

O/0277/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 01633243 BY
SHENZHEN FUTU NETWORK
TECHNOLOGY CO., LTD.
TO REGISTER AS A TRADE MARK:**

FUTU FAMILY

IN CLASSES 9, 28, 35, 36 & 42

AND

**OPPOSITION THERETO
UNDER NO. 0432639 BY
FUTURICE OY**

Background & Pleadings

1. Shenzhen Futu Network Technology Co., Ltd. (“**the applicant**”) is the holder of the International Registration (“IR”) WO0000001633243 (“the designation”) in respect of the mark shown on the front page of this decision. Protection in the UK was requested on 23 November 2021 with a priority date of 28 July 2021 and 24 August 2021 based on its Chinese trade mark Nos 58034184, 58034192, 58051370, 58716029, and 58738061. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 14 January 2022 in respect of the following goods and services:

Class 9: Computer software platforms, recorded or downloadable; computer screen saver software, recorded or downloadable; biometric identity cards; security surveillance robots; computer software, recorded; monitors; computer programs, downloadable; computer software applications, downloadable; security tokens; wearable computers; cases for smartphones; network communication devices; headsets; cameras; protective goggles; spectacles; batteries, electric; refrigerator magnets.

Class 28: Toys; balls for games; table-top games; archery implements; wrist guards for athletic use; stuffed toy animals; machines for physical exercises; body-building apparatus; swimming pools; ornaments for Christmas trees, except lights, candles and confectionery.

Class 35: Advertising; systemization of information into computer databases; provision of an online marketplace for buyers and sellers of goods and services; sponsorship search; sales promotion for others; retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; business auditing; commercial administration of the licensing of the goods and services of others; organization of exhibitions for commercial or advertising purposes; web indexing for commercial or advertising purposes; employment agency services; providing business information via a website; rental of sales stands.

Class 36: Insurance underwriting; art appraisal; surety services; lending against security; foreign exchange trading; real estate management; financial customs brokerage services; charitable fund raising; online real-time currency trading; securities brokerage.

Class 42: Cloud computing; technological research; monitoring of computer systems for detecting unauthorized access or data breach; electronic monitoring of personally identifying information to detect identity theft via the internet; user authentication services using technology for e-commerce transactions; user authentication services using single sign-on technology for online software applications; electronic data storage; data encryption services; software development in the framework of software publishing; development of computer platforms; design and development of multimedia products; surveying; chemistry services; medical research; meteorological information; vehicle roadworthiness testing; toy design; interior design; dress designing; numismatic authenticating services; graphic design.

2. Futurice Oy ("**the opponent**") opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("**the Act**"). The opponent is the proprietor of the following marks:

Trade Mark no.	UK00003429209 ('209)
Trade Mark (Series of 3)	FUTURICE/futurice/Futurice
Goods & Services Relied Upon	Classes 9, 35, 41 & 42
Relevant Dates	Filing date: 17 September 2019
	Date of entry in register: 06 December 2019

Trade Mark no.	UK00917097478 ('478)
Trade Mark	FUTURICE
Goods & Services Relied Upon	Classes 9, 35, 41 & 42
Relevant Dates	Filing date: 15 August 2017
	Date of entry in register: 01 December 2017

Trade Mark no.	UK00917901316 ('316)
Trade Mark	FUTUCARE
Goods & Services Relied Upon	Classes 9 & 42
Relevant Dates	Filing date: 16 May 2018
	Date of entry in register: 05 September 2018

3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent's earlier marks '478 and '316 were automatically converted into comparable UK trade marks. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

4. In its notice of opposition, the opponent states that all the goods and services covered by its earlier marks are relied upon.

5. Under Section 6(1) of the Act, the opponent's trade marks clearly qualify as earlier trade marks. Further, as the registration of the opponent's earlier marks was completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings, as per Section 6A of the Act.
6. The applicant filed a detailed defence and counterstatement, which I do not propose to reproduce here in full. In summary, the applicant concedes that there is a low level of visual similarity, and aurally similar no higher than low. As to the conceptual similarity the applicant claims that:

“If one were to assume that the conceptual comparison would be made on the basis of the (discernible) second elements, the concepts would have to be considered dissimilar. If one were to assume that no concept would be attributed (at least not to the prior rights), then a conceptual comparison would not be possible in the present case.”

