

O/436/17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 136 761 FOR THE
TRADE MARK: SNAIL MAIL BY WICKED VISION LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO BY ASSOCIATED NEWSPAPERS
LIMITED

Background and pleadings

1. Wicked Vision Limited (the applicant) applied to register the trade mark SNAIL MAIL under Number 3 136 761 in the UK on 18th November 2015. It was accepted and published in the Trade Marks Journal on 19th February 2016 in respect of the following goods and services:

Class 09:

Computer software; Downloadable software in the nature of a mobile application; Downloadable software to enable uploading, creating, posting, showing, displaying, blogging, sharing and otherwise providing electronic media or information over the internet and other communications networks.

Class 16:

Printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials.

Class 25:

Clothing, footwear, headgear.

Class 28:

Toys, gifts, games and playthings.

Class 35:

Online retail services connected with the sale of: toys, furniture; office supplies, namely stationery and printed matter.

Class 38:

Providing an online community forum for users to share information, photos, audio and video content, to form virtual communities, and to engage in social networking.

Class 42:

Providing a platform that gives users the ability to upload, exchange and share photos and videos; providing a website on the internet for the purpose of social networking.

2. Associated Newspapers Limited (the opponent) partially oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of, amongst others, its earlier UK Trade Mark Number 2 505 348A **Mail**. The following goods and services are relied upon in this opposition:

Class 09:

Computer hardware and computer software; computer programs; computer software and hardware to enable searching of data and connection to databases and the Internet; on-line electronic publications; electronic publications (downloadable); electronic newspapers, sections, columns and articles; data storage media; modems; discs; compact discs, tapes, cartridges, wires, cards and filaments, all for bearing encoded programmes for computers; CDs; Blue-ray discs and other recordable media; CD-Roms; DVDs; pre-recorded video tapes and cassettes; digital music (downloadable) provided from the Internet; digital music (downloadable) provided from MP3 internet web sites; video tapes, games and cassettes; computer accessories, screen savers, mouse pads, keyboards, bank cards and debit cards (encoded or magnetic); digital imaging devices and digital signal processors; data-

processing equipment and computers; electrical, cinematographic, optical, checking (supervision) and teaching apparatus and instruments; apparatus for recording, transmission and reproduction of sound and images; magnetic data carriers; recording discs; parts and fittings for all the aforesaid goods.

Class 16:

Paper, cardboard and goods made from cardboard; printed matter; printed publications; periodical publications; newspapers; magazines; supplements, books; periodicals, leaflets, address books; autograph books; notebooks; reference books; manuals; catalogues; newsletters; calendars; diaries; brochures; document cases; folders; conference folders; bookbinding materials; posters; instructional and teaching materials (other than apparatus); user guides and training manuals, stationery; artists' materials; photographs; photograph albums; drawings; decalcomanias; stickers, maps, holiday and travel guides, tickets and folders; bank cards and debit cards (other than encoded or magnetic); parts and fittings for all the aforesaid goods.

Class 35:

Advertising, marketing, public relations, publicity and promotional services; business services; retail services; sale of goods and services through electronic and printed publications, internet websites or other communication networks; classified advertising services; advertising, marketing, public relations and promotional services; personnel management; agency, counselling, recruitment and placing services; market studies and analysis; rental of advertising space, dissemination of advertising matter; compilation of advertisements for use as web pages on the Internet; advertising mail order; provision of commercial information; organization of exhibitions and trade fairs for commercial or advertising purposes; television, radio and satellite commercials; news clipping services; business management and administration; compilation and provision of business information, advice and statistics; business research; business organisation and management consultancy services; business information services; economic forecasting;

computerised business information storage and retrieval services; computerised accounting; computerised database management; computerised data processing and business management advice and consultancy; storage of information; provision of advertisement programmes; advice and assistance relating to the establishment of online retail stores; search and retrieval of information; information services relating to all the aforesaid services; all the aforementioned services also provided on-line from a computer database or from the Internet

Class 36:

Financial services; insurance services; analysis, evaluation, information and advice relating to insurance and financial services; provision of information relating to insurance and financial services; financial management services; financial advisory services; financial services relating to credit card services; advice and consultancy relating to property (real estate); estate agency and property services; property surveying and valuation; investment schemes and accounts; bank card and debit card services; cheque verification and cheque cashing, issuing and redemption of traveller's cheques and travel vouchers and advisory services relating thereto; sponsorship services and activities; financial sponsorship; charitable fund raising services; credit card services; investment schemes and accounts; on-line financial, banking, savings, payment and credit facilities; home banking and Internet banking; advisory and consultancy services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the Internet.

Class 38:

Syndicated writing services concerning the Internet and on-line computer services; provision of telecommunications access and links to computer databases and the Internet; providing access time to and leasing access time to computer databases; advisory and consultancy services relating to all the

aforesaid services; all the aforementioned services also provided on-line from a computer database or from the Internet.

Class 41:

Education and entertainment services; publishing services; publication of printed matter and printed publications; education, entertainment, publishing and publication services; electronic publishing services; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; news services; news reporters services; commissioned writing; organisation of exhibitions and shows; provision of information relating to education, sporting, political, current events, cultural activities and entertainment; sports information services; organisation of competitions, quizzes, games and recreational and cultural facilities; information and advice relating to healthcare and beauty care; ticket reservation services; booking services; arranging of tickets for sporting, cultural and entertainment, events, concerts and shows; news programme services for radio or television; electronic game services provided by means of the Internet; production of shows and radio and television programmes; cable television, television and radio entertainment services; syndicated writing services concerning the Internet and on-line computer services; providing digital music (not downloadable) from the Internet; providing digital music (not downloadable) from MP3 Internet web sites; providing digital music from the Internet; providing an on-line music store for purchase of singles and albums; advisory and consultancy services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database and/or from the Internet.

Class 42:

Information services; computer services, namely providing an on-line directory; providing an on-line portal network site; technical consultancy and advising in the establishment of on-line retail stores; providing on-line facilities for real time interaction with other computer users concerning topics of general interest and playing games; all the aforesaid services also provided online from a computer database and/or from the Internet.

3. The opposition is limited to the contested goods and services in classes 09, 16 and 35 only. In this regard, the opponent argues that the respective goods and services in classes 09, 16 and 35 are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.
5. Neither side filed evidence.
6. A Hearing took place on 8th August 2017, with the opponent represented by Mr Martin Krause of Haseltine Lake LLP, the representatives of the opponent and the applicant by its Director, Mr David Strang.

DECISION

Section 5(2)(b)

7. 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 protected, 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

8. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;

- e) 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.

10. I also take into account the following guidance: in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

Comparison of goods in Class 09:

11. The earlier goods are *computer software*. The later goods are *computer software; Downloadable software in the nature of a mobile application; Downloadable software to enable uploading, creating, posting, showing, displaying, blogging, sharing and otherwise providing electronic media or information over the internet and other communications networks*.

12. Irrespective of their precise function, the later goods are all types of software. As such, they are included within the broader earlier term. They are identical.

Comparison of goods in Class 16:

13. The following terms appear in each specification, expressed in an identical (or virtually identical) manner: *printed matter, bookbinding materials, photographs, stationery, artists' materials*. They are clearly identical. During the hearing, Mr Strang offered to limit the trade mark application so as to exclude newspapers. This has been considered during this decision.

However, it is noted that even if such items were excluded, there would still remain other products which are highly similar. Magazines being an obvious example (though the potentially problematic terms within printed matter goes wider than this). As such, this argument must be set aside.

14. This leaves the later *adhesives for stationery or household purposes*. It is considered that this term is highly similar to the earlier terms. This is because adhesives for stationery will be used, in effect, as a stationery item. It will be sold alongside other stationery items and is likely to have the same producers and channels of trade. In respect of adhesives for household purposes, it is considered unrealistic to draw a distinction between such adhesives and those for other uses as they are highly likely to overlap. They are also highly similar.

