

O-145-18

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3179177
BY GO BOX SELF STORAGE LTD
TO REGISTER**



**AS A TRADE MARK (SERIES OF TWO)
IN CLASS 39
AND OPPOSITION THERETO (UNDER NO. 408412)
BY
GO! EXPRESS & LOGISTICS (DEUTSCHLAND) GMBH**

Background & Pleadings

1. Go Box Self Storage Ltd ('the applicant') applied to register the following marks as a series of two on 8 August 2016:



2. The marks were accepted and advertised in the Trade Marks Journal on 28 October 2016 in class 39 for **Self-storage of goods; self-storage of containers and cargo; transit of goods to and from self-storage; none of the aforesaid being transport, delivery or courier services.**

3. GO! Express & Logistics (Deutschland) GmbH ('the opponent') opposes the trade marks under Section 5(2)(b) of the Trade Marks Act 1994 (the Act) on the basis of its two earlier European Union Trade Marks set out below. Both are registered in classes 35 and 39 but only class 39 forms the basis of the opposition:

Opponent's marks	Services relied on in class 39
<p>EUTM No. 2760056</p> <p>GO!</p> <p>Filing date: 2/7/2002</p> <p>Date of entry in register: 2/6/2004</p>	<p>Transport of goods, including postal consignments and express/courier consignments; packaging and storing of goods; delivery of goods, parcels and letters and transport thereof using vehicles of all kinds; courier services of all kinds; transport of valuables.</p>
<p>EUTM No. 10795144</p> <p>GO!</p> <p>EXPRESS & LOGISTICS</p> <p>Filing date: 10/4/2012</p> <p>Date of entry in register: 15/10/2012</p>	<p>Transport; Packaging and storage of goods; Delivery of goods, parcels and letters and transport thereof using vehicles of all kinds; Courier services of all kinds; Armored-car transport.</p>

4. The opponent's above mentioned trade marks are both earlier marks, in accordance with Section 6 of the Act. EUTM 10795144 is not subject to proof of use, having not been registered for five years prior to the publication date of the contested application. As the registration procedure for EUTM No. 2760056 was completed more than 5 years prior to the publication date of the applicant's mark, it is subject to the proof of use conditions, as per section 6A of the Act.¹ The opponent made a statement of use in respect of all the services it relies on.

5. The applicant filed a counterstatement in which it denied the grounds of opposition and requested that the opponent produce evidence of use.

6. In these proceedings, the applicant represents itself and the opponent is represented by Lewis Silkin LLP.

7. The opponent filed evidence. Both parties filed written submissions in lieu of a hearing. I make this decision based on all of the material before me.

Approach

8. The opponent relies on the two marks set out above in paragraph 3. The first of those marks is subject to proof of use, the second mark is not. In the interests of procedural economy, I will proceed on the basis of the second mark, returning to consider the first mark only if it becomes necessary to do so.

Section 5(2)(b)

9. Section 5(2)(b) of the Act states as follows:

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

¹ 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.

(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.

10. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 services

11. The services to be compared are:

Opponent's services	Applicant's services
Transport; Packaging and storage of goods; Delivery of goods, parcels and	Self-storage of goods; self-storage of containers and cargo; transit of goods

letters and transport thereof using vehicles of all kinds; Courier services of all kinds; Armored-car transport.	to and from self-storage; none of the aforesaid being transport, delivery or courier services.
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12. I note that the applicant has added an exclusion clause to its specification namely, *none of the aforesaid being transport, delivery or courier services*. The use of exclusions are specifically dealt with in case law by reference to what is known as the *POSTKANTOOR* principle. In *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), Arnold J. provided the following guidance on the application of the *POSTKANTOOR* principle.

“43. *The POSTKANTOOR principle*. In *POSTKANTOOR* the applicant applied to register the word *POSTKANTOOR* (Dutch for *POST OFFICE*) in respect of goods and services in Classes 16, 35–39, 41 and 42. The Benelux Trade Mark Office refused registration on the grounds that the sign was descriptive. On appeal, the *Gerechtshof te s’-Gravenhage* (District Court of The Hague) referred nine questions of interpretation of the Directive to the Court of Justice, of which the eighth was as follows:

“Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign ‘Postkantoor’ for the services of direct-mail campaigns and the issue of postage stamps, provided they are not connected with a post office’)?”

44. The Court of Justice answered this question as follows:

“113. ... when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for

example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.

114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties — particularly competitors — would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”

45. The guidance given by the Court of Justice must be seen in the context of the question to which it was addressed, namely whether it was acceptable to restrict the goods or services by reference to the absence of “a specific quality”. What the District Court of The Hague meant by this can be seen from the example it gave, viz. “the services of direct mail campaigns and the issue of postage stamps provided that they are not connected with a post office”. When the Court of Justice referred in its answer to “a particular characteristic”, it must have meant the same thing as the District Court meant by “a specific quality”.

