

O-046-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2635942
BY
FASTWAY LIMITED**

TO REGISTER THE TRADE MARK

PARCEL CONNECT

IN CLASSES 16 AND 39

AND

**THE OPPOSITION THERETO
UNDER NO 104397
BY
GRATTAN PLC**

BACKGROUND

1. On 25 September 2012, Fastway Limited (the applicant) applied to register the above trade mark in classes 16 and 39 of the Nice Classification system¹, as follows:

Class 16

Paper, cardboard and goods made from these materials (included in this class); printed matter; bookbinding material, photographs; stationery; adhesives for stationery or household purposes; artists' materials, paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (included in this class); type; printing blocks; labels, envelopes, boxes and bags in this class.

Class 39

Courier services; freight services; transportation of goods including documents, parcels, packages and letters; postal services including collection, transportation, distribution and delivery of goods including documents, parcels, packages and letters; storage services; mail forwarding services; wrapping and packaging services; transportation information; freight brokerage; unloading cargo; storage information; logistic services in the field of transport; collecting, transport and delivering of goods, in particular documents, parcels, packets and letters; follow-up services, involving the electronic tracking of goods, in particular documents, parcels, packages and letters (track and tracing); organisation and handling of returned consignments (returns management); dispatch handling and execution; providing information and data on databases in the field of packaging, parcelling and transportation of documents, parcels, packages and letters; processing and franking of mail.

2. Following publication of the application, on 26 October 2012, Grattan Plc (the opponent) filed notice of opposition against the application.

3. The grounds of opposition were brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon the mark and goods and services shown below:

Mark details and relevant dates	Goods and services relied upon
TM 2510260 Mark: PARCELNET Filed: 4 March 2009 Registered: 31 July 2009	Class 16 Printed matter; printed publications; books; booklets; magazines; catalogues; newsletters; pamphlets; cardboard; paper; articles made of cardboard; articles made of paper; labels; manuals; stationery; advertising materials; packaging materials; padded bags; transport containers of paper or cardboard. Class 35 Administrative processing of customer returns; computerised data management; arranging and concluding commercial transactions via the Internet in relation to transportation services; distribution of samples; direct mail advertising; compiling, updating and administering of data in computer databases; addressing of goods; creating, administering, updating, coordinating and the management of an address database; order handling services; Class 38 Communication, message and data services;

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

	<p>Class 39 Packaging, storage and transport of goods and materials; transport services; distribution services; logistic services; collection of goods; collection, storage and delivery of packets, packages, parcels, freight and other goods, all by road, rail, air or water; unloading of cargo; courier services; tracking and tracing services for letters and parcels; guarded transport of valuables; freight forwarding; warehousing; organisation and handling of returned consignments (returns management); dispatch handling and execution; collecting, stapling, enveloping and franking of goods, processing and franking of packets, packages, parcels, freight and other goods; information and advisory services relating to the aforesaid services.</p>
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4. In its statement of grounds the opponent states:

“5. The Application is for a word mark, PARCEL CONNECT. The Parcelnet Registration is also for a word mark, PARCELNET (the “Parcelnet Mark”). The Parcel Connect Mark therefore reproduces the PARCEL part of the Parcelnet Mark identically and also contains the letters NET within CONNECT.

5. The opponent concludes that the respective parties’ marks “sound very similar”, are visually very similar and are “conceptually identical or, at the very least, conceptually very similar”. With regard to the goods and services comparison the opponent says:

“15...the majority of the goods covered in class 16 by both the Parcelnet Registration and the Application are identical and any goods which are not identical are very similar.

...

22...the services covered in class 39 by the Application and those covered in classes 35, 38 and 39 in the Parcelnet Registration and detailed above are, in general, identical. If all of the services are not found to be identical, which the Opponent disputes, they are certainly all extremely similar.”

6. On 5 April 2013, the applicant filed a counter statement in which it accepted that some of the parties’ goods and services are identical or similar to those in the specification of the earlier mark. Neither of the parties filed evidence, both filed written submissions.

7. A hearing took place on 18 December 2012, by telephone. The applicant was represented by Mr Martin Krause of Haseltine Lake LLP and the opponent was represented by Mr Tom Alkin of Counsel.

DECISION

8. The opposition is brought under section 5(2)(b) of the Act which reads as follows:

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

(a)...

