

O/224/19

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003239703
IN THE NAME OF GRADUATELOOPS LIMITED
FOR THE FOLLOWING TRADE MARK (SERIES OF TWO):



IN CLASS 35

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 501958 BY ABLETON AG

BACKGROUND AND PLEADINGS

1. GraduateLoops Limited (“the proprietor”) applied for the trade mark shown on the cover page of this decision (“the contested mark”) on 26 June 2017. It was registered on 1 December 2017 for the services shown in Annex 1 to this decision.

2. On 31 January 2018, Ableton AG (“the applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon section 5(2)(b) of the Act. The invalidity is directed against some of the services for which the contested mark is registered (shown in paragraph 19 below).

3. The applicant relies on EUTM no. 15764681 for the mark **Loop**. The earlier mark has an application date of 22 August 2016 and a registration date of 11 December 2018. The earlier mark is registered for the following services:

Class 35 Arranging and conducting trade shows; Arranging and conducting of fairs and exhibitions for business and advertising purposes; Advertising and promotion services; Conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes; Arranging and conducting trade shows.

Class 41 Providing information in the field of entertainment by means of a global computer network; Educational services; Entertainment services; Arranging and conducting of workshops and seminars; Arranging, conducting and organisation of workshops; Arranging, conducting and organisation of conferences; Arranging and conducting of conferences, congresses and symposiums; Arranging, conducting and organisation of concerts; Providing multi-media entertainment via a website; Providing entertainment information via a website; Providing video entertainment via a website; Providing information in the field of music; Providing information, commentary and articles in the field of music via computer networks; Providing online electronic publications in the field of music, not downloadable; Providing information in the field of entertainment by

means of a global computer network; Distance learning courses; Distance learning services provided online; Production of live entertainment events; Presentation of live entertainment events.

4. The applicant claims that the contested mark is similar to its own mark and is registered for identical or similar services and there is a likelihood of confusion.

5. The proprietor filed a counterstatement in which it denies the grounds of invalidity.

6. Both parties are unrepresented. The applicant filed submissions during the evidence rounds in the form of a letter dated 17 July 2018. No evidence was filed by the proprietor. No hearing was requested and only the proprietor filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

PRELIMINARY ISSUES

7. In its written submissions in lieu of a hearing, the proprietor stated that “it seems that some letters have been missed and have not been included in the evaluation process”. Attached to those submissions, were print outs showing the respective marks in use on the parties’ websites.

8. On 19 February 2019, the Registry wrote to the proprietor and noted that missing documents had been referred to in their written submissions in lieu. The Registry sought clarification as to whether the documents filed with the submissions were those that the proprietor believed to have gone missing or whether this was fresh evidence that the proprietor sought to file after the conclusion of the evidence rounds.

9. The proprietor did not clarify this point, but filed a further document headed “Witness Statement” dated 5 March 2019 which consisted of further written submissions.

10. On 26 March 2019, the Registry wrote to the proprietor and stated:

“We wrote to you on 19 February 2019 to request clarification regarding the missing letters referred to in your email of 4 December 2018. We noted that you

had attached documents to your email and queried whether these were the documents that you considered had gone missing or whether they were documents being filed afresh for the first time. In response to our letter, you filed a new document headed "Witness Statement" dated 5 March 2019, but did not answer our query regarding the missing letters.

As we have received no clarification from you on this point, the Registry is proceeding on the assumption that the documents attached to your email of 4 December 2018 had not been filed previously and that you were unable to identify any documents that you considered to be missing. That is, that these were documents filed afresh on 4 December 2018. As you were notified of the conclusion of the evidence rounds by letter dated 6 November 2018, and no request to file further evidence has been made, these documents were filed out of time and will not be admitted as evidence in these proceedings.

Further, the document filed by you headed "Witness Statement" dated 5 March 2019 appears to consist of further written submissions. The deadline for filing your written submissions in lieu was 4 December 2018 and you filed submissions by email on that date. Consequently, it is your original submissions that will be taken into account in reaching the final decision as these further submissions were filed out of time.

Please note that our letter of 19 February 2019 sought to clarify your suggestion that documents had gone missing and was not an opportunity to file new evidence and/or written submissions.

In the absence of any clarification from you regarding the missing documents, the Registry proposes to proceed on the assumption that our file is complete and you have been unable to identify any documents that you consider to be missing. The matter will, therefore, now be passed to the Hearing Officer for the final decision to be issued."

11. The proprietor was given until 2 April 2019 to comment on this proposed course of action. No response was received from the proprietor. Consequently, the documents

filed with the proprietor's written submissions in lieu and the document headed "Witness Statement" dated 5 March 2019 have not been taken into consideration in reaching this decision.

12. The proprietor has made various submissions regarding the similarity of the marks as used on the websites of the parties, the fact that they target different customers and the presence of other marks which use the word LOOP on the register. In *O2 Holdings Limited, O2 (UK) Limited v Hutchinson 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, my assessment must take into account only the contested mark (and its specification) and any potential conflict with the earlier trade mark. Any difference between the services actually provided by the parties or their trading styles are irrelevant unless those differences are apparent from the marks as registered, and their respective specifications. The existence of other trade marks on the register is also not relevant to the decision I must make¹.

DECISION

13. Section 5 of the Act has application in invalidation proceedings because of the provisions set out in section 47. The relevant legislation is set out below:

"47. –[...]

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

¹ *Zero Industry Srl v OHIM*, Case T-400/06

(b) that there is an earlier right in relation to which the condition set out in section 5 (3) is satisfied

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.”

14. Given the date of registration of the applicant’s mark and the date of this application, section 2A of the Act is satisfied. It is not subject to proof of use as the earlier mark completed its registration period less than five years before the date on which the invalidation application was made.

15. The invalidation is based on section 5(2)(b) of the Act, which reads as follows:

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

(a) [...]

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

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

16. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

17. Given the filing date for the applicant’s trade mark, it qualifies as an earlier trade mark under section 6 of the Act.

Section 5(2)(b) – case law

18. 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.