I will return to these points later in this decision. Further, the applicant asserts that a part of the competing terms in relation to the Class 9 goods and Class 35 and 42 services are dissimilar as well as Class 28 goods and Class 36 services are dissimilar in their entirety. As for the rest of the terms, the applicant admits that they are similar. I will return to these contentions later in this decision.

7. Only the opponent filed written submissions, which will not be summarised but will be referred to as and where appropriate during this decision. The holder provided three Annexes with weblink printouts but no further submissions. No hearing was requested and so this decision is taken following a careful perusal of the papers.
8. In these proceedings, the opponent is represented by Kilburn & Strode LLP and the applicant by RMW&C Mietzel Wohlneck & Calheiros Partnerschaft mbB.

9. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Decision

Section 5(2)(b)

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

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

[...]

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

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

11. The principles considered in this opposition stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation 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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 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 Goods and Services

12. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned, [...], 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 complementary.”

13. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in

particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

14. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, 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:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. 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.”

16. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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.”

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way

that customers may think that the responsibility for those goods lies with the same undertaking.”

18. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he 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.”

19. Geoffrey Hobbs KC, sitting as an Appointed Person in the case of *Raleigh International Trade Mark* [2001] RPC 11:

“20. If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their "similarity" (whether or not the objection is directed to the use of an identical mark): Canon paragraph 22”

20. The earlier specifications contain identical terms in the respective Classes in these opposition proceedings. Therefore, the competing goods and services to be compared are shown in the following table:

Opponent’s Goods & Services	Applicant’s Goods & Services
<p>All Earlier Marks Class 9: Data processing apparatus; Computers and computer hardware; Software; Computer software development tools; Data storage devices; Cloud servers.</p>	<p>Class 9: Computer software platforms, recorded or downloadable; computer screen saver software, recorded or downloadable; biometric identity cards; security surveillance robots; computer software, recorded; monitors; computer programs, downloadable; computer software applications, downloadable; security tokens; wearable computers; cases for smartphones; network</p>

	communication devices; headsets; cameras; protective goggles; spectacles; batteries, electric; refrigerator magnets.
	Class 28: Toys; balls for games; table-top games; archery implements; wrist guards for athletic use; stuffed toy animals; machines for physical exercises; body-building apparatus; swimming pools; ornaments for Christmas trees, except lights, candles and confectionery.
Earlier Marks '209 & '316 Class 35: Advertising; Business management; Business administration; Clerical services; Business intelligence services; Data management services; Business data analysis services; Business management consultancy; Business management consulting services in the field of information technology.	Class 35: Advertising; systemization of information into computer databases; provision of an online marketplace for buyers and sellers of goods and services; sponsorship search; sales promotion for others; retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; business auditing; commercial administration of the licensing of the goods and services of others; organization of exhibitions for commercial or advertising purposes; web indexing for commercial or advertising purposes; employment agency services; providing business information via a website; rental of sales stands.
	Class 36: Insurance underwriting; art appraisal; surety services; lending against security; foreign exchange trading; real estate management; financial customs brokerage services; charitable fund raising; online real-time currency trading; securities brokerage.
Earlier Marks '209 & '316 Class 41: Teaching; Organisation	

