

O/1083/24

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3741561
IN THE NAME OF PICSART, INC.
TO REGISTER AS A SERIES OF 2 TRADE MARKS



IN CLASSES 9, 42 AND 45

AND

OPPOSITION THERETO UNDER NO. 434281

BY

SHANTANU PTE. LIMITED

Background and pleadings

1. On 10 January 2022, PicsArt, Inc. (“***the Applicant***”) applied to register in the UK, as a series of two, the trade marks shown on the cover page of this decision, under number UK00003741561 (“***the Contested Marks***”). The Contested Marks claim a priority date of 9 July 2021 from the United States of America (USA) trade marks number 90819890 and 90819917. Details of the application were published for opposition purposes on 1 April 2022. Registration is sought for the following goods and services:

Class 9 Downloadable computer application software, namely, software for editing images, graphics, fonts, text, photographs, videos, and data; downloadable computer application software, namely, software that allows users to create, download, upload, design, modify, reproduce, transmit, and share images, graphics, fonts, photographs, text, videos, and data; downloadable computer software for modifying the appearance and enabling transmission of images, graphics, fonts, text, photographs, videos, and data; downloadable computer software that allows users to create, download, upload, design, modify, reproduce, transmit and share images, graphics, fonts, photographs, text, videos, and data; downloadable application programming interface (API) software for integration of content, namely, images, graphics, fonts, text, photographs, videos, and data, into websites; downloadable computer application software for mobile devices, namely, software for editing images, graphics, fonts, text, photographs, videos, and data.

Class 42 Computer services, namely, providing an interactive website that gives users the ability to upload images, graphics, fonts, photographs, texts, videos, and data; computer services, namely, providing an interactive website featuring technology that allows users to create, download, upload, design, modify, reproduce, transmit, and share images, graphics, fonts, photographs, text, videos, and data; file sharing services, namely, providing a website featuring technology enabling users to upload and download electronic files; computer services, namely, providing a website featuring on-line non-downloadable

software tools for image editing; computer services, namely, providing an interactive web site featuring technology that allows users to consolidate and manage social networks, accounts, and connections to existing and emerging application programming interfaces; application service provider (ASP) services featuring application programming interface (API) software for using, creating, downloading, uploading, design, modifying, reproducing, transmitting, and sharing images, graphics, fonts, photographs, text, videos, and data; application service provider (ASP) services featuring software that allows users to create, download, upload, design, modify, reproduce, transmit and share images, graphs, fonts, photographs, text, videos, and data; providing temporary use of non-downloadable software applications for the transmission of images, graphics, fonts, photographs, text, videos, and data; providing temporary use of a web-based software application for creating, downloading, uploading, designing, modifying, reproducing, transmitting, discovering, and sharing images, graphics, fonts, photographs, text, videos, and data; and computer services, namely, creating an online community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking services in the field of photography and videography; providing a website that gives users the ability to review photographic, graphic image, text, video and data content and utilize a custom template to provide input, likes, dislikes, edits, changes, modifications, opinions, suggestions, and comments and engage in social, business and community networking.

Class 45 Licensing of content, namely, photographs, videos, images, text and data; online social networking services; providing a social networking website for entertainment purposes.

2. On 16 June 2022, Shantanu PTE. Limited (“**the Opponent**”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The Opponent relies upon the trade mark registration set out in the Annex to this decision (“**the Earlier Mark**”). The opposition is directed against all the goods and services of the Contested Marks.

3. For the purposes of the opposition, the Opponent relies upon all of the goods and services for which the Earlier Mark is registered as indicated in the Annex.
4. By virtue of its earlier filing date, the registration set out in the Annex constitutes an earlier mark within the meaning of section 6 of the Act.
5. Given the registration date of the Earlier Mark (as indicated in the Annex), it had not completed its registration process more than five years before the priority date of the application in issue. Thus, it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services it has identified without having to demonstrate use.
6. In its notice of opposition,¹ the Opponent contends that the Contested Marks are visually, aurally, and conceptually similar to the Earlier Mark as they both contain the identical letter “P” and that the contested goods and services are identical or similar to most of the Opponent’s goods and services, giving rise to a likelihood of confusion under section 5(2)(b) of the Act, including a likelihood of association.
7. On 17 October 2022, the Applicant filed its defence and counterstatement, denying all the grounds of opposition.
8. The Opponent is represented by Akos Suele, LL.M. The Applicant is represented by DLA Piper UK LLP.