46. The application of this guidance has caused some difficulty in subsequent cases. In *Croom’s Trade Mark Application [2005] R.P.C. 2* at [28]–[29] Geoffrey Hobbs QC sitting as the Appointed Person held that the *POSTKANTOOR* principle precluded the applicant from limiting a specification of goods in Classes 18 and 25 by adding the words “none being items of haute couture” or “not including items of haute couture”. He went on at [30] to refer to “characteristics that may be present or absent without changing the

nature, function or purpose of the specified goods”. Mr Hobbs QC made the same distinction in *WISI Trade Mark* [2007] E.T.M.R. 5; [2006] R.P.C. 22 at [16].

47. In *Oska’s Ltd’s Trade Mark Application* [2005] R.P.C. 20 at [56] I observed *en passant* when sitting as the Appointed Person that I did not consider that it would be permissible to limit the specification by reference to the applicant’s intended target market.

48. In *MERLIN Trade Mark (BL O/043/05)* [1997] R.P.C. 871 at [27]–[28] I held when sitting as the Appointed Person held that the disclaimer “but not including the provision of venture capital” was acceptable, because it was not framed by reference to the absence of particular characteristics of the services, but rather it was a restriction on the scope of the services embraced by the specification. Accordingly, “the effect of [the disclaimer] is simply to excise a particular service from the specification. The mere fact that it is more convenient to express it in negative than positive terms does not make it objectionable.”

49. I also allowed a second disclaimer “and not including the provision of any such services to the pharmaceutical biotechnological [or] bioscientific sectors” for reasons which I expressed at [29] as follows:

“The position with regard to the second disclaimer is more debatable, but in my judgment the disclaimer does not relate to a characteristic of the services. I consider that there is a distinction between goods and services here. An article of clothing is an article of clothing regardless of whether it is of a particular style or quality and regardless of the identity and proclivities of the intended purchaser. By contrast, services can be defined in part by the recipient of the service. The opponent’s registration is an example of this, since both the Class 35 and the Class 36 specification are limited to services provided to the pharmaceutical biotechnological and bioscientific sectors. In my view *POSTKANTOOR* does not make it impermissible to define services in

this way. That being so, I consider that it makes no difference if the definition is expressed negatively rather than positively.”

50. In *Patak (Spices) Ltd's Community Trade Mark Application (R746/2005-4) [2007] E.T.M.R. 3* at [28] the Fourth Board of Appeal at OHIM refused to allow a proposed limitation “*none of the aforesaid being dart games or darts*” to a class 28 specification as offending the *POSTKANTOOR* principle. I find this decision difficult to follow, since the exclusion related to categories of goods, rather than the characteristics of goods. It appears that the objection may have been down to the fact that the exclusion was negatively worded, but as I explained in *MERLIN [1997] R.P.C. 871* that is a matter of form, not substance, and so should not have been determinative.”

And

“56. Against this background, counsel for Swiss submitted that the limitation “intended for a scientific or industrial application in measuring, signalling, checking, displaying or recording heat or temperature (including such having provision to record heat or temperature over a period of time and/or to display the time of day)” contravened the *POSTKANTOOR* principle because it purported to restrict the specification of goods by reference to whether the goods possessed particular characteristics.

57. I do not accept that submission for the following reasons. First, if and insofar as the *POSTKANTOOR* principle depends on the limitation being expressed in negative terms, the limitation in the present case is expressed in positive terms. Secondly, and more importantly, I do not consider that the limitation refers to whether the goods possess particular characteristics in the sense in which the Court of Justice used that term in *POSTKANTOOR*. Rather, the limitation refers to the functions of the goods. To revert to the analogy discussed above, it is comparable to a limitation of “clocks” to “clocks incorporating radios”. Accordingly, in my judgment it falls on the right side of the line drawn by Mr Hobbs QC in *Croom's Trade Mark Application [2005] R.P.C. 2* and *WISI Trade Mark [2007] E.T.M.R. 5; [2006] R.P.C. 22*.”

13. Following the guidance given above, I find that the exclusion of *transit of goods to and from self-storage; none of the aforesaid being transport* lacks clarity.

Furthermore it makes no sense and cannot operate correctly as it is not possible to have a 'transit of goods' that isn't 'transport' as the act of something being transited to or from somewhere is evidently identical to transporting something to or from somewhere.

14. As to the remaining limitation wording, namely *none of the aforesaid being delivery or courier services*, this is *POSTKANTOOR* compliant and is acceptable as it excludes specific categories of services.