<p>of training; Entertainment services; Sporting and cultural activities; On-line publication of electronic books and journals; Coaching.</p>	
<p>All Earlier Marks Class 42: Analytical services relating to computers; Software design and development; Software development; Cloud computing; Consulting in the field of cloud computing networks and applications; Development and testing of computing methods, algorithms and software; Database design and development; Research and development of computer software; Software engineering; Computer software consultancy; Consultancy and information services relating to software maintenance; Providing technical advice relating to computer hardware and software; Software as a service [SaaS]; Advisory and consultancy services relating to computer hardware; Advisory services relating to computer based information systems; Advisory services relating to computer systems analysis; Computer and information technology consultancy services; Consultancy services for designing information systems; Technical consultancy relating to the installation and maintenance of computer software; Technical consultancy relating to the application and use of computer software; Technical consultancy services relating to information technology; Computer programming; Design and development of computer software architecture; Research relating to the development of computer programs and software.</p>	<p>Class 42: Cloud computing; technological research; monitoring of computer systems for detecting unauthorized access or data breach; electronic monitoring of personally identifying information to detect identity theft via the internet; user authentication services using technology for e-commerce transactions; user authentication services using single sign-on technology for online software applications; electronic data storage; data encryption services; software development in the framework of software publishing; development of computer platforms; design and development of multimedia products; surveying; chemistry services; medical research; meteorological information; vehicle roadworthiness testing; toy design; interior design; dress designing; numismatic authenticating services; graphic design.</p>

21. Both parties made lengthy submissions which I have considered but do not propose to reproduce here and will refer to them whenever I consider necessary.

22. I note that the applicant admits similarity for the following terms:

Class 9: Computer software platforms, recorded or downloadable; computer screen saver software, recorded or downloadable; security surveillance robots, computer software, recorded; monitors; computer programs, downloadable; computer software applications, downloadable; security tokens; wearable computers; network communication devices; batteries, electric.

Class 35: advertising; systemization of information into computer databases; provision of an online marketplace for buyers and sellers of goods and services; sales promotion for others; business auditing; organization of exhibitions for commercial or advertising purposes; web indexing for commercial or advertising purposes; providing business information via a website.

Class 42: cloud computing; technological research; software development in the framework of software publishing; development of computer platforms; design and development of multimedia products.

Given the applicant's admission, it is indisputable that the above terms are similar to the opponent's, and, strictly speaking, there is nothing for me to decide.¹ However, even for those goods where similarity has not been denied, I will need to assess the degree of similarity between the competing goods and services. As for the rest of the goods and services, the applicant denies any similarity.

23. I have considered all the cases and dictionary definitions that the applicant has referred to in its comparison of the respective goods and services, and

¹ See CX02 BL O/393/19.

I note that I am not bound by the EUIPO decisions for the assessment of the competing specifications at issue.

24. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.²

Class 28

25. The opponent submits that:

“12. The goods in class 28, being toys, games, and consumer products, are commonly offered via targeted advertising services and sponsorship. Toys, games, playthings and sports equipment are commonly sponsored by unrelated entities, and feature as targeted advertising. These are therefore similar to a low degree to the provision of advertising services.”

26. The applicant denies any similarity between the earlier specification and the contested Class 28 goods.
27. The contested goods in Class 28 are various items, including playthings and sports equipment. I remind myself that services should be narrowly interpreted. In this regard, the earlier advertising services in Class 35 are intended to assist others in selling their goods and services by promoting their launch and/or sale or reinforcing a client’s position in the market and acquiring a competitive advantage through publicity. I do not consider that there is any obvious similarity between the competing goods and services. They differ in nature (goods v services) and purpose, users (end-users v business), method of use, and trade channels. Even though some Class 28 goods may appear in advertisements, this is insufficient to create a complementary relationship as laid down in the case law. Further, there is

² *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

no competition between the given goods and services. To conclude, I find the competing goods in Class 28 and advertisement services in Class 35 dissimilar.

Class 9

Computer software platforms, recorded or downloadable; computer screen saver software, recorded or downloadable; security surveillance robots, computer software, recorded; monitors; computer programs, downloadable; computer software applications, downloadable

28. I find that the contested goods will be encompassed by the broad terms “*Computers and computer hardware; Software*” in the opponent’s specifications and therefore find them to be identical under the *Meric* principles.

Security tokens

29. The contested goods are either digital (investment) assets with encryption capabilities used in a blockchain or physical devices, for example, in the form of a USB stick, that are used as electronic keys, to gain access to an electronically restricted resource, such as computers. In this regard, I consider that the opponent’s “*Data storage devices*” and “*Data processing apparatus*” are broad terms that could readily cover the contested goods. Thus, I find the competing goods to be identical based on *Meric*.