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 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

19. In its Application for Invalidity, the applicant has listed “organisation, operation and supervision of sales and promotional incentive schemes” as one of the proprietor’s services against which the application is directed. However, this does not appear in the proprietor’s specification. I will, therefore, proceed on the basis that the applicant was referring to “organisation, operation and supervision of an incentive scheme” in the proprietor’s specification as this will not affect the outcome of the application. The competing services are, therefore, as follows:

Applicant’s services	Proprietor’s services
<u>Class 35</u> Arranging and conducting trade shows; Arranging and conducting of fairs and exhibitions for business and advertising purposes; Advertising and promotion services; Conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes; Arranging and conducting trade shows.	<u>Class 35</u> Administration of cultural and educational exchange programs; Advertising and marketing services; Advertising and marketing services provided by means of blogging; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising and promotion services and related consulting; Advertising for others;
<u>Class 41</u>	

<p>Providing information in the field of entertainment by means of a global computer network; Educational services; Entertainment services; Arranging and conducting of workshops and seminars; Arranging, conducting and organisation of workshops; Arranging, conducting and organisation of conferences; Arranging and conducting of conferences, congresses and symposiums; Arranging, conducting and organisation of concerts; Providing multi-media entertainment via a website; Providing entertainment information via a website; Providing video entertainment via a website; Providing information in the field of music; Providing information, commentary and articles in the field of music via computer networks; Providing online electronic publications in the field of music, not downloadable; Providing information in the field of entertainment by means of a global computer network; Distance learning courses; Distance learning services provided online; Production of live entertainment events; Presentation of live entertainment events.</p>	<p>Advertising, marketing and promotion services; Advertising, marketing and promotional consultancy, advisory and assistance services; Advertising, marketing and promotional services; Advertising of business web sites; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising, promotional and marketing services; Advertising, promotional and public relations services; Advertising services provided over the internet; Advertising services provided via the internet; Advertising through all public communication means; Advertising via electronic media and specifically the internet; Advertising via the Internet; Arranging of displays for business purposes; Arranging of exhibitions for advertising purposes; Arranging of exhibitions for business purposes; Arranging of exhibitions for commercial purposes; Arranging of exhibitions for trade purposes; Conducting of trade shows; Conducting virtual trade show exhibitions online; Consultancy relating to advertising and promotion services; Customer relationship management; Design of advertising flyers; Design of advertising logos; Design of advertising</p>
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	<p>materials; Development of promotional campaigns; Digital advertising services; Dissemination of advertising material; Dissemination of advertising material [leaflets, brochure and printed matter]; Dissemination of advertising material [leaflets, brochures and printed matter]; Dissemination of advertising materials; Dissemination of advertising matter; Dissemination of advertising matter online; Dissemination of advertising via online communications networks; Distribution of advertising announcements; Distribution of advertising brochures; Distribution of advertising leaflets; Distribution of advertising mail and of advertising supplements attached to regular editions; Distribution of advertising, marketing and promotional material; Distribution of advertising material; Distribution of advertising materials; Distribution of advertising matter; Distribution of advertising samples; Distribution of flyers, brochures, printed matter and samples for advertising purposes; Distribution of printed advertising matter; Distribution of printed promotional material by post; Distribution of products for advertising purposes; Distribution of promotional leaflets; Distribution of promotional material; Distribution of promotional matter;</p>
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	<p>Distribution of prospectuses and samples; Distribution of prospectuses and samples for advertising purposes; Distribution of prospectuses for advertising purposes; Distribution of publicity leaflets; Distribution of publicity materials (flyers, prospectuses, brochures, samples, particularly for catalogue long distance sales) whether cross border or not; Distribution of publicity materials, namely, flyers, prospectuses, brochures, samples, particularly for catalogue long distance sales [whether crossborder or not]; Distribution of publicity texts; Distribution of samples for advertising purposes; Distribution of samples for publicity purposes; Exhibitions (Arranging -) for advertising purposes; Exhibitions (Arranging -) for business purposes; Exhibitions (Arranging -) for commercial purposes; Exhibitions (Arranging -) for trade purposes; Exhibitions (Conducting -) for advertising purposes; Exhibitions (Conducting -) for business purposes; Exhibitions (Conducting -) for commercial purposes; Exhibitions (Conducting -) for trade purposes; Exhibitions for commercial or advertising purposes; Fashion show exhibitions for commercial purposes; Fashion shows for promotional purposes (Organization of -); Foreign trade consultancy services;</p>
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	<p>Foreign trade information and consultation; Foreign trade information (Provision of -); Foreign trade information (Services for the provision of -); Information agencies (Commercial -); Information and expert opinions relating to companies and business; Information (Business -); Information in business matters; Information services relating to advertising; Information services relating to business matters; Information services relating to businesses; Information services relating to data processing; Marketing the goods and services of others; Online advertisements; Online advertising network matching services for connecting advertisers to websites; Organisation of exhibitions and events for commercial or advertising purposes; Organisation of exhibitions and trade fairs for business and promotional purposes; Organisation of exhibitions and trade fairs for commercial and advertising purposes; Organisation of exhibitions and trade fairs for commercial or advertising purposes; Organisation of exhibitions for business or commerce; Organisation of exhibitions for commercial and advertising purposes; Organisation of exhibitions for commercial or advertising purposes; Organisation of prize draws for</p>
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	<p>advertising purposes; Organisation of trade fairs; Organisation of trade fairs for advertising purposes; Organisation of trade fairs for commercial or advertising purposes; Organisation, operation and supervision of an incentive scheme; Organisational consultancy regarding customer loyalty programmes; Organising and conducting job fairs; Organising exhibitions for commercial or advertising purposes; Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; Organization of exhibitions and trade fairs for commercial or advertising purposes; Organization of exhibitions for commercial or advertising purposes; Organization of fairs and exhibitions for commercial and advertising purposes; Organization of fairs for commercial and advertising purposes; Organization of trade fairs for commercial or advertising purposes; Organizing exhibitions for commercial or advertising purposes; Organizing of trade shows; Outdoor advertising; Planning and conducting of trade fairs, exhibitions and presentations for commercial or advertising purposes; Planning and conducting of trade fairs, exhibitions and presentations for economic or advertising purposes; Preparing advertisements for others;</p>
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	<p>Preparing and placing advertisements for others; Preparing and placing of advertisements; Preparing and placing outdoor advertisements for others; Preparing audio-visual presentations for use in advertising; Presentation of companies and their goods and services on the Internet; Presentation of companies on the Internet and other media; Presentation of goods and services; Presentation of goods on communication media, for retail purposes; Presentation of goods on communications media, for retail purposes; Press advertising consultancy; Press advertising services; Production of advertising films; Production of advertising material; Production of advertising materials; Production of advertising matter; Production of advertising matter and commercials; Production of cinema commercials; Production of infomercials; Production of radio advertisements; Production of radio commercials; Production of sound recordings for advertising purposes; Production of sound recordings for marketing purposes; Production of sound recordings for publicity purposes; Production of television and radio advertisements; Production of television</p>
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	<p> commercials; Production of video recordings for advertising purposes; Production of video recordings for marketing purposes; Production of video recordings for publicity purposes; Production of visual advertising matter; Promoting the goods and services of others; Promoting the sale of goods and services of others through promotional events; Promoting the sale of goods and services of others through the distribution of printed material and promotional contests; Promotion, advertising and marketing of on-line websites; Promotion [advertising] of business; Promotion of fairs for trade purposes; Promotion of special events; Promotion services; Promotional advertising for exploration projects; Promotional advertising services; Promotional and advertising services; Promotional marketing; Promotional marketing services using audiovisual media; Promotional services; Promotional services provided by telephone; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Providing academic course administration services for academic institutions; Providing advertising services; Providing commercial information to consumers; Providing </p>
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	<p>consumer information relating to goods and services; Providing consumer product advice; Public relations consultancy; Sales promotion for others; Trade fairs (Organization of -) for commercial or advertising purposes; Advertising and marketing services provided by means of social media.</p>
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20. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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.”

