

O-516-21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3435234
BY SEATED TECHNOLOGIES, INC.
TO REGISTER THE FOLLOWING TRADE MARK:**

SEATED

IN CLASSES 9, 35, 41, 42 AND 43

AND

**OPPOSITION THERETO UNDER NO. 419714
BY BESEATED INC.**

BACKGROUND AND PLEADINGS

1. On 9 October 2019, Seated Technologies, Inc. (“the applicant”) filed trade mark application number UK00003435234 for the mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 6 December 2019, in respect of goods and services in classes 9, 35, 41, 42 and 43.¹

2. On 6 March 2020, BeSeated Inc. (“the opponent”) filed an opposition opposing the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon United Kingdom trade mark (“UKTM”) no. 3267449, the pertinent details of which are as follows:

Representation:



Filing date: 1 November 2017

Registration date: 26 January 2018

3. The opponent relies upon all the goods and services in its registration in classes 9, 39, 41, 43 and 45.²

4. The mark relied upon by the opponent qualifies as an earlier mark and, given its registration date, is not subject to the proof of use provisions contained in section 6A of the Act.

¹ These will be listed in the goods and services comparison later in this decision.

² As above.

5. Under section 5(2)(b), the opponent claims that the marks at issue are highly similar and that the respective goods and services are identical or similar, resulting in a likelihood of confusion.

6. The applicant filed a defence and counterstatement denying a likelihood of confusion on the basis that there is insufficient similarity between the marks and the goods and services.

7. Neither party filed evidence. A hearing took place before me on 27 April 2021, by video conference. The applicant was represented by Mr Leighton Cassidy of Fieldfisher LLP. The opponent did not attend, nor did it file submissions in lieu of attendance.

8. The opponent is represented by Beck Greener LLP; the applicant is represented by Fieldfisher LLP.

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

Section 5(2)(b)

10. Section 5(2)(b) of the Act states that:

“A trade mark shall not be registered if because –

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

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

Relevant law

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

The principles

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

12. The competing goods and services are shown in the table below:

Earlier mark	Contested mark
Class 9: Mobile applications for booking; Mobile software; Mobile apps; Downloadable mobile applications.	Class 9: Downloadable applications for mobile phones and tablets for making reservations and booking of seats and

<p>Class 39: Travel booking agencies; Booking of transportation; Booking of transportation via a website; Rental, booking and providing of airplanes; Rental, booking and providing of yachts.</p> <p>Class 41: Entertainment booking services; Ticketing and event booking services.</p> <p>Class 43: Booking of restaurant seats; Hotel room booking services.</p> <p>Class 45: Security services for the protection of individuals.</p>	<p>spaces at restaurants, bars, hotels, hospitality establishments and at entertainment, sporting, culinary and cultural events; downloadable applications for mobile phones and tablets for providing information in the field of reservations and booking of seats and spaces at restaurants, bars, hotels, hospitality establishments and at entertainment, sporting, culinary and cultural events; downloadable applications for mobile phones and tablets for providing information in the field of restaurants, bars, hotels, hospitality establishments and at entertainment, sporting, culinary and cultural events; downloadable applications for mobile phones and tablets for providing reviews and ratings of restaurants, bars, hotels, hospitality establishments and at entertainment, sporting, culinary and cultural events.</p> <p>Class 35: Administration of a consumer loyalty program to promote the goods and services of others; administration of a consumer loyalty program to reward consumers for using and participating in the restaurants, bars, hotels, hospitality establishments and entertainment, sporting, culinary and cultural events of others; advertising the goods and services of others; providing online</p>
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	<p>business directories featuring restaurants, bars, hotels, hospitality establishments and entertainment, sporting, culinary and cultural events.</p> <p>Class 41: Entertainment ticket agency services; providing services for making reservations and booking of seats and spaces at entertainment, sporting, culinary and cultural events; providing information in the field of reservations and booking of seats and spaces at entertainment, sporting, culinary and cultural events.</p> <p>Class 42:³ Providing online software for making reservations and booking of seats and spaces at restaurants, bars, hotels, hospitality establishments and at entertainment, sporting, culinary and cultural events; providing online information in the field of reservations and booking of seats and spaces at entertainment, sporting, culinary and cultural events; providing online reviews and ratings in the field of reservations and booking of seats and spaces at entertainment, sporting, culinary and cultural events.</p>
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³ It appears that some of the services in class 42 have been misclassified. However, this has no impact on my decision since class headings are irrelevant to the comparison I am required to make.

