

**O/0356/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3673517  
BY MARK KINGSLEY-WILLIAMS  
TO REGISTER THE FOLLOWING TRADE MARK:**

**BRANDVAULT**

**IN CLASSES 38 & 45**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 430507  
BY VAULT IP LIMITED**

## **Background and pleadings**

1. On 26 July 2021, Mark Kingsley-Williams applied to register the trade mark **BRANDVAULT** in the UK, under number 3673517 (“the contested mark”). Details of the application were published for opposition purposes on 22 October 2021. Registration is sought for the following services:

Class 38: Providing access to and leasing access time to computer databases concerning intellectual property matters.

Class 45: Legal services relating to trade marks and intellectual property; Advisory and consultancy services relating to trade marks and intellectual property protection; intellectual property services; Preparation and provision of documents and reports relating to intellectual property; Legal services relating to the registration of trademarks; Legal services relating to the acquisition of intellectual property; Legal services relating to the exploitation of intellectual property rights; Litigation advice and consultancy relating to intellectual property; Enforcement of trade mark rights; Legal services relating to the negotiation and drafting of contracts relating to intellectual property rights; Legal advice and representation relating to intellectual property rights; Preparation of legal reports and documents relating to intellectual property; Trademark watch services for legal advisory purposes; information services and information provided on-line from a computer database or from the Internet, provision of information and advisory services, all relating to the aforementioned services.

2. Vault IP Limited (“the opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>1</sup> The opponent relies upon its UK trade mark number 3390782.<sup>2</sup> The registration consists of a series of two trade marks: **VAULT IP** and **VAULT INTELLECTUAL PROPERTY**. For ease of reference, I will refer to these

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<sup>1</sup> I note that the opposition was also originally brought on the basis of section 5(3) of the Act. However, as no evidence was filed by the opponent, this ground of opposition was withdrawn in accordance with rule 20(3) of the Trade Marks Rules 2008.

<sup>2</sup> I note that the opponent also originally sought to rely upon UK trade mark number 3070729. This mark was subject to the use requirements, and whilst Mr Kingsley-Williams requested proof of use, no evidence was filed by the opponent. Therefore, the opposition based upon this trade mark was also withdrawn in accordance with rule 20(3).

marks in the singular (i.e. “the earlier mark”) unless it becomes necessary to distinguish between them. The earlier mark was filed on 9 April 2019 and became registered on 30 August 2019 in respect of goods and services in classes 16, 41 and 45. For the purposes of the opposition, the opponent relies upon only some of those goods and services, namely:

Class 16: Printed matter; printed publications; books, journals, magazines, pamphlets, manuals, brochures, guides, newsletters, leaflets and flyers; instructional and teaching materials; drawings; all the aforesaid goods relating to the field of intellectual property.

Class 41: Education and training in the field of intellectual property; provision of workshops and seminars in the field of intellectual property; publishing and electronic publishing services in the field of intellectual property; translation services in the field of intellectual property.

Class 45: Legal services in the field of intellectual property; services for the establishment and maintenance of intellectual property rights; intellectual property consultancy; advisory services relating to registered and unregistered intellectual property rights and the protection of intellectual property; intellectual property searching, drafting, filing, prosecution, registration, opposition, cancellation, revocation and invalidation; maintenance, renewal and enforcement of intellectual property; recordal of intellectual property transactions; licensing of intellectual property; intellectual property watching services; intellectual property investigations; professional advisory services relating to infringement of intellectual property; intellectual property management services; intellectual property portfolio management; legal research services all in the field of intellectual property; litigation, arbitration, mediation and dispute resolution services all in the field of intellectual property.

3. Given the respective filing dates, the opponent’s mark is an earlier mark in accordance with section 6 of the Act. As it had not completed its registration process more than five years before the filing date of the contested mark, it is not subject to the proof of use provisions specified in section 6A of the Act. Consequently, the

opponent is entitled to rely upon all the goods and services identified, without having to demonstrate genuine use.

