

**O/529/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003480304**

**BY LOGICOM HUB LTD**

**TO REGISTER:**

**Logicom Hub**

**AS A TRADE MARK IN CLASSES 9, 16, 35, 41 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 421209 BY**

**LOGICOM**

## BACKGROUND AND PLEADINGS

1. On 9 April 2020, Logicom Hub Ltd (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods and services:

Class 9: Training software; Training guides in electronic format; Training manuals in the form of a computer program; Training manuals in electronic format; Packaged software; Integrated software packages; Application software for cloud computing services; Computer software packages; all the aforesaid relating to the logistics and transport industry; none of the aforementioned being, or relating to, computer or electronic devices.

Class 16: Training manuals; Manuals [handbooks]; all the aforesaid relating to the logistics and transport industry.

Class 35: Business consultancy, in the field of transport and delivery; Business advisory and consultancy services; Preparing business reports; Market reports and studies; all the aforesaid relating to the logistics and transport industry.

Class 41: Training; Training consultancy; Business training; Training and further training consultancy; Computer training services; Conducting training seminars; Business training services; Staff training services; Commercial training services; Written training courses; Practical training services; Provision of training courses; Setting of training standards; Providing online training seminars; Know-how transfer [training]; Conducting training seminars for clients; Training services relating to logistics; Provision of training services for industry; Arranging and conducting of training courses; Technical training relating to industrial risk; Consultancy services relating to the analysis of training requirements; Consultancy services relating to the development of training

courses; Production of training videos; Training courses; Industrial training; Training services relating to computer software; Organisation of Webinars; Provision of online training; all the aforesaid relating to the logistics and transport industry.

Class 42: Software as a service; Custom design of software packages; Software customisation services; Software maintenance services; Software development services; Software consultancy services; Computer software programming services; Services for updating computer software; Installation and maintenance services for software; Technical support services relating to computer software and applications; all the aforesaid relating to the logistics and transport industry.

2. The application was published for opposition purposes on 19 June 2020 and on 18 August 2020 it was opposed by LOGICOM (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following mark (“the opponent’s mark”):

LOGICOM

International registration no. 1269277

Filing date 26 June 2015; registration date 17 August 2016

Relying on some goods, namely:

Class 9: Portable and mobile digital electronic devices for sending and receiving telephone calls, electronic mail, messaging, video, music, audiovisual content and other multimedia content and other digital data; multimedia tablets; MP3 and MP4 players and other digital format audio players; digital video recorders and players; digital versatile disc recorders and players; cordless telephones; mobile telephones; parts and accessories for mobile telephones; chargers; apparatus for charging electric accumulators; earphones; car telephones, smartphones, answering machines, wireless communication devices for voice, data or images; software for global positioning systems (GPS);

smartphones in the form of watches; smartphones in the form of bracelets; mobile devices to be worn on the body; portable computer peripherals; personal electronic modules that are wearable and interchangeable, namely tags for personal mobile telephones, telephones, smartphones, tablet computers, portable and handheld digital electronic devices fitted with wireless communication functions; mobile electronic data receivers and transmitters.

3. The opponent submits that in light of the high similarity between the marks, and the similarity between the goods and services, there exists a likelihood of confusion on the part of the public. In its counterstatement, the applicant admits that the respective trade marks are similar but denies that there exists a likelihood of confusion as the competing goods and services are neither identical nor similar.
4. The opponent is represented by Dolleymores and the applicant is represented by Carbon Law Partners. The applicant filed evidence in chief while also filing written submissions during the evidence rounds. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
5. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **PRELIMINARY ISSUE**

6. In its submissions and evidence, the applicant took issue with the opponent's notice of opposition, particularly that it failed to go into full detail regarding the goods and services against which the opposition was aimed. Firstly, the applicant refers to paragraphs 7, 9 and 10 of the Tribunal Practice Notice ("TPN") 1/2018. While these submissions are noted, the TPN states that where pleadings are, for

example, not sufficiently clear, the case worker *may* require further information from the opponent. The case worker in these proceedings did not consider this to be necessary and the opponent was, therefore, entitled to provide that further information either by way of evidence or written submissions, which it did so by way of written submissions in lieu of a hearing.