21. 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 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.

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 for 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.”

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

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

24. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

25. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

26. 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 GC stated that “complementary” means:

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

27. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected

undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

28. “Promotional and advertising services” in the proprietor’s specification is self-evidently identical to “advertising and promotion services” in the applicant’s specification.

29. Public relations, in my view, is a type of promotional service. I therefore consider that “advertising, promotional and public relations services” and “public relations consultancy” in the proprietor’s specification to be identical to “advertising and promotion services” in the applicant’s specification on the principle outlined in *Meric*. If I am wrong in this finding, then the services will overlap in uses, user, method of use and trade channels and will be highly similar.

30. I consider that the following services in the proprietor’s specification fall within the broader categories of “arranging and conducting of fairs and exhibitions for business and advertising purposes” and “conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes” in the applicant’s specification:

“Arranging of displays for business purposes”, “arranging of exhibitions for advertising purposes”, “arranging of exhibitions for business purposes”, “Exhibitions (Arranging -) for advertising purposes”, “Exhibitions (Arranging -) for business purposes”, “Exhibitions (Conducting -) for advertising purposes”, “Exhibitions (Conducting -) for business purposes”, “Organisation of exhibitions

and trade fairs for business and promotional purposes”, “Organisation of exhibitions for business or commerce” and “Organising exhibitions for commercial or advertising purposes”, “Arranging of exhibitions for commercial purposes”, “Exhibitions (Arranging -) for commercial purposes”, “Exhibitions (Conducting -) for commercial purposes”, “Exhibitions for commercial or advertising purposes”, “Organisation of exhibitions and events for commercial or advertising purposes”, “Organisation of exhibitions and trade fairs for commercial and advertising purposes”, “Organisation of exhibitions and trade fairs for commercial or advertising purposes”, “Organisation of exhibitions for commercial and advertising purposes”, “Organisation of exhibitions for commercial or advertising purposes”, “Organisation of trade fairs”, “Organisation of trade fairs for advertising purposes”, “Organisation of trade fairs for commercial or advertising purposes”, “Organization of exhibitions and trade fairs for commercial or advertising purposes”, “Organization of exhibitions for commercial or advertising purposes”, “Organization of fairs and exhibitions for commercial and advertising purposes”, “Organization of fairs for commercial and advertising purposes”, “Organization of trade fairs for commercial or advertising purposes”, “Organizing of trade shows”, “Planning and conducting of trade fairs, exhibitions and presentations for commercial or advertising purposes”, “Planning and conducting of trade fairs, exhibitions and presentations for economic or advertising purposes”, “Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes” and “Trade fairs (Organization of -) for commercial or advertising purposes”.

These services can, therefore, be considered identical on the principle outlined in *Meric*. If I am wrong in this finding, then the services will overlap in uses, users, methods of use and trade channels and will, therefore, be highly similar.

31. I consider that the following services in the proprietor’s specification fall within the broader category of “arranging and conducting of trade shows” in the applicant’s specification:

“Arranging of exhibitions for trade purposes”, “conducting of trade shows”, “conducting virtual trade show exhibitions online”, “Exhibitions (Arranging -) for trade purposes” and “Exhibitions (Conducting -) for trade purposes”.

These services can, therefore, be considered identical on the principle outlined in *Meric*.

32. “Consultancy relating to advertising and promotion services” and “Press advertising consultancy” in the proprietor’s specification would involve an expert in the area of advertising and promotion or press advertising being brought in, either to an advertising agency or directly into a business to assist with and advise on advertising and promotion activities or press advertising. In my view, these services fall within the broader category of “advertising and promotion services” in the applicant’s specification as this is, ultimately, the service that the consultant in both cases is providing. These services can, therefore, be considered identical on the principle outlined in *Meric*.

33. “Fashion show exhibitions for commercial purposes” and “fashion shows for promotional purposes (Organization of -)” in the proprietor’s specification, in my view, fall within the broader category of “conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes” in the applicant’s specification. Fashion shows are ultimately an opportunity for those in the trade to showcase their goods to potential buyers. This is exactly the purpose of a trade show. I acknowledge that fashion shows tend to be presented in a way that is also akin to entertainment that people may attend for their own enjoyment and consequently, this may also be considered to fall within the broader category of “production of live entertainment events” in the applicant’s specification. Such services can, therefore, be considered identical on the principle outlined in *Meric*.

34. “Organisation of prize draws for advertising purposes” in the proprietor’s specification, in my view, falls within the broader category of “advertising and promotion services” in the applicant’s specification. This is an event that may be organised by a business offering advertising and promotional services. Alternatively, it also falls within the category of “production of live entertainment events” in the

applicant's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

35. "Organising and conducting job fairs" in the proprietor's specification falls within the broader category of "Arranging, conducting and organisation of workshops" in the applicant's specification. Job fairs are often offered as careers workshops to enable individuals (such as students) to decide what career path they want to follow. These services can, therefore, be considered identical on the principle outlined in *Meric*. If I am wrong in this finding, then the services will overlap in uses, users, methods of use and trade channels and will, therefore, be highly similar.

36. "Presentation of companies and their goods and services on the Internet", "presentation of companies on the Internet and other media" and "Presentation of goods and services" in the proprietor's specification are broad terms which may both involve advertising the businesses or goods and services in question. These services will, therefore, fall within the category of "advertising and promotion services" in the applicant's specification. The services can, therefore, be considered identical on the principle outlined in *Meric*. If I am wrong, then they will overlap in user, use, trade channel and method of use and will be highly similar.

37. "Information services relating to advertising" in the proprietor's specification is a broad term which may refer to any number of things. This may refer to the provision of information about advertising agencies, the provision of information about approaches to advertising or information about legal and regulatory constraints on advertising activity. The users are likely to be the same as those for "advertising and promotion services" in the applicant's specification as they will both be used by businesses looking to engage in advertising. The use may be the same (in the case of information provided about approaches to advertising) or it may differ. Similarly, the trade channels may overlap. In my view, the services are similar to at least a medium degree.

38. "Customer relationship management" in the proprietor's specification is a service which involves the management of a business' relationships with existing and potential customers with the intention of improving and maintaining these relationships. In my

view, the closest point of similarity with the applicant's services lies in the applicant's "advertising and promotion services". The users of these services will be the same as they will both be used by businesses. The use will be the same on a high level in that they are both services aimed at business growth and improvement, although their specific uses will be different. Their trade channels are likely to differ and the services cannot be said to be complementary or competitive in nature. In my view, there is not enough for these services to be considered similar. However, if I am wrong in this finding then they will be similar to only a low degree.