	<p>Class 43: Providing services for making reservations and booking of seats and spaces at restaurants, bars, hotels, hospitality establishments; providing information in the field of reservations and booking of seats and spaces at restaurants, bars, hotels and hospitality establishments; providing online information in the field of restaurants, bars, hotels and hospitality establishments; providing online reviews and ratings of restaurants, bars, hotels and hospitality establishments.</p>
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13. The opponent has not made any specific submissions on the similarities or differences between the parties' specifications. The applicant, in its skeleton arguments and at the hearing, drew detailed comparisons between the two specifications. I have borne them in mind and will refer to them, where necessary, in my decision.

14. In *Gérard Meric v Office for Harmonisation in the Internal Market* ("OHIM"), Case T-133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur 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 the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

(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.

16. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, the court stated at paragraph 23 of its judgment that:

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

17. 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/services. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is 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”.

18. For the purpose of assessment, I will group the applicant’s goods and services together where I consider they are susceptible to common reasoning.⁴

The applicant’s class 9 goods

19. The applicant’s class 9 goods are all downloadable applications for mobile phones. Despite their limitations, they fall within the opponent’s wider term “downloadable mobile applications”. I find the parties’ class 9 goods identical in accordance with *Meric*.

The applicant’s class 35 services

20. Given the shared field of trade (i.e. hospitality), there is a slight overlap between the applicant’s “administration of a consumer loyalty program to reward consumers for using and participating in the restaurants, bars, hotels, hospitality establishments and entertainment, sporting, culinary and cultural events of others” and the opponent’s “Entertainment booking services”, “Ticketing and event booking services”, “Booking of restaurant seats” and “Hotel room booking services”. However, applying the above case law, the nature of these services differs, as does the purpose and method of use. The way in which these services reach the market is not the same, so there is also no overlap in trade channels. There is a possibility that the users will overlap in that a consumer may book an event, hotel or restaurant and also access the venue or service provider’s associated loyalty program for rewards. I think it is entirely plausible for consumers to expect to book services in the hospitality industry and access rewards for doing so via a loyalty program at the same time, with the same undertaking. I therefore consider there to be a complementary relationship between these services. Taking everything into consideration, I consider there to be a medium degree of similarity between these services.

⁴ As per the decision of Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, in *Separode Trade Mark* BL O/399/10.

21. Similarly to the previous paragraph, given the shared field of trade, there is also an overlap between the applicant's "providing online business directories featuring restaurants, bars, hotels, hospitality establishments and entertainment, sporting, culinary and cultural events" and the opponent's "Entertainment booking services", "Ticketing and event booking services", "Booking of restaurant seats" and "Hotel room booking services". Again, the nature of these services differs, as does the purpose and method of use. There is also no overlap in trade channels. However, there is a possibility that the users will overlap in that a consumer may access an online business directory prior to booking an event, hotel or restaurant. Unlike the previous paragraph, I am not of the view that these services are complementary in the way described in *Kurt Hesse*; I do not believe consumers will consider a business directory that lists hospitality venues and the hospitality venues themselves to be provided by the same undertaking. In light of the foregoing, I find a low degree of similarity between these services.

22. I do not see any obvious similarity between the applicant's "Administration of a consumer loyalty program to promote the goods and services of others" and "advertising the goods and services of others" and any of the opponent's goods or services. Absent any submissions from the opponent, I find no similarity.