7. The applicant goes on to submit that,

“to allow the Opponent to explain for the first time at this late stage of the proceedings why the respective goods and services of the Trademark are claimed to be similar to those of the Opponent’s mark would be unfair and disproportionate to the Registry’s overriding objective to ensure that proceedings are completed within a reasonable time, since this explanation (assuming there is one) could have been provided by the Opponent during the **two month period** noticed by the Registry on *[sic]* letter dated 15 January 2021, where the Opponent was precisely advised of the need to file its evidence and/or submissions in support of the Opposition and it was the Opponent’s decision not to do so.” (original emphasis of the applicant included)

8. Firstly, I fail to see how the opponent setting out its reasons for why it considers the parties’ goods and services to be similar for the first time during the written submissions rounds is contrary to the overriding objecting to ensure proceedings are completed within a reasonable time. These proceedings have not been unduly delayed as a result of the opponent filing written submissions. This is a stage that is allowed for in all proceedings where parties elect not to be heard. Secondly, while the above submissions are noted, the opponent, by pleading under grounds section 5(2)(b), argued that the goods and services were identical and/or similar. Opponents in section 5(2)(b) proceedings are not required to go into minute detail as to what exact goods or services are identical and/or what level of similarity exists between them in its notice of opposition. While this may be of assistance to the parties and the Tribunal, it is not fatal to the opponent’s case if it does not do so.

9. Further, and contrary to what the applicant submits, the opponent was not precisely advised of the need to file its evidence and/or submissions in this matter. These

proceedings are brought under section 5(2)(b) of the Act, which is not a ground that is reliant upon the filing of evidence or submissions. While the opponent was provided with a deadline within which to file evidence or submissions, it was not a requirement and, for whatever reason, the opponent chose not to do so, which it was entitled to do.

10. A final point I wish to make on this issue is that the goods and services comparison I must make in this decision is a notional one and I note that the opponent's written submissions filed in lieu of a hearing set out, in detail, the basis on which it considers the goods and services to be identical and/or similar. I also note that the applicant's submissions also address the goods and services comparison in detail. The assessment I will come to make will take into account both of these submissions and the various factors set out in the case law that I will refer to below.

## **EVIDENCE**

11. As above, only the applicant filed evidence in this matter. This was in the form of the witness statement of Samantha Stretton dated 5 April 2021 and the witness statement of Vivianna Mucharraz dated 20 April 2021. I will summarise this evidence to the extent that I consider it necessary below.

### The Witness Statement of Samantha Stretton

12. Ms Stretton is the Director and CEO of the applicant. Ms Stretton discusses her background in the logistics and transport industries. She also discusses the background of the applicant's mark, the specific types of services that the applicant provides, being the provision of training, consultancy and safety advisory services and how the applicant's goods and services are sold to its clients. While I note Ms Stretton's comments on the average consumer and how the applicant's goods and services are sold, there is no supporting evidence in respect of the average consumer or the nature of the purchasing act for the applicant's goods and services. Further, as with the assessment of the goods and services comparison, the assessment I must make in respect of the average consumer and the

purchasing act is a notional one that I will make on the basis of the wording of the parties' specifications.

13. Ms Stretton goes on to explain that when applying for the applicant's mark, the opponent's mark was brought to its attention and it was decided, by the applicant, that the goods and services were not in competition with the opponent's and that they were of a different nature and of different trade channels. While I note Ms Stretton's comments on this point, I have set out above that the goods and services assessment I must make is a notional one and I am required to take into account all of the ways in which the applicant's mark could be used by reference to the goods and/or services for which it is applied for.

