

O/548/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003394691
IN THE NAME OF MARSTON (HOLDINGS) LIMITED
FOR THE FOLLOWING TRADE MARK:



IN CLASSES 9, 35, 36, 37, 38, 39, 41, 42 AND 45

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 503264 BY
APCOA PARKING HOLDINGS GMBH

BACKGROUND AND PLEADINGS

1. Marston (Holdings) Limited (“the proprietor”) applied to register the trade mark shown on the front page of this decision (“the contested mark”) in the UK on 25 April 2019. It was registered on 26 July 2019 for the goods and services listed in **Annex 1** of this decision.
2. On 31 July 2020, APCOA Parking Holdings GmbH (“the applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon section 5(2)(b) of the Act and relies on the following trade marks:

FLOW

EUTM: 17883605¹

Filing date 4 April 2018; registration date 15 August 2018

(“the applicant’s first mark”);



EUTM: 17770124

Filing date 2 February 2018; registration date 6 June 2018

(“the applicant’s second mark”)

3. The applicant relies on all of the goods and services for which its marks are registered. Save for the inclusion of the term “card reading equipment” twice in the applicant’s first mark’s specification, the marks’ specifications are identical and I will treat them as such throughout the decision. The applicant’s goods and services are set out in **Annex 2** of this decision.

¹ Although the UK has left the EU and the EUTM relied upon by the applicant now enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the application on the basis of the law as it stood at the date of application

4. The applicant claims that as a result of the similarity of the marks and the identity/similarity of the parties' goods and services, there exists a likelihood of confusion. The proprietor filed a counterstatement denying the claims made.
5. Neither party filed evidence. A hearing took place before me on 3 June 2021, by video conference. The applicant was represented by Nigel Parnell of Laytons LLP, who have represented the applicant throughout these proceedings. The proprietor was represented by Michael Edenborough QC of Serle Court Chambers, instructed by AA Thornton & Co, who have represented the proprietor throughout these proceedings. Both parties filed skeleton arguments in advance of the hearing.
6. 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.

PRELIMINARY ISSUE

7. I note that the applicant's first mark is currently the subject of invalidation proceedings filed at the European Union's Intellectual Property Office ("the EUIPO) meaning that it is possible that the applicant's first mark is removed from the EUIPO's trade mark register. Therefore, in the event that this decision is reliant upon the applicant's first mark only, it can only be provisional subject to the successful defence of the invalidation application brought against that mark. I will return to this point below, if necessary.

DECISION

8. Section 5(2)(b) has application in invalidation proceedings pursuant to section 47 of the Act, which reads as follows:

"47. (1) [...]"

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) [...]

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2DA) [...]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

9. 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.”

10. 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.”

11. The applicant’s trade marks qualify as earlier marks under the above provisions. The applicant’s marks had not completed their registration process more than 5 years before the date of the application for invalidity. The use conditions do not, therefore, apply to these marks and the applicant can rely upon all goods and services identified in its Notice of Invalidity.

12. 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

13. The proprietor's and the applicant's goods and services are listed in Annex 1 and Annex 2 of this decision, respectively.

14. 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 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.”

15. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation 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.”

17. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

18. During the hearing, both parties made substantial submissions in respect of the goods and services comparison. While I do not intend to address the bulk of those submissions here, I do consider it necessary to address some of the submissions made by the proprietor at the hearing. The proprietor submits that the case of *Meric* is not binding on the decisions of the Tribunal on the basis that it is a GC case and not part of the law of England and Wales. While these submissions are noted, I refer to point 1.2 of the Tribunal Section of the Trade Mark Manual which states:

“The Trade Marks Act 1994 is largely derived from EU law (Directive 2015/2436). In relation to the interpretation of such retained law, the case law of the Court of Justice of the European Union (including the General Court) issued before the end of the transition period continues to apply, and is binding, as retained EU case law under section 6 of the Withdrawal Act. Furthermore, although not binding, regard can still be had to judgments made by the EU Court after the end of the transition period. However, the power to diverge from retained EU case-law has been vested in the Supreme Court, the High Court of Justiciary in Scotland, and various appeal courts, including the Court of Appeal, whose decisions are binding on the tribunal.”

19. I also refer to submissions made by the proprietor in respect of the case of *Meric* that:

“if the earlier mark is only registered for a very narrow range of goods and services and the later application is being sought for a much wider range of goods and services then identity can only properly and logically be considered to equate to the earlier narrow goods and services. It cannot as a matter of logic or even as a plain usage of the English language be considered that that earlier narrow range of goods and services is identical to the full width of the wider, broader, later, application and so, therefore, the earlier one may be useful to knock a hole in the later, general specification and there may be a penumbra around that hole which is reasonable to consider to be similar but it is not a fatal identity knock out.”

20. While these submissions are noted, the wording of *Meric* and its application before the Tribunal is that, as set out above, goods or services can still be considered identical if one term falls within the scope of another and vice versa. This means that, contrary to the proprietor's submissions, it is possible to find identity between goods and services where the proprietor's term falls within the applicant's broader term and vice versa. However, at the hearing, I set out that, where I consider it appropriate, I will bear in mind Tribunal Practice Notice ("TPN") 1/2012² which states at paragraphs 3.2.2(b) to (d) that:

"In a case where amendment to the specification(s) of goods and/or services is required as a result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her

² <https://webarchive.nationalarchives.gov.uk/20140714074028/http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-tpn/p-tpn-2012/p-tpn-12012.htm>

findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.

d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of *Giorgio Armani SpA v Sunrich Clothing Ltd* (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered "men's and boys' clothing", thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not be reflected in changes to the specification via either the 'blue pencilling' approach or the 'save for' type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal."

21. It is important to bear in mind that the above only applies insofar as any proposed amendment is clear and avoids a likelihood of confusion between the goods or services, in the event that such a likelihood does exist. Further, I bear in mind paragraph (d) above in that it may be disproportionate to embark on formulating proposals which are unlikely to result in a narrow specification of any substance.

Finally, it is necessary to point out that it is not the purpose of this decision to forensically dissect and amend any specification to the point where no likelihood of confusion exists. Any assessment reliant upon TPN 1/2012 cannot be made until the conclusion of this decision, therefore, where necessary I will address this point in my final remarks below.

22. As for the remaining submissions in respect of the goods and services comparison, I will refer to these below, where necessary.

Class 9 goods

Cameras; video cameras; CCTV systems; webcams; electronic publications and material downloadable from a website or the internet; devices and equipment incorporating terminals for electronically processing credit, debit card or store value card payments; terminals for the electronic payment of charges by credit card; electronic data management; recorded tapes, discs, cassettes, cinematographic films; video cassettes and recorded video cassettes; DVDs, CD ROMs; information stored on electronic magnetic and/or optical means; motorway toll-booth apparatus; electronic systems for the automatic generation of information messages relating to motorway traffic; electronic toll systems; electronically controlled access barriers; electronic video systems for object and symbol recognition and object tracking; electronic toll and fee systems and installations; electronic communication and charging apparatus for on-board vehicle operation (on-board units) for communication with electronic toll and fee systems and installations; workforce management software.

23. In respect of “cameras”, “video cameras”, “CCTV systems” and “webcams” in the proprietor’s specification, the applicant submits that they are identical and/or similar to “apparatus for the transmission of data” and/or “devices for automated parking checks and number plate recognition” in the applicant’s marks’ specifications. I do not consider this to be the case. While the proprietor’s goods can be various types of digital cameras that generate data when recording, I do not consider this to be the same as apparatus that transmit data. For example, I consider that an apparatus for the transmission of data will be goods such as cables through which the data is transmitted or, for wireless transmission, some form of router, satellite

or Bluetooth device. Further, while video cameras may be fitted with a device for automated parking checks and number plate recognition, this is not the same good as the video camera itself. On this point, I am reminded that just because one good may be a component or part of another good, it does not warrant, in itself, a finding of similarity between those goods.³ I see no obvious levels of similarity between the proprietor's goods and any of the goods or services in the applicant's specification. Therefore, I consider these goods to be dissimilar.

24. I have given consideration as to whether "recorded tapes, discs, cassettes, cinematographic films", "video cassettes and recorded video cassettes" and "DVDs, CD ROMs" in the proprietor's specification share any similarity with "apparatus for the transmission of data" in the applicant's marks' specifications. A DVD or video cassette, for example, are goods that may contain some form of data but are not used to transmit data itself. Further to my finding above regarding the type of goods that the applicant's term covers, I do not consider that these goods share any obvious level of similarity with the applicant's term nor, for that matter, any of the remaining goods or services in the applicant's specifications. These goods are, therefore, dissimilar.

25. While the applicant's specifications contain a number of different types of software, I do not consider that any of these goods have any obvious level of similarity with "electronic publications and material downloadable from a website or the internet" in the proprietor's specification. Electronic publications are not types of software and while material downloadable from a website or the internet is a vague term, I do not consider that the plain reading of the term covers software. In my view, downloadable material covers goods such as downloadable videos, music or different types of electronic publications such as training manuals and spreadsheets. While software is required to open the proprietor's goods, I do not consider this gives rise to any finding of similarity, especially given the specific nature of the applicant's software related goods. On that basis, I consider these goods to be dissimilar.

³ *Les Éditions Albert René v OHIM*, Case T-336/03

26. The applicant submitted that “devices and equipment incorporating terminals for electronically processing credit, debit card or store value card payments” and “terminals for the electronic payment of charges by credit card” in the proprietor’s specification were identical/similar to “apparatus for the transmission of data” and “computer software and software for automated calculation and payment services” in the applicant’s marks’ specifications. While I see no obvious level of similarity between the former goods of the applicant, I agree that there is a level of similarity with the latter goods. The proprietor submits that its goods are payment terminals like those that a waiter brings to the customer so they can pay via credit or debit card. I agree with these submissions. While these devices are commonly used with payment terminals, it is also becoming increasingly common for such devices to be compatible with portable computer tablets or mobile phones, particularly by smaller traders/retailers to allow them to take card payments. Regardless of whether the payment is taken on a traditional till or through a tablet or mobile phone, the computer apparatus will require use of computer software to work. This software is likely to be supplied on a CD, DVD or downloaded onto the user’s device. Firstly, given the specific purpose of the applicant’s goods, I find that there is an overlap in user in that a user of payment terminals is also a user of the software that accompanies it, and purpose in that both goods are used to facilitate payments. Secondly, I consider that the goods share a complementary relationship on the basis that the average consumer will consider that these goods are important to each other and that they are provided by the same undertaking.⁴ Overall, I find that these goods are similar to a medium degree.

27. I have no submissions as to what “electronic data management” in the proprietor’s specification covers. As it is a good in class 9, I am of the view that it can either be a physical device or software that is used to manage data. Regardless, it is a good that assists the user by storing and organising data for the purpose of security and ease of use. It does not, in my view, involve the transmission of data. While both goods are used for data purposes, I consider any overlap to be very broad. Further, there may be a superficial overlap in user on the basis that a user of a device for storing data will need to transmit the data to that device via cables or wireless

⁴ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

transmission devices. However, any overlap in user is superficial given the very wide user bases for both sets of goods. I do not consider the limited overlap in user and purpose to be sufficient to warrant a finding of similarity between the goods. As a result, I consider these goods to be dissimilar. However, if I am wrong in this finding, they will be similar to a very low degree.

28. "Information stored on electronic magnetic and/or optical means" in the proprietor's specification covers information stored on a magnetic card. If a user was buying this good, it would be purchasing a magnetic card that would include electronically recorded data. As a result, I am of the view that this term describes the same good as "cards bearing electronically recorded data" in the applicant's marks' specifications. Therefore, I find these goods to be identical.

29. "Electronic systems for the automatic generation of information messages relating to motorway traffic" is a good that can be said to relate to traffic management, which is a service for which the applicant is registered in its class 39 services. An undertaking providing traffic management services is, in my view, not likely to provide these goods themselves. However, I do consider there to be an overlap in purpose in that the purpose of the respective goods and services is similar. Further, I also consider there to be an overlap in user in that a user seeking to provide information about traffic is also likely to seek traffic management services. While these goods and services do not overlap in nature or method of use, nor are they competitive or complementary to one another, I consider them similar to a low degree.

30. "Motorway toll-booth apparatus", "electronic toll systems" and "electronic toll and fee systems and installations" in the proprietor's specification all relate to toll roads, which are roads that require a fee to permit passage to the user. I do not consider that the same level of overlap in user and purpose between the goods and services set out at paragraph 29 above will apply to these goods. This is because a user of motorway toll-booth apparatus may not be using these goods for traffic management purposes but, instead, to generate income to allow for the

maintenance and upkeep of the road or bridge for which the toll is required. As a result, I consider these goods and services to be dissimilar.