Comparison of services in Class 35:

15. The earlier term is *retail services*. The later terms are: *online retail services connected with the sale of: toys, furniture; office supplies, namely stationery and printed matter*.

16. The earlier term is broader and will encompass all of the later services, albeit they are specified. They are identical.

Comparison of marks

17. 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.”

18. It would be wrong, therefore, artificially to 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.

19. The respective trade marks are shown below:

Mail	SNAIL MAIL
Earlier trade mark	Contested trade mark

20. It is noted that the earlier trade mark is comprised of only one element whereas the later trade mark is a composite mark. In respect of the later trade mark, it is considered that neither SNAIL nor MAIL is dominant and distinctive in its own right. Rather, it forms a complete unit and so its distinctive character lies within the whole.

21. Visually, the earlier trade mark employs a significantly stylised gothic script, though it is clearly the word MAIL. The marks differ in all other respects. The degree of similarity is pitched as being low.
22. Aurally, the matter is somewhat different. The inclusion of MAIL in the later trade mark inevitably leads to a degree of aural similarity despite SNAIL being articulated first. They are aurally similar to a medium degree.
23. Conceptually, the meanings of the trade marks in question must be ascertained. Upon perusal of the Oxford English Dictionary (online), it is noted that MAIL is defined as “to send by post, to post”. Snail Mail is also defined in the same dictionary as “the physical delivery of mail, as by the postal service, considered as slow in comparison to electronic mail; a letter, etc., sent by post”. It is considered that, bearing in mind the aforesaid definitions (which correspond to those submitted by the opponent and with my own knowledge), the trade marks are conceptually so highly similar so as to be almost identical.

Average consumer and the purchasing act

24. 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, Case C-342/97*.
25. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

26. The goods and services in question are those that are targeted towards both the business sector and the public at large. There will be a range in terms of expense from very cheap in the case of magazines to more expensive in respect of computer software. This in turn equates to a variation in the level of attention one would expect to be displayed during the purchasing process. However even in respect of magazines, choosing the correct topic containing the correct information is crucial. As such, the average level of attention will never be at the lowest end of the spectrum. Rather, in all instances, it will be reasonable.

Distinctive character of the earlier trade mark

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

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

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

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

28. As already outlined, MAIL has an ordinary dictionary meaning. However, it has no clear meaning in respect of the goods and services relied upon in this opposition. It is distinctive, to an average degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

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

30. The overwhelming majority of the goods and services have been found to be identical. This is important as the interdependency principle is in full operation. Further, even in respect of the goods found to be (only) similar, the marks are aurally similar to a medium degree and conceptually so closely similar as to be almost identical. Further, the earlier trade mark is averagely distinctive. It is true that a reasonable degree of attention will be displayed during the purchasing process, which can negate against imperfect recollection. However, this only addresses the potential for direct confusion, i.e. mistaking one trade mark for the other. It does not tackle the likelihood of indirect confusion. In this regard, the following guidance is helpful:

31. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted 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.

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 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).”

32. It is considered that the proceedings in hand fall into category c) as described above. The addition of snail to the later trade mark does not create a gap between them. Rather, it reinforces the conceptual hook of sending/delivering by post; a hook which is almost the same in the earlier trade mark. Bearing this in mind, such an addition is considered to be logical and consistent with a brand extension and is likely to lead the average consumer to believe that the trade marks emanate from the same (or an economically linked) undertaking.

33. The partial opposition therefore succeeds in its entirety.

34. The net result of all this is that the application is refused in respect of classes 09, 16 and 35. In respect of the remaining unopposed classes, namely 28, 25, 38 and 42, it can proceed to registration.

COSTS

35. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1200 as a

contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of Opposition and accompanying statement - £300

Official Fee - £200

Considering statement of case in reply - £200

Preparation for and attendance at Hearing - £500

36. I therefore order Wicked Vision Limited to pay Associated Newspapers Limited the sum of £1200. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of September 2017

Louise White

For the Registrar