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

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

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

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

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

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

10. The opponent's mark is an earlier mark, which is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.²

Section 5(2)(b) case law

11. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

12. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and services and the frequency of the purchase.

13. It was agreed at the hearing that the average consumer of the goods and services at issue will be a member of the general public or a business. The nature of the purchase is likely to vary according to the particular product or service. The goods may be selected from a website, catalogue or from a shelf and will be primarily visual purchases. The

services may also be selected from a website or catalogue but may also be commissioned using the telephone. Accordingly, they may be visual or aural purchases or, in some cases, a combination of both.

14. The specifications cover a range of goods and services which vary in price and frequency of purchase. Consequently, the level of attention is likely to vary: commissioning a freight service is likely to be a fairly expensive, less frequent purchase likely to demand a higher level of attention to be paid than, for example, buying an envelope.

Comparison of goods and services

15. The goods and services to be compared are as follows:

The opponent's goods and services	The applicant's goods and services
<p>Class 16 Printed matter; printed publications; books; booklets; magazines; catalogues; newsletters; pamphlets; cardboard; paper; articles made of cardboard; articles made of paper; labels; manuals; stationery; advertising materials; packaging materials; padded bags; transport containers of paper or cardboard.</p> <p>Class 35 Administrative processing of customer returns; computerised data management; arranging and concluding commercial transactions via the Internet in relation to transportation services; distribution of samples; direct mail advertising; compiling, updating and administering of data in computer databases; addressing of goods; creating, administering, updating, coordinating and the management of an address database; order handling services;</p> <p>Class 38 Communication, message and data services;</p> <p>Class 39 Packaging, storage and transport of goods and materials; transport services; distribution services; logistic services; collection of goods; collection, storage and delivery of packets, packages, parcels, freight and other goods, all by road, rail, air or water; unloading of cargo; courier services; tracking and tracing services for letters and parcels; guarded transport of valuables; freight forwarding; warehousing; organisation and handling of returned consignments (returns management); dispatch handling and execution; collecting, stapling, enveloping and</p>	<p>Class 16 Paper, cardboard and goods made from these materials (included in this class); printed matter; bookbinding material, photographs; stationery; adhesives for stationery or household purposes; artists' materials, paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (included in this class); type; printing blocks; labels, envelopes, boxes and bags in this class.</p> <p>Class 39 Courier services; freight services; transportation of goods including documents, parcels, packages and letters; postal services including collection, transportation, distribution and delivery of goods including documents, parcels, packages and letters; storage services; mail forwarding services; wrapping and packaging services; transportation information; freight brokerage; unloading cargo; storage information; logistic services in the field of transport; collecting, transport and delivering of goods, in particular documents, parcels, packets and letters; follow-up services, involving the electronic tracking of goods, in particular documents, parcels, packages and letters (track and tracing); organisation and handling of returned consignments (returns management); dispatch handling and execution; providing information and data on databases in the field of packaging, parcelling and transportation of documents, parcels, packages and letters; processing and franking of mail.</p>

franking of goods, processing and franking of packets, packages, parcels, freight and other goods; information and advisory services relating to the aforesaid services.	
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16. In its skeleton argument, at paragraph 10, the applicant submits:

“The Applicant will not challenge the Opponent’s submission that the majority of the goods and services for which protection is sought under the opposed mark are identical to those covered by the earlier trade mark and those that are not identical are similar.”

17. At the hearing the applicant accepted that all of the goods and services are identical to goods and services in the specification of the opponent’s earlier mark, except for paint brushes, typewriters, printers’ type and printing blocks (in class 16) which are highly similar to the opponent’s class 16 goods.³

Comparison of marks

18. The marks to be compared are as follows:

The opponent’s mark	The applicant’s mark
PARCELNET	PARCEL CONNECT

19. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁴, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

³ This seems somewhat unlikely but is accepted on the basis that it is an admission against interest.

⁴ *Sabel v Puma AG*, para.23

20. The opponent's mark consists of the single word PARCELNET. Whilst presented as a single word, no part of which is stylised or emphasised in any way, it naturally breaks down into the two component words. The word PARCEL is descriptive of the nature of, or a characteristic of, the majority of goods and services at issue and consequently is a non-distinctive element for those goods and services. The word NET is a common English word which is not descriptive of the goods or services at issue. The distinctiveness lies in the mark as a whole.