Relevance of EU law

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 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

Evidence and submissions

10. Neither party filed any evidence; only the Opponent filed submissions.² Neither party requested a hearing nor filed submissions in lieu. The submissions will not

¹ Dated 16 June 2022.

² Dated 19 April 2023.

be summarised here but will be referred to as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

Decision

The law

11. The relevant parts of section 5 of the Act are as follows:

“5(2) A trade mark shall not be registered if because—

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

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case law

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

The Principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed

and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

13. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

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

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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.”

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.”

17. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

18. The competing goods and services are as follows:

Opponent’s goods and services	Applicant’s goods and services
<u>Class 9</u>	<u>Class 9</u>
Downloadable video recordings; computer graphics software; computer screen saver software; software for processing images, graphics and text; Children's educational software; downloadable computer game programs; web site development software; computer software for creating and editing music and sounds; computer programs for editing images, sound and video; Video recording apparatus for	Downloadable computer application software, namely, software for editing images, graphics, fonts, text, photographs, videos, and data; downloadable computer application software, namely, software that allows users to create, download, upload, design, modify, reproduce, transmit, and share images, graphics, fonts, photographs, text, videos, and data; downloadable computer software for modifying the appearance and enabling transmission of images, graphics, fonts,

<p>vehicles; video processors; video accelerators; personal video recorders [PVRs]; downloadable video files; digital video recorders; digital video players; prerecorded motion picture videos; downloadable video recordings featuring music; interactive video game programs; Video mixing desks; computer software for controlling the operation of audio and video devices; computer software for database management; compiler software; downloadable image files; downloadable computer graphics; computer software applications, downloadable; computer screen saver software, recorded or downloadable; Downloadable video files.</p>	<p>text, photographs, videos, and data; downloadable computer software that allows users to create, download, upload, design, modify, reproduce, transmit and share images, graphics, fonts, photographs, text, videos, and data; downloadable application programming interface (API) software for integration of content, namely, images, graphics, fonts, text, photographs, videos, and data, into websites; downloadable computer application software for mobile devices, namely, software for editing images, graphics, fonts, text, photographs, videos, and data.</p>
<p><u>Class 35</u></p>	
<p>Advertising; advertising agency services; online advertising on a computer network; commercial administration of the licensing of the goods and services of others; marketing; provision of an online marketplace for buyers and sellers of goods and services; systemization of information into computer databases; business consultancy services relating to data processing; business administration services for the processing of sales made on the Internet; presentation of goods on</p>	

<p>communication media, for retail purposes; presentation of financial products on communication media, for retail purposes; advertising via the Internet; business administration services for the processing of sales made on a global computer network; consultancy regarding public relations communication strategies; production of teleshopping programmes; commercial information agency services; on-line data processing services; updating and maintenance of data in computer databases; data search in computer files for others; compilation of information into computer databases.</p>	
<p><u>Class 41</u></p>	
<p>Coaching [training]; organization of competitions [education or entertainment]; lending library services; providing online electronic publications, not downloadable; entertainment services; zoological garden services; modelling for artists; teaching; on-line game services; providing amusement arcade services; video editing services for events; audio and video recording services; providing online videos, not downloadable; audio, film, video and television recording services; Providing age ratings for television,</p>	