The applicant's classes 41, 42 and 43 services

23. The applicant's "Entertainment ticket agency services" and "providing services for making reservations and booking of seats and spaces at entertainment, sporting, culinary and cultural events" are identical to the opponent's "Entertainment booking services" and "Ticketing and event booking services". These terms are not worded identically, but the premise is the same: making reservations or bookings, or booking tickets, for events. In case I am wrong in this finding, I consider the applicant's services to fall within the opponent's wider terms, resulting in identity in accordance with *Meric*. The same reasoning applies to the applicant's "Providing services for making reservations and booking of seats and spaces at restaurants, bars, hotels, hospitality establishments" and the opponent's "Entertainment booking services", "Booking of restaurant seats" and "Hotel room booking services". I find these services identical.

24. I consider the applicant's "providing information in the field of reservations and booking of seats and spaces at entertainment, sporting, culinary and cultural events" to be complementary to the opponent's "Entertainment booking services" and "Ticketing and event booking services". Consumers are likely to believe that if they require information regarding making reservations or bookings for events, that information is provided by the same undertaking with which they would make those reservations or bookings. Whilst the nature and purpose of these services is different in that the applicant's services provide information and the opponent's services allow consumers to make bookings, there is an overlap in the purpose of those services, and so will there be an overlap in user and method of use. I consider these services to be similar to a high degree.

25. Despite being in a different class, the only difference between the applicant's "providing information in the field of reservations and booking of seats and spaces at entertainment, sporting, culinary and cultural events" in class 41 and its "providing online information in the field of reservations and booking of seats and spaces at entertainment, sporting, culinary and cultural events" in class 42 is that the latter specifies the information is provided online. Therefore, I consider the same reasoning as applied in my paragraph 24 applies here. These services are similar to a high degree to the opponent's "Entertainment booking services" and "Ticketing and event booking services". The same applies to the applicant's "providing information in the field of reservations and booking of seats and spaces at restaurants, bars, hotels and hospitality establishments" and "providing online information in the field of restaurants, bars, hotels and hospitality establishments" in class 43 and the opponent's "Booking of restaurant seats" and "Hotel room booking services", which I find similar to a high degree.

26. It is my view that consumers, after attending an event, often return to the service provider with which they made a booking or reservation to provide a review or rating. For this reason, I find the applicant's "providing online reviews and ratings in the field of reservations and booking of seats and spaces at entertainment, sporting, culinary and cultural events" and the opponent's "Entertainment booking services" and "Ticketing and event booking services" will overlap in users. However, the nature of

these services differs, as does the purpose and method of use. The way in which these services reach the market is not the same, so there is also no overlap in trade channels. Taking everything into consideration, I consider there to be a low degree of similarity between these services. The same reasoning applies to the applicant's "providing online reviews and ratings of restaurants, bars, hotels and hospitality establishments" and the opponent's "Booking of restaurant seats" and "Hotel room booking services".

27. Finally, I come to the applicant's "Providing online software for making reservations and booking of seats and spaces at restaurants, bars, hotels, hospitality establishments and at entertainment, sporting, culinary and cultural events", which I will compare to the opponent's "Mobile software" in class 9. Mobile software is purchased by the user as a one-off and downloaded to their device (a mobile phone). It is stored on the device and used for as long as needed. Providing online software for reservations and bookings, for example, is not the software itself, but a service offered by the provider who updates and upgrades the software. It is not stored on the user's device; it is a service accessed via a different method (i.e. a web browser). For this reason, the applicant's services and the opponent's goods differ in method of use and nature. There is an overlap in purpose, which is limited only in that the goods and services generally relate to software. The trade channels for software as a product and providing online software as a service may overlap, and so may the users. Consumers may think the provision of online software is provided by the same undertaking from whom they can download software onto their phone, resulting in a complementary relationship. Taking everything into account, I find the applicant's "Providing online software for making reservations and booking of seats and spaces at restaurants, bars, hotels, hospitality establishments and at entertainment, sporting, culinary and cultural events" and the opponent's "mobile software" similar to a medium degree.