14. Finally, correspondence that took place between the parties prior to the opposition being filed is discussed. While I will not summarise this in full, I note that prior to the commencement of these proceedings, Ms Stretton states that there was correspondence passing back and forth between these parties regarding the restriction of the scope of the applicant's goods and services which were ultimately discontinued by the opponent in favour of filing the opposition. Ms Stretton goes on to state that the opposition has been frivolous and vexatious in nature from the outset and, as a result, an award of costs should be made in the favour of the applicant for an amount at least equal to the profession costs incurred by the applicant in these proceedings. Firstly, I have set out above that I do not consider that the opponent has acted unreasonably throughout these proceedings. Secondly, the correspondence discussed by Mr Stretton is, in my view, ordinary pre-action correspondence that the parties were free to engage in.

#### The Witness Statement of Vivianna Mucharraz

15. Ms Mucharraz is the attorney for the applicant. Ms Mucharraz seeks to show that the marks are conceptually dissimilar with reference to printouts from the parties' websites.<sup>1</sup> While this evidence is noted, the conceptual comparison I must make is a notional one and is based on the marks themselves, not the aims set out on

---

<sup>1</sup> Exhibits VM1.1 to VM1.3

the printouts of the parties' websites, which I note are dated after the relevant date, being the date of the application at issue.

16. Evidence is also provided regarding the purpose and use in trade of the parties' goods and services. Screenshots of the parties' websites are, again, produced to demonstrate that the parties' goods and services relate to different areas of interest.<sup>2</sup> While this point is noted, I have set out above that my assessment of the similarity of the goods and services is a notional one and I am required to take into account all of the ways in which the marks could be used by reference to the goods and/or services for which they are applied for/registered. This assessment is based on the wording of the parties' specifications and not the purpose of the parties' businesses as set out in the screenshots, which I note are dated after the relevant date.

17. Further evidence regarding the different consumer bases of the parties' goods and services is also provided, again, by way of printouts from the parties' websites.<sup>3</sup> This evidence, dated after the relevant date, simply shows a list of retailers that sell the opponent's goods and a contract form on the applicant's website where users can make enquiries with the applicant.

## **DECISION**

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

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

“(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,

---

<sup>2</sup> Exhibits VM1.4 to VM1.6

<sup>3</sup> Exhibits VM1.7 and VM1.8



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

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

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

20. 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.

21. The opponent’s mark qualifies as an earlier trade mark under the above provisions. As the opponent’s mark had not completed its registration process more than 5 years before the application date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods for which its marks are registered.

22. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson*

*Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.*

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

23. The applicant's goods and services are listed in paragraph 1 above whereas the opponent's goods are listed in paragraph 2.

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

"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".

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

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

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

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

27. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

*“...the applicable principles of interpretation are as follows:*

*(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*

*(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

*(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

*(4) A term which cannot be interpreted is to be disregarded.”*

28. I have detailed submissions in respect of the goods and services comparison from both parties. I do not intend to reproduce these in full but will, if necessary, refer to them below.

#### Class 9 goods

29. Before assessing any similarity between the applicant's class 9 goods and the opponent's goods, it is necessary to assess the limitations within the applicant's specification that cover all of its class 9 goods. The goods contain two limitations, firstly that the goods are used in relation to the logistics and transport industry (a limitation which I note is also included in all classes for which the applicant seeks registration) and secondly, that they do not relate to computer or electronic devices. The applicant submits that the latter limitation restricts the applicant from operating in the electronics industry. While this may be the case, the various types of software covered by the applicant's specification are inevitably going to be used on computer and/or electronic devices, which can be said to fall within the electronics industry. The applicant further submits that the opponent's goods relate specifically to the electronics industry. However, this is not the case as the opponent's terms contain no such limitation that limits them to trading in any specific industry. This is particularly the case given that one of the opponent's goods is "software for global positioning systems (GPS)", which is a type of software that can be used in the transport industry. Further, while the opponent's specification includes electronic devices, they are still capable of being used the logistics industry. For example, it is possible that a portable electronic device for sending and retrieving data could be used to scan delivery shipments in order to track their location, movement and progress. Such use would be said to be for the implementation of

a complex, large delivery operation which, in my view, is a service covered by the logistics industry.