21. The applicant's mark consists of the words PARCEL CONNECT. No part of either word is stylised or emphasised in any way. As is the case with the opponent's mark, the word PARCEL is descriptive of the nature of, or a characteristic of, the majority of goods and services at issue and consequently is a non-distinctive element for those goods and services. The word CONNECT is a common English word which does not serve to describe the goods and services. The word CONNECT is the dominant and distinctive element of the mark.

22. In respect of some of the goods in class 16, namely, artists' materials, paint brushes, typewriters, printer's type and printer's blocks, the parties' marks are not descriptive and are both somewhat unusual. In the case of these goods the PARCEL element at the start of both marks, which has no meaning in the context of these goods, would, in my view, be the dominant and distinctive element of the marks at issue.

Visual similarities

23. In its skeleton argument the opponent states:

"7. Both marks begin with the common element 'PARCEL'. The letters 'N-E-T' of the 'NET' element of the Earlier Mark are comprised within the 'CONNECT' element of the Application in the same order. Both end with the letter 'T'. These further commonalities serve to strengthen the degree of visual similarity between the marks created by the common 'PARCEL' element.

8. Unlike the Earlier Mark, the Application consists of two words separated by a space and contains the additional letters 'C-O-N...C'. These differences offset the similarities to a modest extent, but certainly do not outweigh or eliminate these.

9. Overall, therefore, the marks have a moderate to high degree of visual similarity."

24. The applicant submits:

"6...while both marks contain the common word PARCEL as the first word, the differences between the second word in the case of the opposed mark and suffix in the case of the earlier trade mark are immediately noticeable even with a cursory glance such that the degree of overall visual similarity is low."

25. Both marks begin with the same six letters: PARCEL. The second word of the applicant's mark is the word CONNECT. The first six letters of the opponent's mark are followed by the letters NET, which are presented in combination as the one word PARCELNET but will be seen as the two words PARCEL and NET due to the natural

break between two known words. At the hearing and in its submissions, the opponent sought to rely on the fact that the letters N-E-T are included within the second word of the applicant's mark, namely, CONNECT. Both are well known everyday words and it is extremely unlikely that the average consumer would see the word NET within the applicant's mark any more than they would see a number of other words which are also present. There is a moderate degree of visual similarity between these marks.

Aural similarities

26. The opponent submits:

"10...The common 'PARCEL' element and the 'NET' and 'CONNECT' elements will be pronounced. The space between 'PARCEL' and 'CONNECT' in the Application will not be, leaving the sole point of difference the additional letters 'C-O-N...C' in the Application.

11. The additional letters 'C-O-N' create a soft sound that naturally runs together with the hard ending 'N-E-C-T' element such that the two syllables are barely distinguished (as in 'C'NECT'). The 'N-E-C-T' element begins with an 'NE...' sound and end with the hard 'T'. For this reason it creates a fundamentally similar sound to that created by the 'NET' element of the Earlier Mark, notwithstanding the interposed 'C'.

27. In its skeleton argument the applicant submits:

"7...although the marks share the same first word PARCEL, the subsequent elements of the respective marks will be immediately perceived as being sufficiently different such that, when the marks are considered as a whole the degree of phonetic similarity between them is low."

28. At the hearing, Mr Krause also drew my attention to the fact that the applicant's mark contains two 'C's which require a glottal stop in order to pronounce them. He submitted that the opponent's mark PARCELNET can be run together whereas the 'C's in the applicant's mark provide a natural break. He concluded that this aural effect is noticeable.

29. The first six letters, which will be pronounced as the word 'PARCEL', are the same in both marks. The applicant's mark has the second word CONNECT, which is two syllables long, resulting in the overall mark consisting of four syllables. Both syllables are hard sounds which are noticeable within the mark as a whole. The opponent's mark is one word created from the combination of the known words 'PARCEL' and 'NET' which create a natural break in the mark. The second part of the mark is the word NET, resulting in the overall mark consisting of three syllables. Any similarity between the marks rests in the common word PARCEL. Consequently, I find there to be a moderate degree of aural similarity between the marks.

Conceptual similarities

30. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁵ The assessment must be made from the point of view of the average consumer.

31. The opponent submits:

“13. First, the common ‘PARCEL’ element of the two marks is conceptually identical. This immediately calls to mind the concept of a parcel.

