENT'S MARKS

² VICE definition and meaning | Collins English Dictionary (collinsdictionary.com) accessed 26/9/2024.

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

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, 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 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)."

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

39. No evidence has been filed and I only have the inherent distinctiveness of the earlier marks to consider.

The 335 mark

40. The mark consists of the words 'VICE NEWS'. Both words in the mark are ordinary dictionary words with obvious meaning that would be immediately graspable by the majority of average consumers. I consider that the word 'NEWS' is allusive in relation to the information provided by means of the goods relied upon. Consequently, when considered as a whole, I find the mark enjoys a medium degree of inherent distinctive character.

The 095 mark

41. The mark consists of the words 'VICE VOICES', whilst they are two ordinary dictionary words, they do not naturally sit together and so the meaning is not immediately graspable. The mark is mildly allusive for the goods at issue. The word 'VOICES' after 'VICE' will be viewed as a particular opinion or a place where opinions are expressed. Consequently, I consider the mark to be inherently distinctive to a medium degree.

LIKELIHOOD OF CONFUSION

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that s/he has retained in his/her mind.

43. I have found the marks to be visually, aurally and conceptually similar to a medium degree. I have found the goods and services at issue to be similar to a low degree. I have identified the average consumer as the general public (including businesses) who will purchase the goods and services by visual means (although I do not discount an aural component). I have concluded that a medium to higher than medium degree of attention (but not the highest) will be paid during the purchasing process for the goods and the services which are selected by the business users. I have concluded that a medium degree of attention will be paid in relation to services where the average consumer is a member of the general public. I have found the opponent's marks to have a medium degree of inherent distinctive character.

44. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

“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 recognised 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.’”³

45. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize

³ Paragraph 16

for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

46. Taking all the above into account and even bearing in mind the principle of imperfect recollection, I am of the view that the differences between the parties' marks are sufficient to overcome a likelihood of direct confusion. As discussed previously, the applicant's mark will be viewed as 'VICE' despite the number '1' which is present in place of the letter 'I'. Whilst I consider that the difference with the '1'/'I' in the applicant's mark will be overlooked or forgotten, I do not consider that this will also be the case in relation to the words 'NEWS' and 'VOICES' that appear in the opponent's 335 and 095 marks respectively. I have made this decision taking into account varying degrees of attention for selecting the goods and services that ranges from medium to higher than medium (but not the highest). Taking all the above into account, I do not find that there is a likelihood of direct confusion between the marks.

The 335 mark

47. As discussed above, I consider that the average consumer, when confronted with the applicant's mark and the opponent's mark, whilst they will overlook the '1' in place of an 'I', will notice the presence/absence of the word 'NEWS' in the marks. I am of the view that when the average consumer sees the shared 'VICE' element this will lead the average consumer to think the marks came from the same undertaking as 'VICE' is not a common or obvious word to be used with the goods and services. The differences between the marks will then, consequently, be put down to a form of rebranding and sub-branding. Specifically, the word 'VICE' accompanied by the word 'NEWS' in the opponent's mark will point to a news related sub-brand of the applicant's mark. If noticed, the presence/absence of '1/I' will be put down to rebranding. Consequently, I consider that there is a likelihood of indirect confusion. This finding extends to all the goods and services I have found to be similar to a low degree. I have made this finding taking into account that the degree of attention paid when purchasing the goods and services will vary between medium to a higher than medium degree of attention (but not the highest). Further, I have taken into account, the medium degree of inherent distinctive character.

The 095 mark

48. The finding that I have made above in relation to indirect confusion applies here in relation to the opponent's 095 mark. Similarly, to what was discussed above, I consider that the average consumer, when confronted with the applicant's mark and the opponent's mark, whilst they will overlook the '1' in place of an 'l', will notice the presence/absence of the word 'VOICES' in the marks. As referenced above, the shared 'VICE' element will lead the average consumer to think the marks came from the same undertaking; as 'VICE' is not a common or obvious word to be used with the goods and services. The word 'VICE' accompanied by the word 'VOICES' in the mark will be seen as a sub-brand where a particular opinion or a place where opinions are expressed, especially taking into account the goods that are mildly allusive. If noticed, the presence/absence of '1/l' will be put down to rebranding. Consequently, I consider that there is a likelihood of indirect confusion. This finding extends to all the goods and services I have found to be similar to a low degree. I have made this finding taking into account that a degree of attention will vary from medium to a higher than medium degree (but not the highest).

CONCLUSION

49. The opponent's 5(2)(b) ground has succeeded in part. The opposition has succeeded for the following goods and services which will be refused:

Class 9: computer software related to the storage of personal data; electronic databases related to personal contact information; content management software related to storage of personal data; web application and server software related to storage of personal data; data communications software related to personal data.

Class 42: Software as a service relating to storage of personal data; cloud storage services for electronic files related to personal contact information;

cloud storage services for personal data; cloud storage services related to personal contact information; computerised personal information storage; electronic data storage and data back-up services related to personal data; database hosting services related to personal contact information; online data storage services related to personal information.

50. The application will continue for the following goods which were unsuccessful, they will proceed to registration:

Class 9: Blank digital recording and storage media; data storage devices and media; near-field communication data storage apparatus; data storage cards; near-field communication data storage cards; Apparatus and instruments for transmitting personal data; data cards; encoded printed cards; magnetic printed cards; biometric identity cards; coded identification cards; electronic data carriers.

COSTS

51. Both parties have enjoyed a degree of success, however, the opponent has enjoyed a greater degree of success. As a result, the opponent is entitled to a contribution towards its costs. The award of costs is based on the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £400 as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the other side's statement	£200
Filing submissions in lieu of a hearing	£100
Official fee	£100
Total	£400

52. I, therefore, order V1ce Limited to pay Vice Media Canada Inc. the sum of £400. The above sum should be paid within twenty-one days of the expiry of the appeal

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

Dated this 31st day of October 2024

A Klass

**For the Registrar,
the Comptroller-General**