Wearable computers

30. The contested goods are devices with smart functions worn by individuals, such as smartwatches or fitness trackers, which feature applications and provide access to the Internet. Such goods are covered by the opponent’s broad term “*computers and computer software*” rendering the respective goods to be *Meric* identical.

Network communication devices

31. The contested terms are devices, such as routers and hubs, that allow computer systems to communicate with each other within a network. I consider that there is similarity between the contested and the opponent's "*computers and computer hardware*" goods. There is a degree of complementarity, as computer users would typically be using the contested goods to connect to and access a network. In this respect, there is an overlap in users, and trade channels, sold in the same shops, potentially in close proximity to each other. Although they may share the same purpose, they will differ in nature and method of use. I find that the goods will be similar to a medium degree.

Batteries, electric

32. The contested goods may include batteries for laptops/computers which are *Merix* identical to the opponent's broad term "*computers and computer hardware*" goods.
33. If I am wrong, I find that there is a high degree of similarity. As portable computers operate by relying on their batteries, there is a degree of complementarity between the competing goods in the sense that "one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."³ Such goods may be sold in the same stores. They also share the same users and method of use as one is integral part of the other.

Headsets

34. The competing goods are devices consisting of a microphone and headphones, typically used with other devices, such as computers,

³ See *Boston Scientific*, Case T-325/06.

enabling the user to listen and speak while communicating. Although I have considered the applicant's contentions and the case law, I note that this is in relation to the term "*headphones*" and not "*headsets*", the contested term before me. There is a difference between these two terms, as the headphones are used primarily to listen to audio, whereas the headsets to communicate with others via a device, such as a computer. On that basis, it is my view that there is a degree of complementarity with the opponent's "*Computers and computer hardware*", where the average consumer would assume that the responsibility for these types of goods lies with the same undertaking. This is because computer users will use headsets together with their computers to communicate with others. Although the competing goods may differ in nature and purpose, they may share the same users. The respective goods are typically sold in the same retail and specialist stores, potentially in close proximity to each other. Thus, they will overlap in trade channels. There is no apparent competition between the competing goods. I find them to be similar to a medium degree.

Cameras

35. The opponent's earlier specification contains "*computers and computer hardware*", which is the closest comparable term. It is common for computers, such as laptops, to be equipped with webcams, and, thus, the competing goods will overlap in nature. I note that the earlier goods are intended for facilitating online video chatting, whilst the contested goods for taking still shots and videos on the move. Therefore, the method of use is different. Although there might be a general overlap in users, they differ in provider. That said, the trade channels may overlap as the competing goods could be sold in the same technology shops. I do not consider that there is a degree of competition or complementarity. I find that there is a low similarity between the respective goods.

Biometric identity cards

36. The contested goods are a form of identification that enables the recognition and authentication of an individual based on the analysis of their physical (or behavioural) traits. There is no obvious similarity with the opponent's goods in Class 9. They differ in nature, purpose, method of use, users, and trade channels. I find the respective goods to be dissimilar.

Cases for smartphones; protective goggles; spectacles; refrigerator magnets

37. I can see no meaningful similarity in terms of the nature, intended purpose, or method of use nor are the contested goods at issue in competition with or complementary to the opponent's goods. Thus, I find the respective goods to be dissimilar.

Class 35

Advertising

38. The contested term is self-evidently identical to the opponent's as it is identically worded.

Systemization of information into computer databases

39. The contested services are intended for processing, classifying, and organising information and data in order to generate computer databases. I consider that the opponent's terms "*Data management services; Business data analysis services*" are adequately broad to cover the contested services. Thus, I find the competing services to be identical as per *Meric*.

Sales promotion for others

40. The opponent's term "*advertising*" is a broad term that covers the contested services. Thus, I find the competing services to be identical as per *Meric*.

Web indexing for commercial or advertising purposes; providing business information via a website

41. These services strike me as aspects of advertising services at large, as advice on layout or indexing forms part of the advertising service. On that basis, the services are, as subsets of advertising services, also provided under the earlier mark's "*advertising*". They are identical under *Meric*.

