

O/537/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003388638

BY WORLD IS OURS LIMITED

TO REGISTER:



(SERIES OF 2)

AS TRADE MARKS IN CLASSES 9, 16, 35, 41 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 417126 BY

PROJECT: WORLDWIDE, INC

BACKGROUND AND PLEADINGS

1. On 17 April 2019, World is Ours Limited (“the applicant”) applied to register the series of trade marks shown on the cover of this decision (“the application”) in the UK for the following goods and services:

Class 9: Video films.

Class 16: 3D decals for use on any surface; Absorbent paper; Adhesive lettering; Adhesive printed labels; Adhesive stickers; Adhesive transfers; Advertisement boards of card; Advertisement boards of cardboard; Advertisement boards of paper; Advertisement boards of paper or cardboard; Advertising pamphlets; Advertising posters; Advertising publications; Advertising signs of cardboard; Advertising signs of paper; Advertising signs of paper or cardboard; Bags [envelopes, pouches] of paper or plastics, for packaging; Bags made of paper; Bags made of paper for packaging; Bags made of plastics for packaging; Ball pens; Ball point pens; Ballpoint pens; Ball-point pens; Bank checks; Banners of paper; Flyers; Pamphlets; Paper; Paper banners; Digital printing paper; Display banners made of cardboard; Display banners of paper; Leaflets; Events programmes; Events programmes.

Class 35: Advertising and marketing services provided by means of social media; Providing business information in the field of social media; Event marketing.

Class 41: Audio and video production, and photography; Audio, video and multimedia production, and photography.

Class 42: Website design; Website design and development.

2. The application was published for opposition purposes on 26 April 2019. The application was opposed on 26 July 2019 by Project: Worldwide, Inc (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1995 (“the Act”). The opponent relies on the following marks:



EUTM no. 18021958

Filing date 12 February 2019; registration date 28 June 2019

(“the opponent’s first mark”);

PROJECT WORLDWIDE

UK registration no. 3255191

Filing date 7 September 2018; registration dated 1 December 2017

(“the opponent’s second mark”); and



International registration no. WE00001337092

International registration date 5 January 2017; date protection granted in EU 7 June 2018

(“the opponent’s third mark”)

3. The opponent relies upon all services for which its marks are registered. The opponent’s services are set out in the **Annex** to this decision. The opponent’s second and third marks share identical specifications.
4. The opponent submits that there is a likelihood of confusion between the parties’ respective marks due to the similarity between them and the identity or similarity

between the goods and services. The applicant filed a counterstatement denying the claims made.

5. The opponent is represented by Lane IP Limited and the applicant is unrepresented. Neither party has filed evidence. No hearing was requested and only the opponent has filed submissions in lieu of a hearing. I have taken these into consideration and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

DECISION

Section 5(2)(b): legislation and case law

6. Section 5(2)(b) of the Act reads as follows:

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

(a) ...

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

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

7. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

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

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

9. Given their filing dates, the opponent’s marks qualify as earlier trade marks under the above provisions. I note that in its counterstatement, the applicant sought to put the opponent to proof of use of its marks. However, the opponent’s marks had not completed their registration process more than 5 years before the date of the application in issue. Therefore, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely on all services for which its marks are registered.

10. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (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.

Comparison of goods and services

11. The applicant's goods and services are set out in **paragraph 1** above. The opponent's services are set out in the **Annex** to this decision.

12. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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 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".

13. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonization in the Internal Market*, Case T-133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“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”.

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the 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”.

16. In *Sanco SA v OHIM*, Case T-249/11, 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 Amalia Mary Elliot v LRC Holdings Limited* BL-O-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.”

17. 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.”

Class 9 goods

18. The opponent submits that,

“the Applicant’s Class 9 goods and class 41 services are at least similar, complementary and related to the services, Providing marketing and promotion of special events for others, of the Opponent. These services, along with Publicity and sales promotion services, almost always involve some kind of filming or promotional/marketing video or film to be produced and would therefore be deemed as a complementary, or related good.