31. “Electronically controlled access barriers” in the proprietor’s specification are goods that can be used for parking garages. In my view, there is a level of similarity between these goods and “computer applications for automated vehicle parking control” and “devices for automated parking checks and number plate recognition” in the applicant’s marks’ specifications. All of these goods can be used for the running and functioning of car parks. As a result, I consider there to be an overlap in purpose and nature. When such goods are used in car parks, they will be used by car park operators meaning that there is also an overlap in user. Further, the goods may also be supplied by the same provider meaning that there is also an overlap in trade channels. Finally, I consider that the goods may all be used together meaning that there is a level of complementarity between them. For example, an electronically controlled access barrier to a car park is likely to include a computer application within it that provides automatic vehicle parking control (such as staggering the intake of cars if the car park is busy) and also will include a device for conducting parking checks and number plate recognition (cars, when entering car parks are commonly scanned for their vehicle registration number – which is then printed on the ticket). In my view, the average consumer will consider these goods important to one another and that an undertaking responsible for one, is likely responsible for the others. Overall, I consider these goods to be similar to a high degree.

32. The proprietor accepted at the hearing that there was some level of similarity between “electronic video systems for object and symbol recognition and object tracking” with the applicant’s goods. I agree and consider these goods to be similar to “computer programs and software for recognising and identifying vehicles and numberplates” in the applicant’s marks’ specification on the basis that both goods can be used for the identification of number plates. While the goods are not identical due to the fact that the nature of the goods differ, they do overlap in user and purpose. Further, I consider the goods to be complementary to one another in that computer software for recognising and identifying numberplates is important and indispensable for the electronic video system for the recognition and

identification of objects and symbols (which, in my view, in the context of these goods, can be said to be the same as the recognition of numberplates) and the average consumer is likely to consider that the undertaking responsible for one will also be responsible for the other. There is also an overlap in trade channels in that an undertaking that provides one is likely to provide the other. Overall, I consider that these goods are similar to a high degree.

33. In my view, “electronic communication and charging apparatus for on-board vehicle operation (on-board units) for communication with electronic toll and fee systems and installations” in the proprietor’s specification describes a system wherein a user has a small device that is kept within their vehicle so that they may use a separate fast lane instead of queuing for toll booths. At the toll booth or at the barrier, there is also a small device which monitors when the user is passing through. When the user passes through the designated lane, the device in the vehicle will communicate with the device in the toll booth and the user will automatically be charged the appropriate fee. The applicant submits that these goods are identical or highly similar to “RFID chips”, “computer programs and software for detecting and identifying mobile communications devices and radio frequency identification tags (RFID)” and “computer software and software for automated calculations and payment services” in the applicant’s marks’ specification. I do not consider the goods to be identical, however, I do consider there to be a level of similarity between them. I have set out above that the fact that just because one good may form a part of another good, it is not sufficient for a finding of similarity between them. While that is the case, I consider that there are additional levels of similarity between these goods such as an overlap in user and purpose. Further, there is a complementary relationship between them in that an average consumer who uses the proprietor’s goods will consider that the software that operates the system, takes payment and the chip within the device are important and indispensable to each other. The average consumer will also consider that the undertaking responsible for one of these goods is responsible for all of the others. There is also an overlap in trade channels as an undertaking that provides one of these goods will likely provide all of them. Overall, I consider that these goods are similar to a high degree.

34. The applicant submits that “workforce management software” in the proprietor’s specification is vague and covered software embedded in apparatus used for tracking employees that work in large warehouses, for example. The applicant submits that these goods are similar to the various types of software for which the applicant’s marks are registered. I disagree with these submissions. Instead, I consider workforce management software to be software that assists companies in planning and managing their workforce. For example, this software can be used to create and monitor employee rotas, annual leave, sick leave and overtime. I do not consider it to be a vague term as it is a widely used type of software by businesses with large workforces. I do not consider that there is any obvious level of similarity with any of the applicant’s goods and/or services. Therefore, I find these goods to be dissimilar.

Class 35 services

Data processing and data transfer services; business consultancy relating to automation processes; information and consultancy in relation to organisation and management of businesses and in relation to business matters; compilation, systemisation, updating and maintenance of data in computer databases; computerized file management; data search in computer files for others; compilation of data, in particular image, audio and / or video data in computer databases; provision of management services; assistance and consultancy relating to business management and organisation; provision of commercial information; commercial and consumer information services; provision of data and information relating to visitor attendances or visitor numbers at commercial locations, events or the like; management assistance services; business supervision services; business information services; project management services in association with regeneration, transportation, construction or civil engineering projects; logistical management and support services; services relating to the sourcing and procurement of materials, goods and services; supervision and management of sub-contractors; advertising, marketing and promotional services; data processing; information services relating to data processing; provision of management or administrative assistance to others in the operation of data processing equipment or apparatus; the provision of managerial

or administrative assistance in the operation of equipment for the acquisition of data; advisory services and the provision of information and the preparation of reports, all relating to the aforesaid services; advisory and consultancy services in connection with all the aforesaid services.

35. The proprietor submits that there is some level of similarity between the proprietor's service of "data processing and data transfer services" and the applicant's services. While this submission is noted, I consider that this service, together with "data processing" in the proprietor's specification is identical to "data processing for the collection of data for business purposes" in the applicant's marks' specifications. This is on the basis that the applicant's terms fall within the broader term contained within the proprietor's specification. Therefore, these goods are identical under the principle outlined in *Meric*.

36. I also note that the proprietor's specification consists of the service of "information services relating to data processing". I am of the view that when an undertaking provides the service of "data processing for the collection of data for business purposes" as contained in the applicant's marks' specifications, information will also be provided with that service. This is on the basis that the user seeking that service will also expect to be provided with information relating to the data that is being processed on their behalf. As a result, I consider that the applicant's service falls within the proprietor's service meaning that these services are identical under the principle outlined in *Meric*.

37. In my view, "business consultancy relating to automation processes" in the proprietor's specification could include consultancy in relation to the automation process of a car park such as automated monitoring of parking and automated payment of parking fees. As a result, I consider there to be a level of similarity with "professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations" in the applicant's marks' specifications. Given they are both business consultancy services, they overlap in nature. I also consider there to be an overlap in purpose in that both can relate to the operation of car parks. On this same basis, there is an overlap in user also. Finally, I consider there to be an overlap in trade

channels in that a business consultancy provider may provide both types of services. Overall, I consider there to be a high degree of similarity between these services.

38. Given that “information and consultancy in relation to organisation and management of businesses and in relation to business matters” in the proprietor’s specification and “business management and professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations” in the applicant’s marks’ specifications both covers types of consultancy services, it can be said that they overlap in nature and method of use. Further, I consider there to be an overlap in purpose in that both services can relate to businesses operating in the car park sector. There is also likely to be a competitive relationship between the services in that the user may seek the consultancy services of the applicant over that of the proprietor and vice versa. There is also an overlap in trade channels in that a provider of one service is also likely to provide the other. Overall, I consider these services to be similar to a high degree.

39. In my view, “data processing for the collection of data for business purposes” in the applicant’s marks’ specifications is a very broad service. While “compilation, systemisation, updating and maintenance of data in computer databases”, “data search in computer files for others” and “compilation of data, in particular image, audio and / or video data in computer databases” in the proprietor’s specification are not services that are qualified expressly as being for business purposes, they can cover them. Further, I consider the compilation, systemisation, updating and maintenance of data is data processing. Given that all of these services relate to data, it can be said that they overlap in nature. Further, I am of the view that they overlap in trade channels in that an undertaking providing data related services is likely to provide all of these types of services. Insofar as all of these services are sought by business users and for business purposes, they overlap in user and purpose also. Overall, I consider these services to be similar to a high degree.

40. “Computerized file management” in the proprietor’s specification is, in my view, a service wherein an undertaking organises and manages the user’s computer files. In my view, these services share a level of similarity with “data processing for the collection of data for business purposes” in the applicant’s marks’ specifications. While expressed as file management, I consider the proprietor’s service to also cover computerised data. As a result, the purpose and nature of the services may overlap in that both involve the processing and management of data. Further, the proprietor’s term may also be used by business users meaning that there is an overlap in user. Finally, there is an overlap in trade channels as an undertaking providing broad computerised file management services may also process and collect data for business purposes. Overall, I consider these services to be similar to a high degree.

41. Given how broad the term “provision of management services” in the proprietor’s specification is, it can be said to cover the service of “business management [...] relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations” in the applicant’s marks’ specifications. As a result, these services are identical under the principle outlined in *Meric*. In the event that I am wrong in my finding of identity due to the broad nature of the proprietor’s term, I consider there to be a medium degree of similarity between them. This is on the basis that the purpose of both services is to provide some form of management service so the general purpose of the services is the same.

42. “Business management and professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations” in the applicant’s marks’ specifications fall within the broader term “assistance and consultancy relating to business management and organisation” in the proprietor’s specification. These services are, therefore, identical under the principle outlined in *Meric*. In the event that I am wrong in my finding of identity due to the broad nature of the proprietor’s term, I make the same finding as I have at paragraph 41 above and, for those same reasons, find that the services are similar to a medium degree.

43. In the absence of any submissions or evidence to the contrary, I am of the view that “business supervision services”, “business information services” and “management assistance services” in the proprietor’s specification are types of business management services. They are broad services that can be used in relation to any type of business, including the car park sector and, therefore, encompass “business management and professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations” in the applicant’s marks’ specifications. Therefore, I consider that these services are identical under the principle of *Meric*. In the event that I am wrong in my finding of identity due to the broad nature of the proprietor’s term, I consider that these services are similar to a high degree on the basis that they overlap in user in that they are all business users, nature in that they are all business services and purpose in that they all aim to provide business management, generally. Further, they overlap in trade channels as an undertaking providing the proprietor’s more general terms may also provide the more specific business management service of the applicant.

44. “Provision of commercial information” and “commercial and consumer information services” in the proprietor’s specification are services wherein the provider of the service will provide consumer or commercial information for a variety of reasons, including information about the customer’s business. I consider that these services will overlap, generally, in purpose with “data processing for the collection of data for business purposes” in the applicant’s marks’ specifications on the basis that they have the same end purposes of being for business. However, I appreciate that this overlap is very broad. Further, I consider there to be an overlap in trade channels in that an undertaking that provides commercial or consumer information services is likely to undertake the service of processing various data that ultimately forms part of the commercial information provided. Overall, I consider these services to be similar to a low degree.

45. “Provision of data and information relating to visitor attendances or visitor numbers at commercial locations, events or the like” in the proprietor’s specification is a specific type of data and information service. I am of the view that this service is similar to “data processing for the collection of data for business purposes” in the

applicant's marks' specifications. The purpose of the applicant's term is for business generally and can relate to the processing of data relating to visitor attendances and visitor numbers of various businesses. As a result, these services overlap in purpose. They also overlap in user in that the user of both will be a business user. Alternatively, there is a competitive relationship between them in that a user may choose the services of the applicant over the proprietor and vice versa. Further, the nature overlaps in that both are services that relate to data. Trade channels are also likely to overlap in that an undertaking that processes data for business purposes is also likely to provide that data to its customers. Overall, I consider that these services are similar to a high degree.

46. "Project management services in association with regeneration, transportation, construction or civil engineering projects" in the proprietor's specification are, in my view, services that oversee the management of a project to ensure that the objectives of the project are met, such as the budget and timescale. It is possible that these services cover construction and management of parking spaces. As a result, I consider there to be a level of similarity with "business management and professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installation" in the applicant's marks' specifications. This is on the basis that there is an overlap in purpose as both may relate to the construction of car parks. There is also an overlap in user in that the user of both services will be businesses. However, I do not consider there to be an overlap in nature as I do not consider business management and project management to be the same. Further, there is no overlap in trade channels as I consider project management services and general business management and consultancy services will be provided for by different undertakings. Overall, I consider these services to be similar to a low degree.

47. In the absence of any evidence or submissions to the contrary, I am of the view that "logistical management and support services" in the proprietor's specification is a service that governs the supply of goods including their storage, transport and delivery to the customer. I do not consider that this service has any obvious level

of similarity between any of the goods and/or services in the applicant's marks' specifications. As a result, I consider these goods to be dissimilar.

48. "Services relating to the sourcing and procurement of materials, goods and services" in the proprietor's specification is a procurement service that has no counterpart in the applicant's marks' specification. Neither do I consider this service to have any obvious level of similarity with any of the goods and services in the applicant's marks' specifications. These services are, therefore, dissimilar.

49. I do not consider there to be any obvious level of similarity between "supervision and management of sub-contractors" in the proprietor's specification and any of the goods and/or services in the applicant's marks' specifications. These goods are, therefore, dissimilar.