<p>movie, music, video and video game content; Production of sound and music recordings; Production of radio programmes; Production of films; Post-production editing services in the field of music, videos and film; Operation of video and audio equipment for the production of radio and television programs; production of sound and video recordings; videotape editing.</p>	
<p><u>Class 42</u></p>	<p><u>Class 42</u></p>
<p>Conversion of data or documents from physical to electronic media; computer software design; computer programming; software as a service [SaaS]; technological research; interior design; dress designing; graphic arts design; industrial design; quality control; clinical trials; computer system analysis; providing search engines for the internet; video game development services; computer-aided design of video graphics; design and development of video game software; Design and development of video game software; programming of video game software; compilation of computer programs; development of computer platforms; development of computers; Consultancy and information services relating to the design, programming and</p>	<p>Computer services, namely, providing an interactive website that gives users the ability to upload images, graphics, fonts, photographs, texts, videos, and data; computer services, namely, providing an interactive website featuring technology that allows users to create, download, upload, design, modify, reproduce, transmit, and share images, graphics, fonts, photographs, text, videos, and data; file sharing services, namely, providing a website featuring technology enabling users to upload and download electronic files; computer services, namely, providing a website featuring on-line non-downloadable software tools for image editing; computer services, namely, providing an interactive web site featuring technology that allows users to consolidate and manage social networks, accounts, and connections to existing and emerging</p>

maintenance of computer software; design, maintenance and updating of computer software; design, development and programming of computer software.

application programming interfaces; application service provider (ASP) services featuring application programming interface (API) software for using, creating, downloading, uploading, design, modifying, reproducing, transmitting, and sharing images, graphics, fonts, photographs, text, videos, and data; application service provider (ASP) services featuring software that allows users to create, download, upload, design, modify, reproduce, transmit and share images, graphs, fonts, photographs, text, videos, and data; providing temporary use of non-downloadable software applications for the transmission of images, graphics, fonts, photographs, text, videos, and data; providing temporary use of a web-based software application for creating, downloading, uploading, designing, modifying, reproducing, transmitting, discovering, and sharing images, graphics, fonts, photographs, text, videos, and data; and computer services, namely, creating an online community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking services in the field of photography and videography; providing a website that gives users the ability to review photographic, graphic image, text, video and data content and utilize a custom template to provide input,

	likes, dislikes, edits, changes, modifications, opinions, suggestions, and comments and engage in social, business and community networking.
	<u>Class 45</u>
	Licensing of content, namely, photographs, videos, images, text and data; online social networking services; providing a social networking website for entertainment purposes.

19. In its statement of grounds, the Opponent argued that:

“The majority of the goods and services covered under the opposed mark is identical and/or overlapping with the goods and services covered under the Opponent’s registration. The application has been applied in classes 9, 42 and 45 with respect to goods and services in the software industry pertaining to image, graphics, fonts, text, photographs, videos, data etc. which overlaps with the goods and services covered under the Opponent’s earlier mark.”

And:

“The opposed goods and services belong to the software industry and fall in the same segment as the Opponent’s earlier mark, it can be settled that the opposed mark is likely to compete against the Opponent’s earlier mark and will pass through similar retail outlets and channels of distribution.”

20. The Opponent also submitted that the respective goods and services are complementary insofar they are indispensable or important for the use of the other.³

21. The Opponent did not submit further considerations on the similarity of the respective goods and services. I do not consider the Opponent’s submissions to be particularly helpful. In this connection, I am mindful of the comments of Iain

³ See opponent’s submissions dated 19 April 2023.

Purvis KC, sitting as Appointed Person in the *SmartX* trade mark decision.⁴ The onus is on the Opponent to explain where the perceived similarity lies and why. Accordingly, where the Opponent has failed to identify which of its goods/services are similar to the contested goods/services, I can only take into account factors and overlaps that are obvious.

22. All the goods in the Applicant's specification in class 9 are downloadable computer software. They all, obviously, fall within the Opponent's wider category of "*computer software applications, downloadable*". They are identical on the principle outlined in *Meric*.

23. The Applicant's services in class 42 essentially consist of the provision of a website (or application) enabling the users to upload, download, create, and modify images, texts, and videos as well as functioning as a social media platform allowing the users to share their creations and comment on those of others. The Opponent provides services for the "*design, maintenance and updating of computer software*". It seems obvious to me that these services of the Opponent share some overlap with the contested services because providers offering specialised websites and related software applications are also likely to be involved in the design, maintenance, and update of those technologies. Whilst the exact nature, methods of use and purpose are not the same, the Opponent's services may be important for the use of the Applicant's services in such a way that the consumer believes they come from the same undertaking, i.e. they are complementary. They may also share trade channels. I find the services to be similar to at least a low degree.