15. With regard to the comparison of services, in *Canon*, the CJEU 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”.

16. 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.

17. In relation to the assessment of the respective specifications, I note that in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

18. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267, Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

19. I note that the opponent has *storage of goods* in their specification and the applicant has *self-storage of goods; self-storage of containers and cargo*. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM Case T-133/05) ('Meric')*, the General Court ('GC') held:

"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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

20. On that basis *Self-storage of goods; self-storage of containers and cargo* are a subset of *storage services of goods* and are therefore considered identical on the *Meric* principle.

21. With regard to the applicant’s term ‘transit of goods to and from self-storage’, as previously noted the applicant has amended its specification by way of an exclusion clause namely, ‘none of the aforesaid being transport, delivery or courier services’. The opponent submits that the exclusion,

‘...does not assist the applicant in this regard, as any “transit” services are, in fact, transport services for which the opponent has coverage’.

22. I agree with the opponent on this point. As I have previously stated, the act of something being transited to or from somewhere is identical to transporting something to or from somewhere. Accordingly, I find that the opponent’s *transport* services will cover the applicant’s *transit of goods to and from self-storage* services and are identical in accordance with *Meric*.

23. I note in Appendix 9 of its submission, the applicant, outlines the nature of its business provided under the trade mark.

‘...the Go Box list of services is clearly worded on its business, operational and marketing objectives of self-storage. The list of services goes further by

stating, at the request of the opponent, that we specifically do not provide transport, delivery or courier type services

24. Before going any further it is necessary to explain why, as a matter of law, this point has no bearing on the outcome of this opposition. A trade mark registration is essentially a claim to a piece of legal property, i.e. the trade mark. The services for which the mark is registered set some limits to the claim, although since marks can be protected against the use of the same or similar marks in relation to services which are only similar to those for which the earlier mark is registered, the limits of the claim are not precise. Every registered mark is therefore entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar services, if there is a likelihood of confusion.

25. Until a trade mark has been registered for five years (when the proof of use requirements set out in s.6A of the Act are applicable), it is entitled to protection in relation to all the services for which it is registered. Consequently, the opponent's earlier EU trade mark no 10795144 must be protected for the services for which it is registered in class 39 without the opponent needing to prove any use its mark in relation to those services. The opponent's earlier mark is therefore entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for all the services listed in the register. The concept of notional use is set out in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

"78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against

the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

26. With regard to the applicant’s point about the proposed use of its mark, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. In *Oakley v OHIM* (case T-116/06) it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between the two marks, ...cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective –of the trade mark proprietors...”

27. Essentially then the differences between the services currently provided by the parties are irrelevant, except to the extent that those differences are apparent from the lists of services they have tendered for the purpose of the registration of their marks. Differences between the parties’ marks or trading styles are also irrelevant, again except to the extent that these are apparent from the registered and applied-for marks.

The average consumer and the purchasing process

28. I must consider who the average consumer is for the services and how those services will be purchased. 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.

29. 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.”

30. The average consumer for the contested services is a member of the general public or a business. The cost of purchasing the services is likely to vary according to factors such as volume of material to be stored or duration of storage and may involve specialist considerations such as refrigeration.

31. With regard to the purchasing process, selection of storage services is primarily visual. Consumers are likely to search the internet to find a suitable provider or find details from a local business directory. However I have not overlooked any potential for word of mouth recommendations and take account of the fact that it may play a part in the selection of these services. Overall, there will be some factors that will need to be considered and I find that a normal level of attention will be paid during the purchasing process.

Comparison of the marks

32. The marks to be compared are:

Opponent's mark	Applicant's marks (series of two)
	

33. 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 Court of Justice of the European Union 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.”

34. 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.

35. The opponent's trade mark consists of a stylised word **GO** followed by an exclamation mark of the same size, both positioned above the words **EXPRESS & LOGISTICS** which appear in a much smaller font. The words **EXPRESS & LOGISTICS** will be seen as descriptive matter given the services covered by the specification. This, coupled with the much smaller font size, means that these words

carry little weight in the overall impression of the mark. The mark will be referred to by the remaining element, **GO!** , which dominates the overall impression of the mark.

36. The applicant's mark is a series of two, each composed of word and device elements. Both marks in the series are presented in pink but given that the application is not limited to this colour and fair and notional use of the opponent's black and white mark would enable it to be used in colour, means that this does not form part of my consideration. The first mark comprises a series of four horizontal lines of unequal lengths, positioned one above the other, to the left of a square device containing the words **GO BOX**. Within the square, the word **GO** is placed above the word **BOX**. The second mark in the series contains exactly the same **GO BOX** word and device but has the additional words **MOBILE SELF STORAGE** positioned to the right of the square device. The words **MOBILE SELF STORAGE** will be seen as descriptive for the majority of the services covered in the specification and therefore carry little weight in the overall impression of the second mark. In terms of the two remaining elements, i.e. the device and words **GO BOX**, it is a general rule of thumb that words speak louder than devices. I consider that rule to be applicable here. Although both the words and device are distinctive and have some visual impact, the square background simply reinforces the 'GO BOX' message meaning that it is the **GO BOX** element which carries the greater weight in the overall impression of the marks.