30. Bearing in mind the decision of *Skykick* (cited above), if I were to interpret the applicant's terms, being "packaged software", "integrated software packages", "application software for cloud computing services" and "computer software packages" (all limited for use in relation to the transport and logistics industries) in accordance with their clear literal meanings, I consider it reasonable to conclude that it is entirely possible for those goods to cover GPS software, amongst other things. The opponent submits that GPS "is commonly used in the logistics and transport industry". I agree with these submissions and, therefore, consider that "software for global positioning systems (GPS)" in the opponent's specification falls within the applicant's broader terms, listed above. As a result, I consider that these goods are identical under the principle outlined in *Meric*.

31. While I do not consider "training software", "training guides in electronic format", "training manuals in the form of a computer program" and "training manuals in electronic format" to be identical with "software for global position systems (GPS)" in the opponent's specification, I do consider there to be a level of similarity between them. This is particularly the case given that, in accordance with paragraph 30 above, the applicant's goods can reasonably be said to include GPS related goods, given the limitation. In my view, software for use with GPS is likely to come with its own in-built training software, training guides or training manuals. While the purpose of the applicant's goods will be used to train the user whereas the opponent goods' purpose will be to utilise GPS devices themselves, the end purpose of the goods may overlap, generally, in that they may all be used for the ultimate purpose of using GPS software. Additionally, the user will overlap in that the user of GPS software is also likely to use training software, manuals and guides in respect of that software. The goods are also likely to overlap in trade channels as the provider of the GPS software is likely to provide the training software, guide or manual for it. Overall, I consider that these goods are similar to between a low and medium degree.

### Class 16 goods

32. As a result of the limitation that the applicant's goods relate to the transport and logistic industries, it is reasonable to conclude that the applicant's class 16 goods, being "training manuals" and "manuals [handbooks]" may relate to training manuals for use with GPS software. In my view, it is common for undertakings who provide software to provide both physical training manuals and electronic manuals with its software. I consider that these goods share the same overlap in factors as set out in paragraph 31 above. I, therefore, consider there to be between a low and medium degree of similarity between these goods.

### Class 35 services

33. As per classes 9 and 16 above, the applicant's class 35 services contain the limitation that the services relate to the logistics and transport industry. Having considered the class 35 services, I do not consider there to be any obvious level of similarity between "business consultancy, in the field of transport and delivery", "business advisory and consultancy services", "preparing business reports", "market reports and studies" and any of the opponent's class 9 goods.

### Class 41 services

34. Considering the applicant's class 41 services in line with the limitation of being used in relation to the transport and logistics industries, it is reasonable to conclude that the various training services provided by the applicant can include training relating to the operation of GPS software and/or the various electronic devices for which the opponent's mark is registered which may be used in those industries. Whilst I am conscious not to narrow the scope of the applicant's specification too finely, I must consider all likely interpretations of the terms before me, in the context they are presented. In my view, the operation of businesses in the transport and logistics industry will rely heavily on GPS and electronic devices and it is likely that undertakings would provide training on how to use these types of software/devices in the transport or logistics industry. As a result, I am of the view that "training", "training and further training consultancy", "computer training services",

“conducting training seminars”, “written training courses”, “training services relating to computer software”, “practical training services”, “provision of training courses”, “providing online training seminars”, “conducting training seminars for clients”, “training services relating to logistics”, “provision of training services for industry”, “arranging and conducting of training courses”, “staff training services”, “training courses”, “industrial training”, “organisation of webinars” and “provision of online training” in the applicant’s specification, all of which are for use in relation to transport and logistics, share a level of similarity with “portable and mobile digital electronic devices for sending and receiving [...] digital data”, “wireless communication devices for [...] data”, “software for global positioning systems (GPS)” and “mobile electronic data receivers and transmitters” in the opponent’s specification. This is on the basis that these goods are likely to be used in the transport and logistic industries and undertakings operating in those industries will provide training on these types of devices/software resulting in an overlap in trade channels and user. As a result, I consider that these goods and services are similar to a low degree.