39. "Information agencies (Commercial -)", "Information and expert opinions relating to companies and business", "Information (Business -)", "Information in business matters", "Information services relating to business matters", "information services relating to businesses" in the proprietor's specification are very general information services and may cover any number of aspects of a business and its operation. This may include information relating to advertising and promotional strategies and therefore the highest level of similarity lies in the applicant's "advertising and promotion services". The services will overlap in user as they will all be used by businesses. The use will be similar on a high level in that they will be focused on offering assistance to businesses (albeit this may be in different areas). The trade channels may overlap. The services cannot be said to be competitive or complementary. In my view, these services are similar to no more than a medium degree.

40. "Organisation, operation and supervision of an incentive scheme" and "organisational consultancy regarding customer loyalty programmes" in the proprietor's specification shares a degree of similarity with "advertising and promotion services" in the applicant's specification. The services in the proprietor's specification involve the running of schemes which are intended to promote the business of the operator. There is, therefore, a degree of overlap in use and user with the applicant's promotional services. However, the proprietor's services involve either the running of such schemes or organisational advice relating to them. Whilst those providing advertising and promotional services may recommend schemes that a business might adopt, they are unlikely to be involved in the organisation and running of such schemes. The trade channels will, therefore, differ. The method of use will differ. The

services cannot be said to be complementary or competitive. I consider there to be no more than a medium degree of similarity between the services.

41. "Presentation of goods on communication media, for retail purposes" appears twice in the proprietor's specification. This service is qualified as being specifically for retail purposes. It cannot, therefore, be said to fall within the category of "advertising and promotion services". However, the users will overlap. The use will be similar in that both services are aimed at developing a business. The trade channels will differ. The services are neither competitive nor complementary. In my view, the services are similar to only a low degree.

42. "Foreign trade consultancy services", "Foreign trade information and consultation", "Foreign trade information (Provision of -)", "Foreign trade information (Services for the provision of -)" in the proprietor's specification are all services aimed at assisting businesses engaged in trade with other countries. For example, this might include advice on import and export activities. Again, in my view, the highest point of similarity with the applicant's services is the applicant's "advertising and promotion services". These services will all be used by businesses, although in the case of the proprietor's services this will be specifically those businesses involved in international trade. The use will, again, be the same on a high level in that the services are all aimed at business growth and development, although the specific uses clearly differ. The trade channels differ and the services cannot be said to be competitive or complementary. In my view, the services are dissimilar. If I am wrong in this finding, then the services will be similar to only a low degree.

43. "Information services relating to data processing" in the proprietor's specification has no clear counterpart in the applicant's services. Whilst both this service and "advertising and promotion services" in the applicant's specification will both be used by businesses they clearly have different uses. I acknowledge that advertising may involve a degree of data processing in order to analyse consumer habits to achieve maximum return on advertising, however this is one step further removed from the provision of information about data processing. The services are neither competitive nor complementary. In my view, there is no similarity between these services and any

of the applicant's services. If I am wrong in this finding then they will be similar to only a low degree.

44. In my view, the only point of possible similarity between "Providing academic course administration services for academic institutions" and "Administration of cultural and educational exchange programs" in the proprietor's specification and the applicant's specification is the applicant's "educational services". However, the proprietor's services are those that would be provided to educational institutions by a third-party business whereas the applicant's services would be provided by educational institutions to their students. The users and trade channels are, therefore, different. The uses will differ because educational services are intended to offer education or development in a particular subject area, whereas the proprietor's administrative services are intended as a support and organisational function. These services are not competitive as you would not choose one as an alternative to the other. The services may be said to share a degree of complementarity because without the applicant's educational services there would be no need for the proprietor's administrative services to exist. Notwithstanding this, in my view, these services are dissimilar. If I am wrong in this finding then they will be similar to only a low degree.

45. "Providing commercial information to consumers", "providing consumer information relating to goods and services" and "providing consumer product advice" in the proprietor's specification have no clear counterpart or point of similarity in the applicant's specification. Although commercial information may be provided during the course of advertising, this is not enough on its own for a finding of similarity. I have considered the users, uses, method of use, trade channels and whether there is a complementary or competitive relationship with any of the applicant's services. In the absence of any substantive submissions to assist me, I do not consider there to be any similarity with the applicant's services. As some degree of similarity between the services is necessary to engage the test for likelihood of confusion², the application must fail in respect of these services.

46. That leaves the following services in the proprietor's specification:

² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

“Advertising and marketing services”, “advertising and marketing services provided by means of blogging”, “advertising and marketing services provided by means of social media”, “advertising and marketing services provided via communications channels”, “advertising for others”, “advertising of business web sites”, “advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors”, “advertising on the Internet for others”, “advertising services provided over the internet”, “advertising services provided via the internet”, “advertising through all public communication means”, “advertising via electronic media and specifically the internet”, “advertising via the Internet”, “online advertisements”, “online advertising network matching services for connecting advertisers to websites”, “preparing advertisements for others”, “preparing and placing advertisements for others”, “preparing and placing of advertisements”, “preparing and placing outdoor advertisements for others”, “development of promotional campaigns”, “digital advertising services”, “Marketing the goods and services of others”, “Outdoor advertising”, “Press advertising services”, “Promoting the goods and services of others”, “Promoting the sale of goods and services of others through promotional events”, “Promoting the sale of goods and services of others through the distribution of printed material and promotional contests”, “Promotion, advertising and marketing of on-line websites”, “Promotion [advertising] of business”, “Promotion of fairs for trade purposes”, “Promotion of special events”, “Promotion services”, “Promotional advertising for exploration projects”, “Promotional advertising services”, “Promotional marketing”, “Promotional marketing services using audiovisual media”, “Promotional services”, “Promotional services provided by telephone”, “Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet”, “Providing advertising services”, “Sales promotion for others”, “Advertising and promotion services and related consulting”, “advertising, marketing and promotion services”, “advertising, marketing and promotional consultancy, advisory and assistance services”, “advertising, marketing and promotional services”, “advertising, promotional and marketing services”, “Advertising and marketing services provided by means of social media”, “Design of advertising flyers”, “Design of