50. "Advertising, marketing and promotional services" in the proprietor's specification are broad services that cover all types of advertising, marketing and promotion. I note that the applicant's marks' specifications contain "professional business consultancy, for others, regarding market-development measures, including sales, marketing, advertising campaigns and development and implementation of marketing concepts in relation to the management, by means of rental and leasing, of parking spaces, as well as the design and marketing thereof". While expressed indirectly, this covers advertising and marketing services in relation to the management of parking spaces. Given the applicant's terms' specific nature and the broad term in the proprietor's specification, I consider that the applicant's term falls within the proprietor's term. These goods are, therefore, identical under the principle outlined in *Meric*. I have given consideration as to whether it is possible to utilise TPN 1/2012. However, even if I were to propose a 'save for' provision or propose alternate wording to the proprietor's term, for example 'save for services relating to the management of car parking spaces' I still consider there to be a level of similarity between these services. This is on the basis that there will remain a general overlap in nature, method of use and trade channels between them as both would still remain advertising and marketing services, albeit for different purposes.

51. “Provision of management or administrative assistance to others in the operation of data processing equipment or apparatus” and “the provision of managerial or administrative assistance in the operation of equipment for the acquisition of data” in the proprietor’s specification are two types of services that involved data processing and the acquisition of data, respectively. I consider these services to share a level of similarity with “data processing for the collection of data for business purposes” in the applicant’s marks’ specification. While the proprietor’s terms relate to the operation of data processing equipment, they are still services that relate to data processing, meaning that there is a general overlap in purpose with the applicant’s term. Further, I consider there to be an overlap in users as someone looking for data processing services for business purposes is also likely to seek the provision of management or administrative assistance in relation to the same. I also find there to be an overlap in trade channels in that an undertaking that provides the proprietor’s services is also likely to provide the applicant’s services. Overall, I consider these services to be similar to a medium degree.

52. The proprietor’s class 35 services contain “advisory services and the provision of information and the preparation of reports, all relating to the aforesaid services” and “advisory and consultancy services in connection with all the aforesaid services”. Where I have found services to be dissimilar, it follows that there is no level of similarity between these terms. However, where I have found the proprietor’s services to be identical/similar to the applicant’s services, the proprietor’s advisory, information, preparation of reports and consultancy services relating to identical or similar services are also similar to the applicant’s services, although to a lesser degree.

Class 36 services

Electronic toll collection; debt recovery agency and debt collection agency services; bailiff services (debt collection); debt settlement negotiation services.

53. “Electronic toll collection” in the proprietor’s specification is a service that is an electronic payment service and, as a result, falls within the broader term of

“electronic payment services” in the applicant’s marks’ specification. These services are, therefore, identical under the principle outlined in *Meric*.

54. “Financial affairs and payment collection in relation to parking charges and fines” in the applicant’s marks’ specifications describe either a financial affairs service or a service for the collection of parking charges and/or fines. I do not consider the literal meaning of this term to extend to “debt recovery agency and debt collection agency services” or “bailiff services (debt collection)” in the proprietor’s specification. The proprietor’s services are specific types of debt recovery services that are not covered by the applicant’s term which are for the collection of payment only and do not, on the plain reading of the term, appear to cover payment of unpaid debts. While there may be an overlap in purpose in that both services aim to collect money, I do not consider this alone to warrant a finding of similarity between these services. The user, nature, method of use and trade channels of these services differ. These services are neither competitive nor complementary with one another. As a result, I consider these services to be dissimilar.

55. Following on from the reasoning set out at paragraph 54 above, I do not consider that “debt settlement negotiation services” in the proprietor’s specification shares any level of similarity with “financial affairs and payment collection in relation to parking charges and fines” in the applicant’s marks’ specification. While these services may overlap in purpose as they are both for the collection of money, I do not consider there to be any overlap in user, nature, method of use or trade channels. Further, these services are not complementary or competitive with one another. Overall, I consider that these services are dissimilar.

Class 37 services

Installation, maintenance, connection and disconnection of utilities (gas, water and electricity) meters; installation, maintenance, connection and disconnection of civil traffic enforcement apparatus, namely, cameras, closed circuit television, video cameras and web cameras, electronic toll systems; construction, maintenance and repair of buildings, roads, highways, bridges, footpaths, car and vehicle parks and car

and vehicle parking areas; site development and creation; construction, revamping and repair of recreational areas, sports grounds and the landscape; installation, maintenance and repair of traffic lights, alarms, cameras, vehicle detection devices; diagnostic maintenance services; installation, repair and maintenance of electric vehicle charging points; installation of electrical and electronic instruments, apparatus and equipment; erection of signs and street furniture; installation of traffic management systems; maintenance and repair of traffic management systems; installation of equipment, alarms, electrical appliances, elevators in commercial or residential properties or developments; land development and management services for housing or commercial use; project management services in relation to all the aforesaid services; cleaning services, cleaning of buildings, land, plant and machines; project preparation and studies, preparation of reports and provision of information in relation to the aforesaid; advisory and consultancy services in connection with all the aforesaid services.

56. "Installation, maintenance, connection and disconnection of utilities (gas, water and electricity) meters" in the proprietor's specification has no counterpart in the applicant's marks' specification. I see no obvious level of similarity between the proprietor's service and any of the goods or services in the applicant's marks' specifications. These services are, therefore, dissimilar.

57. "Installation, maintenance, connection and disconnection of civil traffic enforcement apparatus, namely, cameras, closed circuit television, video cameras and web cameras, electronic toll systems" in the proprietor's specification has no counterpart in the applicant's marks' specification. While car parks will have cameras installed for security purposes, there is no reason to consider that car park services and the installation, maintenance, connection and disconnection of apparatus such as cameras or CCTV are in anyway similar to car park services. While the car park service provider may monitor those cameras on site, they are unlikely to install, maintain, connect or disconnect those apparatus and are, instead, likely to hire a sub-contractor to do it. I have also given consideration to the fact that the applicant's marks' specifications also contain "computer programs and software for recognising and identifying vehicles and numberplates". While these programs will be used on cameras and CCTV systems, there is no obvious

level of similarity between this good and the proprietor's service. Overall, I consider these goods to have no obvious level of similarity with the goods and/or services in the applicant's marks' specifications. These services are, therefore, dissimilar.

58. For the same reasons set out in paragraphs 56 and 57 above, I see no obvious level of similarity between "installation, maintenance and repair of traffic lights, alarms, cameras, vehicle detection devices", "erection of signs and street furniture" and "installation of equipment, alarms, electrical appliances, elevators in commercial or residential properties or developments" in the proprietor's specification and any of the goods and/or services in the applicant's marks' specification. Therefore, I find these services to be dissimilar.

59. "Installation of traffic management systems" and "maintenance and repair of traffic management systems" in the proprietor's specification are goods that relate to traffic management. As a result, there is a level of similarity with "traffic management services" in the applicant's marks' specifications. Firstly, I consider there to be an overlap in user in that an undertaking seeking traffic management services may require the installation, maintenance or repair of traffic management systems. There may also be a competitive relationship between these services in that a user looking to engage in traffic management may wish to choose the service of traffic management itself or arrange for the installation, maintenance and repair of those systems itself. While the specific purposes of these services differ, it can be said that the end purposes are the same in that both relate to traffic management. Overall, I consider these services to be similar to a medium degree.

60. I do not consider that construction, maintenance or repairs services relating to car parks and the service of operating the car park are similar to any degree. The user, nature, method of use for construction, maintenance or repairs services is not the same for car parking services. Further, there is no overlap in trade channels as a car park provider will not construct, maintain or repair the car park themselves but will likely hire a third-party contractor to do it. The same also applies for site development and site creation, even where the sites involved are car parks. Therefore, I consider that "construction, maintenance and repair of buildings,

roads, highways, bridges, footpaths, car and vehicle parks and car and vehicle parking areas”, “site development and creation”, “construction, revamping and repair of recreational areas, sports grounds and the landscape” and “diagnostic maintenance services” are dissimilar to any of the goods and/or services in the applicant’s marks’ specifications.

61. For the same reasons set out in paragraph 60 above, I do not consider that “land development and management services for housing or commercial use” in the proprietor’s specification shares any level of similarity with any of the goods and/or services in the applicant’s marks’ specifications. These services are, therefore, dissimilar.

62. While it is becoming more common for car parks to install electric charging points, I do not consider that there is any overlap between car park services and the “installation, repair and maintenance of electric vehicle charging points” in the proprietor’s specification on the basis that these services differ in user, purpose, nature, method of use and trade channels. However, I consider that the proprietor’s service may overlap in trade channels with “providing of information concerning electrical charging options on the internet, on telecommunications networks and via mobile telephone”. While I appreciate that the manufacturer may sub-contract a third party to install, repair or maintain charging points, the manufacturer itself may also undertake this service. It is also common for charging point installers to offer information services regarding those charging points that the user can access via the internet to see what charging points are available or whether there are any issues. Again, this service is also one that is provided by a third party that collates data from all electric charging providers instead of having to access the information of different providers separately. As the adoption of electric vehicles increases, more and more members of the general public are having charging points installed at their homes meaning that there is an overlap in user in that someone may seek installation of a charging point and also use the information regarding charging locations while going on a long journey. The purpose, nature and method of use of these services differs. Overall, I consider that these services are similar to a low degree.

63. Given that “installation of electrical and electronic instruments, apparatus and equipment” is a broad term, it could be said to cover the installation of electrical charging points and, therefore, share a low degree of similarity with “providing of information concerning electrical charging options on the internet, on telecommunications networks and via mobile telephone” in the applicant’s marks’ specification for the same reasons set out in paragraph 62 above. Therefore, these services can be said to be similar to a low degree.

64. In respect of all the above services that I have assessed in class 37 of the proprietor’s specification, the proprietor’s specification contains the term “project management services in relation to all the aforesaid services”. As I have found the majority of the above services dissimilar, the same finding will apply in respect of project management services in relation to those services.

65. As for the service I have found to be similar to a medium degree, and those services I have found to be similar to a low degree, the proprietor’s project management services relating to those services are also similar to the applicant’s services although to a lesser degree.

66. Whilst car parks are likely to require cleaning services, I do not consider there to be any obvious level of similarity between “cleaning services, cleaning of buildings, land, plant and machines” in the proprietor’s specification and any of the goods and/or services in the applicant’s marks’ specifications. These services are, therefore, dissimilar.

67. At the end of the proprietor’s class 37 list of services, it has the terms “project preparation and studies, preparation of reports and provision of information in relation to the aforesaid” and “advisory and consultancy services in connection with all the aforesaid services”. For those services where I have found no similarity, it follows that there is no similarity in respect of project preparation, studies, preparation of report, information, advisory and consultancy services relating to those services. However, where I have found that the proprietor’s services to be similar to the applicant’s services, the proprietor’s project preparation, studies,

preparation of report, information, advisory and consultancy services relating to those services are also similar to the applicant's services although to a lesser degree.

Class 38 services

Telephone communication services provided for hotlines and call centres.

68. In my view, "telecommunications, mobile telephone services, radio communications and providing access to application software (apps) for providing information on the internet for searching for, reserving, use and paying for parking spaces" in the applicant's marks' specifications can include, amongst other things, a telephone service where the user parks their car and rather than use the payment terminal, they call a number provided on a sign and pay for parking via debit/credit card that way. As a result, I consider that this term falls within the broader term of "telephone communication services provided for hotlines and call centres" in the proprietor's specification. As a result, these services are identical under the principle outlined in *Meric*. However, even taking into account the broad range of services that the proprietor's term can cover, I still consider that it would share a level of similarity between these services. This is on the basis that, even if the purpose of the telecommunication service was different, there would still be an overlap in nature, method of use and a broad overlap in user. Further, I am of the view that there would be an overlap in trade channels on the basis that companies that operate call centres do so for a broad range of purposes. For example, it is common for companies to outsource their call centres to be operated by a third parties. As a result, I do not consider it appropriate to utilise TPN 1/2012 for this service.