The average consumer and the nature of the purchasing act

28. It is necessary for me to determine who the average consumer is for the goods and services in question; I must then determine the manner in which the goods and services are likely to be selected by the average consumer in the course of trade.

29. 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.

30. 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.”

50. Mr Muir Wood, in his skeleton arguments and at the hearing, submitted that the average consumer is likely to be a professional in the case of the applicant's goods and services and a professional or member of the public in the case of the proprietor's goods and services, all of whom will pay a high degree of attention to the selection. Mr Harris, at the hearing, agreed that the average consumer is likely to be a consumer within a business. He submitted that there is a wide range of potential consumers, who could pay anything from a low to a significant level of attention, but that the most important group is the one paying a low attention.”

31. The relevant goods and services are those for which I have found similarity (or identity). I consider the average consumer of those to be a member of the general public or a business either looking to make reservations or bookings within the hospitality industry or to access associated services such as directories and review websites. Bookings for restaurants or events, for example, are made fairly frequently.

The purchase will be considered to the extent that consumers will want to ensure they are booking the correct venue. For restaurants and bars, consumers will take into consideration factors such as type of cuisine offered, previous reviews and speed of service. For entertainment and events, for example, consumers will consider location of seats, time and duration of events and ticket cost. Mobile software and applications are used frequently and often without much consideration, given the ease with which applications can be downloaded (often for free) and then deleted again. Overall, the goods and services will vary in cost and frequency of purchase. The average consumer is likely to pay a medium degree of attention during the purchasing process.

32. The goods and services are likely to be purchased by self-selection from websites, mobile applications or via printed adverts. I consider the purchasing process to be predominantly visual, however, given that word-of-mouth recommendations might be made, and bookings can be made via telephone, I do not discount an aural component.

Comparison of marks


33. It is clear from *Sabel* 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. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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 trade

marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

35. The trade marks to be compared are as follows:

Earlier mark	Contested mark
	SEATED

36. The opponent, in its statement of grounds, submitted that the contested mark is highly similar to its earlier mark. At the hearing, Mr Cassidy, for the applicant, made detailed submissions on the comparison of the marks. I have taken them into account and will refer to them where necessary in my decision.

Overall impression

37. The contested mark consists of the plain word SEATED, in upper case, the overall impression of which lies in the word itself. The earlier mark consists of a black and gold oval device, contained within which are both non-verbal and verbal elements: a gold table and two chairs towards the top of the oval and the word BESEATED in a black standard font at the bottom. The oval device is underlined by a thin black line. BESEATED will most likely be seen as the ordinary dictionary words BE and SEATED, conjoined. The device, being the largest element in the mark, is dominant; a slightly weaker role is played by the word BESEATED. The oval is simply decorative and acts as a background to the other components. The underlining of the mark is unlikely to be given any significance.

Visual comparison

38. Visually, the similarity between the marks rests in the letters S-E-A-T-E-D, which is the entirety of the contested mark. The fact that none of the remaining elements of the earlier mark are present in the other creates multiple visual differences. The earlier mark contains a figurative device of a table and chairs, a black and gold oval and the additional letters B and E that have no counterpart in the earlier mark. I consider there to be a low degree of visual similarity.

Aural comparison

39. The contested mark will be pronounced as the two-syllable English word SEATED. The earlier mark will be pronounced as the two English words BE and SEATED, forming three syllables. The figurative elements of the earlier mark are unlikely to be articulated. Overall, I find a medium degree of aural similarity.

Conceptual comparison

40. Mr Cassidy for the applicant, at the hearing, submitted as follows:

“From a conceptual perspective, the earlier mark “BESEATED” has a meaning. It means to “assume a sitting position” or a command to “sit down”. We would say that someone who is asked to be seated would not be confused as to what they were instructed to do, whereas “SEATED” as a verb in the past tense, its normal meaning would be for talking about arrangements for someone to sit somewhere. As to a phrase on a plane, “She was seated in Business Class” could be an example of how it is used in the everyday vernacular. We say, with the different meanings being understood by the relevant public, it gives rise to conceptual differences between the marks, and therefore the earlier mark and the sign have a medium to low degree of conceptual similarity.”

