

O-009-15

**TRADE MARKS ACT 1994**

**INTERNATIONAL TRADE MARKS (UK) 1118945 & 1125766**

**BY MAIL.RU, A LIMITED LIABILITY COMPANY**

**AND**

**CONSOLIDATED OPPOSITIONS 72456 & 400909**

**BY ASSOCIATED NEWSPAPERS LIMITED**

## Background and pleadings

1. International trade mark 1118945 (“IR 1118945”) was registered on 28 March 2012. On the same date the holder designated the UK as a territory in which it sought to have the mark protected. This makes it an ‘international trade mark (UK)’ for the purposes of The Trade Marks (International Registration) Order 2008.

2. IR 1118945 is shown below.



mailru

3. Protection is sought in relation to:

Class 35

Advertising; business management; sales promotion for others.

Class 38

News agencies; rental of message sending apparatus; information about telecommunication; computer aided transmission of messages and images; electronic mail.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; organization of meetings, including through the Internet.

Class 42

Research and development for others.

4. The holder of IR 1118945 is Mail.Ru, a limited company incorporated in the Russian Federation.

5. The holder’s mark was published for opposition purposes on 20 July 2012.

6. Protection of the mark in the UK is opposed by Associated Newspapers Ltd. The opponent originally relied on 19 earlier trade marks including the word ‘mail’ as support for grounds of opposition based on ss.5(2) and 5(3) of the Act. There was also a further ground of opposition under s.5(4)(a) of the Act based on the opponent’s earlier common law rights in the word ‘mail’. However, at the hearing described below the only ground pursued was under s.5(2)(b) of the Act based on the following three marks.



7. None of these marks had been registered for five years at the date of publication of the holder's mark. Consequently, the proof of use requirement set out in s.6A of the Act does not apply. This means that the opponent can rely on these marks in this opposition in respect of all the goods/services for which they are registered (to which I return below).

8. The holder also designated the UK for protection of another international mark - IR 1125766 - consisting of the word MAIL alone. This mark was also opposed by Associated Newspapers on similar grounds to those relied upon in the opposition to IR 1118945.

9. The holder filed counterstatements defending both oppositions.

10. The oppositions were consolidated

11. Evidence was filed on behalf of both sides. The holder also filed written submissions. A hearing took place on 5 December 2014 at which the opponent was represented by Mr Martin Krause of Haseltine Lake LLP. The holder was not represented.

12. Shortly before the oppositions were due to be heard the holder indicated that it was withdrawing its request for protection of IR 1125766. Consequently, there is no need for me to say anything more about that opposition, except in the context of costs.

### **The evidence**

13. No one from either of the parties themselves filed evidence. However, witness statements were filed from their Trade Mark Attorneys. The opponent filed two statements from Heather Orr, who is a Trade Mark Attorney at Haseltine Lake. The first shows what Ms Orr found when she visited the holder's website. Exhibits HO1 and HO2 consist of copies of pages from the English language version of that website. They show that the holder trades under the name '@mail.ru group'. I note that the word 'mail' is presented in a contrasting colour to the letters 'ru'. The word 'group' appears in relatively small letters beneath the name '@mail.ru'. The third

exhibit to Ms Orr's first statement consists of a list of Country domains<sup>1</sup> showing that 'ru' is the international code used to identify Russian domain names.

14. Ms Orr's second statement exhibited 91 pages of hits yielded by further internet searches. These were intended to show that companies that produce computer and computer software products also supply related installation, support and maintenance services and/or are involved in the design, development and analysis of computer systems. This was meant to illustrate why some of the goods and services at issue in the opposition to IR 1125766 are similar. However, as the holder no longer seeks protection for that trade mark in the UK, and the goods/services in the opposition to IR 1118945 are different, there is no need for me to say any more about this evidence, except in the context of costs.

15. The evidence filed on behalf of the holder is in two witness statements by Ms Sharon Kirby, who is a Trade Mark Attorney at Kilburn and Strode. Ms Kirby's first statement includes the results of a search she conducted on the IPO's trade mark database for any mark consisting of, or containing, the word 'mail' in classes 35, 38, 41 and 42 (i.e. the classes in which protection of IR 1118945 is sought). The search returned 641 results. Ms Kirby exhibits the first page of the results<sup>2</sup>. These show a well known mark - ROYAL MAIL – as well as some of the opponent's marks – THE MAIL ON SUNDAY and DAILY MAIL. Not surprisingly, the search shows that MAIL is popular in marks in classes 9 and 38. This is no doubt because of the connection between goods and services in these classes and electronic mail. Some examples are SKY MAIL, I-MAIL, A-MAIL and ELECTRIC MAIL<sup>3</sup>.