24. Regarding the Applicant's "*Licensing of content, namely, photographs, videos, images, text and data*" in class 45, I believe the licensing of content will require legal advice and guidance as to the need to cover off several issues. For example, when licensing content, advice will need to be provided as to issues such as copyright and other intellectual property rights. Such points are often complex legal issues and, therefore, I consider that licensing services are a type of legal service. Additionally, I am of the view that by virtue of being class 45 services, the Applicant's term above must be intended as a legal service presupposing a

⁴ BL O/0911/24, [9].

knowledge and understanding of legal issues surrounding the protection of intellectual property rights.⁵ In my view, the most obvious and closest comparison in the Opponent's specification is class 35 "*commercial administration of the licensing of the goods and services of others*". However, I find the respective services to be similar to a very low degree. Whilst the services may share the same subject matter (i.e., licenses), they differ in nature (commercial against legal), intended purpose, and trade channels and it is not obvious to me that there is any competitive or complementary relationship in play.

25. Turning to the Applicant's "*online social networking services; providing a social networking website for entertainment purposes*" in class 45, the Opponent has simply made a blanket statement that all of the Applicant's goods/services are complementary to its goods/services and that they all share distribution channels. It is not obvious to me where such complementarity/similarity lies in respect of the above contested services. In the absence of any clear submissions from the Opponent as to which of its goods or services are complementary or similar to these services of the Applicant, I find that there is no similarity between them.

Conclusion on the goods and services comparison

26. As some degree of similarity between the respective goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition reliant upon the 5(2)(b) ground aimed against those goods and services I have found to be dissimilar must fail.⁶ In light of my findings above, the opposition proceeds only in relation to the following goods and services:

Class 9 Downloadable computer application software, namely, software for editing images, graphics, fonts, text, photographs, videos, and data; downloadable computer application software, namely, software that allows users to create, download, upload, design, modify, reproduce, transmit, and share images, graphics, fonts, photographs, text, videos, and data; downloadable computer software for modifying the

⁵ The explanatory note of the Nice Classification sets out that class 45 "includes mainly legal and security services, as well as certain personal and social services rendered by others to meet the needs of individuals".

⁶ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA and *Waterford Wedgwood PLC v OHIM* - C398/07 P.

appearance and enabling transmission of images, graphics, fonts, text, photographs, videos, and data; downloadable computer software that allows users to create, download, upload, design, modify, reproduce, transmit and share images, graphics, fonts, photographs, text, videos, and data; downloadable application programming interface (API) software for integration of content, namely, images, graphics, fonts, text, photographs, videos, and data, into websites; downloadable computer application software for mobile devices, namely, software for editing images, graphics, fonts, text, photographs, videos, and data.

Class 42 Computer services, namely, providing an interactive website that gives users the ability to upload images, graphics, fonts, photographs, texts, videos, and data; computer services, namely, providing an interactive website featuring technology that allows users to create, download, upload, design, modify, reproduce, transmit, and share images, graphics, fonts, photographs, text, videos, and data; file sharing services, namely, providing a website featuring technology enabling users to upload and download electronic files; computer services, namely, providing a website featuring on-line non-downloadable software tools for image editing; computer services, namely, providing an interactive web site featuring technology that allows users to consolidate and manage social networks, accounts, and connections to existing and emerging application programming interfaces; application service provider (ASP) services featuring application programming interface (API) software for using, creating, downloading, uploading, design, modifying, reproducing, transmitting, and sharing images, graphics, fonts, photographs, text, videos, and data; application service provider (ASP) services featuring software that allows users to create, download, upload, design, modify, reproduce, transmit and share images, graphs, fonts, photographs, text, videos, and data; providing temporary use of non-downloadable software applications for the transmission of images, graphics, fonts, photographs, text, videos, and data; providing temporary use of a web-based software application for creating, downloading, uploading, designing, modifying, reproducing,

transmitting, discovering, and sharing images, graphics, fonts, photographs, text, videos, and data; and computer services, namely, creating an online community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking services in the field of photography and videography; providing a website that gives users the ability to review photographic, graphic image, text, video and data content and utilize a custom template to provide input, likes, dislikes, edits, changes, modifications, opinions, suggestions, and comments and engage in social, business and community networking.