Further as the Opponent's services include advertising services, namely, *promoting and marketing the goods and services of others through all public communication means*, consumers, on understanding this service is provided by the Opponent may easily be led to believe the Class 9 goods and Class 41 services relating to the video or film, are a related or complementary good/service offered by the Opponent."

19. "Video films" in the applicant's specification describes goods such as cassettes or DVDs that contains video footage or the actual reel of celluloid film on which the video images are imprinted. It can also describe downloadable video files. The opponent's class 35 services cover a range of advertising, promotion, publicity and marketing services. The purpose of the opponent's class 35 services is to provide services to its clients in the field of advertising etc, whereas the purpose of video films is to store and watch videos. While the result of the opponent's services may include video advertisements, the respective purposes are more different than they are similar. Providing services in the field of advertising etc is different in nature to video films. Video films are provided via cassette, DVDs, film reels or downloadable files whereas services in the field of advertising etc are usually provided via advice or by way of bespoke campaigns. While the campaigns may include video advertisements, the respective methods of use are more different than they are similar. Consequently, I find that there is no overlap in nature, purpose and method of use between the goods and services. While the goods and services will not be directed at the same user, there may be a slight overlap given the wide user base of video films. Further, I do not consider there to be any overlap in trade channels as an undertaking who provides advertising services is unlikely also to sell video films, be that a cassette, DVD, film reel or downloadable file. There is also no competitive relationship between these goods and services.

20. I note that the opponent has submitted that the average consumer would understand that some advertising, marketing and promotional services in the opponent's specifications would include some kind of filming or video production. However, this comparison is between the opponent's class 35 services and the applicant's class 9 goods, not filming or video production. I do not consider that the average consumer would believe that an undertaking that provides advertising,

marketing or promotional services would be the same undertaking the sells the video film, be that a video cassette, DVD, celluloid film reel or downloaded video file. As a result, there is no complementarity between the goods and services. Overall, I do not consider the limited overlap in user to be enough to warrant a finding of similarity and I, therefore, find that these goods and services are dissimilar.

Class 16 goods

21. “3D decals for use on any surface”, “absorbent paper”, “adhesive lettering”, “adhesive printed labels”, “adhesive stickers”, “adhesive transfers”, “bags [envelopes, pouches] of paper or plastics, for packaging”, “bags made of paper”, “bags made of paper for packaging”, “bags made of plastics for packaging”, “ball pens”, “ball point pens”, “ballpoint pens”, “ball-point pens”, “bank checks”, “banners of paper”, “pamphlets”, “paper”, “paper banners”, “digital printing paper”, “display banners made of cardboard”, “display banners of paper” and “leaflets”, in the applicant’s specification do not fall within any category of services in the opponent’s specifications. Further, these goods differ in nature, method of use and trade channels with any of the services in the opponent’s specifications. While I appreciate that there may be limited overlap in purpose in that the applicant’s goods may be used for advertisement purposes or as a medium for disseminating advertising, I do not consider this to be sufficient enough to find similarity with the opponent’s class 35 services. These goods are therefore dissimilar to any services within the opponent’s specifications.

22. “Advertisement boards of card”, “advertisement boards of cardboard”, “advertisement boards of paper”, “advertisement boards of paper or cardboard”, “advertising pamphlets”, “advertising posters”, “advertising publications”, “advertising signs of cardboard”, “advertising signs of paper”, “advertising signs of paper or cardboard” and “flyers” in the applicant’s specification will all describe goods that are specifically used for disseminating advertising. These goods will overlap in purpose with “advertising services, namely, promoting and marketing the goods and services of others through all public communication means” in the opponent’s marks’ specifications in that both the goods and services will be used

for advertisement, promotional or marketing purposes. The user of the applicant's goods will be either be an individual or a company looking to advertise something or an advertising company who buys the goods in bulk and uses them to create advertising materials for its customer base. The user of the opponent's services will be either an individual or a company who requires advertising services. Therefore, there will be some overlap in the user bases of the goods and services. There may also be an overlap in trade channels in that an undertaking that provides advertising services may also provide printed matter in bulk, such as advertising boards and posters etc. These goods and services will differ in method of use. Further, I do not find that they will have a competitive relationship.