Class 39 services

Transportation services; airport transfers; inspection of vehicles or goods before transport; geolocation services, namely, the identification or estimation of real-world location of an object or person; provision of information relating to traffic on transport routes; operating of road and motorway tolls; The provision of coach, bus and taxi

services; passenger and baggage transportation services; traveller transportation services; escort of passengers; inter-terminal and inter-airport transfer of passengers and baggage; transportation, inter-terminal and airport transfer of air crew and baggage; arranging of tours and of travel; the provision of transportation information; booking of seats for travel; travel reservation services; transport reservation services; the provision and arrangement of the transportation or distribution of goods by air, road, rail, car and by sea; reservation services in connection with the transportation of goods; storage of goods for transportation; the collection, transportation and delivery of packets, letters, wallets or parcels; corporate hospitality travel and transfer services; specialist and private coach, bus and taxi hire services; cycle hire services; the provision of medical transport; ambulance services; repatriation services; rental of garage and of parking places; provision of parking facilities; provision of car parks and car parking services; arranging parking places by means of electronic device; rental of specialised equipment relative to parking sites; removal of vehicles causing an obstruction in breach of parking traffic regulations; vehicle parking services; advisory and consultancy services in relation to road use and road traffic flows; advisory and consultancy services in relation to the location of vehicle parking and of designated use of road traffic lanes; the provision of information (not downloadable) from websites or provided from the Internet in connection with the location and provision of parking spaces; the provision of information (not downloadable) from websites or provided from the Internet in connection with coach and other transport services and to the movement of passengers; the provision of information (not downloadable) from websites or provided from the Internet in connection with electronic parking tickets and speed cameras; arrangement of vehicle recovery, arranging vehicle towing, delivery of vehicles, motor vehicle recovery services, recovery (vehicle-), recovery services for vehicles, storage of vehicles, vehicles (recovery of-), vehicle rescue [recovery], vehicle rescue services; advisory and consultancy services in relation to all the aforesaid services.

69. "Transportation services" in the proprietor's specification is a very broad term that covers all types of services relating to transportation. I am of the view that "transport and traffic logistics, in particular operation and control of traffic and parking guidance systems for moving and stationary traffic", "taxi management" and "shuttle services" in the applicant's marks' specifications fall within the proprietor's

broader term. As a result, these services are identical under the principle outlined in *Meric*.

70. Using the principles set out in the case of *Skykick* (cited above), it is my view that “shuttle services” in the applicant’s marks’ specification describes short transport services that ‘shuttle’ their passengers to and from various destinations such as from a hotel to the airport, the airport to the plane or from one holiday resort to another. It does not, in my view, extend to all services relating to travel. These services are generally considered to cover short journeys, however, they can cover longer range journeys, for example, from airports to ski resorts in mountainous regions that can take a number of hours. In my view, “airport transfers”, “inter-terminal and inter-airport transfer of passengers and baggage”, “transportation, inter-terminal and airport transfer of air crew and baggage”, “corporate hospitality travel and transfer services”, “passenger and baggage transportation services”, “traveller transportation services”, “the provision of coach, bus and taxi services” and “specialist and private coach, bus and taxi hire services” in the proprietor’s specifications can all cover different types of shuttle services and, therefore, fall within the applicant’s broader term. Therefore, I am of the view that these services are identical under the principle outlined in *Meric*.

71. “Escort of passengers” in the proprietor’s specification is a broad term that can be said to cover “shuttle services” in the applicant’s marks’ specification. This means that these services can be said to be identical under the principle outlined in *Meric*.

72. It is my view that the ordinary reading of the service of “arranging of tours and of travel” in the proprietor’s specification is more in line with travel agency services wherein the provider arranges the entire tour or travel packages including, for example, flights, hotels and arranged excursions or activities. In my view, it is likely that these services also to include the arranging of shuttle services in that the passenger will require transport from the airport to the hotel or between arranged excursions, for example. As a result, these services overlap in user. These services are similar in nature and purpose in that they are travel services. Further, there is likely to be an overlap in trade channels in that a travel agency may operate and

run their own shuttle service for its clients. Overall, I consider these services similar to a high degree.

73. "The provision of transportation information", "the provision of information (not downloadable) from websites or provided from the Internet in connection with coach and other transport services and to the movement of passengers", "booking of seats for travel", "travel reservation services" and "transport reservation services" in the proprietor's specification can all be said to include information, booking and reservation of "shuttle services" in the applicant's marks' specifications. I consider that there is an overlap in user in that a user of a shuttle service may also seek to obtain information regarding the transport and also book seats for the service. Further, an undertaking providing the shuttle service is also likely to provide information and booking services for the same. While the specific purposes of the proprietor's service relate to the booking of the travel, the end purpose can be said to overlap in that they all relate to travel. Overall, I consider these services to be similar to a medium degree.

74. In my view, "inspection of vehicles or goods before transport", "geolocation services, namely, the identification or estimation of real-world location of an object or person", "operating of road and motorway tolls", "the provision and arrangement of the transportation or distribution of goods by air, road, rail, car and by sea", "reservation services in connection with the transportation of goods", "storage of goods for transportation", "the collection, transportation and delivery of packets, letters, wallets or parcels", "cycle hire services", "the provision of medical transport", "ambulance services" and "repatriation services" in the proprietor's specification have no obvious level of similarity with any of the goods and/or services listed in the applicant's marks' specifications. Therefore, I find that these services are dissimilar.

75. "Rental of garage and of parking places", "provision of parking facilities", "provision of car parks and car parking services", "rental of specialised equipment relative to parking sites" and "vehicle parking services" in the proprietor's specification all fall within the broader category of "car park services" in the applicant's mark's

specifications. These services are, therefore, identical under the principle outlined in *Meric*.

76. “Arranging of parking spaces, for others, in particular via the Internet” in the applicant’s specification is not limited to the arranging of parking spaces via the internet but it is one of the methods used. This means that such services can be arranged by way of an electronic device. This means that the term “arranging parking places by means of electronic device” in the proprietor’s specification falls within the applicant’s broader term. As a result, these services are identical under the principle outlined in *Meric*.

77. “The provision of information (not downloadable) from websites or provided from the Internet in connection with the location and provision of parking spaces” in the proprietor’s specification falls within the broader category of “providing of information relating to parking options on the internet, on telecommunications networks and via mobile telephone” in the applicant’s marks’ specification. These services are, therefore, identical under the principle outlined in *Meric*.

78. “Removal of vehicles causing an obstruction in breach of parking traffic regulations” in the proprietor’s specification describes a service such as towing services where a vehicle is removed if it is causing an obstruction. In my view, the towing of vehicles that have breached car parking regulations is a service that is ancillary to car park services. As a result, I consider there to be a level of similarity to “operation of multi-storey car parks and parking facilities” in the applicant’s marks’ specifications. While the nature, method of use and purpose of these services differ, it is likely that they are provided by the same undertaking meaning that there is an overlap in trade channels. In addition, I consider that there is a complementary relationship between the services in that the average consumer will consider that the removal of vehicles causing an obstruction in breach of parking regulations is important to the operation of a car park and that the undertaking responsible for one service is also responsible for the other. Overall, I consider there to be a medium degree of similarity between these services.

79. I consider that the service of “the provision of information (not downloadable) from websites or provided from the Internet in connection with electronic parking tickets” in the proprietor’s specification shares a level of similarity with “operation of multi-storey car parks and parking facilities” in the applicant’s marks’ specifications. This is on the basis that the proprietor’s service is ancillary to the operation of a car park. I consider that there is an overlap in trade channels as the provider of the car park service is also likely to provide the information on the parking ticket to the user. In addition, I consider there to be an overlap in user in that someone looking for information regarding a parking ticket received is also going to be a user of a car park, being the location where the ticket was imposed. Further, I consider that an average consumer, when using a car park, will consider that the responsibility for any parking fines imposed and any information relating thereto will be important to the running of the car park itself. The average consumer will consider that the undertaking responsible for the information regarding the car parking ticket is also responsible for the operation of the car park itself, meaning there is a complementary relationship between these services. Overall, I consider these services to be similar to a medium degree.

80. Traffic management services are broad services that cover traffic monitoring, planning to help improve traffic flow, making decisions about planning road maintenance as well as helping to reduce congestion and pollution and evaluating changes created by transportation actions and measures. It is my view that “advisory and consultancy services in relation to road use and road traffic flows”, “advisory and consultancy services in relation to the [...] designated use of road traffic lanes” and “provision of information relating to traffic on transport routes” in the proprietor’s specification are not traffic management services themselves but are likely to be seen as ancillary services. In my view, these services overlap in trade channels in that an undertaking providing a broad traffic management service is likely to also provide those services covered by the proprietor’s terms. Further, there is likely to be an overlap in user in that a user of traffic management service may also seek the proprietor’s services. I also consider that these services are complementary to one another on the basis that the advisory, consultancy and information services contained in the proprietor’s term are important to the broader traffic management services and the average consumer is likely to consider that

an undertaking responsible for one is also responsible for the others. Overall, I consider these services to be similar to a medium degree.

81. “Arrangement of vehicle recovery, arranging vehicle towing, delivery of vehicles, motor vehicle recovery services, recovery (vehicle-), recovery services for vehicles, storage of vehicles, vehicles (recovery of-), vehicle rescue [recovery], vehicle rescue services” in the proprietor’s specification is one term that consists of a number of services relating to the recovery of vehicles. In my view, save for arranging vehicle towing (which can be said to be for the removal of obstructing vehicles), the services in this term are vehicle breakdown services. I do not consider there to be any obvious level of similarity between these services and any of the goods and/or services in the applicant’s marks’ specifications. However, in respect of the service of “arranging vehicle towing”, I make the same finding here that I have at paragraph 78 above. Therefore, I consider that the services of “arrangement of vehicle recovery , [...] delivery of vehicles, motor vehicle recovery services, recovery (vehicle-), recovery services for vehicles, storage of vehicles, vehicles (recovery of-), vehicle rescue [recovery], vehicle rescue services” in the proprietor’s specification are dissimilar where as “arranging vehicle towing” is similar to a medium degree with “operation of multi-storey car parks and parking facilities”.

82. I have no evidence or submissions as to what the term “advisory and consultancy services in relation to the location of vehicle parking” in the proprietor’s specification is. I consider it to be a service that provides advice and consultancy regarding the whereabouts and availability of car parks. For example, if a user was travelling to a location where they required parking, they could consult this service to find the location of public car parks at that location. As a result, I consider this service to be similar to “providing of information relating to parking options on the internet, on telecommunications networks and via mobile telephone” in the applicant’s marks’ specifications. I consider these services to overlap in trade channels as an undertaking providing such advisory and consultancy services is also likely to provide information regarding parking options. There is also likely to be an overlap in user as someone seeking advice and consultancy regarding vehicle parking location is also likely to look for information relating to parking via

the internet, for example. Further, there is an overlap in purpose as both services relate to parking. Overall, I consider these services to be similar to a medium degree.

83. I do not consider that “the provision of information (not downloadable) from websites or provided from the Internet in connection with [...] speed cameras” in the proprietor’s specification has any obvious level of similarity with the goods and/or services in the applicant’s marks’ specifications. I, therefore, consider these services to be dissimilar.

84. The proprietor’s specification contains “advisory and consultancy services in relation to all the aforesaid services” at the end of its list of class 39 services. For those services where I have found no similarity, it follows that there is no similarity in respect of the advisory and consultancy services relating to those services. However, where I have found that the proprietor’s services to be identical/similar to the applicant’s services, the proprietor’s advisory and consultancy services relating to identical or similar services are also similar to the applicant’s services although to a lesser degree.

Class 41 services

Arranging and conducting of seminars, workshops and conferences; the provision of education and of training services; practical training; publication of electronic books and media on-line or from the Internet; provision of training courses; preparation of text for publication; advisory and consultancy services in connection with all the aforesaid services.

85. In respect of the proprietor’s class 41 services, the applicant referred me to the decision of this Office, being BL O/623/20 and, in particular, the finding of the Hearing Officer in that decision of a medium degree of similarity between education and training services and business assistance, management and administrative services and business consultancy and advisory services. The applicant submitted that the same level of similarity should apply in respect of the proprietor’s class 41

services and the applicant's class 35 services. While I have considered the Hearing Officer's findings in that decision, I am not bound by them and I must make an assessment based on my own findings. Further, I note that the terms relied on in that decision are different from those relied on in these proceedings.

86. The purpose of the applicant's class 35 services, being "business management and professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations" and "professional business consultancy, for others, regarding market-development measures, including sales, marketing, advertising campaigns and development and implementation of marketing concepts in relation to the management, by means of rental and leasing, of parking spaces, as well as the design and marketing thereof" is to provide business management or business consultancy services in order to assist companies in constructing and managing parking spaces and to provide business consultancy services in respect of market-development measures. These services' purpose is not the same as the proprietor's class 41 services, being "arranging and conducting of seminars, workshops and conferences", "the provision of education and of training services", "practical training" and "provision of training courses", which is to educate or train its user. Even if the proprietor's services were to provide training regarding business consultancy and/or business management, this would not be the same as providing those services themselves. Therefore, I do not consider any overlap in purpose between these services. As for trade channels, while I acknowledge that some companies that provide business management or business consultancy services may also provide training in relation to those subjects, any overlap in trade channels will be superficial as, for the most part, the proprietor's services will be provided by educational institutions. The user of the services may also overlap on a superficial level as businesses seeking business management or consultancy services may also seek educational services. Overall, I do not consider that these services share any overlap in nature, method of use or purpose. Further, I do not consider there to be any level of competition or complementarity between them. Given that I have found a superficial overlap in user and trade channels only, I do not consider this sufficient to warrant a finding of similarity between these services. These services are, therefore, dissimilar.