Organization of exhibitions for commercial or advertising purposes

42. The contested services are similar to the opponent's "*advertising*" services. They share the same purpose, users, and trade channels. There might be a degree of competition between the services as the users may choose one over the other. I find that the respective services are similar to between a medium to high degree.

Employment agency services

43. The contested terms are all services that relate to the recruitment of personnel. Although I noted the applicant's comparison between the contested services and business administration services in the earlier specifications, I consider that the closest comparable term from the earlier specification is "*advertising*" services under the same Class. There is a degree of complementarity between the competing services, as it is common for recruitment-type services to include advertising to attract and locate suitable candidates for vacant roles/positions. There is an element of competition as the business users may choose between recruitment and advertising services to fill a vacant post. I do not exclude the possibility that

such services may be offered as a package for businesses that seek to recruit personnel. Further, there is an overlap between the competing services, which may share the same purpose, and business users. I find them to be similar to a high degree.

Provision of an online marketplace for buyers and sellers of goods and services

44. The contested services are intended for providing online marketplace services (e-commerce) via a website where users display and offer their goods/services for sale. The closest comparable term in the opponent's specification is "*Business management*" in Class 35. The earlier services are intended to help companies manage their business and, therefore, will be involved in activities associated with running a business, including the sales of the goods. It is my view that there is a degree of complementarity between the competing services as the consumer may perceive that the respective services are offered by the same undertaking. Further, they may share the same distribution channels and users. However, I do not consider that there is competition between the competing services. I find that they are similar to a medium degree.

Business auditing

45. I consider that the contested term is similar to the opponent's "*business administration*" as they overlap in purpose, i.e. examination/inspection of financial records to evaluate the financial health and correctness of financial statements. In addition, they may share the same users and trade channels. I also consider that there is a degree of complementarity. I find that there is a medium degree of similarity.

Rental of sales stands

46. There is a similarity between the contested services and the opponent's "*advertising*" services as both can be used in advertising campaigns and

promotion of products/services. In this regard, there might be an overlap in the general purpose. Also, the competing services share the same users, which will primarily be businesses. I do not consider that they overlap in trade channels. I find that there is a medium degree of similarity.

Sponsorship search; retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; commercial administration of the licensing of the goods and services of others

47. The opponent made general claims that its services in Class 35 are identical/highly similar to all the contested services under the same Class. However, in the absence of particularised submissions or evidence, there is no obvious similarity between the earlier advertising and business management services with the above contested services. Even though the competing services share the same users, i.e. businesses, this is not a sufficient factor by itself to find similarity. They do not share the same purpose or trade channels will be different for the respective services, and they are not complementary or in competition. Thus, I consider them to be dissimilar.

Class 36

Insurance underwriting; art appraisal; surety services; lending against security; foreign exchange trading; real estate management; financial customs brokerage services; charitable fund raising; online real-time currency trading; securities brokerage

48. The contested services contain financial services (“*surety services; lending against security; foreign exchange trading; financial customs brokerage services; charitable fund raising; online real-time currency trading; securities brokerage*”), insurance services (“*Insurance underwriting*”), real estate management services, and asset valuation services (“*art appraisal*”). Most of these services could be considered as niche services requiring expert knowledge.

49. Although the opponent did not make any specific submissions regarding any points of similarity between the contested terms and the earlier goods and services in its specifications, in its submissions, it listed the following terms against the contested services in Class 36:

Class 9: Data processing apparatus; Computers and computer hardware; Software

Class 42: Analytical services relating to computers; Software design and development; Software development; Cloud computing; Consulting in the field of cloud computing networks and applications.

50. Following the opponent's approach, I consider that the earlier goods in Class 9 and 42 are dissimilar to the contested services in Class 36. Although such goods and services may be used together, in the absence of evidence, the use of technical means or IT services does not generate any sufficient degree of complementarity between the competing goods and services to suggest that consumers would think that the services derive from the same undertaking. The nature and purpose of the competing goods and services is different. Further, the users, method of use, and trade channels will not overlap. I find that there is no similarity between the respective goods and services.

