

O-564-22

TRADE MARKS ACT 1994

**IN THE MATTER OF THE REQUEST FOR
PROTECTION IN THE UK OF INTERNATIONAL
REGISTRATION NO. 1479699**

**IN THE NAME OF ARCADIS CORPORATE SERVICES INC
FOR THE TRADE MARK**

FieldNow

IN CLASS

42

AND

THE OPPOSITION THERETO UNDER NUMBER OP000418370

BY

IDMOG

Background and pleadings

FieldNow

2. The IR consists of the following specification:

Class 42: Data automation and collection service using software to evaluate, analyze and collect service data.

3. Following the Holder's request to seek protection in the UK, the designation of the IR was published in the Trade Marks Journal for opposition purposes on 9 August 2019.

4. On 11 November 2019, IDMOG ("the Opponent") filed a Notice of Opposition against the conferring of protection of the IR in the UK, for all of the listed services, based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act").

5. The Opponent relies upon its EU Trade Mark No. 1425023, **FieldBox**, which was filed on 13 August 2018 and completed its registration process on 1 March 2019. The goods and services relied upon in these proceedings are as follows:¹

Class 9: Data processing equipment, computers; software (recorded programs).

Class 42: Evaluations and assessments in the fields of science and technology provided by engineers; scientific and technical research; design and development of computers and software; technical project studies; development (design), installation, maintenance, updating or rental of software; programming for

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

computers; computer system analysis; computer system design; software as a service (SaaS); cloud computing; information technology (IT) consultancy; hosting of servers; electronic data storage.

6. The Opponent contends that the Holder's mark is highly similar to its mark and that the contested services in class 42 are identical to the services relied upon under the earlier mark.

7. In its Defence and Counterstatement, the Holder denies that the marks are similar and that the applied for services are identical or similar to the goods and services of the earlier registration.

8. In these proceedings the Opponent is represented by Sipara Limited; and Cleveland Scott York LLP (CSY Herts) represents the IR Holder. Both parties filed evidence and written submissions.

9. A hearing was neither requested nor considered necessary; however, both parties filed written submissions in lieu of a hearing. I therefore give this decision after careful review of all the papers before me.

EVIDENCE AND SUBMISSIONS

10. The Holder filed evidence in the form of a witness statement from Sophie Louise Maughan dated 15 November 2021 (with 4 exhibits, exhibit 3 was later amended). This evidence was accompanied by written submissions. Ms Maughan is a Chartered Trade Mark Attorney at CSY Herts, and as confirmed in the witness statement, she is duly authorised to speak on the Holder's behalf.

11. The Opponent filed a witness statement dated 17 January 2022 (with 3 exhibits), in the name of Katy Fuggle, a Chartered Trade Mark Attorney at Sipara, who is duly authorised to act on behalf of the Opponent.

12. As noted above, both parties filed submissions in lieu of a hearing. I do not propose to summarise the evidence and submissions here. However, I have taken them all into consideration and will refer to them below where necessary.

DECISION

Section 5(2)(b)

13. The opposition is founded upon section 5(2)(b) of the Act, which stipulates that:

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

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

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

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

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

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.”

15. The Opponent's trade mark registration, with a filing date of 13 August 2018, qualifies as an earlier trade mark under section 6 of the Act. Further, given that it had not been registered for more than five years at the date the contested international registration was filed, it is not subject to the proof of use provisions contained in section 6A of the Act.² The Opponent is, as a consequence, entitled to rely upon its earlier mark in relation to all of the goods and services indicated within its pleadings without having to prove that genuine use has been made of it.

Relevant law

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

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must

² As these proceedings commenced after 14 January 2019, when the Trade Mark Regulations 2018 came into force, the relevant period for proof of use purposes is the five years prior to and ending on the filing date of the contested international registration.

³ 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 Trade Marks 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.

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 greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

17. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“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”.

18. 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 users of the respective goods or services;
- (b) The physical nature of the goods or acts of services;
- (c) The respective trade channels through which the goods or services reach the market;
- (d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular

whether they are, or are likely to be, found on the same or different shelves;

- (e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods and 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”.