23. Moving on to complementarity, if an average consumer sought the opponent's services, it would be reasonable for them to expect that the advertising materials (such as pamphlets, posters and advertising boards) produced as a result of this service would be supplied by the opponent itself. I am therefore of the view that these goods and services will have a complementary relationship. Overall, I find that these goods and services will be similar to a medium degree.

24. In the applicant's specification, "events programmes" is included as two identical terms but describes the same goods. Event programmes will commonly be sold or handed out at events. I find that there may be an overlap in user between these goods and "event planning and management for marketing, branding, promoting or advertising the goods and services of others" which is included in all three of the opponent's specifications. This is because someone who seeks to plan an event may also require the provision of programmes for that event. Further, the average consumer would expect that the undertaking planning the event would also be the same undertaking that provides the programmes for that event. Therefore, I find that there is a complementary relationship between these goods services. The nature of these goods is that they will be booklets or leaflets that contain information about a planned event, that will be read by the user. The nature and method of use of the goods and services is, therefore, different. The purpose of the goods and services will also differ in that the purpose of the goods is to provide the user with information about an event whereas the purpose of the services is to plan

an event. Overall, I find that these goods and services are similar to a medium degree.

Class 35 services

25. “Advertising and marketing services provided by means of social media” in the applicant’s specification describes advertising and marketing services specifically through the use of social media. In these services, social media will be used as a means of public communication and, therefore, these services fall within the category of “advertising services, namely, promoting and marketing the goods and services of others through all public communication means”, which is contained within all of the opponent’s marks’ specifications. These services are, therefore, identical under the principle outlined in *Meric*.

26. I have no submissions in respect of the meaning of the service, “providing business information in the field of social media” in the applicant’s specification. It is common in business today for companies to use various social media platforms as a way of marketing and reaching new customers. On that basis and in the absence of any submissions to the contrary, I find that this service is one that will be provided to businesses who are looking for information on how to expand their reach via social media. This service will include information such as market analysis and research services specifically in relation to the field of social media. I am, therefore, of the view that this service will fall within the broader categories of “business marketing consulting services”, “market analysis and research services” and “advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media [...]” which are all included in all three of the opponent’s marks’ specifications. These services are, therefore, identical under the principle outlined in *Meric*.

27. “Event marketing” in the applicant’s specification describes the service of marketing an event and not the service of planning marketing events. I consider that these services describe the same services covered in “providing marketing and promotion of special events for others” that is included in all three of the

opponent's marks' specifications. These services are, therefore, identical under the principle outlined in *Meric*.

Class 41 services

28. I do not consider that "audio and video production, and photography" and "audio, video and multimedia production, and photography" in the applicant's specification falls within any of the opponent's services. However, I note that the opponent's submissions I have referred to at paragraph 18 above also state that these services are similar to the opponent's class 35 services and that they are complementary. I do not consider that the average consumer seeking to run an advertising campaign would believe that the undertaking providing the advertising services themselves would also provide the filming, multimedia or audio production or photography services. Instead, the average consumer would expect the services of an external filming or audio production company or photographer to be enlisted.

29. The nature and method of use of these services will also differ. Further, they will have a different purpose in that the applicant's services are included within class 41, which covers services for entertainment, training, sporting or cultural activities and not services for advertisement (which is reserved for class 35). However, there may be a limited overlap in user as video, multimedia and audio production and photography are very wide-reaching services and a company who requires advertising services may also wish to use the applicant's services for other purposes. I do not consider this limited overlap in user to be sufficient for a finding of similarity and I, therefore, find that these services are dissimilar.

Class 42 services

30. "Website design" and "website design and development" in the applicant's specification will describe the same services as "design, development, and consulting services related thereto in the field of websites for others" which is included in all three of the opponent's marks' specifications. These services are, therefore, identical under the principle outlined in *Meric*.