Class 42

Cloud computing

51. This term is identically worded as in the opponents specifications. Thus, the competing terms are identical.

Software development in the framework of software publishing; development of computer platforms; design and development of multimedia products

52. Although the applicant admitted similarity for the above terms, I find that they are identical under *Meric*, as the opponent's specifications contain broad terms such as “*Software design and development; Database design and development; Research and development of computer software*”.

Technological research

53. The contested term is a broad term that will readily cover the opponent's “*Research relating to the development of computer programs and software*”. Therefore, they are identical according to *Meric*.

Monitoring of computer systems for detecting unauthorized access or data breach; electronic monitoring of personally identifying information to detect identity theft via the internet

54. The contested services are computer/electronic monitoring services detecting unauthorised access, data breach and identity theft. The closest comparable term from the opponent's specification is “*data management services*” under Class 35. Following the guidance in *Avnet*, I consider that the earlier services should not be given “a wide construction covering a vast range of activities” even if they share the same users, namely businesses. Thus, although the earlier services concern the management of all sorts of computer data, the contested services, namely computer/electronic monitoring services, are niche services rendering them dissimilar.

Surveying; chemistry services; medical research; meteorological information; vehicle roadworthiness testing; toy design; interior design; dress designing; numismatic authenticating services; User authentication services using technology for e-commerce transactions; user authentication services using single sign-on technology for online software applications

55. I can see no obvious aspect of similarity between the above contested services and the opponent's specification. The nature, purpose, and method of use are different. There is no competition or complementarity between the respective goods. Thus, I find them to be dissimilar.
56. The likelihood of confusion does not arise in relation to the application's goods and services which are dissimilar to the earlier specifications.⁴ **The opposition cannot succeed against dissimilar goods and services and, therefore, is dismissed insofar as it concerns the following terms:**

Class 28: Toys; balls for games; table-top games; archery implements; wrist guards for athletic use; stuffed toy animals; machines for physical exercises; body-building apparatus; swimming pools; ornaments for Christmas trees, except lights, candles and confectionery.

Class 9: Biometric identity cards; cases for smartphones; cameras; protective goggles; spectacles; refrigerator magnets.

Class 35: Sponsorship search; retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; commercial administration of the licensing of the goods and services of others.

⁴ Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

Class 36: Insurance underwriting; art appraisal; surety services; lending against security; foreign exchange trading; real estate management; financial customs brokerage services; charitable fund raising; online real-time currency trading; securities brokerage.

Class 42: Surveying; chemistry services; medical research; meteorological information; vehicle roadworthiness testing; toy design; interior design; dress designing; numismatic authenticating services; Monitoring of computer systems for detecting unauthorized access or data breach; electronic monitoring of personally identifying information to detect identity theft via the internet; User authentication services using technology for e-commerce transactions; user authentication services using single sign-on technology for online software applications.

Average Consumer and the Purchasing Act

57. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

58. The Class 9 goods will be purchased by members of the general public without excluding professionals/businesses altogether. Such goods are usually offered for sale in stores, for instance, high street retail stores, brochures, catalogues, and online. The goods will be displayed on shelves and racks in retail premises, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods relying on the images displayed on the relevant web pages. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment, as advice may be sought from a sales assistant or representative. The cost of the goods may vary, but in any case, and irrespective of the cost, the average consumer may examine the products to ensure software/hardware compatibility with other components or systems or that the goods possess the required features. In this regard, the degree of attention will range from relatively medium to high, with professionals and businesses potentially paying slightly a higher degree of attention.
59. For the services at issue, the average consumer will primarily be business users/professionals or a member of the general public. The consumer will select such services by looking through brochures and websites or signs on a physical property, so the visual element will be important. However, I do not discount the aural element, as word-of-mouth recommendations may also influence consumers' decisions. The cost of the services will be relatively significant, contributing to the selection process of the service provider. Given the more specialist nature of the services in play, especially those selected by business users, I consider that the average consumer will pay a slightly higher than average degree of attention in choosing the service provider.

Comparison of Trade Marks

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

61. 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.