16. Ms Orr says that she also conducted internet searches on the terms 'www.mail.uk' and 'Daily Mail Russia'. The former returned no results. The latter returned hits from the opponent's website [www.dailymail.co.uk](http://www.dailymail.co.uk).

17. Ms Kirby's second statement shows images of the opponent's products intended to show that it trades under the names DAILY MAIL and THE MAIL ON SUNDAY (i.e. not under the word MAIL alone).

### **Section 5(2)(b)**

18. Sections 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

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<sup>1</sup> Exhibit HO3

<sup>2</sup> See exhibit SK01

<sup>3</sup> Registered as a Community trade mark for telecommunications services.

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”.

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

19. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*<sup>4</sup>, the court stated at paragraph 23 of its judgment that:

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

20. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*<sup>5</sup> the General Court (“GC”) stated that “complementary” means:

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

21. In *Sanco SA v OHIM*<sup>6</sup> the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

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





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<sup>4</sup> Case C-39/97

<sup>5</sup> Case T-325/06

<sup>6</sup> Case T-249/11

22. The following table shows the holder's services and the goods and services covered by the opponent's earlier marks that it submits are identical (shown in bold below) or similar.

 IR 1118945	 UK 2505348A	 UK 2505349	 CTM7487366
Class 35  Advertising; business management; sales promotion for others.	Class 35  <b>Advertising;          business          management and          administration;          publicity and          promotional          services</b>	Class 35  <b>As 2505348A</b>	
Class 38  News agencies;           Rental of message sending apparatus;           Information about telecommunication;           Computer aided transmission of messages and images; electronic mail.	<b>Syndicated writing          services          concerning the          Internet and on-line          computer services          (Cl.38)</b> News services (Cl.41)  Computer hardware; apparatus for recording, transmission and reproduction of sound and images (Cl.9)  <b>Advisory and          consultancy          services relating to          telecommunications          access services          (Cl.38)</b>  Provision of telecommunications access and links to computer databases and the Internet (Cl.38). Computer		<b>News services          Cl.38</b>           <b>Information          services relating to          telecommunication          of information          (including web          pages) (Cl.38)</b>           <b>Telecommunication          of information          (including web          pages), computer          programs and any          other data (Cl.38)</b>

	hardware (Cl.9)		
Class 41			
Education; providing of training	<b>Education (Cl.41)</b>	<b>Education; organisation of educational, entertainment and training exhibitions and shows (Cl.41)</b>	
Entertainment	<b>Entertainment (Cl.41)</b>	<b>Entertainment (Cl.41)</b>	
Sporting and cultural activities	Organisation of exhibitions and shows; provision of information relating to ...sporting... cultural activities; arranging of tickets for sporting, cultural...events. (Cl.41)	<b>Organisation of competitions... games</b> and recreational and cultural facilities (Cl.41)	
Organisation of meetings including through the internet	As above	As above	
Class 42			
Research and development for others	Technical consultancy and advising in the establishment of on- line retail stores. (Cl.42) Business research (Cl.35) Computer software (Cl.9)		

23. I accept that all the services that the opponent claims to be identical to the holder's services (in bold above) are identical. Where the terms are not literally identical, this is because the holder's services are covered by the corresponding description of the opponent's services, or vice versa.

24. I find that there is no similarity between '*rental of message sending apparatus*' and '*computer hardware; apparatus for recording, transmission and reproduction of sound and images*' in class 9. I accept that the latter descriptions cover '*message sending apparatus*', but the former is a service whereas the latter are goods. They are therefore different in nature and purpose. There is no evidence that these goods and services are in competition, or that the one is important or indispensable for the use of the other, such that consumers may expect the same undertaking to both sell the hardware and provide the rental services. If I am wrong that there is no similarity between these services and goods, then at most the level of similarity would be low.

25. I find that '*computer aided transmission of messages and images; electronic mail*' is highly similar to '*provision of telecommunications access and links to computer databases and the internet*'. This is because both are telecommunications services and are therefore similar in nature. Further, the holder's services are liable to be provided via the services covered by the opponent's mark. Although the services are not likely to be in direct competition, the latter services are indispensable for the provision of the former services. Further, a telecoms company is likely to provide both services.