31. As some degree of similarity between services is necessary to engage the test for likelihood of confusion¹, my findings above mean that the opposition must fail in respect of those goods and services that I have found to be dissimilar:

The average consumer and the nature of the purchasing act

32. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

33. Given my findings above regarding the similarity of the goods and services, it is only necessary for me to consider the average consumer of those goods and services in classes 16, 35 and 42 that I have found identical or similar. I do not have any submissions in respect of the average consumer. I consider the average consumers of the goods and services to be business users and members of the general public. While the majority of consumers are likely to be members of the business community, it is not uncommon for members of the public to purchase the goods in order to create their own advertising or to obtain these services by way of paying for local adverts in newspapers or online or seeking website design services.

¹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

34. For either type of user, the purchase of the goods is likely to be straightforward. However, for the selection of the services, the user is likely to follow a measured thought process. Given that the services at issue are in relation to advertising, marketing and promotional services, it would be an important choice for the user to ensure that they receive the correct quality and quantity of exposure to the most appropriate audience. The user of the services would want to ensure that they will be provided professionally and will meet their particular needs.
35. The purchasing process for the goods will predominantly be visual in nature and they are likely to be purchased from shops that specialise in advertising materials and their online equivalents. However, the selection of the services would predominantly be visual in nature in that they are likely to be purchased after viewing information on the internet, in advertising or brochures. However, I do not discount that aural considerations will play a role as a result of word of mouth recommendations or consultations with marketing. The frequency of the purchase of these goods and services is likely to vary. The cost of the goods and services will range from low to fairly high. I am of the view that the average consumer is likely to pay a medium degree of attention during the selection process of the goods and services at issue, however, I acknowledge that some users are likely to pay a higher degree of attention.

Distinctive character of the earlier mark

36. 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).”

37. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

38. The opponent has not pleaded that its marks have acquired enhanced distinctiveness. Therefore, I have only the inherent position to consider.

The opponent's first mark

39. The opponent's first mark contains a word and device element. The word element consists of two words, the first being 'project' displayed in a large, white standard typeface that sits above the second word, 'WORLDWIDE' which is displayed in a smaller, white standard typeface font. The device element is a black rectangular shape that acts as a background to the words and I find that it will have no impact on the distinctive character of the mark.

40. The word 'project' will be viewed as an ordinary dictionary word that has multiple meanings as either a noun or a verb. As a noun, it will be seen as meaning 'a piece

of planned work that is finished over a period of time that is intended to achieve a particular purpose'.² However, in conjunction with the word 'WORLDWIDE', it may be seen as a verb and taken to mean 'to convey an image or message around the world'. Of the two meanings, I consider that the average consumer is more likely to understand 'project' as the former, being a noun. In the context of the services at issue, projects are a common way of delivering business and advertising services. As a result, I am of the view that the word 'project' will have allusive qualities and will, therefore, have between a low and medium level of distinctive character. The word 'WORLDWIDE' will be seen as allusive to an undertaking that offers a worldwide service and will, therefore, have little impact on the overall distinctiveness of the marks. Further, the size and placement of 'WORLDWIDE' means that it will not contribute to the distinctiveness of the mark. Overall, I find that the opponent's first mark has between a low and medium degree of inherent distinctive character.

The opponent's second mark

41. The opponent's second mark is a word only mark that consists of the words 'PROJECT WORLDWIDE'. These words will be given the same meanings as those found at paragraph 40 above. While 'WORLDWIDE' in the opponent's second mark is displayed larger than it is in the opponent's first mark, I do not consider that it will contribute to the distinctiveness of the opponent's second mark. As a result, I find that the opponent's second mark has between a low and medium degree of inherent distinctive character.

The opponent's third mark

42. The opponent's third mark consists of three words, being 'project' and 'WORLDWIDE: CREATIVITY'. The word 'project' is displayed in a larger, standard typeface font that sits above 'WORLDWIDE: CREATIVITY' which are displayed in a smaller, standard typeface font. All words are displayed in black. The findings I have made regarding these words at paragraph 40 above will apply here. The word

² <https://dictionary.cambridge.org/dictionary/english/project>

'CREATIVITY' will be seen as allusive in that it resonates strongly with services which can be 'creative', such as, for example, advertising, marketing and promotional services. Given their allusive and laudatory nature and their size and placement within the mark, 'WORLDWIDE: CREATIVITY' will not contribute to the distinctiveness of the mark. Overall, I find that the opponent's third mark has between a low and medium degree of inherent distinctive character.