35. As for “business training”, “business training services”, “commercial training services”, “training consultancy”, “technical training relating to industrial risk”, “consultancy services relating to the analysis of training requirements”, “consultancy services relating to the development of training courses”, “setting of training standards”, “know-how transfer [training]” and “production of training videos” in the applicant’s specification, I am of the view that these services will not relate to training in the use of the devices referred to at paragraph 34 above. This is due to the more specific nature of the training provided. As a result, I do not consider there to be any level of similarity between these services and any of the goods listed in the opponent’s specification. Therefore, these services are dissimilar.

#### Class 42 services

36. As with the previous classes of goods and services in this comparison, the applicant’s class 42 services contain the limitation that they are only to be used in relation to the logistics and transport industry. For the same reasons set out at



paragraph 29 above, I find that it is possible that the software services which the applicant seeks to register can include software relating to GPS. While I do not consider that “software as a service” in the applicant’s specification is identical with “software for global positioning systems (GPS)”, there is a level of similarity between them. While the nature of the goods/services is different in that one is a good you purchase as a one off and the other is a service that you subscribe to, they do overlap in user, purpose and method of use. There is also an overlap in trade channels as undertakings who provide software to buy as a one off are likely to offer software as a service also. Further, the goods and services are likely to be competitive in that a user may choose to buy the software for a one-off fee or pay for it on a periodic basis via the ‘software as a service’ route. Overall, I consider these goods and services to be similar to a high degree.

37. “Services for updating computer software”, “installation and maintenance services for software”, “software maintenance services” and “technical support services relating to computer software and applications” in the applicant’s specification are a range of services relating to software and, as above, given the limitation in the applicant’s specification, it is possible that these services are used in relation to GPS software. Therefore, I consider there to be a level of similarity with “software for global position systems (GPS)” in the opponent’s specification. A user of software for GPS is likely to require the service of updating that software, its installation, maintenance and technical support in relation to it, meaning that there is an overlap in user between these goods and services. While the purpose, nature and method of use differs, they do overlap in trade channels as an undertaking providing the software is likely to provide the updating, installation, maintenance and technical support services surrounding that software and vice versa. Overall, I consider there to a low degree of similarity between these goods and services.

38. “Custom design of software packages”, “software customisation services”, “software development services”, “software consultancy services”, “computer software programming services” in the applicant’s specification are services that will likely be used by professional users looking for an undertaking to create software for them. The user will not be someone looking to use software meaning that there is no overlap in user with “software for global positioning systems (GPS)”

in the opponent's specification. Further, the nature and method of use differs. As for trade channels, I do not consider that it is common for an undertaking providing software to also offer bespoke software design, customisation, development, consultancy and programming services. While there is a general overlap in purpose in that the end software being created may be used for GPS, I do not consider this overlap is sufficient to warrant a finding of similarity between these services. These services are, therefore, dissimilar.

39. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods and services I have found to be dissimilar will fail.<sup>4</sup> For ease of reference, the opposition may proceed against the following goods and services in the applicant's specification:

Class 9: Training software; Training guides in electronic format; Training manuals in the form of a computer program; Training manuals in electronic format; Packaged software; Integrated software packages; Application software for cloud computing services; Computer software packages; all the aforesaid relating to the logistics and transport industry; none of the aforementioned being, or relating to, computer or electronic devices.

Class 16: Training manuals; Manuals [handbooks]; all the aforesaid relating to the logistics and transport industry.

Class 41: Training; Training and further training consultancy; Computer training services; Conducting training seminars; Staff training services; Written training courses; Practical training services; Provision of training courses; Providing online training seminars; Conducting training seminars for clients; Training services relating to logistics; Provision of training services for industry; Arranging and conducting of training courses; Training courses; Industrial training; Training services relating to computer

---

<sup>4</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

software; Organisation of Webinars; Provision of online training; all the aforesaid relating to the logistics and transport industry.

Class 42: Software as a service; Software maintenance services; Services for updating computer software; Installation and maintenance services for software; Technical support services relating to computer software and applications; all the aforesaid relating to the logistics and transport industry.