87. As for the remaining terms in the proprietor's specification, being "publication of electronic books and media on-line or from the Internet" and "preparation of text for publication", I see no obvious level of similarity with the goods and/or services listed in the applicant's marks' specification. I note that the applicant has included "encoded cards" and "SIM cards" in its class 9 goods as being similar to these services but I do not consider this to be the case. This is on the basis that encoded cards and SIM cards are physical goods that have no obvious connections with the proprietor's services, which are both publication services and have no relation whatsoever to encoded cards or SIM cards. As a result, these services are dissimilar.

88. At the end of the proprietor's class 41 services, it has the service of "advisory and consultancy services in connection with all the aforesaid services". Given that I have found the proprietor's class 41 services to be dissimilar, I see no reason why the advisory and consultancy services relating to those services would share any level of similarity with the applicant's goods and/or services.

Class 42 services

Software as a Service [SaaS] relating to the provision of civil traffic enforcement services, enforcement of clean air zones and on-road parking enforcement; Platform as a Service [PaaS] relating to the provision of civil traffic enforcement services, enforcement of clean air zones and on-road parking enforcement; Software as a Service [SaaS] relating to workforce management; Platform as a Service [PaaS] relating to workforce management; property inspection services; inspection of utilities (gas, electricity and water) meters; design services; architectural consultancy and advisory services; architectural services; architectural planning services; architectural design services; preparation of architectural plans and reports; civil engineering advisory and consultancy services; structural engineering advisory and consultancy services; civil engineering services; civil engineering design services; civil engineering drawing services; civil engineering planning services; technical consultancy services relating to civil engineering; structural engineering services; quantity surveying; design of road and road networks; design services; traffic management services; public space

design and development services; design and development of electronic systems for use on or in connection with roads; urban design; urban planning; preparation of technical reports; advisory and consultancy services in relation to road layout and urban design services; technical advice and assessment services in connection with the aforesaid services; advisory services and the provision of information and the preparation of reports, all relating to the aforesaid services; advisory and consultancy services in connection with all the aforesaid services.

89. Software as a service is a type of service that an undertaking provides whereby the user subscribes to or pays a licence fee that allows them to access software that is hosted on the undertaking's server. It is not a software that requires the user to download it to their device, thereby saving the user from having to store the software on its own device/servers. The applicant's marks' specifications contain a number of computer software goods in class 9. While computer software as a good can share a level of similarity with software as a service, I do not consider that to be the case in respect of "software as a service [SaaS] relating to workforce management". This is because the specific purpose of the applicant's class 9 goods and the proprietor's service are very different. The nature also differs in that one is a good and one is a service. Further, while one undertaking can provide both software as a good and as a service, I do not consider that an undertaking would provide such different types of software. Also, the difference in purpose and nature means that these goods and services are not competitive or complementary to one another. I have also given consideration in relation to any similarity between the proprietor's services and "software design and development" in the applicant's marks' specifications. The user of these services will be someone looking for design of software and not the use of the software itself. These are design and development services and do not overlap in nature or method of use with software as a service. Further, the purposes differ completely. Therefore, I do not consider there to be any obvious level of similarity between the applicant's goods and/or services and the proprietor's services. These services are, therefore, dissimilar.

90. In the absence of any submissions or evidence to the contrary, it is my understanding that Platform as a Service (PaaS) is a type of cloud-based computer service that allows its users to create and develop their own software. Therefore, I

consider there to be a level of similarity between “platform as a service [PaaS] relating to workforce management” and “platform as a service [PaaS] relating to the provision of civil traffic enforcement services, enforcement of clean air zones and on-road parking enforcement” in the proprietor’s specification and “software design and development” in the applicant’s marks’ specifications. This is on the basis that they overlap in trade channels in that an undertaking providing software design services is also likely to provide a platform as a service so that their clients can design their software themselves. While the user’s will not overlap in that a user seeking to design their own software is unlikely to require software design services, I do consider them to be competitive as a user looking to have software created is likely to choose one or the other. The applicant’s service is a broad term and can be used for the purposes of designing software for workforce management or for the design of software relating to civil traffic enforcement service, clear air zone and on-road parking. Therefore, I consider there to be an overlap in purpose. Overall, I consider these services to be similar to a high degree.

91. “Software as a service [SaaS] relating to the provision of civil traffic enforcement services, enforcement of clean air zones and on-road parking enforcement” in the proprietor’s specification is a service that is used for the ultimate purpose of enforcing traffic, clean air zones and on-road parking. For the reasons set out at paragraph 89 above, I do not consider there to be any level of similarity between these services and the applicant’s class 9 goods and class 42 services. However, given this service’s specific purpose in that it relates to parking and traffic, I have considered whether they share any level of similarity with “traffic management services” in the applicant’s marks’ specifications. While both services can be said to relate to traffic, I do not consider this alone to warrant a finding of similarity. These services have different natures and methods of use. Further, I do not consider that traffic management services cover civil traffic enforcement services, enforcement of clean air zones or on-road parking. Instead, traffic management services are for the purpose of organising, arranging, guiding, and controlling moving traffic and, in my view, this does not extend to the enforcement of traffic infractions. As a result, I do not consider these services to share any level of similarity. They are, therefore, dissimilar.

92. I see no obvious level of similarity between “property inspection services” and “inspection of utilities (gas, electricity and water) meters” in the proprietor’s specification and any goods and services in the applicant’s marks’ specifications. While these services will be required by the applicant’s car parking services, they are not the same service and I do not consider there to be any level of similarity between them. Therefore, I find these services to be dissimilar.
93. “Design services” is included twice in the proprietor’s specification. It is a broad term that covers the services of “software design and development” and “design and development of computer hardware” in the applicant’s marks’ specifications. These services are, therefore, identical under the principle outlined in *Meric*.
94. In my view, urban design services can include the design of car parks in built up, urban areas. Therefore, I am of the view that “technical consultancy for design, development and building design of parking facilities with automated parking checks and automated payment services” in the applicant’s marks’ specification falls within the broader category of “advisory and consultancy services in relation to road layout and urban design services” in the proprietor’s specification. These services are, therefore, identical under the principle outlined in *Meric*. However, if I am wrong in my finding of identity, these services are similar to a medium degree on the basis that they overlap in nature in that both are consultancy services, purpose in that both aim to assist with design services and trade channels in that an undertaking providing consultancy for urban design services may also provide consultancy for the design of car parks.
95. “Design of road and road networks”, “design and development of electronic systems for use on or in connection with roads”, “public space design and development services”, “urban design” and “urban planning” in the proprietor’s specification share a level of similarity with “technical consultancy for design, development and building design of parking facilities with automated parking checks and automated payment services” in the applicant’s marks’ specification. While the nature and method of use differs, I am of the view that there is an overlap in user between these services as someone looking for the specific service of the

applicant may also require the broader design services in the proprietor's specification. Alternatively, there may also be a level of competition between these services as a user may choose to select one over the other. I also consider there to be an overlap in trade channels in that an undertaking providing the specific applicant's term may also provide the broad design services of the proprietor. The broad purposes of the services may also be said to overlap in that they all relate to design services. Overall, I consider the services to be similar to a medium degree.

96. Architectural services are services wherein the provider creates and designs plans and technical drawings in relation to the construction of buildings. While the architectural services in the proprietor's specification, namely "architectural consultancy and advisory services", "architectural services", "architectural planning services", "architectural design services" and "preparation of architectural plans and reports" are not identical to the terms "technical consultancy for the design, development and building design of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities" and "technical consultancy for design, development and building design of parking facilities with automated parking checks and automated payment services" in the applicant's marks' specifications, I do consider there to be a level of similarity between them, even taking into account the specific purpose of the applicant's terms. This is because the proprietor's terms are broader and can be said to include services relating to car parks and parking facilities. I consider that the general purposes of the services overlap on the basis that the aim of them is to assist in designing a building or structure that could, reasonably, be a car park. The user also overlaps in that a user seeking technical consultancy regarding the building of a car park is also likely to seek architectural services and vice versa. Alternatively, if a user only wishes to seek the services of one or the other, there will be a competitive relationship between them. Further, there may be an overlap in trade channels in that an architectural firm designing a car park may also offer technical consultancy in relation to the design and development of that project. Overall, I consider these services to be similar to a medium degree.

97. Civil engineering covers the design, construction and maintenance of a wide range of projects such as roads, bridges, pipelines and buildings. It is a broader discipline

than that of an architect as it relates to the entire process of building projects. Further, it is my understanding the structural engineering is a sub-category of civil engineering. I am of the view that my findings in respect of similarity between the services discussed at paragraph 96 above apply to the services of “civil engineering advisory and consultancy services”, “civil engineering services”, “civil engineering design services”, “civil engineering drawing services”, “civil engineering planning services”, “technical consultancy services relating to civil engineering”, “structural engineering services” and “structural engineering advisory and consultancy services” in the proprietor’s specification and the terms “technical consultancy for the design, development and building design of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities” and “technical consultancy for design, development and building design of parking facilities with automated parking checks and automated payment services” in the applicant’s marks’ specifications. This is on the basis that the same overlap of factors found above apply to these services. Therefore, I consider these services to be similar to a medium degree.

98. “Quantity surveying” in the proprietor’s specification is not a service that relates to the design, development or building design of project but instead focuses on factors such as estimating quantities of materials required for a project, for example. While it may be a service that is required as part of a larger construction project, I do not consider that it shares a level of similarity with “technical consultancy for the design, development and building design of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities” and “technical consultancy for design, development and building design of parking facilities with automated parking checks and automated payment services” in the applicant’s marks’ specifications. I also do not consider that it overlaps in any way with any of the remaining goods and/or services in the applicant’s marks’ specifications. Therefore, I consider these services to be dissimilar.

99. I note that the proprietor has the service of “traffic management services” in class 42 of its specification and that the same service appears in class 39 of the applicant’s marks’ specification. Just because a good or service are listed in

different classes, it does not mean that they cannot be identical.⁵ As a result, I consider that these services are identical. However, if I am wrong in this finding due to their different classes, they are highly similar.

100. “Preparation of technical reports” in the proprietor’s specification is a very broad term that can cover the preparation of technical reports relating to a wide range of issues. I am of the view that there is a level of similarity between these services and the applicant’s services of “technical consultancy for the design, development and building design of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities” and “technical consultancy for design, development and building design of parking facilities with automated parking checks and automated payment services”. In my view, technical consultancy services are complex services that will include the preparation of reports. While technical consultancy services and preparation of reports are not the same service, they are similar. This is on the basis that they overlap in user, purpose and trade channels. I am of the view that a user seeking technical consultancy is also likely to require a technical report stemming from that service. Further, the undertaking providing the technical consultancy is likely to provide a technical report. Finally, the purposes will overlap due to the fact both services aim to provide the user with technical information and advice. Overall, I consider these services to be similar to a medium degree.

101. At the end of the class 42 list of services in the proprietor’s specification, the services of “technical advice and assessment services in connection with the aforesaid services”, “advisory services and the provision of information and the preparation of reports, all relating to the aforesaid services” and “advisory and consultancy services in connection with all the aforesaid services” are included. Where I have found the proprietor’s services to be dissimilar, it follows that these additional services relating to them are also dissimilar. Where I have found the proprietor’s services to be identical/similar to the applicant’s services, the proprietor’s technical advice, assessment, advisory, information, preparation of

⁵ *Procter and Gamble Company v Simon Grogan*, BL O/176/08

reports and consultancy services relating to identical or similar services are also similar to the applicant's services, although to a lesser degree.

Class 45 services

Provision of judicial information; identity verification services; Operation, management and monitoring of closed circuit television surveillance cameras; the operation of television cameras for surveillance and vetting; checking the authenticity of legal documents; the validation of legal rights; vetting services; legal and regulatory advice and information; legal and regulatory enforcement services; legal services relating to immigration namely establishing rights of access to entry, to remain, to work; legal and regulatory services namely, establishing rights to entitlement to serve, to work and to rent; absconders (tracing of-), clamping (wheel-), provision of information relating to vehicle verification (mileage and condition), tracing of absconders; advisory and consultancy services in connection with all the aforesaid services.

102. I do not consider there to be any obvious level of similarity between “provision of judicial information”, “identity verification services”, “vetting services”, and “absconders (tracing of-), [...] provision of information relating to vehicle verification (mileage and condition) [and] tracing of absconders” in the proprietor's specification and any of the goods and/or services in the applicant's marks' specifications. These services are, therefore, dissimilar.