14. Secondly, there is a clear conceptual similarity between the ‘NET’ and ‘CONNECT’ elements of the two marks. Nowadays, the word ‘net’ is most commonly used as a shorthand for ‘network’ (as reflected in the Collins English Dictionary definition - see §12 of Grattan’s reply submissions). The word therefore immediately calls to mind an ‘interconnected group or system’ (again as reflected in the Collins English Dictionary definition - see § 7 of Grattan’s statement of grounds). This natural meaning is reinforced by the context of the Earlier Mark. In association with the word ‘PARCEL’, the word ‘NET’ naturally communicates a delivery network, i.e. an interconnected system via which parcels may be sent and delivered. This is conceptually similar to the concept communicated by the word connect.

15. Thirdly, the word juxtapositions ‘PARCELNET’ and ‘PARCEL CONNECT’ are themselves conceptually similar. Both call to mind the concept of senders and recipients of parcels being connected via the delivery network, thereby implicitly likening it to a communications network. This concept is highly specific and goes beyond the general concept of a parcel delivery service by focusing on a modern, end-user point of view of a parcel delivery network, rather than its internal operation (cf. PARCELFORCE).”

32. At the hearing Mr Alkin added that in both cases the marks consist of a combination of known English words which when juxtaposed create the concept of a parcel delivery network. He submitted that both marks liken a traditional service, the delivery of parcels, to a modern concept of communication networks. In his view, they create the same impression, the ability to connect end users.

33. The applicant submits:

“8...the word PARCEL in each of the marks will convey the same idea to consumers. However, the additional elements CONNECT and NET convey quite different concepts. When combined with the word PARCEL, the opposed mark suggests the active linking of parcels, perhaps with recipients, and the earlier trade mark suggests a container for parcels. Therefore, while there is a degree of conceptual similarity between the marks, the conceptual differences are such that the overall degree of conceptual similarity is not high.

⁵ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

Consumers will also perceive the mark PARCELNET as one that “works” semantically, whereas PARCEL CONNECT is a mark that jars because of the unusual juxtaposition of the two constituent words.”

34. At the hearing Mr Krause added that the applicant does not accept that ‘NET’ is a common abbreviation for NETWORK but would accept that it is used for ‘INTERNET’. He submitted that NET may suggest something to do with the internet or may refer to a device for holding parcels. He concluded that the opponent does not accept that the earlier mark will be seen as PARCEL NETWORK. He concluded that PARCEL CONNECT implies a physical connection between the parcel and the customer and provides a quite different message. He suggested that at the highest level there may be a degree of conceptual similarity in the same way as between ‘car’ and ‘motorway’ but that the two marks do not convey the same conceptual impression.

35. The opponent’s earlier mark, PARCELNET, may bring to mind a network for transporting parcels or may refer to a website dealing with parcels in some way. The applicant’s mark, PARCEL CONNECT may refer to connections between parcels and customers or connections between the parcels themselves.

36. While I accept that both parties’ marks are susceptible to different conceptual meanings, in my view, the meanings that will immediately occur to the average consumer of the goods and services at issue will be those mentioned above, and as such, taking into account that PARCEL is non-distinctive for the services and the majority of goods at issue, the competing marks are conceptually similar to a low degree.

37. As I have stated above, the PARCELNET and PARCEL CONNECT marks are distinctive for some of the goods in class 16, namely, artists’ materials, paint brushes, typewriters, printer’s type and printer’s blocks. In the case of these goods the PARCEL element at the start of both marks has no meaning and would be the dominant and distinctive element of the marks at issue and would result in a fairly high degree of conceptual similarity between the competing marks for these goods.

Distinctive character of the earlier mark

38. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been used as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

39. I have no evidence of use to consider so only need to make a finding in respect of the inherent distinctiveness of the earlier mark.

40. In respect of artists’ materials, paint brushes, typewriters, printer’s type and printer’s blocks the earlier mark PARCELNET is highly distinctive, having no meaning in relation to the goods.

41. For the remaining goods and all of the services, the mark is possessed of a much lower degree of distinctiveness since the parcel element serves to describe, inter alia, the

nature or purpose of the goods and services. Consequently, it has a low degree of inherent distinctive character.

Likelihood of confusion

42. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁶ I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and have regard to 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.