37. In a visual comparison of the marks, all contain the common word **GO**. The applicant's marks contain the additional word **BOX**. However given that the services cover storage of goods then the word **BOX** itself is not especially distinctive. There are additional elements present such as the exclamation mark in the opponent's trade mark and the lines and square device elements in the applicant's marks. Overall, taking all these factors into account, I find there is a medium degree of visual similarity.

38. In an aural comparison the opponent's submits that,

'...The exclamation point indicates a means of enunciating and emphasising the dominant element GO. It does not change or alter the fact that GO is the dominant verbal element'.

I agree that the marks all contain the common word **GO** which will be pronounced identically in each case but in the case of the applicants mark there is the additional word element of **BOX** which will be verbalised. The exclamation mark and device in the respective marks will not be verbalised. Furthermore I consider it unlikely that consumers will vocalise either of the descriptive phrases present in both parties' marks. Taking this into account, the average consumer will pronounce the respective marks 'GO' and 'GO BOX'. I find there is a medium degree of aural similarity.

39. In a conceptual comparison, the opponent's mark, **GO!**, will bring to mind movement or the act of going somewhere. The remaining element of the mark, **EXPRESS & LOGISTICS**, directly describes the services and will not be given any particular origin significance. An average consumer encountering the applicant's marks may puzzle about what a 'go box' is if they perceive it to relate to a specific thing, in which case the words do not have an 'immediately graspable concept'², though, more likely in the context of the services at issue, the average consumer is likely to perceive it as relating to a box for transit. This is particularly likely given the remaining words in the applicant's second mark, **MOBILE SELF STORAGE**, which directly describe the services. In both marks the word **GO** is likely to give rise to the same concept, i.e. the movement of something and to that extent there is a conceptual similarity which I consider to be medium to high.

Distinctive character of the earlier mark

40. I need now to consider the distinctive character of the earlier mark. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

² It has been highlighted in numerous judgments such as *The Picasso Estate v OHIM*, Case C-361/04 that it is only concepts capable of immediate grasp by the consumer that are relevant.

“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).”

41. In the absence of evidence, I can only consider the earlier mark’s inherent distinctiveness. The earlier mark consists of an ordinary dictionary word which, although not descriptive in relation to the opponent’s services, clearly has allusive qualities in relation to transport, delivery and courier type services. There is nothing particularly unusual or striking about the addition of an exclamation mark and as previously outlined the words EXPRESS & LOGISTICS are descriptive of the services. Overall I consider that the earlier mark has a lower than average degree of inherent distinctiveness.

Likelihood of confusion

42. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 9:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

43. I have found that the contested services are identical and that they are primarily purchased visually by the general public and/or businesses who will be paying a normal level of attention during the purchasing process. In addition I have found that the earlier mark has a lower than average level of inherent distinctiveness and that the contested marks share a medium degree of visual and aural similarity and to be conceptually similar to a medium - high degree.

44. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he 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”.

45. Based on the marks and the services before me and taking into account the assessments I have made, I do not find that the average consumer would directly confuse these marks one for the other. However, bearing in mind Mr Purvis’s decision in LA Sugar, I do find that an average consumer familiar with either of the parties’ marks would, on encountering the other, believe that it originated from the same or a linked undertaking. As previously stated both the words and device have some visual impact, but the square background reinforces the **GO BOX** element meaning that it is this which carries the greater weight in the overall impression of the marks. A consumer familiar with the opponent’s GO! Storage services would, on encountering the applicant’s GO BOX self-storage services, simply think it was another service offered by the opponent (or vice versa).

Conclusion

46. The opposition succeeds under section 5(2)(b) and, subject to any successful appeal against my decision, the application is refused. I did not need to consider the opponent’s other earlier mark as it did not put the opponents in any stronger a position

Costs

47. As the opponent has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN2/2016, I award costs as follows:

£100 Official fee for filing Notice of Opposition

£400 Consideration of counterstatement & filing submissions

£500 Total

48. I decline to award costs for the preparation of evidence as it was unnecessary for the decision made in this case.

49. I order Go Box Self Storage Ltd to pay GO! Express & Logistics (Deutschland) GmbH the sum of £500. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of March 2018

June Ralph

For the Registrar,

The Comptroller General