26. I find that '*sporting and cultural activities*' are at least highly similar, as Mr Krause submitted, to '*organisation of exhibitions and shows*' and '*provision of information relating to ...sporting... cultural activities; arranging of tickets for sporting, cultural...events*'. The organisation of exhibitions and shows appears to me to be a specific example of '*sporting and cultural activities*'.

27. I find that '*organisation of meetings including through the internet*' are moderately similar to '*organisation of exhibitions and shows*' and '*provision of information relating to ...sporting... cultural activities; arranging of tickets for sporting, cultural...events*'. This is because the respective services both include organising events for others. They are therefore similar in nature and also similar in purpose at a high level of generality. However, the specific purposes are different. A show or an exhibition is usually a passive event intended to impart information and/or display items for educational or entertainment purposes, whereas a meeting is an interactive event. Mr Krause submitted that the holder's description of services would cover the organisation of sports meetings, which would be similar to '*provision of information relating to ...sporting... cultural activities*'. I accept that the subject of the meetings in question could be about anything, including sports or culture. However, I do not find that this makes these services any more similar to the holder's services than '*organisation of exhibitions and shows*', which could similarly be on any subject. There is nothing to suggest that the respective services are in competition or complementary in the sense described in the case law. Therefore although there is some similarity between the respective services, it is only moderate.



28. I find that *'research and development for others'* in class 42 is similar to a low degree to *'technical consultancy and advising in the establishment of on-line retail stores'*. The former services (in class 42) cover scientific and technical R & D<sup>7</sup>. The latter services cover the provision of technical expertise and advice in the setting up of an on-line retail store. The respective services are somewhat similar in nature; both use technical ability to develop solutions. However, they are different in purpose. R & D is about developing products or solutions for the future. By contrast, the holder's services utilise existing expertise and knowledge to overcome the immediate challenges around setting up an on-line store. The services are not in competition or complementary.

29. Mr Krause invited me to compare the holder's R & D services to just *'technical consultancy'*. I have not done so for two reasons. Firstly, I consider that this would be an artificial dissection of the composite term *'technical consultancy and advising in the establishment of on-line retail stores'*. Secondly, the term *'technical consultancy'* alone is too vague and imprecise to identify any specific services. I could not therefore make a proper comparison between *'technical consultancy'* and the holder's services. The consequence of the second point reinforces the correctness of the first point.

30. I find that *'research and development for others'* in class 42 is similar to a low to moderate degree to the opponent's *'business research'* services in class 35. The descriptions of the services sound quite similar, but as I have already noted, the research services in class 42 cover technical and scientific (i.e. not business) research. Therefore although the services are somewhat similar in nature, they are different in purpose. Nor are they in competition or complementary.

31. Mr Krause submitted that *'research and development for others'* is similar to *'computer software'* because it includes software research. I accept that the material exhibited to Ms Orr's second statement shows that well known computer and software suppliers, such as IBM, Fujitsu and Dell conduct their own research and development in computer software, there is no evidence that they conduct R & D in the field of computer software *'for others'*. There is therefore nothing to suggest that businesses selling computer software are also likely to provide consumers (of any kind) with research and development services in the field of computer software. Further, even if I am wrong about that, and large companies of this kind do provide such services to others, it does not follow that the public expects that to be the case generally. There is no evidence that the opponent is a leading player like IBM, Fujitsu or Dell (or indeed a player at all) in the field of computer software.

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<sup>7</sup> See *Altecnic Ltd's Trade Mark Application* [2002] RPC 34

## The case law

32. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 marks

33. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*<sup>8</sup>, 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.”

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.

34. The respective trade marks are shown below:

	
Earlier trade marks	Contested trade mark

<sup>8</sup> Case C-591/12P

35. Mr Krause accepted that the holder's mark had to be taken as registered. Accordingly, he did not suggest that normal and fair use of the mark included use of the mark with a break or punctuation between the 'mail' and 'ru' components. Nevertheless, he submitted that because 'mail' is such a well known word in the UK, consumers would recognise that word in the holder's mark and therefore naturally perceive it as composed of two elements; 'mail' and 'ru'. This was particularly likely if the holder's mark was used in relation to on-line services where 'ru' was liable to be recognised as the geographic domain identifier for Russian websites.

36. The holder submits that the contested mark is likely to be taken as an invented word.

37. I accept Mr Krause's submission for the reasons he gave.

38. It follows from what I have said that I regard the word 'mail' as making an important contribution to the visual and aural impressions created by the holder's mark, particularly as the word is at the beginning of that mark. Nevertheless, the second element, 'ru', also has a significant impact on the overall visual and aural impression created by the contested mark.