20. In its Notice of Opposition and Statement of Grounds, the Opponent indicates that it relies upon the goods and services in classes 9 and 42; however, in subsequent substantive submissions reliance appears to be placed upon the entirety of the earlier specification, to include the registered services in class 35. On a preliminary view, there appears to be no need to look beyond the earlier class 42 services to assess the similarity between the competing specifications. Therefore, I will begin with the earlier class 42 specification and turn to the remainder of the protected specification, should the former comparison convey the necessity to do so. The parties’ respective services in class 42 are:

The opposed class 42 services	The earlier marks’ class 42 services
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<p>Data automation and collection service using software to evaluate, analyze and collect service data.</p>	<p>Evaluations and assessments in the fields of science and technology provided by engineers; scientific and technical research; design and development of computers and software; technical project studies; development (design), installation, maintenance, updating or rental of software; programming for computers; computer system analysis; computer system design; software as a service (SaaS); cloud computing; information technology (IT) consultancy; hosting of servers; electronic data storage.</p>
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21. The Opponent's specification includes a number of terms that either have direct counterparts and/or are broad enough to encompass the opposed services; for example: *computer system analysis; software as a service (SaaS); cloud computing; and electronic data storage*. These services are therefore identical on the *Meric* principle to the Holder's later services: *Data automation and collection service using software to evaluate, analyze and collect service data*.

22. For reasons of completeness, I address the Holder's submissions that the competing services entail delivery in distinct fields and discrete *modi operandi* to avoid confusion on the market. Although there may be differences in the way the services are delivered or used, that does not change the nature of the services and as indicated earlier, the comparison must be made on the basis of notional use of the mark across the full width of the specification. Therefore the Holder's submissions are not relevant to this consideration.

Average consumer and the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

24. For the purpose of assessing the likelihood of confusion, it must also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

25. The Holder submits that: “The average consumer for the opposed services are those who are highly specialised and technically sophisticated in the IT sector. This group is made up of business and large corporations requiring services such as data automation services, data collection services, and data analysis services. The consumer of these services is not the public at large. The acquisition of the Applicant's services will be obtained for a highly skilled and technical function. In the circumstances, the degree of attention paid by the purchaser of the Applicant's services will be at the least above average but is more likely to be high.”

26. The Opponent states: “As a preliminary comment, the goods and services at hand are directed at business customers with specific knowledge but also at the public at

large. As a result of this, the public's degree of attentiveness may vary from average to high."

27. I am of the view that the respective services are of the type that are purchased/selected by business users as well as members of the general public. For example, "*data automation and collection service using software to evaluate, analyze and collect service data*" can constitute SaaS (for example) to manage one's social media accounts or finances⁴ (this also applies to the earlier class 9 goods, which are similar to the opposed services).

28. For both categories of consumers, the selection process is likely to be primarily visual in nature, with the services being selected from printed material or the virtual marketplace (for example). However, I have also considered that aural considerations in the form of, for example, spoken endorsements or enquiries to, or advice from, technical advisors, may play a part in the selection process. There will be various factors the average consumer takes into consideration when selecting the services, such as security, nature of the provider or whether they are regulated, as well as potential costs. Therefore, the average consumer's level of attention (whether a business user or member of the public), would be above medium when choosing the goods and services under consideration.

29. That being said, I also find, having considered the General Court's dictum in the *DUNGEONS* case,⁵ that a substantial proportion of the relevant public is likely to exercise an average degree of attention when purchasing the earlier class 9 software in particular.

Comparison of the marks

⁴ In the absence of submissions from the Holder as to the meaning of *service data*, this (in my experience) is a broad term which can be any electronic data, which is collected, stored, transmitted or otherwise processed by or on behalf of end-users.

⁵ *Kalypto Media Group v EUIPO — Wizards of the Coast (DUNGEONS)* (Case T-700/18). According to the General Court of the EU, computer software are "no longer sold merely on 'focused markets' but have gone 'mainstream'".

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

31. 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.

32. The respective trade marks are shown below:

FieldBox	FieldNow
Earlier trade mark	Contested trade mark

33. After having considered the parties’ detailed, divergent submissions in relation to the distinctiveness of the elements of the marks, particularly the FIELD element, I find, in terms of the marks’ overall impressions, that they are readily recognisable as a

conjoining of the words FIELD and BOX (in relation to the earlier mark) and FIELD and NOW (in the relation to the contested mark).

34. In terms of the impact of the earlier mark, I consider that both FIELD and BOX play roughly equal roles in the overall impression they make on the eye and the ear. Whereas in the contested mark, I find that the word NOW alludes to the immediacy or speed of the services provided; therefore, the element FIELD is marginally more dominant in this mark.