4. In its notice of opposition, the opponent essentially contends that the competing marks are similar and that the parties' goods and services are identical or similar, giving rise to a likelihood of confusion, including the likelihood of association.

5. Mr Kingsley-Williams filed a counterstatement, denying the ground of opposition.

6. Both parties have appointed themselves as their own professional representatives. Only Mr Kingsley-Williams filed evidence. Neither party requested a hearing, but both filed written submissions in lieu of attendance. I note that both parties also filed written submissions during the evidence rounds. This decision is taken following careful consideration of the papers before me, keeping all submissions in mind.

7. 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 upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

### **Evidence and submissions**

8. Mr Kingsley-Williams gives evidence in his witness statement dated 2 November 2022 and three accompanying exhibits. His statement serves as a vehicle to introduce into evidence details of other UK trade marks containing the word 'VAULT', their alleged use in trade, printouts of a Google search for the term 'IP' and further printouts purported to show differences between the terms 'IP' and 'Brand'.

9. As noted above, both parties filed written submissions during the evidence rounds and in lieu of attending an oral hearing.

10. I have read all of the evidence and submissions and will return to them to the extent I consider necessary in the course of this decision.

## **Decision**

### **The law**

11. Sections 5(2)(b) and 5A of the Act read as follows:

“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.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

“In assessing the similarity of the goods or services concerned, [...] 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”.

14. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

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

15. Further, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“[...] there is close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

16. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

“29. [...] goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM-Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

17. The goods and services to be compared are outlined at paragraphs 1 and 2.

### Class 38

*‘Providing access to and leasing access time to computer databases concerning intellectual property matters’*

18. The opponent’s goods and services broadly consist of printed matter, education, publishing and legal services in the field of intellectual property. The nature and method of use of these goods and services is clearly different from that of providing

and leasing access to computer databases. Moreover, although Mr Kingsley-Williams' services specifically relate to the same field as the opponent's goods and services, to my mind, they have different core purposes. Moreover, the respective goods and services are unlikely to reach the market through shared trade channels. There is no evidence to demonstrate that undertakings which provide Mr Kingsley-Williams' services also provide the opponent's goods and services; in the absence of such evidence, I do not consider it to be typical in trade. There is no material competition between the respective goods and services. Neither, in my view, are they complementary. It is possible that some of the opponent's goods or services may be used with Mr Kingsley-Williams' services, but it does not automatically follow that they are similar for trade mark purposes.<sup>3</sup> Mr Kingsley-Williams' services are not important or indispensable to the use of the opponent's goods or services in such a way that consumers would believe that the responsibility for them lies with the same undertaking, or vice versa. Users may overlap. However, this, alone, is not sufficient for a finding of similarity. Taking all of this into account, I find that the contested services are dissimilar to the opponent's goods and services.

#### Class 45

*'Legal services relating to trade marks and intellectual property; [...] preparation and provision of documents and reports relating to intellectual property; legal services relating to the registration of trademarks; legal services relating to the acquisition of intellectual property; legal services relating to the exploitation of intellectual property rights; [...] enforcement of trade mark rights; legal services relating to the negotiation and drafting of contracts relating to intellectual property rights; [...] representation relating to intellectual property rights; preparation of legal reports and documents relating to intellectual property; trademark watch services for legal advisory purposes'*

19. The opponent's *'legal services in the field of intellectual property'* is a broad term which covers any legal service relating to any kind of intellectual property, such as trade marks. It encompasses all of Mr Kingsley-Williams' services outlined above. As such, they are to be regarded as identical in accordance with *Meric*.

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<sup>3</sup> *Sandra Amelia Mary Elliot v LRC Holdings Limited*, Case BL O/255/13

*'Intellectual property services'*

20. The above term in Mr Kingsley-Williams' specification incorporates any service (in this class) relating to intellectual property. This would include many, if not all, of the opponent's class 45 services, such as, for example, *'legal services in the field of intellectual property'*. Accordingly, I find that the respective services are identical under the principle outlined in *Meric*.