39. The word 'Online' is so non-distinctive for the services at issue that I consider that the first two marks shown above can be taken together for the purposes of comparison with the holder's mark. The obvious point of similarity is the word MAIL. However, the opponent's marks show that word in a particular gothic font, which is absent from the holder's mark. Further, the 'ru' part of the holder's mark is absent from the opponent's marks. There are therefore significant differences between the parties' marks.

40. From a conceptual perspective, the word 'mail' is evident in each of these marks. The meanings of that word are very well known to UK consumers. The addition of the letters 'ru' does not change the meanings of 'mail' in the holder's mark. If the letters 'ru' are recognised as identifying a Russian connection, then the holder's mark conveys the idea of 'mail' and 'Russia'. If the letters 'ru' are not recognised as having a meaning, then the holder's mark conveys only the meanings associated with the recognisable word 'mail'. Either way there is a high degree of conceptual similarity between the holder's mark and the first two of the opponent's marks shown above.

41. Much the same analysis can be applied to the comparison between the holder's mark and the opponent's earlier CTM, shown as the third mark above. However, I consider that the device element (obviously based on the outline of an envelope), which is used in place of the letter 'M' in the CTM means that there is a greater visual difference between that mark and the word MAIL *per se*, than the gothic script used for the word 'Mail' in the opponent's other two earlier UK marks. There is

therefore less visual similarity between that mark and the holder's mark compared to the opponent's two earlier UK registered marks.

42. Overall, I find that there is a moderate degree of similarity between the opponent's UK registered marks and the holder's mark and a low degree of similarity between the opponent's CTM and the holder's mark.

### **Average consumer and the purchasing act**

43. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 or services in question: *Lloyd Schuhfabrik Meyer*.

44. Some of the holder's services could be used by the general public or businesses, e.g. advertising, entertainment. Other services are likely to be used by businesses only, e.g. business management, research and development for others. In each case the relevant consumer is likely to pay at least an average level of attention when selecting the services. In some cases, e.g. research and development for others, the relevant consumer is likely to pay a particularly high level of attention.

### **Distinctive character of the earlier trade mark**

45. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* the CJEU stated that:

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

46. In *Kurt Geiger v A-List Corporate Limited*<sup>9</sup>, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or

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<sup>9</sup> BL O-075-13

by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out".

47. As I have already noted, the common element of the respective marks is the word MAIL. The holder's representative points out that this word appears in many registered trade marks. However, this kind of evidence carries no weight because it does not show that these marks are in use in the relevant area of commerce such that consumers have been educated to understand that there are numerous users of marks including that word in the relevant field. See, for example, *Zero Industry Srl v OHIM*<sup>10</sup>, in which the GC stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71)."

48. On the other hand, it is obvious that the word MAIL *per se* has no distinctive character for electronic mail services. It follows that the word is not distinctive for '*telecommunication of information (including web pages), computer programs and any other data*' in class 38, which the opponent rightly contends is identical to electronic mail services. Further, as '*provision of telecommunications access and links to computer databases and the Internet*', '*advisory and consultancy services relating to telecommunications access services*' and '*information services relating to telecommunication of information (including web pages)*' in class 38 could all relate

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<sup>10</sup> Case T-400/06

to electronic mail services, the word MAIL has low distinctiveness for these services too.

### **Likelihood of confusion.**

49. As I found that there was no similarity between the holder's services in class 38 for the '*rental of message sending apparatus*' and any of the goods/services for which the earlier marks are protected, it follows that the opposition fails in respect of these services<sup>11</sup>.

50. Mr Krause asked me to take into account that the opponent uses the word MAIL in various forms, as illustrated by the variations between the earlier marks relied on in this opposition. This is effectively an argument that the earlier marks constitute a series of marks with a common feature, i.e. the word MAIL. However, In *Il Ponte Finanziaria SpA v OHIM*<sup>12</sup>, the CJEU stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

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<sup>11</sup> *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

<sup>12</sup> Case C-234/06

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

51. There is no evidence of use of the opponent's marks, at least prior to the relevant date in these proceedings, or in relation to the goods/services for which the earlier marks are registered. The argument that the earlier marks constitute a series of used MAIL marks must therefore be rejected.