62. The marks to be compared are:

Opponent's Marks	Applicant's Mark
<u>Earlier Mark '209</u> FUTURICE/futurice/Futurice	FUTU FAMILY
<u>Earlier Mark '478</u> FUTURICE	
<u>Earlier Mark '316</u> FUTUCARE	

Overall Impression

63. The earlier marks '209, '478, and '316 consist of the single word "FUTURICE/futurice/Futurice", "FUTURICE" and "FUTUCARE", respectively, presented in a standard typeface. Registration of a word mark protects the word itself.⁵ The overall impression of the earlier marks lies in the conjoined words, with neither word component dominating the other.
64. The contested mark contains the word elements "FUTU FAMILY", presented in a bold standard typeface and upper case. I note that there is a stylised letter replacing the letter 'A' in the second word. I consider that both word elements will make a roughly equal contribution to the overall impression. This is because the word element "FAMILY" has no allusive or descriptive meaning and might be seen as acting as a qualifier of the "FUTU" element of the mark.

⁵ See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

Visual Comparison

Earlier Marks '209 & '478 and Contested Mark

65. The earlier marks are eight letters long (FUTURICE) and the contested ten (FUTU FAMILY). The competing marks coincide in the first four letters FUTURICE/FUTU FAMILY. However, they differ in the rest of the letters and the presence/absence of the stylised letter 'A'. Bearing in mind that the beginnings of words tend to have more impact than the ends,⁶ and considering the overall impression of the marks, I find them to be visually similar to a medium degree.

Earlier Mark '316 and Contested Mark

66. In this instance again, the competing marks overlap in the first four letters, FUTUCARE/FUTU FAMILY, differing in the remaining letters and the presence/absence of the stylised letter 'A'. Considering the overall impression of the marks, I find them to be visually similar to a medium degree.

Aural Comparison

Earlier Marks '209 & '478 and Contested Mark

67. The earlier marks are three syllables long and will be pronounced as "FOO-TOO-RYS", whereas the contested mark is five syllables long "FOO-TOO FAM-UHL-EE". I note that the marks only coincide in the articulation of the first two syllables ("FOO-TOO"). I also note that the average consumer will naturally replace the stylised letter in the contested mark with the letter 'A'. Taking into account the above factors and the overall impressions, I consider that the marks are aurally similar to a medium degree.

⁶ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court observed that the attention of the consumer is usually directed to the beginning of a mark.

68. For completeness, I will now assess an alternative pronunciation for the earlier marks based on the first five letters, which might be spelt as the word 'future'. In the case where the earlier marks are verbalised as "FEW-CHUR-YS", the competing marks will overlap only in the sound generated from the 'F' sound at the beginning of the marks. In this instance, I consider that there is only a low degree of similarity.

Earlier Mark '316 and Contested Mark

69. In this instance, the competing marks will only share the same first two syllables "FOO-TOO-CEUH/ FOO-TOO FAM-UHL-EE". However, they will differ in the rest of the syllables. I consider that the marks are aurally similar to a medium degree.

Conceptual Comparison

70. The average consumer may extract the meaning of 'future' or 'ice' from the conjoined words "FUTURICE" in the earlier marks '209 and '478. However, I do not consider that they will attribute any meaning to the entirety of the marks and, thus, will perceive them as an invented term. Similarly, the average consumer will treat the earlier mark '316, "FUTUCARE", as an invented term as a whole, albeit the concept emanating from the word component "CARE" will be recognised. However, I note that the concept of 'future' will not be discerned in this case due to the absence of the letter 'R' as in the other two earlier marks. Further, the contested mark will be viewed as the combination of an invented term "FUTU" and the well-known word "FAMILY", which will be immediately understood. As a result, I find that the marks are conceptually dissimilar as the earlier marks are invented terms, whereas the contested mark contains one recognisable element.

Distinctive Character of the Earlier Trade Mark

71. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

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

73. The opponent has not shown use of its mark and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent

distinctiveness of the earlier mark to consider. The earlier marks '209, '478, and '316 are single-worded marks ("FUTURICE" and "FUTUCARE", respectively), which will be viewed as invented terms in their entirety. However, I note that the average consumer may recognise the terms "-ICE" in the earlier marks '209 and '478 and "-CARE" in the earlier mark '316. I do not consider that the word component "-ICE" has an allusive significance as opposed to the word component "-CARE" in the earlier mark '316, where it could be considered as being allusive to the care provided alongside the goods and services. Although the conjoining of those words is not highly fanciful, I find the earlier marks '209 and '478 are inherently distinctive to at least a medium degree (but not the highest), whereas the earlier '316 is inherently distinctive to a medium degree.