Class 45 Licensing of content, namely, photographs, videos, images, text and data.

The average consumer and the nature of the purchasing act

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

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

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

29. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question.⁷
30. The average consumer for the goods in class 9 (software for editing and sharing images/videos) will likely be a member of the general public who purchases applications (also available as websites) to upload, edit and share content on social media platforms for entertainment purposes; the purchase of such applications is likely to be reasonably frequent and inexpensive but the relevant consumer will make considerations regarding the software such as functionality, features, compatibility, and price. I therefore find that the average consumer will pay a medium level of attention when purchasing the goods at hand.
31. The average consumer for the services in class 42 (digital platforms enabling users to upload, create, modify, and share content) will be a member of the general public (directly accessing the platform) as well as professionals (i.e., third-party businesses providing the platform). I consider the costs of the services to range from relatively low (for purchasing the access to the platform, for example, through a mobile application) to possibly fairly high (for third-party providers that license the platform to make it available). The average consumer will likely make the same considerations above for the software goods. The professional public is likely to carry out further considerations on the platform design, availability, price, licensing terms and conditions. I therefore find the degree of attention will vary from medium (average) for the general public to above medium for the professionals. However, the likelihood of confusion must be assessed from the perspective of the former (the general public) since they are the group who will pay the lower degree of attention.⁸
32. The relevant public of the relevant services in class 35 (commercial administration of goods/services licensing) will most likely be a business user (and other comparable organisations) requiring an insight/evaluation into their business (particularly regarding legal matters concerning licensing). These consumers are likely to consider the type of service offered, the reputation of the service provider

⁷ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

⁸ Case T-356/14, [25] – [26].

and suitability of those services (including any experience the service provider has) to the user's desired purpose. The level of attention paid by this professional public when selecting and purchasing the services will be above medium. Similar considerations apply to the relevant services in class 45 (Licensing of content, namely, photographs, videos, images, text and data). I find an above medium level of attention will be paid by business users for those services also.

33. In all instances I consider the purchase of the goods and services to be mainly visual with the mark being advertised, for the goods/services in classes 9 and 42, online (e.g., other social media platforms) or in online/offline stores and for the services in classes 35 and 45 on specialised websites or printed brochures. This means that the mark will be seen and so the visual element of the mark will be the most significant (see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50). Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount aural considerations will play their part, particularly when advice is sought from sales representatives or for word of mouth recommendations.

Comparison of trade marks




34. 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 created by the trade marks, bearing in mind their distinctive and dominant components.

35. The 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”.

36. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

37. The trade marks to be compared are as follows:

Earlier trade mark	Contested trade mark (series of two)
	<div style="text-align: center;">  <p data-bbox="1015 1055 1185 1088">(first mark)</p>  <p data-bbox="991 1462 1214 1496">(second mark)</p> </div>

Overall impression

38. The Earlier Mark features a white stylised device placed on a red background that gradually fades from top to bottom. The red background containing the white device has the shape of a square with rounded edges. I find the white device to be the most dominant element in the mark with the background playing a lesser role.

39. The first Contested Mark consists of a rounded white letter 'p' placed at the centre of the mark and a colourful square background that varies from light blue at the top right corner to dark violet at the centre, and to light purple in the mark's bottom left

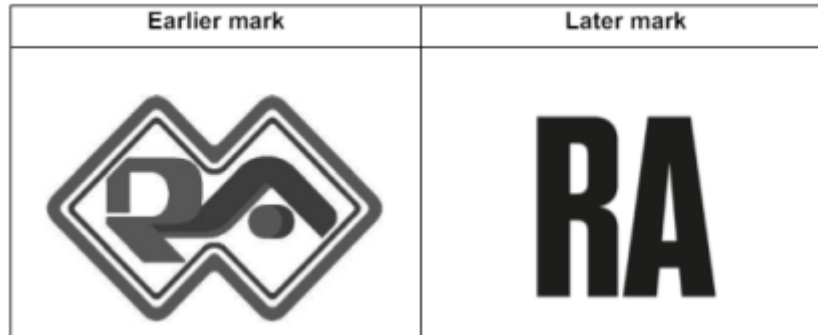
corner. The second mark in the series reproduces the first mark but it is in grey scale. In both marks of the series the stylisation of the letter 'p' does not prevent the marks being read as 'p' and it is this verbal element that forms the most dominant element of the mark overall with the square/coloured background playing a lesser role.