*'Advisory and consultancy services relating to trade marks and intellectual property protection; [...] litigation advice and consultancy relating to intellectual property; legal advice [...] relating to intellectual property rights'*

21. The above services all describe the provision of advice and consultancy in the field of intellectual property. They, therefore, fall within the scope of the opponent's *'intellectual property consultancy; advisory services relating to registered and unregistered intellectual property rights and the protection of intellectual property'* and are to be regarded as identical in accordance with *Meric*.

*'Information services and information provided on-line from a computer database or from the Internet, provision of information and advisory services, all relating to the aforementioned services'*

22. The above term appears at the end of Mr Kingsley-Williams' specification and provides protection for information and advisory services in connection with all the services preceding it. Such services are encompassed by the opponent's *'intellectual property consultancy; advisory services relating to registered and unregistered intellectual property rights and the protection of intellectual property'* and are, therefore, identical under the *Meric* principle. If I am wrong in this finding, it remains the case that there will be substantial overlaps in nature, method of use, intended purpose and trade channels. Moreover, the respective services share users and are in direct competition. As such, if they are not identical, I find that the respective services are highly similar.

23. As some degree of similarity between goods or services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail against the services of the application that I have found to be dissimilar,<sup>4</sup> namely:

Class 38: Providing access to and leasing access time to computer databases concerning intellectual property matters.

### **The average consumer and the nature of the purchasing act**

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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 (as he then was) described the average consumer in these terms:

“60. [...] 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.”

25. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of services in question.<sup>5</sup>

26. Consistent with my approach to the comparison of the parties' goods and services, my assessment will focus upon the average consumer of the respective services in class 45 for which I have found at least some similarity.

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<sup>4</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

<sup>5</sup> *Lloyd Schuhfabrik Meyer*

27. Although legal services in the field of intellectual property are available to the general public, it is my view that the average consumer of the services at issue is more likely to be a business user. It is my view that, overall, the services may be purchased relatively frequently for the ongoing protection of the business' intellectual property assets. The cost of the services may vary, though, overall, they are likely to be relatively expensive. The selection of the services would be relatively important for businesses as they will wish to ensure that they are provided to a professional standard and suitable for their needs. Such consumers may also be mindful of the important role intellectual property matters can play in the successful operation of a business. The purchasing of the services is likely to follow a measured thought process with consideration given to factors such as the provider's expertise, capacity, and prior outcomes. In light of all this, I find that business users will demonstrate between a medium and high level of attention during the purchasing process. The services are likely to be obtained directly from the provider via websites or printed materials. As such, it is my view that the purchasing process will be predominantly visual in nature. However, aural considerations in the form of word-of-mouth recommendations or verbal discussions with the provider, for instance, cannot be excluded entirely.

### **Distinctive character of the earlier mark**

28. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *WindsurfingChiemsee*, paragraph 51).”

29. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the services will be somewhere in the middle. The degree of distinctiveness 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 confusion.

30. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the opponent has filed no evidence of use; accordingly, I have only the inherent position to consider.

31. The earlier mark comprises a series of two word-only marks: ‘VAULT IP’ and ‘VAULT INTELLECTUAL PROPERTY’.

32. Mr Kingsley-Williams has argued that the word ‘VAULT’ is commonly used in industry to refer to an area used for storage (including online) and that consumers would perceive this element as descriptive. In support of this contention, Mr Kingsley-Williams has provided extracts from the register of trade marks containing the word, as well as printouts from the websites of some of the respective undertakings.<sup>6</sup> However, the mere fact that a number of trade marks registered in class 45 contain