Likelihood of Confusion

74. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.⁷ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater may be the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁸
75. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that

⁷ See *Canon Kabushiki Kaisha*, paragraph 17.

⁸ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

the later mark is another brand of the owner of the earlier mark or a related undertaking.

76. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

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

I note that the categories identified above are not exhaustive.⁹

77. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.
78. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against

⁹ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

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

79. Earlier in this decision I have concluded that:

- the goods and services at issue range from identical to dissimilar;
- the average consumer of the Class 9 goods will be a member of the general public without excluding professionals/businesses. The selection process is predominantly visual without discounting aural considerations. Depending on the cost of the item, the degree of attention will range from relatively medium to high, with professionals and businesses potentially paying slightly a higher degree of attention. In relation to the services in question, the average consumer will primarily be business users/professionals or a member of the general public who will select the provider based on visual means without discounting the aural considerations. The cost of the services will be relatively significant, contributing to the selection process of the service provider. Therefore, the average consumer will pay a slightly higher than average degree of attention in choosing the service provider;
- the earlier marks ‘209 and ‘478 and the contested mark: are visually and aurally similar to a medium degree (or aurally to a low degree

when the alternative pronunciation is taken into account), and conceptually dissimilar;

- the earlier mark '316 and the contested mark: are visually and aurally similar to a medium degree, and conceptually dissimilar;
- the earlier marks '209 and '478 are inherently distinctive to at least a medium degree (but not the highest), whereas the earlier '316 is inherently distinctive to a medium degree.

80. Taking into account the above factors and considering the identical goods and services in play, there is no likelihood of direct confusion. Notwithstanding the doctrine of imperfect recollection, the differences are sufficient to enable the average consumer to distinguish the respective marks. Even though the competing marks share the first four letters, "FUTU", the consumer will recognise and remember the differences arising from the rest of the dictionary and well-known word components present in the competing marks, i.e. "-ICE", "-CARE", and "FAMILY". Thus, the various visual, aural, and conceptual differences between the competing marks previously identified are, in my view, sufficient, and, as a result, the marks will not be directly confused.

81. Even if the average consumer recalls the points of similarity between the marks, such as that both contain the common word component "FUTU", I still consider the marks would not be indirectly confused. Sitting as the Appointed Person in *Eden Chocolat*,¹⁰ James Mellor QC (as he then was) stated:

"81.4 [...] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining¹¹ in more formal terms the sort of mental process involved at the end of his [16], he

¹⁰ Case BL O/547/17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017).

¹¹ In *L.A. Sugar*.

made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (Emphasis added)

In light of the guidance above, the conjoined words in the earlier marks form a cohesive whole. The overall impression lies within the conjunction of the word components of the marks. Thus, the average consumer will not consider the competing marks as variants or sub-brands of each other nor that the goods in question are from the same or economically linked undertakings merely on the use of the word component “FUTU”, which is not highly distinctive. Further, I note that the conceptual dissimilarity here will lead the average consumer away from linking the marks. Thus, I find that the guidance given in *Duebros* applies to this case, namely that an average consumer may merely associate the common word element in the marks but would not confuse them. To conclude, I consider that there is no “proper basis” to find likelihood of indirect confusion.

82. The above finding extends to the goods and services for which I found any degree of similarity.

Outcome

83. There is no likelihood of confusion. **The opposition on the basis of the claim under Section 5(2)(b) fails.** Therefore, subject to appeal, the application can proceed to registration.

Costs

84. This opposition has failed in its entirety and the applicant is entitled to a contribution towards its costs of defending its application. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs as follows:

Considering the other side's statement and preparing a counterstatement	£500
Total	£500

85. I, therefore, order, Futurice Oy to pay Shenzhen Futu Network Technology Co., Ltd. the sum of £500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 15th day of March 2023

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General