103. I have no evidence or submissions in respect of the service “monitoring of compliance with parking and usage rules and imposing penalties (legal services and security services)” in the applicant's marks' specifications. In the absence of these, I am of the view that this service is a specific one which includes the provision of parking wardens or automatic devices that monitor the compliance of the rules of the car park and, if necessary, will impose legally enforceable penalties on any offending vehicles such as parking tickets, towing or clamping. There is, in my view, a degree of similarity between this service and “legal and regulatory enforcement service” in the proprietor's specification. This is on the basis that the user of the applicant's term may also require services to enforce the penalties imposed. Further, it is my view that when an undertaking provides the service of

imposing a penalty, it is likely that they will also offer the enforcement of the same, meaning that there is an overlap in trade channels. There is also likely to be a complementary relationship between these services on the basis that the enforcement of a penalty is important to the service of imposing one and the average consumer will consider that the undertaking responsible for one is responsible for both. Overall, I consider these services to be similar to a medium degree.

104. For the same reasons set out in paragraph 103 above, I consider there is the same level of similarity between “legal and regulatory advice and information” in the proprietor’s specification and “monitoring of compliance with parking and usage rules and imposing penalties (legal services and security services)” in the applicant’s marks’ specifications. Therefore, I consider these services to be similar to a medium degree.

105. Further to paragraph 103 above, the legal service covered by the applicant’s term is a very specific one in that it is the service of imposing legally binding penalties on the offending vehicle. In my view, this does not extend to the remaining types of legal services in the proprietor’s specification, being “checking the authenticity of legal documents”, “the validation of legal rights”, “legal services relating to immigration namely establishing rights of access to entry, to remain, to work” and “legal and regulatory services namely, establishing rights to entitlement to serve, to work and to rent”. Therefore, I consider these services to be dissimilar.

106. “Operation, management and monitoring of closed circuit television surveillance cameras” and “the operation of television cameras for surveillance and vetting” in the proprietor’s specification are broad terms that cover the operation, management and monitoring of CCTV cameras for a broad range of purposes. This can be on building sites, for businesses or for car parks. As a result, it covers the more specific term of “monitoring of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities (security services)” that is contained with the applicant’s marks’ specifications. As a result, I consider these services to be identical under the principle outlined in *Meric*. Both services are

types of security services and even if I were to consider an amendment in accordance with TPN 1/2012, there would still be a level of similarity between these services.

107. In my view, the term “clamping (wheel-)” in the proprietor’s specification describes a service where the provider clamps the wheels of vehicles that are parked illegally or are not complying with the rules of the car park. This is a service that falls within the category of “monitoring of compliance with parking and usage rules and imposing penalties (legal services and security services)” in the applicant’s marks’ specifications. This is because clamping wheels is the imposition of a penalty for non-compliance with parking rules. These services are, therefore, identical under the principle outlined in *Meric*.

108. At the end of the proprietor’s list of services in class 45, the service of “advisory and consultancy services in connection with all the aforesaid services” is included. I have either found identity or dissimilarity between the services in the proprietor’s class 45 services and the applicant’s goods and services. It follows that advisory and consultancy services in relation to those services I have found dissimilar will also be dissimilar. Where I have found that the proprietor’s services are identical/similar to the applicant’s services, the proprietor’s advisory and consultancy services relating to identical or similar services are also similar to the applicant’s services, although to a lesser degree.

109. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the application aimed against those goods and services I have found to be dissimilar will fail.⁶ For ease of reference, the application may proceed against the following goods and services in the proprietor’s specification:

Class 9: Devices and equipment incorporating terminals for electronically processing credit, debit card or store value card payments; terminals for the electronic payment of charges by credit card;

⁶ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

electronic data management; information stored on electronic magnetic and/or optical means; electronically controlled access barriers; electronic systems for the automatic generation of information messages relating to motorway traffic; electronic video systems for object and symbol recognition and object tracking; electronic communication and charging apparatus for on-board vehicle operation (on-board units) for communication with electronic toll and fee systems and installations.

Class 35: Data processing and data transfer services; business consultancy relating to automation processes; information and consultancy in relation to organisation and management of businesses and in relation to business matters; compilation, systemisation, updating and maintenance of data in computer databases; computerized file management; data search in computer files for others; compilation of data, in particular image, audio and / or video data in computer databases; provision of management services; assistance and consultancy relating to business management and organisation; provision of commercial information; commercial and consumer information services; provision of data and information relating to visitor attendances or visitor numbers at commercial locations, events or the like; management assistance services; business supervision services; business information services; project management services in association with regeneration, transportation, construction or civil engineering projects; advertising, marketing and promotional services; data processing; information services relating to data processing; provision of management or administrative assistance to others in the operation of data processing equipment or apparatus; the provision of managerial or administrative assistance in the operation of equipment for the acquisition of data; advisory services and the provision of information and the preparation of reports, all relating to the aforesaid services; advisory and consultancy services in connection with all the aforesaid services.

- Class 36: Electronic toll collection.
- Class 37: Installation, repair and maintenance of electric vehicle charging points; installation of electrical and electronic instruments, apparatus and equipment; installation of traffic management systems; maintenance and repair of traffic management systems; project preparation and studies, preparation of reports and provision of information in relation to the aforesaid; advisory and consultancy services in connection with all the aforesaid services.
- Class 38: Telephone communication services provided for hotlines and call centres.
- Class 39: Transportation services; airport transfers; provision of information relating to traffic on transport routes; The provision of coach, bus and taxi services; passenger and baggage transportation services; traveller transportation services; escort of passengers; inter-terminal and inter-airport transfer of passengers and baggage; transportation, inter-terminal and airport transfer of air crew and baggage; arranging of tours and of travel; the provision of transportation information; booking of seats for travel; travel reservation services; transport reservation services; corporate hospitality travel and transfer services; specialist and private coach, bus and taxi hire services; rental of garage and of parking places; provision of parking facilities; provision of car parks and car parking services; arranging parking places by means of electronic device; rental of specialised equipment relative to parking sites; removal of vehicles causing an obstruction in breach of parking traffic regulations; vehicle parking services; advisory and consultancy services in relation to road use and road traffic flows; advisory and consultancy services in relation to the location of vehicle parking and of designated use of road traffic lanes; the provision of information (not downloadable) from websites or provided from the Internet in connection with the

location and provision of parking spaces; the provision of information (not downloadable) from websites or provided from the Internet in connection with coach and other transport services and to the movement of passengers; the provision of information (not downloadable) from websites or provided from the Internet in connection with electronic parking tickets; arranging vehicle towing; advisory and consultancy services in relation to all the aforesaid services.

Class 42: Platform as a Service [PaaS] relating to the provision of civil traffic enforcement services, enforcement of clean air zones and on-road parking enforcement; Platform as a Service [PaaS] relating to workforce management; design services; architectural consultancy and advisory services; architectural services; architectural planning services; architectural design services; preparation of architectural plans and reports; civil engineering advisory and consultancy services; structural engineering advisory and consultancy services; civil engineering services; civil engineering design services; civil engineering drawing services; civil engineering planning services; technical consultancy services relating to civil engineering; structural engineering services; design of road and road networks; design services; traffic management services; public space design and development services; design and development of electronic systems for use on or in connection with roads; urban design; urban planning; preparation of technical reports; advisory and consultancy services in relation to road layout and urban design services; technical advice and assessment services in connection with the aforesaid services; advisory services and the provision of information and the preparation of reports, all relating to the aforesaid services; advisory and consultancy services in connection with all the aforesaid services.

Class 45: Operation, management and monitoring of closed circuit television surveillance cameras; the operation of television cameras for surveillance and vetting; legal and regulatory advice and information; legal and regulatory enforcement services; clamping (wheel-); advisory and consultancy services in connection with all the aforesaid services.

The average consumer and the nature of the purchasing act

110. As the case law set out 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

111. The applicant submits that the average consumer will be made up of both professional users and members of the general public. Given the wide range of goods and services at issue, I agree with these submissions and, therefore, find that the average consumer is both members of the public (for services such as parking services) and professional users (for various types of goods such as electronic toll fee systems and services such as structural engineering services). As for how the goods and services are purchased/selected, this will vary. For example, services such as shuttle services are likely to be selected directly from the provider itself via catalogues, brochures or on the internet or via third party

retailers such as travel agents where the services will be listed in brochures or on the agent's website. For services such as these, the visual component is likely to dominate the purchasing/selection process. However, I do not discount an aural component playing a part by way of word of mouth recommendations or advice from a sales person or travel agent, for example. For services such as structural engineering services, these are likely to be selected by visiting a specialist provider where the goods and services will be selected after having viewed them in a catalogue or pamphlet which, in my view, will be followed by a discussion with a salesperson or, for example, a structural engineer themselves. In my view, the selection process for these types of services is going to be made up of both visual and aural considerations.

112. As for the level of attention paid during the selection process, this is also likely to vary. For example, for free shuttle services from a hotel to an airport, a member of general public is likely going to consider the timetable and the length of journey to ensure that they arrive at the terminal within good time. For these types of services, the level of attention paid may be slightly lower than average. However, for members of the public selecting a car parking service, they are likely going to consider the cost of the service, the opening hours and the security of the car park itself such as whether there are any attendants on site and the level of CCTV provided. For these services, the average consumer is likely to pay an average degree of attention. However, for services such as civil engineering design services, the average consumer is likely going to consider multiple factors such as, but not limited to, any previous projects undertaken by the provider, testimonials from previous users, the level of qualifications of the providers and the size and expertise of the team of engineers involved in the project. For these types of services, the level of attention paid will be high.

Comparison of marks

113. 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.

114. 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.”

115. 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.

116. The respective trade marks are shown below:

The contested mark	The applicant's marks
	<p data-bbox="938 1375 1308 1451">FLOW (the applicant's first mark)</p>  <p data-bbox="912 1608 1334 1644">(the applicant's second mark)</p>

117. I have detailed submissions from both parties regarding the comparison of the marks and while I do not intend to reproduce them in full here, I will, if necessary, refer to them below.

Overall Impression

The contested mark

118. The contested mark consists of both a device and a word element. The word element is the word 'freeflow' presented in a dark grey, standard typeface. The device element is made up of a group of light blue wavy lines. The proprietor submits that the device element in the contested mark is striking and not easily forgotten. While this submission is noted, I disagree on the basis that, even taking into account its placement at the beginning of the mark, the eye is naturally drawn to the parts of the mark that can be read. As a result, I find that the overall impression of the mark is dominated by 'freeflow', with the device element playing a lesser role.

The applicant's marks

119. The applicant's first mark is a word only mark consisting of the word 'FLOW'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself. Turning to the applicant's second mark, this consists of both a device and a word element. The word element is the word 'FLOW' that is presented in a blue, italic typeface. The device element is a round-edged green square with three horizontal white lines sitting within it. On the same basis as set out above in that the eye is naturally drawn to the parts of the mark that can be read, I am of the view that the overall impression of the applicant's second mark is dominated by the word 'FLOW' with the device element playing a lesser role.

Visual Comparison

The applicant's first mark and the contested mark

120. Visually, the marks share the word 'FLOW', which forms the only element in the applicant's first mark. The word 'FREE' and the device element that are present in the contested mark are not present in the applicant's first mark. The differences sit at the beginning of the contested mark, which is where the average consumer

tends to focus.⁷ While I have found that the device element plays a lesser role in the overall impression of the contested mark, it still constitutes a visual difference between the marks. Finally, I note that the applicant's first mark is a word only mark that is registered in black and white, which means that it is registered for use in any standard typeface (including use in either lower or upper case letters or any customary combination of the two⁸) and in any colour. Taking all of this into account, I find that the marks are visually similar to a medium degree.

The applicant's second mark and the contested mark

121. While the word elements are presented differently in each mark, they both share the word 'FLOW'. The marks differ in the presence of 'FREE' before 'FLOW' in the contested mark. They also differ in their device elements. The differences between the marks sit at their beginnings which, as I have set out above, is where average consumers tend to focus. I have also set out above that while the device elements play lesser roles in their respective marks, they still constitute a visual difference. Taking all of this into account, I find that the marks are similar to between a low and medium degree.

Aural Comparison

122. The device elements of the marks will not be pronounced meaning that the applicant's marks will be pronounced identically as one syllable, being 'FLOW'. The contested mark consists of two syllables that will be pronounced 'FREE-FLOW'. The proprietor submits that the word 'FLOW' will be swallowed by the pronunciation of the word 'FREE' meaning that 'FLOW' will not be as clearly pronounced compared to when it is spoken alone in the applicant's marks. I see no reason as to why this would be the case and find that the average consumers will pronounce 'FLOW' identically, regardless of whether it is preceded by the word 'FREE' or not.

123. While the entire aural element of the applicant's marks makes up half of the aural element of the contested mark, the similarity sits at the end. Given that the

⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

⁸ *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

average consumer tends to focus on the beginning of marks, I am of the view that the marks are aurally similar to a medium degree.