### **The average consumer and the nature of the purchasing act**

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

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

41. The opponent submits that:

“Due to the limitation included by the Applicant the average consumer will be involved in the logistics and transport industry. As there are no further limitations to either the Applicant's or Opponent's specifications that would affect the assessment of the average consumer it must be deemed to consist of the entire spectrum of persons and businesses in this commercial field. As

such, it will include a sole trader, such as a van driver or motorcycle courier at one end of the scale, up to large multi-faceted logistics business, such as, UPS or DHL.”

42. I agree with the opponent’s submissions and find that the average consumer for the goods and services at issue is a business user in the field of transport or logistics. However, even considering the limitation in the applicant’s specification, I also find that the average consumer for goods such as GPS software could also include members of the general public. I consider that the goods and services are likely to range from being purchased/selected relatively infrequently (such as training services for computer software that may be purchased annually or when new software is released) to one off purchases (such as software design services). The price of the goods and services are also likely to range from being relatively inexpensive (for goods such as training manuals) to expensive (for services such as software design services). The goods and services are likely to be selected via retailers in store or their online equivalents. Some of the goods will be self-selected by the consumer from shelves in stores. However, for other goods and services, they are likely to be selected after seeing an image of them either in catalogues, brochures or on placards. When selecting the goods and services online, this will be done after viewing an image on a website. I am of the view that the selection process will be primarily visual, however, I do not discount an aural component playing a part in the form of advice from sales assistants, for example.

43. In respect of the level of attention paid for the goods and services at issue, this too will be varied. The average consumer is likely to have different considerations depending on what goods or services are being selected. For example, for goods such as training manuals, the average consumer is likely to consider the print quality, the materials used and turn around time for completion (in cases of large printing orders). Alternatively, the average consumer for software design services is likely to consider the undertaking’s track record (such as previous software designed), the specific expertise offered and the timescale at which the project can be delivered. Overall, I consider that the average consumer will pay, generally, a medium degree of attention, however, for some goods and services, this may be reasonably high (but not the highest).

## **Distinctive character of the opponent's mark**

44. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the Court of Justice of the European Union ("CJEU") stated that:

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

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

45. Registered trade marks possess various 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. The opponent has not submitted that its mark has been enhanced through use, nor has it filed any evidence to that effect. Therefore, I have only the inherent position to consider.

46. The opponent's mark is a word only mark made up of the word 'LOGICOM'. The opponent submits that "[t]he element LOGICOM has no meaning in relation to the goods and services and is, therefore, inherently highly distinctive." I agree that the

average consumer will not consider attribute any meaning to 'LOGICOM'. In my view, the average consumer will see 'LOGICOM' as a made-up word with no obvious meaning. Further, I do not consider that 'LOGICOM' has any allusive or descriptive qualities in respect of the goods for which it is registered. As a result, I consider the opponent's mark to enjoy a high degree of inherent distinctive character.

### Comparison of marks

47. It is clear from *Sabel 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.

48. 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.”

49. 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.

50. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
LOGICOM	Logicom Hub

## Overall Impression

51. The applicant's mark is a word only mark. I consider that the word 'Logicom' is the dominant and most distinctive component of the applicant's mark with 'Hub' playing a lesser role. This finding is made on the basis that 'Hub' has little trade mark significance for the reasons I will come to discuss below when considering the conceptual comparison between the marks. As for the opponent's mark, it is also a word only mark that is made up of the word 'LOGICOM'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

## Visual Comparison

52. Visually, the marks share the word 'LOGICOM'. While this is presented differently in that the opponent's mark is presented in upper case whereas the applicant's is a combination of upper and lower case, I am reminded of the fact that a word mark registered in standard characters may be considered to cover the use of the same word(s) presented in any normal font. This is irrespective of the use of upper and lower case letters, or any customary combination of the two.<sup>5</sup> The marks differ with the presence of the word 'Hub' that is present in the applicant's mark but absent in the opponent's. While the word 'Hub' plays a lesser role in the overall impression of the applicant's mark, it still constitutes a visual difference. Overall, taking into account that the visual similarities sit at the beginning of the marks, being where average consumers tend to focus,<sup>6</sup> I find that these marks are visually similar to a high degree.