Comparison of marks





43. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

44. 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.”

45. 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.

46. The respective trade marks are shown below:

The opponent's marks	The application
 <p data-bbox="352 510 756 546">("the opponent's first mark");</p> <p data-bbox="368 622 735 658">PROJECT WORLDWIDE</p> <p data-bbox="325 674 783 710">("the opponent's second mark");</p>  <p data-bbox="352 958 756 994">("the opponent's third mark")</p>	  <p data-bbox="1023 831 1198 866">(Series of 2)</p>

47. I have detailed submissions from the opponent regarding the comparison of the marks that I do not intend to reproduce here but will refer to them below where necessary.

Overall Impression

The application

48. The application consists of two marks. Both marks consist of a word element, being 'THE PROJECT' displayed in a white, standard typeface. There is also a device element in greyscale that consists of two hands, one of which is holding a baton. This device will be seen as an orchestral conductor's hands. Both elements sit on a black background. While I find that the background has no trademark significance, I do note that it acts as a contrast to the other elements of the mark, especially the white word element. The only difference between the first and second marks in the series is the placement of the device element, being directly behind 'THE PROJECT' in the first mark but sitting above it in the second.

49. I find that 'THE' will have no trade mark significance. While I note the size and placement of the device element in the mark, I am of the view that the eye will be drawn to the part of a mark that can be read. This is particularly the case given the contrast between the background and the text. As a result, I find that the word 'PROJECT' plays a greater role in the overall impression of the mark with the device element and 'THE' playing a lesser role.

The opponent's first mark

50. I do not consider that the mark's black background will have any trade mark significance although I do note the contrast between the light text on a dark background. Further, given the allusive nature of 'WORLDWIDE' and its size and placement within the mark, it will play a lesser role in the overall impression of the mark, with 'PROJECT' playing the greater role.

The opponent's second mark

51. The opponent's second mark is a word only mark. Given its allusive nature, I find that 'WORLDWIDE' will play a lesser role in the overall impression of the mark, with 'PROJECT' playing the greater role.

The opponent's third mark

52. I find that the colon in this mark will have no trade mark significance and will be overlooked. Further, given the allusive nature of 'WORLDWIDE' and the allusive nature of 'CREATIVITY', together with their placement and size in the mark, these words will play a lesser role in the overall impression of the mark with 'PROJECT' playing the greater role.

Visual Comparison

The opponent's first mark and the application

53. The opponent's first mark and the application both contain the word 'project'. They differ in the presence of 'WORLDWIDE' in the opponent's first mark, which is not

present in the application and the word 'THE' in the application, which is not present in the opponent's mark. While the different words play lesser roles in their respective marks, they still constitute a visual difference. The application also consists of a device element. While it plays a lesser role in the overall impression of the mark, it will still constitute a visual difference.

54. The marks also differ in the presentation of their word elements. The application's word element is displayed in upper-case letters, whereas the opponent's first mark is displayed in both upper and lower-case letters. They are both also displayed in slightly different typefaces. Overall, I find that the marks are similar to between a medium and high degree.

The opponent's second mark and the application

55. These marks share the same similarities and differences highlighted in paragraph 53 above. The opponent's second mark is a word only mark and this covers use of the mark in any standard typeface. Overall, I find these marks to be similar to between a medium and high degree.

The opponent's third mark and the application

56. These marks share the same similarities and differences highlighted in paragraphs 53 and 54 above. However, they also differ in the word 'CREATIVITY' that is present in the opponent's third mark but absent in the application. While 'CREATIVITY' plays a lesser role in the overall impression of the opponent's third mark, it still constitutes a visual difference. Overall, I find that the marks are similar to a higher than medium degree.