Conceptual Comparison

124. I do not consider that the device element in the applicant's first mark carries any conceptual impact. Therefore, the only element that carries a conceptual message in the applicant's marks is the word 'FLOW'. Average consumers in the UK will consider 'FLOW' to have multiple meanings, for example, as a noun it could be seen to mean the 'movement of something in one direction'⁹ or, as a verb, it could be seen as to mean to 'continue to arrive or be produced'.¹⁰

125. Turning to the conceptual message of the contested mark, it is my view that when confronted with the word 'freeflow', the average consumer will understand it as the conjoining of two ordinary words which creates the concept of something that is flowing freely without obstacle or resistance. As for the device element, the proprietor submits that this would be seen as a stream or multi-carriage highway. I disagree with these submissions and, instead, find that the device element would be seen as a stylised flourish with no particular meaning. In my view, the device element does not add to the conceptual impact of the contested mark.

126. When comparing the concept of the parties' marks, the word 'FLOW' will have the same meaning. In my view, the addition of 'free' in the contested mark simply qualifies the term 'flow' in that it is describing the nature of what is 'flowing' in that it is flowing without any obstacles or resistance. While 'free' does act as a point of conceptual difference between the marks, I do not consider it to be a significant one in that the understanding of both marks will be something that is 'flowing', be it 'free' or not. Overall, I consider the marks to be conceptually similar to a high degree.

⁹ <https://dictionary.cambridge.org/dictionary/english/flow>

¹⁰ Ibid.

Distinctive character of the opponent's mark

127. 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).”

128. 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. The applicant has not submitted that its marks have acquired an enhanced level of distinctive character through use and have filed no evidence to that effect. Therefore, I have only the inherent position to consider.

129. The applicant's first mark is a word only mark meaning that 'FLOW' is the only element of the mark that contributes to its distinctive character. 'FLOW' is an ordinary dictionary word that, as I have set out above, can have different meanings. In the context of goods and services that mostly relate to car parking, I do not consider that 'FLOW' will have any allusive or descriptive qualities. I find that this also applies to those goods and services that do not relate to car parking. From a trade mark perspective, despite not being allusive or descriptive, it is not particularly remarkable. Therefore, I find that the applicant's first mark enjoys a medium degree of distinctive character. This finding will also apply to the use of 'FLOW' in the applicant's second mark. Turning to the device element in the applicant's second mark, I do not consider that this will have any particular meaning to the average consumer. It may be that in conjunction with the word 'FLOW' it will be seen as an 'F'. If not, it will be seen as three horizontal lines. Either way, I do not consider that it will contribute to the distinctive character of the applicant's second mark to the point that it increases its distinctiveness to beyond a medium degree. Therefore, I find that the applicant's second mark enjoys a medium degree of distinctive character.

Likelihood of confusion

130. 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.

131. I have found the goods and services for which the proprietors' mark is registered to range from being identical to similar to a very low degree. I have found the average consumer for the goods and services to be both members of the general public and business users. I have found that some of the goods and services will be selected through primarily visual means (although I do not discount an aural component). However, for some others, this will be both visual and aural. I have concluded that the level of attention paid by the average consumer when selecting the goods and/or services will range from below average to a high degree, depending on what is being selected.

132. I have found both of the applicant's marks to have a medium degree of inherent distinctive character. I have found contested mark to be visually similar to a medium degree with the applicant's first mark and visually similar to between a low and medium degree with the applicant's second mark. I have found the contested mark to be aurally similar to a medium degree and conceptually similar to a high degree with both of the applicant's marks.

133. Taking all of the above factors and the principle of imperfect recollection into account, I consider that the visual and aural differences between the marks are sufficient to ensure that they will not be misremembered or mistakenly recalled as each other. Consequently, I am satisfied that there is no likelihood of direct confusion between the marks, even on goods and services that are identical.

134. It now falls to me 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.

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.). BL O/375/10 Page 15 of 16

(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).”

135. I have borne in mind that the examples given by Mr Purvis QC are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹¹

¹¹ *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

136. The applicant submits that the differing element, being the word 'FREE' is not distinctive and will be understood as being indicative of something that is available without charge to the consumer. The proprietor argued that this was the antithesis of the applicant's business in that customers don't get free parking services and that this argument simply does not work. The applicant responded further on this point and set out that parking can be available for free at various times, such as being free overnight, for example. Therefore, the applicant submitted that the addition of 'FREE' would be indicative of certain services that are provided for 'free' at a particular time. The proprietor then put forward that the applicant was seeking to introduce evidence on this point. However, while the proprietor's point is noted, I am prepared to take it on judicial notice that a significant proportion of average consumers will be aware that parking services may be offered for free after certain times. While I am cautious not to assume that my own knowledge is more widespread than it is, I am of the view that this is not a subject of serious dispute.¹²

137. In the event that the differences between all of the parties' marks are noticed, I am of the view that they will be seen by average consumers as indicators that they are alternative marks from the same or economically linked undertakings. When considering the marks, I am of the view that the addition of the word 'FREE' will be seen as a non-distinctive one that the average consumer would expect to see in a sub-brand or brand extension. I accept that the inclusion of 'free' at the beginning of the mark is unusual in that non-descriptive elements such as these are usually placed after the distinctive element, however, I am of the view that this will be seen as a play on words, given that the meaning of 'freeflow' will be immediately understood by average consumers. I do not consider that the use of 'FLOW' in the parties' marks is allusive or descriptive of any of the goods and services at issue. As a result, it is my view that the use of 'FLOW' in both marks will not be seen as coincidental and, as given its shared use in all marks, I consider that the average consumer will believe this to be indicative of an economic connection between the marks. I make this finding in respect of both of the applicant's marks. In addition to the above, the differences in stylisation and presentation of the marks (such as the typefaces, colour and device elements used) will be seen as alternative marks

¹² *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

being used by the same or economically linked undertakings and consistent with a re-branding. Consequently, I consider there to be a likelihood of indirect confusion between the marks on all those goods and services that I have found to be similar to a medium degree and above and even in instances where the average consumer may pay a higher degree of attention during the selection process.

138. Where I have found the goods and services to be similar to a low or very low degree, I consider that the differences between those goods and services will offset the similarities between the marks. As a result, there is no likelihood of confusion in respect of those goods and services, even where the average consumer pays a lower than average degree of attention.

FINAL REMARKS

139. I set out at paragraph 7 above that in the event that this decision was reliant upon the applicant's first mark only, it would be provisional subject to the successful defense of the invalidation application brought against that mark. While I have found a likelihood of confusion in respect of the applicant's first mark, I have made the same findings in respect of the applicant's second mark also. As the application reliant upon the applicant's second mark is not subject to any invalidation proceedings, this decision is, subject to any appeal, final.

CONCLUSION

140. The invalidation application succeeds in respect of some of the goods and services against which it was directed. The contested mark is, therefore, invalid in respect of the following goods and services:

Class 9: Devices and equipment incorporating terminals for electronically processing credit, debit card or store value card payments; terminals for the electronic payment of charges by credit card; electronic video systems for object and symbol recognition and object tracking; information stored on electronic magnetic and/or

optical means; electronically controlled access barriers; electronic communication and charging apparatus for on-board vehicle operation (on-board units) for communication with electronic toll and fee systems and installations; electronic toll and fee systems and installations.

Class 35: Data processing and data transfer services; business consultancy relating to automation processes; information and consultancy in relation to organisation and management of businesses and in relation to business matters; compilation, systemisation, updating and maintenance of data in computer databases; computerized file management; data search in computer files for others; compilation of data, in particular image, audio and / or video data in computer databases; provision of management services; assistance and consultancy relating to business management and organisation; provision of data and information relating to visitor attendances or visitor numbers at commercial locations, events or the like; management assistance services; business supervision services; business information services; advertising, marketing and promotional services; data processing; information services relating to data processing; provision of management or administrative assistance to others in the operation of data processing equipment or apparatus; the provision of managerial or administrative assistance in the operation of equipment for the acquisition of data; advisory services and the provision of information and the preparation of reports, all relating to the aforesaid services; advisory and consultancy services in connection with all the aforesaid services.

Class 36: Electronic toll collection.

Class 37: Installation of traffic management systems; maintenance and repair of traffic management systems; advisory and consultancy services in connection with all the aforesaid services.

Class 38: Telephone communication services provided for hotlines and call centres.

Class 39: Transportation services; airport transfers; provision of information relating to traffic on transport routes; The provision of coach, bus and taxi services; passenger and baggage transportation services; traveller transportation services; escort of passengers; inter-terminal and inter-airport transfer of passengers and baggage; transportation, inter-terminal and airport transfer of air crew and baggage; arranging of tours and of travel; the provision of transportation information; booking of seats for travel; travel reservation services; transport reservation services; corporate hospitality travel and transfer services; specialist and private coach, bus and taxi hire services; rental of garage and of parking places; provision of parking facilities; provision of car parks and car parking services; arranging parking places by means of electronic device; rental of specialised equipment relative to parking sites; removal of vehicles causing an obstruction in breach of parking traffic regulations; vehicle parking services; advisory and consultancy services in relation to road use and road traffic flows; advisory and consultancy services in relation to the location of vehicle parking and of designated use of road traffic lanes; the provision of information (not downloadable) from websites or provided from the Internet in connection with the location and provision of parking spaces; the provision of information (not downloadable) from websites or provided from the Internet in connection with coach and other transport services and to the movement of passengers; the provision of information (not downloadable) from websites or provided from the Internet in connection with electronic parking tickets; arranging vehicle towing; advisory and consultancy services in relation to all the aforesaid services.

Class 42: Platform as a Service [PaaS] relating to the provision of civil traffic enforcement services, enforcement of clean air zones and on-road parking enforcement; Platform as a Service [PaaS] relating to workforce management; design services; architectural consultancy and advisory services; architectural services; architectural planning services; architectural design services; preparation of architectural plans and reports; civil engineering advisory and consultancy services; structural engineering advisory and consultancy services; civil engineering services; civil engineering design services; civil engineering drawing services; civil engineering planning services; technical consultancy services relating to civil engineering; structural engineering services; design of road and road networks; design services; traffic management services; public space design and development services; design and development of electronic systems for use on or in connection with roads; urban design; urban planning; preparation of technical reports; advisory and consultancy services in relation to road layout and urban design services; technical advice and assessment services in connection with the aforesaid services; advisory services and the provision of information and the preparation of reports, all relating to the aforesaid services; advisory and consultancy services in connection with all the aforesaid services.

Class 45: Operation, management and monitoring of closed circuit television surveillance cameras; the operation of television cameras for surveillance and vetting; legal and regulatory advice and information; legal and regulatory enforcement services; clamping (wheel-); advisory and consultancy services in connection with all the aforesaid services.

141. The application has failed against some goods and services and the contested mark remains registered for the following:

- Class 9: Cameras; video cameras; CCTV systems; webcams; recorded tapes, discs, cassettes, cinematographic films; video cassettes and recorded video cassettes; DVDs, CD ROMs; electronic publications and material downloadable from a website or the internet; electronic data management; motorway toll-booth apparatus; electronic systems for the automatic generation of information messages relating to motorway traffic; electronic toll systems; workforce management software.
- Class 35: Project management services in association with regeneration, transportation, construction or civil engineering projects; logistical management and support services; services relating to the sourcing and procurement of materials, goods and services; supervision and management of sub-contractors; advisory services and the provision of information and the preparation of reports, all relating to the aforesaid services; provision of commercial information; commercial and consumer information services; advisory and consultancy services in connection with all the aforesaid services.
- Class 36: Debt recovery agency and debt collection agency services; bailiff services (debt collection); debt settlement negotiation services.
- Class 37: Installation, maintenance, connection and disconnection of utilities (gas, water and electricity) meters; installation, maintenance, connection and disconnection of civil traffic enforcement apparatus, namely, cameras, closed circuit television, video cameras and web cameras, electronic toll systems; construction, maintenance and repair of buildings, roads, highways, bridges, footpaths, car and vehicle parks and car and vehicle parking areas; site development and creation; construction, revamping and repair of recreational areas, sports grounds and the landscape; installation, maintenance and repair of traffic lights, alarms, cameras, vehicle detection devices;

diagnostic maintenance services; erection of signs and street furniture; installation of equipment, alarms, electrical appliances, elevators in commercial or residential properties or developments; land development and management services for housing or commercial use; project management services in relation to all the aforesaid services; cleaning services, cleaning of buildings, land, plant and machines; installation, repair and maintenance of electric vehicle charging points; installation of electrical and electronic instruments, apparatus and equipment; project preparation and studies, preparation of reports and provision of information in relation to the aforesaid; advisory and consultancy services in connection with all the aforesaid services.