advertising logos”, “Design of advertising materials”, “Preparing audio-visual presentations for use in advertising”, “Dissemination of advertising material”, “Dissemination of advertising material [leaflets, brochure and printed matter]”, “Dissemination of advertising material [leaflets, brochures and printed matter]”, “Dissemination of advertising materials”, “Dissemination of advertising matter”, “Dissemination of advertising matter online”, “Dissemination of advertising via online communications networks”, “Distribution of advertising announcements”, “Distribution of advertising brochures”, “Distribution of advertising leaflets”, “Distribution of advertising mail and of advertising supplements attached to regular editions”, “Distribution of advertising, marketing and promotional material”, “Distribution of advertising material”, “Distribution of advertising materials”, “Distribution of advertising matter”, “Distribution of advertising samples”, “Distribution of flyers, brochures, printed matter and samples for advertising purposes”, “Distribution of printed advertising matter”, “Distribution of printed promotional material by post”, “Distribution of products for advertising purposes”, “Distribution of promotional leaflets”, “Distribution of promotional material”, “Distribution of promotional matter”, “Distribution of prospectuses and samples”, “Distribution of prospectuses and samples for advertising purposes”, “Distribution of prospectuses for advertising purposes”, “Distribution of publicity leaflets”, “Distribution of publicity materials (flyers, prospectuses, brochures, samples, particularly for catalogue long distance sales) whether cross border or not”, “Distribution of publicity materials, namely, flyers, prospectuses, brochures, samples, particularly for catalogue long distance sales [whether crossborder or not]”, “Distribution of publicity texts”, “Distribution of samples for advertising purposes”, “Distribution of samples for publicity purposes”, “Production of advertising films”, “Production of advertising material”, “Production of advertising materials”, “Production of advertising matter”, “Production of advertising matter and commercials”, “Production of cinema commercials”, “Production of commercials”, “Production of infomercials”, “Production of radio advertisements”, “Production of radio commercials”, “Production of sound recordings for advertising purposes”, “Production of sound recordings for marketing purposes”, “Production of sound recordings for publicity purposes”, “Production of television and radio advertisements”, “Production of television commercials”, “Production of video recordings for

advertising purposes”, “Production of video recordings for marketing purposes”, “Production of video recordings for publicity purposes” and “Production of visual advertising matter”.

47. The Oxford English Dictionary defines “marketing” as:

“The action or business of promoting and selling products or services, including market research and advertising³.”

48. I consequently consider that all of these services in the proprietor’s specification will fall within the broader category of “advertising and promotion services”. These services will, therefore, be identical on the principle outlined in *Meric*. If I am wrong in this finding then they will overlap in uses, users, trade channels and methods of use and will be highly similar.

The average consumer and the nature of the purchasing act

49. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which these 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. 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”.

³ <https://en.oxforddictionaries.com/definition/marketing>

50. I have no submissions from either party on the average consumer or the purchasing process for the services in issue.

51. The services are largely aimed at business users, although I accept that some of them will be used by members of the general public (such as educational services). The average consumer will, therefore, be either a business user or a member of the general public. The services are likely to be purchased fairly infrequently and will vary significantly in cost. For example, some entertainment services may be relatively low in price (such as the cost of a cinema ticket), whereas educational services may be very high in price (such as the cost of university tuition fees). In respect of all of the services, the consumer will take various factors into consideration such as cost, suitability for their specific requirements and reputation. The level of attention paid during the purchasing process will, therefore, be at least average.

52. The services are likely to be purchased from specialist outlets or their online equivalent. The purchasing process for the services is likely to be dominated by visual considerations, as the average consumer is likely to select the services at issue following inspection of the premises' frontage on the high street, websites and in advertisements (such as flyers, posters or online adverts). However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

Comparison of the trade marks

53. 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. 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.”

54. 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.

55. The respective trade marks are shown below:

Applicant’s trade mark	Proprietor’s trade mark
<p style="text-align: center;">Loop</p>	<div style="text-align: center;">  <p>(series of two)</p> </div>

56. The applicant’s mark consists of the 4-letter, recognisable dictionary word LOOP. There are no other elements to contribute to the overall impression, which lies in the word itself.

57. The proprietor’s mark consists of the letter ‘L’ presented in upper case and the letters ‘P’ and ‘S’ presented in lower case. All of these appear in a dark navy/grey colour. The ‘L’ and ‘P’ are joined by a pink curving line. There is a mortar board graduation hat presented at the end of the curving line. In the first mark in the series,

these elements are presented on a white background. In the second mark in the series, these elements are presented on a black background. In my view, the overall impression lies in the combination of all of these elements, with the background in both cases playing a lesser role in the overall impression.

58. Visually, the applicant's mark clearly consists of the ordinary dictionary word LOOP, presented in upper case. It is the proprietor's case that its mark consists of the word LOOPS. However, in my view the pink curving line (which is presumably intended to represent the 'OO' in the word) is not recognisable as a letter or letters. Even if the consumer does look for letters in the pink curving line there are any number of letters that it could represent (such as a U and an I or a U and an N or an inverted letter S lying on its side). In my view, it is unlikely that the mark will be recognised by the consumer as the word LOOPS. The font and stylisation of the wording in the proprietor's mark goes beyond a standard typeface. The proprietor's mark includes a representation of a mortar board graduation hat which has no counterpart in the applicant's mark. In my view, the marks only coincide in the presence of the letters L, P and S and are visually similar to only a very low degree.

59. If the consumer does recognise the presence of the word LOOPS in the proprietor's mark then they will not fail to notice the other elements that come together to form the mark. There are a number of other elements in the proprietor's mark which have no counterpart in the applicant's mark. In my view, if the consumer does recognise the proprietor's mark as being the word LOOPS, there will only be a low degree of visual similarity between the marks.

60. Aurally, the word LOOP in the applicant's mark will be given its ordinary English pronunciation. As noted above, it is unlikely that the proprietor's mark will be seen as the word LOOPS. In my view, the only elements of it that are likely to be pronounced are the letters L, P and S and these will each be pronounced individually. I consider that the marks share no aural similarity. If the consumer does recognise the word LOOPS in the proprietor's mark, then there will be a high degree of aural similarity.

61. Conceptually, the applicant's mark will be given its ordinary dictionary meaning. The Cambridge Dictionary defines 'LOOP' as:

“The curved shape made when something long and thin, such as a piece of string, bends until one part of it nearly touches or crosses another part of it.⁴”

62. It is this meaning that is likely to be attributed to the applicant’s mark. I do not consider that the letters in the proprietor’s mark have any meaning that will be immediately graspable by the consumer. The presence of the mortar board device in the proprietor’s mark conveys the meaning of some link with education which has no counterpart in the applicant’s mark. I do not consider that the marks share any conceptual similarity. If the consumer does recognise the presence of the word LOOPS in the proprietor’s mark then the marks will be conceptually similar to a high degree.

Distinctive character of the earlier mark

63. 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-2779, paragraph 49).

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

⁴ <https://dictionary.cambridge.org/dictionary/english/loop>

by the undertaking in promotion of the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

65. As the applicant has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider. I have no submissions from either party on the distinctiveness of the earlier mark.

66. I must make an assessment of the inherent distinctiveness of the earlier mark as a whole. The word LOOP is a common dictionary word with a recognisable meaning. The meaning of the word LOOP has no apparent link with the services for which the mark is registered and it is not, therefore, descriptive or allusive. In my view, the applicant’s mark has a medium degree of inherent distinctive character.