Visual similarity

40. The Earlier Mark consists of a white figurative device with rounded edges and a slightly darker shade at the centre of the mark giving the impression that the cylindrical part of the device coming down on the left-hand side of the device projects a shadow onto the central part of the mark. The device is placed at the centre of a rounded-edged square with a colourful red background that fades from top to bottom.

41. In its statement of grounds, the Opponent argues that the respective marks share the identical letter 'P'. I disagree. It is my view that the Earlier Mark's device is heavily stylised, and the average consumer is unlikely to immediately perceive the figurative device as the letter 'p'. The appearance of the white device is very different to the stylised letter 'p' in the Contested Marks. The red background of the Earlier Mark is also quite different to the coloured background in the first Contested Mark. I find that the Earlier Mark and the first Contested Mark are not visually similar. Whilst I bear in mind that the second Contested Mark could notionally be used with a red square background, when considered overall, I also find that this mark is not visually similar to the Earlier Mark. If I am wrong about that, then there is no more than a very low degree of visual similarity overall between the Earlier Mark and the second Contested Mark, stemming from the similarities between the square background (because the second Contested Mark could be used in red).

42. Further, even if I am wrong to conclude that the average consumer would not recognise the letter 'p' in the Earlier Mark, I maintain my position that the respective white figurative device in the Earlier Mark and stylised 'p' in the later marks have no visual similarity. In this regard, I note that in *Errea Sport S.P.A. v The Royal Academy of Arts*, BL O/010/16, Mr Iain Purvis Q.C., sitting as the Appointed Person, considered an appeal concerning the following two trade marks:



43. In that case, the Hearing Officer decided that there was no visual similarity between the marks. On appeal, the opponent contended that the earlier mark would be understood as consisting of the letters RA and that, therefore, the marks should have been found to be visually similar to at least a low degree. Mr Purvis Q.C. stated (my underlining):

“11. I do not accept this. First of all, it seems to me to be a matter of semantics rather than substance. There is no doubt that the Hearing Officer was proceeding on the basis that the average consumer would understand the letters RA to be conveyed by the earlier mark. Indeed she makes the point herself on more than one occasion. When she states that there is no visual similarity between the marks, she cannot therefore be taken to have forgotten this point. Similarly, she cannot be taken to have forgotten it when considering the overall ‘global’ question of whether the average consumer is likely to be confused.

12. Secondly, the difference between ‘no visual similarity’ and ‘a low degree of visual similarity’ is not only impossible to define but quite subjective. It is hard to imagine a case in which the spread of reasonable opinions about visual similarity could not cover both of these characterisations. This is not, therefore, fertile ground upon which to base an alleged error of principle.

13. Thirdly, I do not have any difficulty with the notion (which Mr Stobbs appeared to be contending was illogical) that two representations of the same thing may have no visual similarity. In the world of art, the visual representation of a horse in Picasso’s Guernica has little or nothing in common with the visual representation of a horse in one of George Stubbs’ portraits. I do not think it

unreasonable to say that they have no visual similarity, whilst having some limited conceptual similarity (they are both paintings of horses).

14. I therefore do not consider that the Hearing Officer's Decision is undermined by the alleged error of principle identified in the Grounds of Appeal."

44. Therefore, even if a significant proportion of average consumers perceive the Earlier Mark as comprising or containing the letter 'p' (which I consider unlikely), it is not visually similar to the stylised 'p' in the Applicant's marks. This is analogous to the Picasso and George Stubbs horses. The mere fact that both parties' marks may contain the letter 'p' does not, of itself, make them visually similar. It follows that the potential for some average consumers to perceive the letter 'p' in the Earlier Mark does not alter my findings of the overall visual similarity between the marks which I made in paragraph 41, above.