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<sup>6</sup> Exhibit 1

the word 'VAULT' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned.<sup>7</sup> Secondly, the printouts that have been provided are insufficient to establish that the marks are in use and that the average UK consumer of the services at issue in these proceedings would have perceived the word as descriptive at the relevant date. I note that the printouts are all undated. Moreover, the vast majority do not appear to be from UK-facing websites. Crucially, many of the printouts do not show what goods or services are actually being provided, some appear to show entirely different goods or services being provided, whilst others suggest that no trading has occurred under those marks. Further, some do not show any 'VAULT' marks being used at all. Those that do appear to show the word being used in combination with other terms in a trade mark sense, i.e. not as a description of a characteristic of the goods or services being provided. To my mind, the word 'VAULT' will be understood by the average consumer in accordance with its dictionary meaning, that being a room (particularly in a bank) with thick walls and a strong door, used to safely store money or other valuables.<sup>8</sup>

33. The words 'INTELLECTUAL PROPERTY' will be understood as a category of property that consists of intangible creations of the mind, such as copyright, patents and trade marks. They will be seen as a descriptive reference to the legal services at issue. As argued by Mr Kingsley-Williams, the letters 'IP' may be recognised as an abbreviation for 'internet protocol', the technical rules for communication on the internet. However, in the context of the services at issue, I consider it unlikely. I am not persuaded by the printout of Google search results provided by Mr Kingsley-Williams in this regard.<sup>9</sup> Firstly, the printout is undated and is, therefore, presumably from after the relevant date. Furthermore, internet searches use algorithms which become tailored to a user based upon their search history. Search results will also vary over time and are dependent upon who is doing the search. Moreover, businesses can pay search engines for their details to be listed higher in search results. As such, I do not consider the Google search results to be compelling evidence of how the letters will be understood by the average consumer. Rather, I find that at least a significant proportion of average consumers will perceive the letters as an

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<sup>7</sup> *Zero Industry Srl v OHIM*, Case T-400/06

<sup>8</sup> <https://dictionary.cambridge.org/dictionary/english/vault>

<sup>9</sup> Exhibit 2

abbreviation for 'intellectual property'. Having attributed this meaning to the letters, such consumers will also perceive them as a descriptive reference to the services.

34. Given these factors, the distinctive character of both marks in the opponent's series predominantly rests in the word 'VAULT'. This is a common dictionary word with no obvious connection to the services at issue. Overall, I find that both marks in the opponent's series possess a medium level of inherent distinctive character.

### **Comparison of marks**

35. It is clear from *Sabel* 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 CJEU stated at paragraph 34 of its judgment in *Bimbo* that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their 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.”

36. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

37. The competing trade marks are as follows:

The earlier mark	The contested mark
VAULT IP VAULT INTELLECTUAL PROPERTY	BRANDVAULT

### Overall impressions

38. The earlier mark consists of a series of two word-only marks: 'VAULT IP' and 'VAULT INTELLECTUAL PROPERTY'. The overall impression of both marks in the series is dominated by the word 'VAULT', while the letters 'IP' and the words 'INTELLECTUAL PROPERTY' play lesser roles.

39. The contested mark is in word-only format and comprises the word 'BRANDVAULT'. Although it is presented as a single word, the average consumer will identify the two ordinary English words 'BRAND' and 'VAULT'. Both words provide a roughly equal contribution to its overall impression.

### Visual comparison

40. The competing marks are visually similar in that they share the word 'VAULT'. This word dominates the overall impression of the earlier mark and co-dominates that of the contested mark. The competing marks are visually different insofar as this common element appears in different positions. This results in the marks having different beginnings, a position which is generally considered to have more impact.<sup>10</sup> Moreover, the earlier mark contains either the letters 'IP' or the words 'INTELLECTUAL PROPERTY', neither of which are replicated in the contested mark. Further, the contested mark contains the word 'BRAND', which has no counterpart in the earlier mark. Particularly considering the second mark in the opponent's series, these differing elements result in the competing marks being significantly different in length.

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<sup>10</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Bearing in mind my assessment of the overall impressions, I find that there is between a low and medium degree of visual similarity between the competing marks.