Likelihood of confusion

67. 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 applicant’s trade mark, the average consumer of the 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 he has retained in his mind.

68. For those average consumers who do not recognise the presence of the word LOOPS in the proprietor's mark, I have found the parties' marks to be visually similar to a very low degree. There is no conceptual or aural similarity between the marks. However, I recognise that there may be some average consumers who do recognise the presence of the word LOOPS in the proprietor's mark. For these average consumers, I have found the marks to be visually similar to a low degree and aurally and conceptually similar to a high degree. I have found the earlier mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be a business user or a member of the general public who will select the services primarily by visual means (although I do not discount an aural component). I have concluded that the degree of attention paid during the purchasing process will be at least average. I have found the parties' services to be vary from identical to similar to only a low degree (except for those services which are not similar).

69. For those average consumers who do not recognise the presence of the word LOOPS in the proprietor's mark, there can be no likelihood of direct confusion. The low degree of visual similarity between the marks will not be sufficient for them to mistake one mark for the other. For those consumers who do recognise the presence of the word LOOPS in the proprietor's mark, notwithstanding the principle of imperfect recollection and the identity of some of the services, the degree of visual difference between the marks will be sufficient to avoid a likelihood of direct confusion.

70. I recognise that for those consumers who recognise the proprietor's mark as LOOPS and who verbalise the mark, it will sound highly similar to the applicant's mark. However, these consumers are likely to recognise that the use of the pink curving line in the proprietor's mark will lead to ambiguity about how it should be pronounced. Consequently, they are likely to be cautious about relying on this verbal description alone. The same will be true of those receiving enquiries or recommendations by reference to the word LOOPS, and who know of the applicant's mark. In any event,

the purchasing process for the services in issue will be a primarily visual one. Consequently, consumers are unlikely to select the services without sight of the trade mark. There is, therefore, only limited potential for aural confusion.

71. In *Royal Academy of Arts v Errea Sports S.p.a*, Mr Justice Purvis QC, sitting as the Appointed Person, stated:

“In essence [the] argument was that there was bound to be a likelihood of confusion in this case because of the aural ‘identity’ between the marks (if one tried to ask for goods using an aural version of the earlier mark, one would ask for ‘RA’ goods, just as one would ask for the applicant’s goods). This argument seems to me to fly in the face of the necessary ‘global’ assessment, bearing in mind the visual, conceptual and aural similarities, which the tribunal must carry out.”

72. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin L.J. stated that:

“if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

73. This was, of course, in the context of infringement. However, the same approach is appropriate under section 5(2)⁵. It is not, therefore, necessary for me to find that the majority of consumers will be confused. However, if the most that can be said is that occasional confusion amongst a few average consumers cannot be ruled out, then this is not sufficient. Rather, the question is whether there is a likelihood of confusion amongst a significant proportion of the public displaying the characteristics attributed to an average consumer of such services.

⁵ *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch), Mann J.

74. The fact that a significant proportion of the relevant public will see only a low degree of visual similarity between the marks and no aural or conceptual similarity (meaning there is no overall similarity between the marks) is plainly relevant to the assessment I must undertake. The limited scope for direct confusion even amongst those who see some similarity between the marks is also relevant. Consequently, I find that there is no likelihood of direct confusion.

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

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

76. For those consumers who do not see the presence of the word LOOPS in the proprietor’s mark there cannot be said to be “something in common” and therefore there will be no likelihood of indirect confusion. There would be no reason for them to consider that the marks originated from the same or economically linked undertakings.

77. For those consumers who do recognise the presence of the word LOOPS in the proprietor’s mark, I must consider whether this will lead them to conclude that the marks originate from the same or economically linked undertakings. Clearly, the proprietor’s mark is the plural of the applicant’s, although I accept that this may go unnoticed by the average consumer (bearing in mind that they will not have the

opportunity to compare the marks side by side). However, in my view, the proprietor's mark is much more than just the word LOOPS with some stylisation. It cannot be said to unambiguously be the word LOOPS and the stylisation and use of additional graphic elements go beyond a natural development or variation of the applicant's word mark (even if the presence of the additional letter goes unnoticed).

78. In *Duebros Limited v Heirler Cenovis GmbH*, Case BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. He pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

79. For those consumers who recognise a common element in the marks (the four letters LOOP), in the context of the later mark as a whole, I find that there will be no likelihood of indirect confusion.

CONCLUSION

80. The invalidation has failed in its entirety.

COSTS

81. The proprietor has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£500** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Providing a statement and considering the applicant's statement	£200
Preparing written submissions in lieu of a hearing	£300
Total	£500

82. I therefore order Ableton AG to pay GraduateLoops Limited the sum of £500. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated 30 April 2019

S WILSON

For the Registrar

ANNEX 1

Class 35 Administration of business affairs; Administration of businesses; Administration of cultural and educational exchange programs; Advertising and marketing services; Advertising and marketing services provided by means of blogging; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising and promotion services and related consulting; Advertising for others; Advertising, marketing and promotion services; Advertising, marketing and promotional consultancy, advisory and assistance services; Advertising, marketing and promotional services; Advertising of business web sites; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising, promotional and marketing services; Advertising, promotional and public relations services; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services relating to clothing; Advertising services relating to the recruitment of personnel; Advertising through all public communication means; Advertising via electronic media and specifically the internet; Advertising via the Internet; Advice relating to business management; Advice relating to business organisation; Advice relating to business organization; Advice relating to marketing management; Advice relating to personnel management; Advice relating to the organisation and management of business; Advisory services for business management; Advisory services relating to business administration; Advisory services relating to personnel placement; Advisory services relating to personnel recruitment; Advisory services relating to public relations; Analysis of the public awareness of advertising; Arranging of contracts, for others, for the providing of services; Arranging of contracts for the purchase and sale of goods and services, for others; Arranging of displays for business purposes; Arranging of exhibitions for advertising purposes; Arranging of exhibitions for business purposes; Arranging of exhibitions for

commercial purposes; Arranging of exhibitions for trade purposes; Assessment analysis relating to business management; Assistance, advisory services and consultancy with regard to business analysis; Assistance, advisory services and consultancy with regard to business management; Assistance, advisory services and consultancy with regard to business organization; Assistance, advisory services and consultancy with regard to business planning; Assistance and advice regarding business management; Assistance and advice regarding business organisation and management; Assistance and advice regarding business organization; Assistance and advice regarding business organization and management; Assistance and consultancy relating to business management and organisation; Assistance relating to business organisation; Assistance relating to recruitment and placement of staff; Automated data processing; Business administration assistance; Business administration for others; Business advice relating to marketing management consultations; Business advisory services, consultancy and information; Business consultancy services; Business consulting; Business consulting services; Business management consulting; Business management consulting services; Business planning and business continuity consulting; Business project management; Business project management services; Business recruitment consultancy; Career advisory services (other than education and training advice); Career information and advisory services (other than educational and training advice); Career networking services; Career placement; Career placement consulting services; Career planning consultancy; Conducting of trade shows; Conducting virtual trade show exhibitions online; Confirming scheduled appointments for others; Consultancy and advisory services for business management; Consultancy and advisory services relating to business management; Consultancy and advisory services relating to personnel management; Consultancy and advisory services relating to personnel recruitment; Consultancy and information services relating to accounting; Consultancy of personnel recruitment; Consultancy (Professional business -); Consultancy regarding advertising communications strategy;