43. In relation to the interdependency principle, the GC in *Aldi GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-505/11* stated:

“91 In addition, the Opposition Division considered that the goods at issue were identical, as was recalled in the contested decision, without the Board of Appeal’s taking a final decision in that regard (see paragraph 40 et seq. above). That implies, in accordance with the case-law cited at paragraph 23 of the present judgment, that, if there is to be no likelihood of confusion, the degree of difference between the marks at issue must be high (see, to that effect, judgment of 29 January 2013 in Case T-283/11 *Fon Wireless v OHIM – nfon (nfon)*, not published in the ECR, paragraph 69).”

44. However, as the GC held in *Meda Pharma GmbH & Co KG c Office de l’harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI) les affaires jointes T-492/09 et T-147/10*, where goods are identical it is not essential, in order to exclude the likelihood of confusion, that there is a large difference between the trade marks being compared. This is the case where the earlier trade mark has limited distinctiveness.

45. I have found the marks to possess a moderate degree of visual and aural similarity. I have found a low degree of conceptual similarity for the majority of the goods in class 16 and all of the services in class 39. In respect of artists’ materials, paint brushes, typewriters, printer’s type and printer’s blocks in class 16 I have found a high degree of conceptual similarity. I have found the earlier mark to have a low level of inherent distinctive character for all of the goods and services except artists’ materials, paint brushes, typewriters, printer’s type and printer’s blocks for which the mark is highly distinctive. The parties’ services in class 39 are identical. The parties’ goods in class 16 are identical save for paint brushes, typewriters, printer’s type and printing blocks, which are highly similar. I have identified the average consumer, namely a member of the general public or a business and have concluded that the degree of attention paid is likely to vary.

46. It is well established⁷ that the more distinctive the earlier trade mark, the greater the likelihood of confusion will be. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ commented upon the logical corollary of this proposition:

⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

⁷ *Sabel v Puma*

“The more distinctive the earlier mark, the greater will be the likelihood of confusion. The converse, of course, follows. The more descriptive and the less distinctive the major feature of the mark, the less the likelihood of confusion.”

47. However, in relation to the limited distinctiveness of an earlier trade mark the judgment of the CJEU in *L’Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-235/05 P* is pertinent:

“45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

48. Taking all of these factors into account, I find that the average consumer is more likely to see the inclusion of the word PARCEL in both parties’ marks to be due to the fact that the goods and services relate to parcels and not that the goods and services relate to the same undertaking. Consequently, for the goods and services related to parcels there is no likelihood of confusion, either direct or indirect, between the respective marks.

49. With regard to the remaining goods, artists’ materials, paint brushes, typewriters, printer’s type and printer’s blocks in class 16, the word PARCEL is a distinctive and somewhat unusual element. Given that it is present at the start of both marks and would be memorable in respect of these goods I find that there would be direct confusion in respect of these goods.

CONCLUSION

50. The opposition fails under section 5(2)(b) of the Act in respect of the following goods.

Class 16

Paper, cardboard and goods made from these materials (included in this class); printed matter; bookbinding material, photographs; stationery; adhesives for stationery or household purposes; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (included in this class); labels, envelopes, boxes and bags in this class.

Class 39

Courier services; freight services; transportation of goods including documents, parcels, packages and letters; postal services including collection, transportation, distribution and delivery of goods including documents, parcels, packages and letters; storage services; mail forwarding services; wrapping and packaging services; transportation information; freight brokerage; unloading cargo; storage information; logistic services in the field of transport; collecting, transport and delivering of goods, in particular documents, parcels, packets and letters; follow-up services, involving the electronic tracking of goods, in particular documents, parcels, packages and letters (track and tracing); organisation and handling of returned consignments (returns management); dispatch handling and execution; providing information and data on databases in the field of packaging, parcelling and transportation of documents, parcels, packages and letters; processing and franking of mail.

51. The opposition succeeds under section 5(2)(b) of the Act in respect of

Artists' materials, paint brushes, typewriters, printer's type and printer's blocks.

COSTS

52. The opposition having failed for all of the services in class 39 and most of the goods in class 16, the applicant is entitled to a contribution towards its costs. I make the award on the following basis, bearing in mind that the hearing was conducted by telephone:

Preparing a statement and considering the other side's statement:	£200
Preparation for and attending a hearing:	£500
Total	£700

53. I order Grattan Plc to pay Fastway Ltd the sum of £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of January 2014

**Ms Al Skilton
For the Registrar,
The Comptroller General**