## Aural Comparison

53. Aurally, the opponent's mark consists of three syllables that will be pronounced 'LODJ-E-COM'. The applicant's mark consists of four syllables that will be pronounced 'LODJ-E-COM-HUB'. The applicant submits that the 'COM' element is the dominant aural component of the opponent's mark and that 'HUB' is the

---

<sup>5</sup> *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

<sup>6</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

dominant aural element of the applicant's on the basis that it is those elements that will be stressed in the pronunciation of those marks. I disagree with these submissions and see no reasons as to why this would be the case. Instead, I consider that no part of either mark will be emphasised more greatly than the others. The entirety of the opponent's mark makes up three of the four syllables of the applicant's, with the only difference coming in the fourth syllable. On the basis that the average consumer tends to focus on the beginnings of marks, I find that these marks are aurally similar to a high degree.

### Conceptual Similarity

54. The applicant has submitted that the marks are conceptually dissimilar on the basis that the three components of 'LOGI', 'COM' and 'HUB' in the applicant's mark will be seen as follows:

“Logi: related or associated to logistics

Com: related or associated to commerce

Hub: a center of business activity”

55. In respect of the opponent's mark, the applicant submits that it will be seen as “one component which is meaningless or with no evident or apparent meaning.” I see no reason why the average consumer would dissect the applicant's mark to the point where they would derive the submitted meaning from it, but not the opponent's, especially given that the word 'LOGICOM' is identical in both marks.

56. I have found above that 'LOGICOM' in the opponent's mark has no obvious meaning to the average consumer and that it will be seen as a made-up word. I make the same finding in respect of the word 'Logicom' in the applicant's mark. While I note the submissions referred to at paragraph 54 above, I do not consider that the average consumer would see 'Logicom' as consisting of two separate elements (being 'Logi' and 'Com') and, even if they do, I do not consider that they would derive the submitted meanings from them. I have set out above that 'Hub' has little trade mark significance in the applicant's mark and this is on the basis that I accept the meaning of 'Hub', as submitted by the applicant, which is to mean



'a center for business activity'. As a result, I am of the view that it will simply be seen as an identifier that the undertaking using the mark is a center for business activity.

57. Despite the fact that 'LOGICOM' is present in both marks, it has no obvious meaning and is, therefore, conceptually neutral. I do not consider that the addition of 'Hub', which will be seen as an identifier of business activity, will do enough to warrant a finding of conceptual dissimilarity given its lesser role and limited conceptual impact in the applicant's mark. Overall, the marks are conceptually neutral.

### **Likelihood of confusion**

58. 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/or services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

59. I have found some of the applicant's goods and services to be identical or similar to varying degrees with the opponent's goods. I have found the average consumer for the goods and services to be either members of the general public or business users. I have found that the goods and services will be selected through primarily visual means (although I do not discount an aural component). I have concluded

that the average consumer will generally pay a medium degree of attention but that this may reasonably high (but not the highest) for some of the goods and services.

60. I have found the applicant's mark to be visually and aurally similar to a high degree and conceptually neutral with the opponent's mark. I have found the opponent's mark enjoys a high degree of inherent distinctive character. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

61. Taking all of the above factors and the principle of imperfect recollection into account, I am satisfied that the average consumer would likely mistake one mark for the other. This is particularly the case given the high visual and aural similarity between the marks. I make this finding on the basis that the word 'Hub', which sits at the end of the applicant's mark, carries little trademark significance and is likely to be forgotten or overlooked by the average consumer, particularly given the high level of distinctive character enjoyed by the word 'LOGICOM'. Consequently, I consider there to be a likelihood of direct confusion between the marks, even where the average consumer pays a higher degree of attention when selecting the goods and services. I also consider there to be a likelihood of direct confusion in respect of the services that I have found to be similar to a low degree. I am of the view that the high level of visual and aural similarities between the marks is sufficient to offset the lesser degree of similarity between those services, as per the interdependency principle. For the sake of completeness, I will now move to consider indirect confusion.