Consultancy regarding the organization or managing of a trade company; Consultancy relating to advertising and promotion services; Consultancy relating to business management and organisation; Consultancy relating to management selection; Consultancy relating to personnel management; Consultancy relating to personnel recruitment; Consultancy relating to the management of personnel; Consultancy relating to the selection of personnel; Creating advertising material; Customer loyalty services for commercial, promotional and/or advertising purposes; Customer relationship management; Design of advertising flyers; Design of advertising logos; Design of advertising materials; Design of marketing surveys; Design of public opinion surveys; Developing and coordinating volunteer projects for charitable organisations; Development of promotional campaigns; Digital advertising services; Dissemination of advertising material; Dissemination of advertising material [leaflets, brochure and printed matter]; Dissemination of advertising material [leaflets, brochures and printed matter]; Dissemination of advertising materials; Dissemination of advertising matter; Dissemination of advertising matter online; Dissemination of advertising via online communications networks; Distribution of advertising announcements; Distribution of advertising brochures; Distribution of advertising leaflets; Distribution of advertising mail and of advertising supplements attached to regular editions; Distribution of advertising, marketing and promotional material; Distribution of advertising material; Distribution of advertising materials; Distribution of advertising matter; Distribution of advertising samples; Distribution of flyers, brochures, printed matter and samples for advertising purposes; Distribution of printed advertising matter; Distribution of printed promotional material by post; Distribution of products for advertising purposes; Distribution of promotional leaflets; Distribution of promotional material; Distribution of promotional matter; Distribution of prospectuses and samples; Distribution of prospectuses and samples for advertising purposes; Distribution of prospectuses for advertising purposes; Distribution of publicity leaflets; Distribution of publicity materials (flyers, prospectuses, brochures, samples,

particularly for catalogue long distance sales) whether cross border or not; Distribution of publicity materials, namely, flyers, prospectuses, brochures, samples, particularly for catalogue long distance sales [whether crossborder or not]; Distribution of publicity texts; Distribution of samples for advertising purposes; Distribution of samples for publicity purposes; Employee leasing; Employee record services; Employee relocation services; Employment agencies; Employment agency services; Employment agency services for people skilled in the use of computers; Employment agency services for personnel in general office positions; Employment agency services for temporary work assignments; Employment agency services provided for nannies; Employment agency services relating to au pairs; Employment agency services relating to bilingual staff; Employment agency services relating to nurses; Employment agency services relating to placement of medical and nursing personnel; Employment agency services the provision of staff for the manning of show houses; Employment booking services for film television technicians; Employment booking services for performing artists; Employment bureau services; Employment consultancy; Employment consultancy services; Employment consultancy services relating to data processing personnel; Employment counselling; Employment counselling and consultancy services; Employment counselling services; Employment management services for film television technicians; Employment outplacement services; Employment placement services for butlers; Employment placement services for housekeepers; Employment placement services for personal assistants; Employment recruiting consultancy; Employment recruiting services; Employment recruitment; Evaluation of personnel requirements; Evaluations relating to business management in commercial enterprises; Evaluations relating to business management in industrial enterprises; Evaluations relating to business management in professional enterprises; Executive placement services; Executive recruiting services; Executive recruitment services; Executive search and placement services; Executive search and selection services; Executive search services; Executive selection services; Exhibitions

(Arranging -) for advertising purposes; Exhibitions (Arranging -) for business purposes; Exhibitions (Arranging -) for commercial purposes; Exhibitions (Arranging -) for trade purposes; Exhibitions (Conducting -) for advertising purposes; Exhibitions (Conducting -) for business purposes; Exhibitions (Conducting -) for commercial purposes; Exhibitions (Conducting -) for trade purposes; Exhibitions for commercial or advertising purposes; Expert evaluations and reports relating to business matters; Export agency services; Export and import agencies; Export promotion services; Export-import agency services; Fashion show exhibitions for commercial purposes; Fashion shows for promotional purposes (Organization of -); Foreign trade consultancy services; Foreign trade information and consultation; Foreign trade information (Provision of -); Foreign trade information (Services for the provision of -); Franchising (Business advisory services relating to -); Headhunting services; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise; Human resources consultancy; Human resources consultation; Human resources management; Human resources management and recruitment services; Import agency services; Industrial management assistance (Commercial or -); Industrial management consultation including cost/yield analyses; Information agencies (Commercial -); Information and data compiling and analyzing relating to business management; Information and expert opinions relating to companies and business; Information (Business -); Information in business matters; Information or enquiries on business and marketing; Information services relating to advertising; Information services relating to business matters; Information services relating to businesses; Information services relating to data processing; Information services relating to jobs and career opportunities; Interviewing services [for personnel recruitment]; Invoicing; Invoicing services; Issuing and updating of advertising texts; Job agency services; Job agency services for medical personnel; Job agency services for para-medical personnel; Job and personnel placement; Job matching services; Job placement; Job placement consultancy; Labor exchanges; Labour exchange services;

Maintenance of personnel records [for others]; Management advice relating to the placing of staff; Management advice relating to the recruitment of staff; Management (Advisory services for business -); Management assistance for promoting business; Management assistance in business affairs; Management consultancy (Personnel -); Management consulting; Marketing the goods and services of others; Matching skilled volunteers with non-profit organisations; Negotiation of business contracts for others; Office administration services [for others]; Office management services [for others]; Office support staff recruitment services; Online advertisements; Online advertising network matching services for connecting advertisers to websites; Online retail services relating to clothing; Online retail services relating to luggage; Online retail store services in relation to clothing; Online retail store services relating to clothing; Operation of businesses [for others]; Organisation and management of business incentive and loyalty schemes; Organisation and management of customer loyalty programs; Organisation of exhibitions and events for commercial or advertising purposes; Organisation of exhibitions and trade fairs for business and promotional purposes; Organisation of exhibitions and trade fairs for commercial and advertising purposes; Organisation of exhibitions and trade fairs for commercial or advertising purposes; Organisation of exhibitions for business or commerce; Organisation of exhibitions for commercial and advertising purposes; Organisation of exhibitions for commercial or advertising purposes; Organisation of exhibitions of flowers and plants for commercial or advertising purposes; Organisation of fashion shows for commercial purposes; Organisation of prize draws for advertising purposes; Organisation of trade fairs; Organisation of trade fairs for advertising purposes; Organisation of trade fairs for commercial or advertising purposes; Organisation, operation and supervision of an incentive scheme; Organisation, operation and supervision of customer loyalty schemes; Organisation, Operation and supervision of loyalty and incentive schemes; Organisation, operation and supervision of loyalty schemes and incentive schemes; Organisation, operation and supervision of sales and promotional