### Aural comparison

41. The first mark in the opponent's series consists of a one-syllable word and a two-letter abbreviation, which will be pronounced as an initialism, i.e. "VOLT-EYE-PEE". The second mark in the opponent's series comprises nine syllables, i.e. "VOLT-IN-TE-LEC-TU-AL-PRO-PER-TEE". The contested mark consists of two syllables, i.e. "BRAND-VOLT". The competing marks are aurally similar insofar as they contain the identical syllable "VOLT". They are aurally different in that this common element appears in different positions. Clearly, they also differ in the other syllables present in the marks. Again, the second mark in the opponent's series is much longer than the contested mark. Overall, I find that the contested mark is aurally similar to the first mark in the opponent's series to a medium degree and aurally similar to the second mark in the opponent's series to a low degree.

### Conceptual comparison

42. The word 'VAULT' in the competing marks will be understood as referring to a room with thick walls and a strong door, used to safely store money or other valuables. The words 'INTELLECTUAL PROPERTY' in the second mark of the opponent's series will be understood as referring to intangible creations of the mind, such as copyright, patents and trade marks. The letters 'IP' in the first mark of the opponent's series will be perceived by at least a significant proportion of consumers as an abbreviation for these words and, as such, they also convey this meaning. The word 'BRAND' in the contested mark will be understood as referring to the particular name of a product sold by a particular undertaking.<sup>11</sup> In the context of legal services relating to intellectual property, it is strongly allusive, if not descriptive. The contested mark as a whole may figuratively refer to a vault for brands. However, for a concept to be relevant, it must be capable of immediate grasp by the relevant consumer.<sup>12</sup> As it is not immediately

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<sup>11</sup> <https://dictionary.cambridge.org/dictionary/english/brand>

<sup>12</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

apparent how a physical vault could hold intangible brands in any logical sense, the words do not combine to form a unit with a different meaning than the two words taken separately. The competing marks conceptually overlap to the extent that they both contain the identical word 'VAULT'. They differ in the presence of the words 'BRAND' and 'IP'/'INTELLECTUAL PROPERTY', though they both convey meanings associated with matter used to distinguish an undertaking's goods or services. Bearing in mind my assessment of the overall impression, I find that the competing marks are conceptually similar to between a medium and high degree.

### **Likelihood of confusion**

43. 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. One such factor 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 services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

44. 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 services down to the responsible undertakings being the same or related.

45. Earlier in this decision, I concluded that:

- The parties' respective services in class 45 are identical or highly similar;

- The average consumer of the services is likely to be a business user, who will demonstrate between a medium and high level of attention;
- The purchasing process will be predominantly visual in nature, though aural considerations have not been discounted;
- The earlier mark possesses a medium level of inherent distinctive character;
- The overall impression of the earlier mark predominantly lies in the word 'VAULT', while the letters 'IP' and the words 'INTELLECTUAL PROPERTY' play lesser roles;
- Both words which comprise the contested mark provide a roughly equal contribution to its overall impression;
- The competing marks are visually similar to between a low and medium degree, and conceptually similar to between a medium and high degree;
- The competing marks are aurally similar to either a low or medium degree.

46. In support of Mr Kingsley-Williams' position that there is no risk of confusion, he has provided a data set,<sup>13</sup> said to be from Google and its keyword tool. It is not entirely clear what this evidence is intended to show. Mr Kingsley-Williams has argued that it shows that there is a difference in meaning and use of the terms 'IP' and 'BRAND' because, of 22 searches for 'Protect Brand', none contained the term 'IP', whilst, of 154 results for the term 'Protect IP', only 5 contained the term 'brand'. However, these statistics appear to be predicated on what Google, itself, considered the searcher's intention to be. Moreover, the absence of each term from the searching intention of the other could be for any number of reasons. It is not determinative, or even indicative, of whether the average UK consumer would be confused between the competing marks. Further, there is no additional information or context. For example, there is nothing which eliminates the possibility that each searcher used both terms in separate

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<sup>13</sup> Exhibit 3

but sequential searches when looking for the same service. I also note that the data relates to the period between 1 October 2021 and 30 September 2022, i.e. after the relevant date. Finally, it is my view that the sample sizes are not sufficient to be taken as representative of the average consumer, nor a significant proportion of average consumers. In light of all this, I do not consider the evidence to be relevant to my global assessment.