Aural comparison

57. The opponent submits that:

“As regards a phonetic comparison of the marks, as referenced above the Subject Mark contains the words, 'THE' and 'PROJECT'. It is settled Case Law

that the word 'the' has no trade mark value and therefore the distinctive verbal element of the Subject Mark is simply 'PROJECT'. In relation to the Opponent's Marks, these all contain the words, 'PROJECT' and 'WORLDWIDE'. The average consumer would not associate any trade mark value to the word, 'WORLDWIDE' and so the dominant and distinctive verbal element of the Opponent's Marks is also the word, 'PROJECT'.

With this in mind, the respective marks are phonetically identical and will be perceived as such by the relevant consumer."

58. The opponent suggests that due to lack of trade mark significance in the words 'THE' in the application and 'WORLDWIDE' in the opponent's marks, they will not be pronounced. While I agree that these words play lesser roles in their respective marks, I am of the view that they will still be pronounced, meaning the marks will not be identical.

59. The device element in the application will not be pronounced. The application consists of three syllables that will be pronounced 'THEE-PROH-JEKT'. The opponent's first mark and second mark will be pronounced identically so I will assess the aural comparison of these marks together.

The opponent's first and second marks and the application

60. The opponent's first and second marks consist of four syllables that will be pronounced 'PROH-JEKT-WERLD-WAID'. The marks are identical in their pronunciation of the word 'project', which forms the last two thirds of the aural element of the application and first half of the aural element of the opponent's first and second marks. Overall, I find that they are aurally similar to between a medium and high degree.

The opponent's third mark and the application

61. The opponent's third mark consists of nine syllables that will be pronounced 'PROH-JEKT-WERLD-WAID-CREE-ATE-IVV-IT-TEE'. The marks are identical in

their pronunciation of the word 'project', which forms the last two thirds of the aural element of the application and less than a quarter of the aural element of the opponent's third mark. While 'project' will play significant roles in both marks, I cannot discount the significance of the differences between them, even taking into account the fact that the average consumer tends to focus on the beginnings of marks.³ Therefore, I find that the marks are aurally similar to no more than a medium degree.

Conceptual Comparison

62. I have set out at paragraph 40 above that the word 'project' in the opponent's marks may be seen as a verb and in combination with the word 'WORLDWIDE', it may be seen as meaning to project an image or message around the world. However, I do not consider that a significant proportion of average consumers would identify this meaning and instead, they are more likely to view the word 'project' in the opponent's marks as a noun, meaning 'a piece of planned work that is finished over a period of time that is intended to achieve a particular purpose'. I find that the average consumer will attribute the same meaning to 'PROJECT' in the application. Therefore, 'project' in both parties' marks will convey an identical conceptual message. However, the marks will have points of conceptual differences in the presence of the device element in the application, which will be seen as conductor's hands holding a baton. I do not consider that the average consumer will see any link between this and the word 'PROJECT'. Despite this, it will have a slight impact on the conceptual identity of the application. Further, the words 'WORLDWIDE' (in all of the opponent's marks) and 'CREATIVITY' (in the opponent's third mark only) will also act as points of conceptual difference between the marks. Overall, I find that the application and the opponent's first and second marks are conceptually similar to between a medium and high degree, whereas the application and the opponent's third mark will be conceptually similar to a medium degree.

³ *El Corte Inglés, SA v OHIM* Cases T-183/02 and T-184/02

Likelihood of confusion

63. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

64. I have found some of the goods and services to be identical, some to be similar to a medium degree and some to be dissimilar. I have concluded that the average consumer is either a business user or a member of the general public who will purchase the goods and services by primarily visual means, but I do not discount that an aural component will play a part. I have also concluded that the level of attention paid will be mostly medium but may be higher for some services (such as the parties' class 35 services). I have found that the opponent's marks have between a low and medium degree of distinctive character.

65. I have also found that:

- a. the opponent's first and second marks and the application are visually, aurally and conceptually similar to between a medium and high degree; and
- b. the opponent's third mark and the application are visually similar to a higher than medium degree, aurally similar to no more than a medium degree and conceptually similar to a medium degree.

66. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

Direct Confusion

67. I have found that the word 'PROJECT' will play a greater role in both parties' marks.

I have also found that the application's device element and the words 'THE' in the application and 'WORLDWIDE' and 'WORLDWIDE: CREATIVITY' in the opponent's marks will play a lesser role in their respective marks. Because of imperfect recollection, it is likely that 'PROJECT' is the element of the marks that the average consumer will recall. Taking all of the above factors into account and in light of the principles of imperfect recollection and interdependency, where the services are identical, I consider that the average consumer is likely to mistake the application and the opponent's marks for one another and be directly confused. However, given that the average consumer will pay at least a medium degree of attention during the selection process and that the level of distinctive character of the opponent's marks between a low and medium degree, I do not find that the likelihood of direct confusion will extend to those goods and services that I have found to be similar.

Indirect Confusion

68. If I am wrong in my finding of likelihood of direct confusion, I will now move to consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

"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.”

69. I must now consider the possibility of indirect confusion and whether average consumers would believe that there is an economic connection between the marks or that they are variant marks from the same undertaking as a result of the shared common elements of the marks. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. It is not sufficient that a mark merely calls to mind another mark. This is mere association, not indirect confusion.⁴

70. Even if the words ‘THE’ in the application, ‘WORLDWIDE’ in the opponent’s first and second mark and ‘WORLDWIDE: CREATIVITY’ in the opponent’s third mark are noticed, the word ‘PROJECT’ will still play a greater role in the overall impression of the parties’ marks. As a result, I am of the view that the differences between the marks will be seen by the average consumer as alternative marks from the same or economically linked undertakings. It is also possible that the average consumer will view the different wording as an indication of a sub-brand (such as a range of services that are targeted at a worldwide audience or a range of services that offer creative solutions). Further, the differences in stylisation and presentation of the marks (such as the typeface used and presence of the device element in the application) will be seen as an alternative mark being used by the same or economically linked undertakings where the services are identical.

71. I will now address those goods that I have found to be similar. While the word ‘PROJECT’, being the common element, has between a low and medium degree of distinctive character, even if the distinctiveness of the earlier marks is towards the lower end of that range, this does not preclude a likelihood of confusion: see

⁴ Duebros Limited v Heirler Cenovis GmbH, BL O/547/17

*L'Oréal*⁵. I note that the goods I have found to be similar to a medium degree all share a level of complementarity with the opponent's services. On those goods, even where the differences are noticed, I am of the view that their complementary nature to the opponent's services together with common element of 'PROJECT' will be seen by a significant proportion of average consumers to be alternative marks used by the same or economically linked undertakings. It seems to me that they are likely to assume that printed material (be it advertising or event programmes) are the responsibility of the same undertaking as that supplying the advertising or event planning services, or an economically connected one. Consequently, I consider there to be a likelihood of indirect confusion between the marks, even on those goods that are similar to a medium degree.

CONCLUSION

72. The opposition has succeeded against the majority of goods and services against which it was directed. The application is refused in respect of the following goods and services:

Class 16: Advertisement boards of cardboard; Advertisement boards of paper; Advertisement boards of paper or cardboard; Advertising pamphlets; Advertising posters; Advertising publications; Advertising signs of cardboard; Advertising signs of paper; Advertising signs of paper or cardboard; Events programmes; Events programmes; Flyers.

Class 35: Advertising and marketing services provided by means of social media; Providing business information in the field of social media; Event marketing.

Class 42: Website design; Website design and development.

⁵ *L'Oréal SA v OHIM*, Case C-235/05 P

73. The application can, however, proceed to registration in respect of the following goods and services:

Class 9: Video films.