incentive schemes; Organisational consultancy regarding customer loyalty programmes; Organising and conducting job fairs; Organising exhibitions for commercial or advertising purposes; Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; Organization of exhibitions and trade fairs for commercial or advertising purposes; Organization of exhibitions for commercial or advertising purposes; Organization of fairs and exhibitions for commercial and advertising purposes; Organization of fairs for commercial and advertising purposes; Organization of fashion shows for promotional purposes; Organization of trade fairs for commercial or advertising purposes; Organization, operation and supervision of sales and promotional incentive schemes; Organizing exhibitions for commercial or advertising purposes; Organizing of trade shows; Outdoor advertising; Outsource service provider in the field of customer relationship management; Outsourced administrative management for companies; Outsourcing services [business assistance]; Outsourcing services in the nature of arranging service contracts for others; Pay per click advertising; Personal management consultancy services; Personality testing for recruitment purposes; Personality testing for the selection of personnel; Personnel agency services relating to the electronics industry; Personnel consultancy; Personnel management; Personnel management advice; Personnel management and employment consultancy; Personnel management assistance; Personnel management assistance services; Personnel management consultancy; Personnel management consultancy services; Personnel management consultation; Personnel management consulting; Personnel management for advertising purposes; Personnel management of marketing personnel; Personnel management of sales personnel; Personnel management services; Personnel placement; Personnel placement and recruitment; Personnel placement consultancy; Personnel placement services; Personnel recruitment; Personnel recruitment advertising; Personnel recruitment agency services; Personnel recruitment consultancy; Personnel recruitment services; Personnel recruitment services and employment agencies;

Personnel relocation; Personnel resources management; Personnel selection [for others]; Personnel selection using psychological testing; Personnel services; Placement of design staff; Placement of permanent personnel; Placement of staff; Placement of temporary personnel; Placing advertisements for others; Planning and conducting of trade fairs, exhibitions and presentations for commercial or advertising purposes; Planning and conducting of trade fairs, exhibitions and presentations for economic or advertising purposes; Planning concerning business management, namely, searching for partners for amalgamations and business take-overs as well as for business establishments; Preparing advertisements for others; Preparing and placing advertisements for others; Preparing and placing of advertisements; Preparing and placing outdoor advertisements for others; Preparing audio-visual presentations for use in advertising; Presentation of companies and their goods and services on the Internet; Presentation of companies on the Internet and other media; Presentation of financial products on communication media, for retail purposes; Presentation of goods and services; Presentation of goods on communication media, for retail purposes; Presentation of goods on communications media, for retail purposes; Press advertising consultancy; Press advertising services; Procurement of contracts [for others]; Procurement of contracts for others relating to the sale of goods; Procurement of contracts for the purchase and sale of goods and services; Procurement of contracts for the purchase and sale of goods and services for others; Procurement of goods on behalf of other businesses; Production of advertising films; Production of advertising material; Production of advertising materials; Production of advertising matter; Production of advertising matter and commercials; Production of cinema commercials; Production of commercials; Production of infomercials; Production of radio advertisements; Production of radio commercials; Production of sound recordings for advertising purposes; Production of sound recordings for marketing purposes; Production of sound recordings for publicity purposes; Production of television and radio advertisements; Production of television commercials; Production

of video recordings for advertising purposes; Production of video recordings for marketing purposes; Production of video recordings for publicity purposes; Production of visual advertising matter; Professional business consultancy; Professional business consultancy services; Professional business consultation relating to the operation of businesses; Professional business consultation relating to the setting up of businesses; Professional business consultations; Professional business consulting; Professional consultancy relating to business management; Professional consultancy relating to marketing; Professional consultancy relating to personnel management; Professional recruitment services; Promoting the goods and services of others; Promoting the sale of goods and services of others through promotional events; Promoting the sale of goods and services of others through the distribution of printed material and promotional contests; Promoting the sale of the services [on behalf of others] by arranging advertisements; Promotion, advertising and marketing of on-line websites; Promotion [advertising] of business; Promotion of fairs for trade purposes; Promotion of goods and services through sponsorship of international sports events; Promotion of goods and services through sponsorship of sports events; Promotion of insurance services, on behalf of third parties; Promotion of special events; Promotion services; Promotional advertising for exploration projects; Promotional advertising services; Promotional and advertising services; Promotional marketing; Promotional marketing services using audiovisual media; Promotional services; Promotional services provided by telephone; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Providing academic course administration services for academic institutions; Providing advertising services; Providing business information directory services, via a global computer network; Providing business information in the field of social media; Providing business information via a web site; Providing business information via a website; Providing business management and operational assistance to commercial businesses; Providing business management start-up support for other businesses; Providing business

marketing information; Providing commercial directory information via the Internet; Providing commercial information relating to companies; Providing commercial information to consumers; Providing consumer information relating to goods and services; Providing consumer product advice; Providing consumer product advice relating to cosmetics; Providing employment counseling services; Providing employment information; Providing information relating to employee relocation services; Providing information relating to employment recruitment; Providing information relating to personnel recruitment; Provision of advice relating to the recruitment of graduates; Provision of information relating to recruitment; Psychological testing for the selection of personnel; Psychometric testing for the selection of personnel; Public opinion polling; Public opinion polling services; Public relations consultancy; Purchasing of goods and services for other businesses; Real estate marketing; Recruitment advertising; Recruitment and personnel management services; Recruitment and placement services; Recruitment consultancy for lawyers; Recruitment consultancy for legal secretaries; Recruitment consultancy services; Recruitment consultants in the financial services field; Recruitment of airline personnel; Recruitment of airport ground staff; Recruitment of computer staff; Recruitment of executive staff; Recruitment of flight personnel; Recruitment of high-level management personnel; Recruitment of temporary personnel; Recruitment of temporary technical personnel; Recruitment (Personnel -); Recruitment services; Recruitment services for sales and marketing personnel; Sales promotion for others; Secretarial employment agency services; Secretarial employment services; Staff placement services; Staff recruitment; Staff recruitment consultancy services; Staff recruitment services; Temporary employment agencies; Temporary personnel employment services; Temporary personnel services; Trade fairs (Organization of -) for commercial or advertising purposes; Wholesale services in relation to clothing; Advertising and marketing services provided by means of social media; Providing business information in the field of social media; Providing marketing consulting in the field of social media.