Class 39: Inspection of vehicles or goods before transport; geolocation services, namely, the identification or estimation of real-world location of an object or person; operating of road and motorway tolls; the provision and arrangement of the transportation or distribution of goods by air, road, rail, car and by sea; reservation services in connection with the transportation of goods; storage of goods for transportation; the collection, transportation and delivery of packets, letters, wallets or parcels; cycle hire services; the provision of medical transport; ambulance services; repatriation services; the provision of information (not downloadable) from websites or provided from the Internet in connection with [...] speed cameras; arrangement of vehicle recovery, [...] delivery of vehicles, motor vehicle recovery services, recovery (vehicle-), recovery services for vehicles, storage of vehicles, vehicles (recovery of-), vehicle rescue [recovery], vehicle rescue services; advisory and consultancy services in relation to all the aforesaid services.

Class 41: Arranging and conducting of seminars, workshops and conferences; the provision of education and of training services; practical training; provision of training courses; publication of

electronic books and media on-line or from the Internet; preparation of text for publication; advisory and consultancy services in connection with all the aforesaid services.

Class 42: Software as a Service [SaaS] relating to the provision of civil traffic enforcement services, enforcement of clean air zones and on-road parking enforcement; Software as a Service [SaaS] relating to workforce management; property inspection services; inspection of utilities (gas, electricity and water) meters; quantity surveying; advisory and consultancy services in connection with all the aforesaid services.

Class 45: Provision of judicial information; identity verification services; checking the authenticity of legal documents; the validation of legal rights; vetting services; legal services relating to immigration namely establishing rights of access to entry, to remain, to work; legal and regulatory services namely, establishing rights to entitlement to serve, to work and to rent; absconders (tracing of-), [...] provision of information relating to vehicle verification (mileage and condition), tracing of absconders; advisory and consultancy services in connection with all the aforesaid services.

COSTS

142. In my view, both parties have enjoyed an approximately equal degree of success in these proceedings. As a result, I do not consider it appropriate to make an award of costs in the favour of either party. Therefore, I order that each party bear their own costs.

Dated this 22nd day of July 2021

A COOPER
For the Registrar

Annex 1

Class 9

Cameras; video cameras; CCTV systems; webcams; electronic publications and material downloadable from a website or the internet; devices and equipment incorporating terminals for electronically processing credit, debit card or store value card payments; terminals for the electronic payment of charges by credit card; electronic data management; recorded tapes, discs, cassettes, cinematographic films; video cassettes and recorded video cassettes; DVDs, CD ROMs; information stored on electronic magnetic and/or optical means; motorway toll-booth apparatus; electronic systems for the automatic generation of information messages relating to motorway traffic; electronic toll systems; electronically controlled access barriers; electronic video systems for object and symbol recognition and object tracking; electronic toll and fee systems and installations; electronic communication and charging apparatus for on-board vehicle operation (on-board units) for communication with electronic toll and fee systems and installations; workforce management software.

Class 35

Data processing and data transfer services; business consultancy relating to automation processes; information and consultancy in relation to organisation and management of businesses and in relation to business matters; compilation, systemisation, updating and maintenance of data in computer databases; computerized file management; data search in computer files for others; compilation of data, in particular image, audio and / or video data in computer databases; provision of management services; assistance and consultancy relating to business management and organisation; provision of commercial information; commercial and consumer information services; provision of data and information relating to visitor attendances or visitor numbers at commercial locations, events or the like; management assistance services; business supervision services; business information services; project management services in association with regeneration, transportation, construction or civil engineering projects; logistical management and support services; services relating to the sourcing and procurement of materials, goods and services; supervision and management of sub-contractors; advertising, marketing and promotional services; data processing; information services relating to

data processing; provision of management or administrative assistance to others in the operation of data processing equipment or apparatus; the provision of managerial or administrative assistance in the operation of equipment for the acquisition of data; advisory services and the provision of information and the preparation of reports, all relating to the aforesaid services; advisory and consultancy services in connection with all the aforesaid services.

Class 36

Electronic toll collection; debt recovery agency and debt collection agency services; bailiff services (debt collection); debt settlement negotiation services.

Class 37

Installation, maintenance, connection and disconnection of utilities (gas, water and electricity) meters; installation, maintenance, connection and disconnection of civil traffic enforcement apparatus, namely, cameras, closed circuit television, video cameras and web cameras, electronic toll systems; construction, maintenance and repair of buildings, roads, highways, bridges, footpaths, car and vehicle parks and car and vehicle parking areas; site development and creation; construction, revamping and repair of recreational areas, sports grounds and the landscape; installation, maintenance and repair of traffic lights, alarms, cameras, vehicle detection devices; diagnostic maintenance services; installation, repair and maintenance of electric vehicle charging points; installation of electrical and electronic instruments, apparatus and equipment; erection of signs and street furniture; installation of traffic management systems; maintenance and repair of traffic management systems; installation of equipment, alarms, electrical appliances, elevators in commercial or residential properties or developments; land development and management services for housing or commercial use; project management services in relation to all the aforesaid services; cleaning services, cleaning of buildings, land, plant and machines; project preparation and studies, preparation of reports and provision of information in relation to the aforesaid; advisory and consultancy services in connection with all the aforesaid services.

Class 38

Telephone communication services provided for hotlines and call centres.

Class 39

Transportation services; airport transfers; inspection of vehicles or goods before transport; geolocation services, namely, the identification or estimation of real-world location of an object or person; provision of information relating to traffic on transport routes; operating of road and motorway tolls; The provision of coach, bus and taxi services; passenger and baggage transportation services; traveller transportation services; escort of passengers; inter-terminal and inter-airport transfer of passengers and baggage; transportation, inter-terminal and airport transfer of air crew and baggage; arranging of tours and of travel; the provision of transportation information; booking of seats for travel; travel reservation services; transport reservation services; the provision and arrangement of the transportation or distribution of goods by air, road, rail, car and by sea; reservation services in connection with the transportation of goods; storage of goods for transportation; the collection, transportation and delivery of packets, letters, wallets or parcels; corporate hospitality travel and transfer services; specialist and private coach, bus and taxi hire services; cycle hire services; the provision of medical transport; ambulance services; repatriation services; rental of garage and of parking places; provision of parking facilities; provision of car parks and car parking services; arranging parking places by means of electronic device; rental of specialised equipment relative to parking sites; removal of vehicles causing an obstruction in breach of parking traffic regulations; vehicle parking services; advisory and consultancy services in relation to road use and road traffic flows; advisory and consultancy services in relation to the location of vehicle parking and of designated use of road traffic lanes; the provision of information (not downloadable) from websites or provided from the Internet in connection with the location and provision of parking spaces; the provision of information (not downloadable) from websites or provided from the Internet in connection with coach and other transport services and to the movement of passengers; the provision of information (not downloadable) from websites or provided from the Internet in connection with electronic parking tickets and speed cameras; arrangement of vehicle recovery, arranging vehicle towing, delivery of vehicles, motor vehicle recovery services, recovery (vehicle-), recovery services for vehicles, storage of vehicles, vehicles (recovery of-), vehicle rescue [recovery], vehicle rescue services; advisory and consultancy services in relation to all the aforesaid services.

Class 41

Arranging and conducting of seminars, workshops and conferences; the provision of education and of training services; practical training; publication of electronic books and media on-line or from the Internet; provision of training courses; preparation of text for publication; advisory and consultancy services in connection with all the aforesaid services.

Class 42

Software as a Service [SaaS] relating to the provision of civil traffic enforcement services, enforcement of clean air zones and on-road parking enforcement; Platform as a Service [PaaS] relating to the provision of civil traffic enforcement services, enforcement of clean air zones and on-road parking enforcement; Software as a Service [SaaS] relating to workforce management; Platform as a Service [PaaS] relating to workforce management; property inspection services; inspection of utilities (gas, electricity and water) meters; design services; architectural consultancy and advisory services; architectural services; architectural planning services; architectural design services; preparation of architectural plans and reports; civil engineering advisory and consultancy services; structural engineering advisory and consultancy services; civil engineering services; civil engineering design services; civil engineering drawing services; civil engineering planning services; technical consultancy services relating to civil engineering; structural engineering services; quantity surveying; design of road and road networks; design services; traffic management services; public space design and development services; design and development of electronic systems for use on or in connection with roads; urban design; urban planning; preparation of technical reports; advisory and consultancy services in relation to road layout and urban design services; technical advice and assessment services in connection with the aforesaid services; advisory services and the provision of information and the preparation of reports, all relating to the aforesaid services; advisory and consultancy services in connection with all the aforesaid services.

Class 45

Provision of judicial information; identity verification services; Operation, management and monitoring of closed circuit television surveillance cameras; the operation of television cameras for surveillance and vetting; checking the authenticity of legal

documents; the validation of legal rights; vetting services; legal and regulatory advice and information; legal and regulatory enforcement services; legal services relating to immigration namely establishing rights of access to entry, to remain, to work; legal and regulatory services namely, establishing rights to entitlement to serve, to work and to rent; absconders (tracing of-), clamping (wheel-), provision of information relating to vehicle verification (mileage and condition), tracing of absconders; advisory and consultancy services in connection with all the aforesaid services.

Annex 2

Class 9

Computer programs and software for recognising and identifying vehicles and numberplates; Computer programs and software for detecting and identifying mobile communications devices and radio frequency identification tags (RFID); Computer programs and software for data transmission between devices over short distance via radio technology; Apparatus for the transmission of data; Computer programs and software for recognising parking manoeuvres; Computer software and software for automated calculations and payment services; Computer applications for automated vehicle parking control; Devices for automated parking checks and number plate recognition; Computer applications (downloadable) and mobile apps for searching for, reserving, use and paying for parking spaces; Radio-frequency identification (RFID) tags; Labels and cards with integrated RFID chips; Readers for radio frequency identification (RFID) and recognition of data codes; Card reading equipment; Card reading equipment; Encoded cards; SIM cards; Electronic card readers; Software for card readers; Encoded cards for use in point of sale transactions; Cards bearing electronically recorded data; Encoded cards for use in relation to the electronic transfer of funds; Smart cards [integrated circuit cards]; Smart card readers.

Class 35

Business management and professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations; Administrative management of multi-storey car parks, parking spaces and other parking facilities; Professional business consultancy, for others, regarding market-development measures, including sales, marketing, advertising campaigns and development and implementation of marketing concepts in relation to the management, by means of rental and leasing, of parking spaces, as well as the design and marketing thereof; Data processing for the collection of data for business purposes; Collection of data relating to parking manoeuvres about users and vehicles for commercial purposes.

Class 36

Rental and leasing and management of properties; Financial affairs and payment collection in relation to parking charges and fines; Electronic payment services, including via the internet and mobile terminals (via SMS and application software or apps); Payment by means of radio frequency identification (RFID); Automated payment services; Money transfer services utilising electronic cards; Processing electronic payments made through prepaid cards; Bank card, credit card, debit card and electronic payment card services.

Class 37

Providing of information concerning electrical charging options on the internet, on telecommunications networks and via mobile telephone; Reservation and booking of electric charging bays on the internet, on telecommunications networks and via mobile telephone services and application software (apps).

Class 38

Telecommunications, mobile telephone services, radio communications and providing access to application software (apps) for providing information on the internet for searching for, reserving, use and paying for parking spaces; Delivery of messages and data by electronic transmission; Data transmission.

Class 39

Car park services; Car parking; Car park services; Provision of car parks and car parking services; Rental of multi-storey car parks, parking spaces and other parking facilities; Operation of multi-storey car parks and parking facilities; Rental, leasing and reservation of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities, on the basis of rental, leasing and business service agreements, in particular providing tailored services for parking customers; Rental and leasing of parking spaces; Arranging of parking spaces, for others, in particular via the Internet; Providing of information relating to parking options on the internet, on telecommunications networks and via mobile telephone; Reservation and booking of parking spaces on the internet, telecommunications networks and via mobile telephone and applications software (apps); Transport and traffic logistics, in particular

operation and control of traffic and parking guidance systems for moving and stationary traffic; Traffic management services; Taxi management; Shuttle services.

Class 42

Technical consultancy for the design, development and building design of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities; Design and development of computer programs and apparatus for recognition of numberplates and vehicles, for navigation in buildings, for radio frequency identification, for technology for data transmission between devices over short distance via radio technology, for detecting of parking manoeuvres, parking checks and for processing of payment procedures; Technical consultancy for design, development and building design of parking facilities with automated parking checks and automated payment services; Software design and development; Design and development of computer hardware.

Class 45

Licensing of computer software for the use of Internet platforms for online and offline management of parking spaces; Licensing of software for the recognition of number plates and vehicles, for navigation in buildings, for radio frequency identification, for technology for data transmission between devices over short distance via radio technology, for detecting of parking manoeuvres, parking checks and for processing of payment procedures; Monitoring of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities (security services); Monitoring of compliance with parking and usage rules and imposing penalties (legal services and security services).