62. Indirect confusion involves recognition by the average consumer of the differences between the marks. In the present case, even if the differences between the marks are noticed, I have found the word 'LOGICOM' to be the dominant and distinctive element of both marks. As a result, I am of the view that the differences between the marks will be seen by the average consumer as indicative of a sub-brand or alternative marks from the same or economically linked undertakings.<sup>7</sup> I am of the view that 'Hub' may be seen as an additional, non-distinctive element, meaning that it is possible that it will be viewed as an indication of a sub-brand. For example,

---

<sup>7</sup> Paragraphs 16 & 17 of *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

'Hub' could be viewed as a sub-brand of 'LOGICOM' that sits at the center (being the 'hub') of Logicom's business operations. Alternatively, the addition of 'Hub' may be seen as a reference to a brand extension of 'LOGICOM' where the undertaking has expanded to open physical 'hubs' in city centres. Further, it is possible that the average consumer will consider that 'LOGICOM' is simply short for 'LOGICOM HUB' which is, therefore, indicative of alternative marks used by the same undertaking. Consequently, I consider there to be a likelihood of indirect confusion between the marks, even in circumstances where the average consumer pays a higher degree of attention. I have set out at paragraph 61 above that the high visual and aural similarities between the marks is sufficient to offset the low degree of similarity I have found in respect of some services. I make that same finding here and consider that a likelihood of indirect confusion exists in respect of all goods and services where I have found similarity, including the services that I have found to be similar to a low degree.

## **CONCLUSION**

63. The opposition has succeeded in respect of some of the goods and services against which it was aimed. The application is, therefore, refused in respect of the following goods and services:

Class 9: Training software; Training guides in electronic format; Training manuals in the form of a computer program; Training manuals in electronic format; Packaged software; Integrated software packages; Application software for cloud computing services; Computer software packages; all the aforesaid relating to the logistics and transport industry; none of the aforementioned being, or relating to, computer or electronic devices.

Class 16: Training manuals; Manuals [handbooks]; all the aforesaid relating to the logistics and transport industry.

Class 41: Training; Training and further training consultancy; Computer training services; Conducting training seminars; Staff training services; Written training courses; Practical training services;

Provision of training courses; Providing online training seminars; Conducting training seminars for clients; Training services relating to logistics; Provision of training services for industry; Arranging and conducting of training courses; Training courses; Industrial training; Training services relating to computer software; Organisation of Webinars; Provision of online training; all the aforesaid relating to the logistics and transport industry.

Class 42: Software as a service; Software maintenance services; Services for updating computer software; Installation and maintenance services for software; Technical support services relating to computer software and applications; all the aforesaid relating to the logistics and transport industry.

64. The application can proceed to registration for the following services which I have found to be dissimilar with the opponent's goods:

Class 35: Business consultancy, in the field of transport and delivery; Business advisory and consultancy services; Preparing business reports; Market reports and studies; all the aforesaid relating to the logistics and transport industry.

Class 41: Business training; Business training services; commercial training services; Training consultancy; Technical training relating to industrial risk; Consultancy services relating to the analysis of training requirements; Consultancy services relating to the development of training courses; Setting of training standards; Know-how transfer [training]; Production of training videos; all the aforesaid relating to the logistics and transport industry.

Class 42: Custom design of software packages; Software customisation services; Software development services; Software consultancy services; Computer software programming services; all the aforesaid relating to the logistics and transport industry.

## **COSTS**

65. As the opponent has enjoyed a greater degree of success, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. However, as the opposition failed against some of the services against which it was aimed, I consider it appropriate to reduce the award of costs relative to the degree of success. In the circumstances, I award the opponent the sum of **£425** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering the applicant's counter statement:	£125
Preparing submissions in lieu of a hearing:	£200
Official Fees:	£100
<b>Total</b>	<b>£425</b>

66. I therefore order Logicom Hub Ltd to pay LOGICOM the sum of £425. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 13<sup>th</sup> day of July 2021**

**A COOPER**  
**For the Registrar**