35. The predominant point of visual and aural overlap between the respective marks is found in the shared word “Field” (and its pronunciation), positioned at the beginning of both marks, which also both end with three-letter suffixes (both containing the letter “o”, in the same position) “Box” and “Now”. It is settled law that the first element, the common element of the marks, will first catch the consumer’s attention when encountering them; by reason of the fact that the public reads from left to right. However, this does not mean that the average consumer would only focus on the initial element of the marks. Consequently, after having weighed up the similarities and differences, I find that there is a medium degree of similarity, both visually and aurally, between the marks.

36. I have considered detailed submissions from both parties regarding the meaning/s of the marks. I have borne in mind that the average consumer will not spend time considering the meaning/s of a word/s in a mark, but will simply look at a mark as a whole and attach significance to dictionary words or words with recognisable meaning (within a mark). The average consumer will be familiar with the words FIELD, BOX and NOW and will attribute meaning to them; though I find that there is no universal definition of the combined forms.

37. The Holder submits, for example: “In the context of sport, Field Box seats refer to seats near the field, such as near the field at a baseball stadium”. Although a small number of consumers may attribute this meaning to the mark, I do not consider that number to be significant, particularly as baseball is not a popular sport in this jurisdiction and the services do not especially target the sports industry.

38. In the alternative, the Holder states that “Field Box” (based upon a *Google* search), “may be understood by consumers as referring to a case or box designed for use in the field for transporting equipment such as ammunition or other accessories”. I do not agree that this precise meaning would be perceived by a significant proportion of the relevant consumer (and it does not relate to any of the goods or services offered by the Opponent). However, I see no reason why it could not be taken simply to mean a box used in a field, or a box on a field (whether it is two or three dimensional), given the ordinary dictionary meanings of the words.

39. Further submissions by the Holder include the argument that “FieldBox” has meaning in relation to software and computer databases: “from the meaning of ‘field’ in the context of IT, which refers to a specified area for a particular class of data (see the glossary entry for ‘field’ in Exhibit 4). A ‘field box’ is therefore a box where a particular field (i.e. component of a record) can be entered/displayed.”

40. In response, the Opponent submits amongst other things that: “The meanings attributed to the Opponent’s mark [by the Holder] are both contrived and inaccurate, for example you might use a box to enter data into a field, but that does not make it a ‘fieldbox’.” The Opponent also submitted evidence of dictionary searches for ‘fieldbox’ and ‘field box’, which produced no results.

41. However, I consider that the Holder’s latter argument carries some weight. In addition to the definition of “field” in *Wikipedia’s Glossary of computer science* (Exhibit 4), the Holder also adduced into evidence five sources (including a software manual from the World Health Organization, *LexisNexis* and other public-facing documents), in which the term “field box” is used, in the context of giving instructions to either design, manipulate or enter data into a “field box”. I find that a significant number of the relevant consumer may be familiar with this term in the IT industry, or that people in the industry will immediately grasp the concept of “fieldbox”: “a box in a software user interface for inputting a specific type of data”, particularly given the Opponent’s submission that: “The end users are ... users of data in business, science or research”.

42. I consider too, that members of the wider public who are not familiar with “FieldBox” as a term will know, particularly where the context of the goods and services is borne in mind, that a field can mean a box in which to enter data. In this scenario, the earlier

mark might be seen as a tautological pleonasm (for example), to positively convey a particular meaning; for example, that field in this context does not relate to an area of land, but field in the sense of databases, or data records in fields or boxes, or field in the sense of a box to enter information.

43. Whether the average consumer attaches meaning to the words in the marks collectively or individually, there are clear conceptual differences in the conjoined forms of the words, as well as in the diverse suffixes, which pull the conceptual similarity away from the ordinary meaning of FIELD. Therefore, I find that FieldBox and FieldNow share a below medium degree of conceptual similarity, based on the fact of the shared common element FIELD.

Distinctive character of the earlier trade mark

44. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion⁶. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

45. “In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings” - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

46. 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

⁶ *Sabel BV v Puma AG*, Case C-251/95 [para. 24]

words which have no allusive qualities. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it. In this case, however, the Opponent has not filed any evidence to support such a claim. Consequently, I have only the inherent position to consider.