Class 16: 3D decals for use on any surface; Absorbent paper; Adhesive lettering; Adhesive printed labels; Adhesive stickers; Adhesive transfers; Bags [envelopes, pouches] of paper or plastics, for packaging; Bags made of paper; Bags made of paper for packaging; Bags made of plastics for packaging; Ball pens; Ball point pens; Ballpoint pens; Ball-point pens; Bank checks; Banners of paper; Pamphlets; Paper; Paper banners; Digital printing paper; Display banners made of cardboard; Display banners of paper; Leaflets;

Class 41: Audio and video production, and photography; Audio, video and multimedia production, and photography.

COSTS

74. As the opponent has enjoyed the greater degree of success, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. While the opposition failed against some goods and services at which it was aimed, I do not consider it appropriate to reduce the costs award. In the circumstances, I award the opponent the sum of £700 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the applicant's counterstatement:	£200
Preparing written submissions in lieu:	£300
Official fee:	£200

Total:

£700

75. I therefore order World is Ours Limited to pay Project: Worldwide, Inc the sum of £700. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of October 2020

**A COOPER
For the Registrar**

Annex

The opponent's first mark's specification:

Class 35: Advertising agencies, namely, promoting the goods and services of others; Advertising services, namely, promoting and marketing the goods and services of others through all public communication means; Public relations; Business marketing consulting services; Branding services, namely, consulting, development, management and marketing of brands for businesses; Market analysis and research services; Conducting marketing studies; Direct marketing advertising for others; Customer relationship management; Event planning and management for marketing, branding, promoting or advertising the goods and services of others; Arranging and conducting trade show exhibits for others for commercial and advertising purposes; Business management and business consulting services in the field of event planning for others; Providing marketing and promotion of special events for others; Providing office support staff services, namely, providing administrative and business support services to event organizers and exhibitors at trade shows; Special event planning consultation for commercial, promotional or advertising purposes; Arranging and conducting special events for commercial, promotional or advertising purposes; Publicity and sales promotion services; Business to business direct marketing services; Advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, Internet marketing, mobile marketing, blogging and other forms of passive, shareable or viral communications channels; Consulting services, namely, providing brand marketing, event consulting and production, namely, talent procurement, image consulting, entertainment marketing, audience acquisition, brand activation, experience design,

marketing strategy and planning, graphic design consulting and production, keynote production, branding theme development and messaging, and business project management; Analyzing and compiling business data for event and experiential marketing.

Class 41: Special event planning consultation for social entertainment purposes; Arranging and conducting special events for social entertainment purposes.

Class 42: Design, development, and consulting services related thereto in the field of websites for others; Packaging design for others; Graphic design services; Computer graphics design services, namely, creating animations for others; Designing theme graphics and multimedia shows for trade show exhibits; design of lighting systems for others; exhibit design services for others, namely, design of exhibits, the buildings that contain exhibits, and the display area around the exhibits for brand promotion and consultation services pertaining thereto; visual communication services, namely, integrating graphic art design with facility design; Custom engineering, design, and fabrication of event, conference and trade show displays, exhibit designs, permanent installations and retail pop-up stores.

The opponent's second and third mark's specification

Class 35: Advertising agencies, namely, promoting the goods and services of others; advertising services, namely, promoting and marketing the goods and services of others through all public communication means; public relations; business marketing consulting services; branding services, namely, consulting, development, management and marketing of brands for businesses; market analysis and research services; conducting marketing studies; direct marketing advertising for others; customer relationship management; event planning and

management for marketing, branding, promoting or advertising the goods and services of others; arranging and conducting trade show exhibits for others for commercial and advertising purposes; business management and business consulting services in the field of event planning for others; providing marketing and promotion of special events for others; providing office support staff services, namely, providing administrative and business support services to event organizers and exhibitors at trade shows; special event planning consultation for commercial, promotional or advertising purposes; arranging and conducting special events for commercial, promotional or advertising purposes; publicity and sales promotion services; business to business direct marketing services; advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, shareable or viral communications channels.

Class 41: Special event planning consultation for social entertainment purposes; arranging and conducting special events for social entertainment purposes.

Class 42: Design, development, and consulting services related thereto in the field of websites for others; packaging design for others; graphic design services; computer graphics design services, namely, creating animations for others; designing theme graphics and multimedia shows for trade show exhibits.