52. Starting first with earlier UK marks 2505348A and 2505349 (Mail and Mail Online with Mail in gothic script), I find that the moderate level of overall similarity between the marks combined with the (at least) average level of attention paid by relevant consumers is sufficient to rule out a likelihood of direct confusion between these marks and the holder's mark, even where the services are identical and after allowing for a degree of imperfect recollection.

53. This brings me to the likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*<sup>13</sup>, Mr Iain Purvis Q.C. as the Appointed Person explained the difference between the two like this:

"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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even

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<sup>13</sup> Case BL-O/375/10



where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

54. As I have already noted, the word ‘mail’ is non-distinctive for electronic mail services. I find that this is sufficient to rule out a likelihood of indirect confusion where the holder’s mark is used in relation to the following related services:

Class 38

Information about telecommunication; computer aided transmission of messages and images; electronic mail.

55. I further find that the mere use of marks based on, or incorporating, the word MAIL is insufficient to give rise to indirect confusion where the respective services are only similar to a low or moderate degree. This means that there is no likelihood of indirect confusion in relation to:

Class 41

Organisation of meetings including through the internet.

Class 42

Research and development for others.

56. By contrast, I find that where the word MAIL has an average degree of distinctive character for the services at issue, and those services are identical or highly similar to the services for which the holder seeks protection for IR 1118945, the moderate degree of similarity between the respective marks is sufficient to create a likelihood of indirect confusion. This is because, in these circumstances, the presence of the word MAIL in the holder’s mark is likely to lead the relevant average consumer to believe that the holder’s mark is a variant of the opponent’s earlier marks 2505348A and/or 2505349. I appreciate that in the example cited by Mr Purvis in paragraph 17a of his decision in *L.A. Sugar Limited v By Back Beat Inc* (re-produced at paragraph 53 above) he had in mind marks with common elements that are “strikingly distinctive”, whereas I have found that the word MAIL is of average distinctiveness for the services under consideration. Mr Purvis clearly had marks with highly distinctive common elements in mind, hence his point that the fact that the later mark includes another highly distinctive element, such as TESCO, may not be enough to avoid indirect confusion. Mr Purvis’s examples were clearly not intended to be

exhaustive and I do not regard them as setting some kind of rule. In the end each case must be assessed on its own facts, including in this case that the other element in the holder's mark - the letters 'ru' – is not very distinctive in the context of online services.

57. In reaching my finding I have also taken into account that the relevant average consumer is likely to pay an above average level of attention when selecting some of the services at issue, e.g. business management. However, whilst this supports my finding that there is no likelihood of direct confusion between the marks, I do not consider that this will prevent such a consumer from making an association between the marks in the sense that he/she will believe that they are marks used by the same undertaking or by economically linked undertakings.

58. The opponent's opposition based on earlier CTM 7487366 is a little weaker than the opposition based on its earlier UK marks and cannot therefore succeed to any greater extent.

### **Other grounds**

59. As the opponent filed no evidence to support the grounds of opposition under ss. 5(3) and 5(4)(a), and did not seek to pursue them at the hearing, these grounds must be rejected.

### **Outcome**

60. The opposition to IR 1118945 succeeds in class 35, fails in class 42 and partly succeeds in classes 38 and 41. Subject to appeal, IR 1118945 will be protected for:

Class 38

Rental of message sending apparatus; information about telecommunication; computer aided transmission of messages and images; electronic mail.

Class 41

Organization of meetings, including through the Internet.

Class 42

Research and development for others.

### **Costs**

61. The opponent partly succeeded in its opposition to IR 1118945, but partly failed. I therefore find that each side should bear its costs as regards that opposition.

62. The holder indicated shortly before the hearing that it was withdrawing its designation of the UK as regards IR 1125766, but only after the opponent filed a

skeleton argument covering both oppositions, which presented different issues and covered differing goods/services. I therefore find that the opponent should be treated as having won that opposition.

63. In the circumstances I award the opponent the sum of £1450 as a contribution towards the cost of the opposition to IR 1125766. The sum is calculated as follows:

£500 for filing the notice of opposition and considering the counterstatement (including the £200 official filing fee for the TM7)

£600 for filing evidence and considering the holder's evidence and written submissions

£350 for filing a skeleton argument for the hearing.

64. Subject to appeal, I therefore order Mail.Ru to pay Associated Newspapers Ltd the sum of £1450. The above sum should be paid within seven days of the expiry of the appeal period, or within seven days of the conclusion of any appeal.

**Dated this 7th day of January 2015**

**Allan James  
For the Registrar,**