47. As earlier indicated, the earlier mark is comprised of ordinary dictionary words with recognisable meaning. Where the average consumer perceives the mark as consisting of ordinary dictionary words, which do not describe or allude to the goods and services under the mark, the word combination FieldBox has a medium degree of inherent distinctive character. The average consumer with relevant IT knowledge will recognise that FieldBox has some meaning in relation to the goods and services under offer; and from this perspective, the earlier mark will have a below medium degree of inherent distinctiveness. The same applies to all consumers who make a connection between the mark and the goods and services offered under it.

Conclusions on Likelihood of Confusion

48. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear in mind the average consumer for the goods and services, the nature of the purchasing process and 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 they have retained in their mind.

49. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other; and indirect, where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10. He said:

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:

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).

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.).

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).”

50. I have found the parties’ marks to be visually and aurally similar to a medium degree. The earlier mark’s inherent distinctive character ranges from below medium to medium, depending on whether the average consumer knows the term, or makes

a connection between FieldBox and the relevant goods and services. The parties' respective class 42 services were found to be identical; whilst the competing marks share a below medium degree of conceptual similarity; and the average consumer, identified as both members of the general public and business users, who will deploy an above medium degree of attention, will select the goods and services primarily by visual means (though I do not discount an aural component).

51. I also indicated earlier that, as a general rule, the first parts of words catch the attention of consumers. However, it is clear that each case must be decided on its merits, considering each mark in its entirety. In this case, the fact that the first word or syllable of each mark is the same does not necessarily mean that they are likely to be confused. In my view, the presence of the word FIELD, positioned first in each mark is not, of itself, sufficient for a finding of a likelihood of confusion. I must also take account of the additional elements in the respective marks when considering them in their totalities.

52. Bearing in mind that visual considerations are likely to dominate the purchasing process, I find that the average consumer is likely to notice and recall the visual differences between the marks, even taking into account the identical services, where members of the public exercise an above medium degree of attention when purchasing them. Whilst the degree of care and attention exercised in the selection process is not high, neither will the process be a completely casual one. The average consumer will exercise a sufficient degree of care to recognise and recall the difference between the marks.

53. I have also considered the possibility of confusion through consumers mishearing one mark for the other. However, I find this to be unlikely, as the marks are aurally similar to a medium degree, with different endings, and they will be articulated in their entireties.

54. Although I consider that the average consumer will notice the differences between the marks, I must also consider the possibility of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely

because the competing marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

55. In approaching the question of indirect confusion in this case, I must assess whether the average consumer will make a connection between the marks and assume that the services in question are from the same or economically linked undertakings.

56. I have found that the average consumer will recognise that the later mark is different from the earlier mark. Whilst I have found FIELD to be the marginally more dominant element in the contested mark, I have also found that the earlier mark FieldBox forms a unit, which conveys a different meaning to FieldNow.⁷

57. Furthermore, I find that as an ordinary dictionary word at the beginning of the marks, FIELD could not be said to be so unusual that the average consumer, when selecting the services at issue, would assume that no other trader would use this element as a part of their trade marks, so as to render the parties economically linked. Further, bearing in mind that the categories identified in *L.A. Sugar* (above) are not exhaustive, I do not consider that “FieldNow” constitutes a consistent or natural extension of the earlier mark. It does not simply add an element to the earlier mark (FieldBox), which would suggest to the average consumer that it was merely a sub-brand or extension of the earlier known brand. I therefore find there is also no likelihood of indirect confusion.

Conclusion

58. The opposition under section 5(2)(b) fails in its entirety. Accordingly, subject to any successful appeal, the IR designation may proceed to protection (for the entirety of its class 42 specification).

⁷ See the CJEU's judgment in *Bimbo* and paragraph 20 of Arnold J.'s judgment in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch).

COSTS

59. As the Holder has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying this guidance, I award costs to the Holder on the following basis:

Reviewing the Notice of Opposition and filing the Counterstatement:	£300
Filing of evidence and the consideration of the Opponent’s evidence	£300
Reviewing the Opponent’s submissions and filing written submissions:	£500
Total:	£1,100

60. Accordingly, I hereby order IDMOG to pay to ARCADIS Corporate Services, Inc. the sum of **£1,100**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of July 2022

**Denzil Johnson,
For the Registrar**