41. I agree somewhat with Mr Cassidy: BESEATED is likely to be seen as a command or invitation to sit down (the table and chairs device reinforces that concept), whereas SEATED will not. However, this creates only a minor conceptual difference. Both

marks will conjure, in the mind of consumers, the thought of someone sitting down, whether that is as a result of being invited to sit, or not. There is a high degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

42. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* 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).”

43. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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 that has been made of it.

44. With no evidence of use of the earlier mark from which to make an assessment as to an enhanced distinctive character, I have only the inherent position to consider. As I found earlier in this decision, BESEATED is likely to be seen as the two words BE and SEATED, conjoined, which is a common command or invitation to sit, particularly in the hospitality industry. The earlier mark, containing BESEATED and a device of a table and chairs, is allusive for the majority of the goods and services for which it is registered, and I find it has a lower than average degree of inherent distinctive character.

Likelihood of confusion

45. 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 opponent's trade mark, the average consumer for the 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.

46. I have found the marks to be visually similar to a low degree, aurally similar to a medium degree and conceptually highly similar. I have found the earlier mark to have a lower than average degree of inherent distinctive character. I have identified the average consumer to be either a member of the general public or a business who will

purchase the goods and services predominantly by visual means, though I do not discount an aural element to the purchase. I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the goods and services to vary in similarity from dissimilar to identical.

47. I will carry out my assessment on the basis of those goods and services which are identical, as if there is no likelihood of confusion in respect of those, it follows that there will be no likelihood of confusion in respect of those goods and services which share a lesser degree of similarity.

48. I bear in mind the decision of the CJEU in *L'Oreal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion. However, it is clear from the judgment of the CJEU in *Lloyd* (cited above), that descriptive matter should be given less weight when comparing trade marks. Further, I bear in mind the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O/075/13. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

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

49. In my view, the distinctiveness of the earlier mark does not lie in the use of the word SEATED but in the conjoining of SEATED with the word BE and the figurative components.

50. Because the common element of the marks is allusive for the goods and services, greater weight will be attributed to the remaining elements of the mark. The contested mark is the word SEATED by itself. However, the earlier mark combines different elements with the word SEATED and in a different form (with the letters BE at the beginning of the earlier mark and the figurative components). Whilst the marks may have highly similar conceptual meanings, the visual differences are sufficient to differentiate between them. In particular, the average consumer will not misremember the additional letters BE at the start of the earlier mark since the beginnings of marks tend to have more impact than the ends.⁵ Notwithstanding the principle of imperfect recollection, I consider that the different additional elements in the marks will be sufficient to enable the consumer to differentiate between them. I do not, therefore, consider that there is a likelihood of direct confusion.

51. I will now 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.*⁶

“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 recognised 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’.

⁵ See *El Corte Inglés SA v OHIM*, cases T-183/02 and T-184/02 at paragraphs [81]-[83].

⁶ BL O/375/10.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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

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

52. If the consumer recognises the differences between the marks, I see no reason why the average consumer would assume that the marks come from the same or economically linked undertakings. The common element – the word SEATED – is allusive for the goods and services at issue. The consumer is unlikely to believe that only one undertaking would use the word SEATED in relation to those goods and services. The additional letters BE are not logical with a rebranding or brand extension and I consider it more likely that consumers will think it a coincidence that two undertakings use the word SEATED in their marks. I do not, therefore, consider there to be a likelihood of indirect confusion.

CONCLUSION

53. The opposition has failed under section 5(2)(b) and the application can proceed to registration.

COSTS

54. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. I assess these as follows:

Preparing a statement and considering the other side's statement	£200
Preparing for and attending a hearing	£400
Total	£600

55. I therefore order BeSeated Inc. to pay Seated Technologies, Inc. the sum of £600. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 7th day of July 2021

E VENABLES

For the Registrar