Aural similarity

45. As I found above, the average consumer is likely to see the Earlier Mark as a stylised device; therefore, they will not be able to voice it.⁹ The Applicant's marks will be read as the letter of the English alphabet 'p'. Thus, I find the competing marks to have no aural similarity. If I am wrong about that and a significant proportion of consumers would see the Earlier Mark as containing the letter 'p', the marks would be aurally identical.

Conceptual similarity

46. In its statement of grounds, the Opponent contends that the competing marks share the identical letter 'P'. As found above, I do not believe that a significant proportion of the relevant consumers will understand the Earlier Mark as the letter 'p' due to its high stylisation and will merely perceive it as a figurative device. I accept, though, that the average consumer will readily read the letter 'p' in the Applicant's marks. However, as a letter per se does not have any clear concept as such, the position would be that the marks are conceptually neutral in that scenario. It also follows that, even if I am wrong and a significant proportion of consumers do perceive the letter 'p' in the Earlier Mark, this does not give rise to conceptual similarity between the respective marks because, as I have said, a letter per se

⁹ *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, T- 424/10, [46].

does not have a clear meaning as such.¹⁰ Accordingly, in that scenario, the conceptual position would still be, effectively, neutral.

Distinctive character of the Earlier Mark

47. 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 C-108/97 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).”

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

¹⁰ See, for example, *Poloplast v OHIM — Polypipe (P)*, Case T-189/09, at paragraph 83.

49. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the Opponent has filed no evidence of use of its mark. Accordingly, I have only the inherent position to consider.
50. The Earlier Mark features a stylised device placed on a colourful red background and inscribed into a rounded-edge square. The figurative device does not seem to have any connection with the goods or services for which the mark has been registered. Even considering the Opponent's argument that the mark indicates the letter 'p', I do not see any semantic correlation between this letter of the English alphabet and the goods/services at hand. Therefore, I find that the Earlier Mark as a whole has a medium degree of inherent distinctive character.

Likelihood of confusion

51. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).
52. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).
53. I have found the respective goods and services degree of similarity to range from very low to identical. The level of attention ranges from medium for the general public in classes 9 and 42 to higher than medium for the professional public in classes 35 and 45. The distinctiveness of the Earlier Mark is medium. My primary finding in this case is that the average consumer would not perceive the letter 'p' in the Earlier Mark. That being so, I found the respective marks to have no visual similarity overall (or if I am wrong in relation to the second Contested Mark because it could notionally be used with a red square background, the visual similarity between that mark and the Earlier Mark is very low), no aural similarity and to be

conceptually neutral. In those circumstances, weighing all factors, I do not consider there to be a likelihood of direct confusion in respect of either of the Contested Marks.

54. In the event I am found to be wrong that the Earlier Mark would not be perceived as containing the letter 'p', I went on to consider what the position would be if a significant proportion did perceive that letter in the Earlier Mark. If that scenario were to occur, I found that the parties' marks still have no visual similarity (or if I am wrong in relation to the second Contested Mark, the visual similarity between that mark and the Earlier Mark is very low) and they would be aurally identical and conceptually neutral. Although some of these factors seem to weigh in the Opponent's favour, there is one factor, in particular, which weighs strongly against the Opponent, namely, my finding that the marks have no/very low visual similarity. This is of particular importance in the global assessment of the likelihood of confusion given that the purchasing act is likely to be primarily visual for all of the goods and services at issue.

55. In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (BUDMEN, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

56. Weighing all of these factors I find that also in this circumstance the average consumer, paying a medium or above medium degree of attention, is not likely to

mistake either of the Contested Marks for the Earlier Mark. Therefore, I do not consider there to be a likelihood of direct confusion in that scenario either.

57. Having found that there is no likelihood of direct confusion between the marks, I must now consider the possibility of indirect confusion. It should be borne in mind that a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.¹¹ Further, 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.¹²

58. It is my view that, whether the relevant consumers see the Earlier Mark as containing a stylised 'p' or not, the competing marks are so visually different, that I see no reason why the average consumer would assume that they came from the same or economically linked undertakings. I do not consider that the average consumer would think that the Opponent's mark was connected with the Applicant, and vice versa. Given the Earlier Mark's heavy stylisation, I believe that the parties' marks are clearly not natural variants or brand extensions of each other. Even if the Opponent's mark is brought to mind, this is mere association, not confusion.¹³ Thus, I find there is no likelihood of indirect confusion.

Conclusion

59. The opposition fails under section 5(2)(b) of the Act.

60. The Applicant has been successful. Subject to any successful appeal, the application by PicsArt, Inc. may proceed to registration.

Costs

61. The Applicant has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice ("TPN") 2/2016. Bearing that scale in mind, I award costs to the Applicant as follows:

¹¹ In *Liverpool Gin Distillery Limited v Sazerac Brands LLC* [2021] EWCA Civ 1207, paragraph 13, Arnold LJ approved this "consolation prize statement" as made by James Mellor QC's (sitting as the Appointed Person) statement in *Cheeky Italian Ltd v Sutaria* (O/219/16) paragraph 16.

¹² *Ibid*, Arnold LJ's words at paragraph 13.

¹³ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, [81].

Considering the notice of opposition and preparing the counterstatement	£200
Total:	£200

62. I order Shantanu PTE. Limited to pay PicsArt, Inc. the sum of **£200**. 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 15th day of November 2024

Andrea Rossi

For the Registrar

ANNEX

The Opponent's Earlier Mark

1) UK00918289017



Mark:

Goods and services relied upon for the opposition:

Class 9 Downloadable video recordings; computer graphics software; computer screen saver software; software for processing images, graphics and text; Children's educational software; downloadable computer game programs; web site development software; computer software for creating and editing music and sounds; computer programs for editing images, sound and video; Video recording apparatus for vehicles; video processors; video accelerators; personal video recorders [PVRs]; downloadable video files; digital video recorders; digital video players; prerecorded motion picture videos; downloadable video recordings featuring music; interactive video game programs; Video mixing desks; computer software for controlling the operation of audio and video devices; computer software for database management; compiler software; downloadable image files; downloadable computer graphics; computer software applications, downloadable; computer screen saver software, recorded or downloadable; Downloadable video files.

Class 35 Advertising; advertising agency services; online advertising on a computer network; commercial administration of the licensing of the goods and services of others; marketing; provision of an online marketplace for buyers and sellers of goods and services; systemization of information into computer databases; business consultancy services

relating to data processing; business administration services for the processing of sales made on the Internet; presentation of goods on communication media, for retail purposes; presentation of financial products on communication media, for retail purposes; advertising via the Internet; business administration services for the processing of sales made on a global computer network; consultancy regarding public relations communication strategies; production of teleshopping programmes; commercial information agency services; on-line data processing services; updating and maintenance of data in computer databases; data search in computer files for others; compilation of information into computer databases.

Class 41 Coaching [training]; organization of competitions [education or entertainment]; lending library services; providing online electronic publications, not downloadable; entertainment services; zoological garden services; modelling for artists; teaching; on-line game services; providing amusement arcade services; video editing services for events; audio and video recording services; providing online videos, not downloadable; audio, film, video and television recording services; Providing age ratings for television, movie, music, video and video game content; Production of sound and music recordings; Production of radio programmes; Production of films; Post-production editing services in the field of music, videos and film; Operation of video and audio equipment for the production of radio and television programs; production of sound and video recordings; videotape editing.

Class 42 Conversion of data or documents from physical to electronic media; computer software design; computer programming; software as a service [SaaS]; technological research; interior design; dress designing; graphic arts design; industrial design; quality control; clinical trials; computer system analysis; providing search engines for the internet; video game development services; computer-aided design of video graphics; design and development of video game software; Design and development of video game software; programming of video game software; compilation of computer programs; development of computer

platforms; development of computers; Consultancy and information services relating to the design, programming and maintenance of computer software; design, maintenance and updating of computer software; design, development and programming of computer software.

Filed: 14/08/2020

Date of entry in the register: 08/12/2020