47. I acknowledge that the competing marks share the word 'VAULT'; this word dominates the overall impression of the earlier mark and co-dominates that of the contested mark. I also accept that the marks share a relatively high level of conceptual similarity. Nevertheless, the identical word appears in different positions in the competing marks, resulting in their beginnings being entirely different. Moreover, the contested mark contains the word 'BRAND', which has no counterpart in the earlier mark, whereas the marks in the opponent's series encompass the letters 'IP' or the words 'INTELLECTUAL PROPERTY', which are not replicated in the contested mark. The second mark of the opponent's series, in particular, is noticeably different in length when compared with the contested mark. Although I have found that these elements play lesser roles in the overall impression of the earlier mark, they are not negligible. In my view, it is unlikely that these differences will be overlooked by the average consumer. Therefore, the aforementioned differences are likely to be sufficient for the average consumer – paying between a medium and high level of attention – to distinguish between the competing marks and avoid mistaking one for the other. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion, even in relation to identical services.

48. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the

other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

49. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.<sup>14</sup> I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that

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<sup>14</sup> *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>15</sup> The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.<sup>16</sup>

50. I have found that the average consumer will immediately notice and recall the differences between the competing marks. However, they will also recognise the identical word ‘VAULT’, which dominates (or at least co-dominates) the competing marks. Whether consciously or unconsciously, this will lead the average consumer through the mental process described in *L.A. Sugar*. I have found that the letters ‘IP’ and the words ‘INTELLECTUAL PROPERTY’ in the earlier mark play lesser roles in its overall impression and will be seen as descriptive references to the services. Moreover, whilst the word ‘BRAND’ co-dominates the overall impression of the contested mark and appears at its beginning, this word is also strongly allusive, if not descriptive, of the services. To my mind, the difference created by the replacing of the letters ‘IP’ or the words ‘INTELLECTUAL PROPERTY’ with the word ‘BRAND’ readily lends itself to a sub-brand or brand extension, i.e. the contested mark is likely to be perceived as an alternate brand of the earlier mark using a different term to inform consumers as to the legal focus of the services. This is particularly the case, given that the differing terms used in the competing marks are closely connected, if not entirely interchangeable. I do not believe the fact that the common element appears in different positions in the competing marks precludes the marks being seen in this way. In the context of the competing marks as wholes, it remains the case that the common presence of the distinctive and dominant element word ‘VAULT’, combined with strongly allusive, or descriptive, references to characteristics of the services, will result in the average consumer believing there is an economic connection between the parties. Taking all of the above into account, as well as the respective services being identical or highly similar, I am satisfied that the average consumer – even paying between a medium and high level of attention – would assume a commercial association between the parties due to the presence of the identical word ‘VAULT’. Accordingly, I find that there is a likelihood of indirect confusion.

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<sup>15</sup> *Duebros Limited v Heirler Cenovis GmbH*, Case BL O/547/17

<sup>16</sup> *Liverpool Gin Distillery*

## **Conclusion**

51. The opposition under section 5(2)(b) of the Act has been partially successful. Subject to any successful appeal, the application will be refused in respect of the following services:

Class 45: Legal services relating to trade marks and intellectual property; Advisory and consultancy services relating to trade marks and intellectual property protection; intellectual property services; Preparation and provision of documents and reports relating to intellectual property; Legal services relating to the registration of trademarks; Legal services relating to the acquisition of intellectual property; Legal services relating to the exploitation of intellectual property rights; Litigation advice and consultancy relating to intellectual property; Enforcement of trade mark rights; Legal services relating to the negotiation and drafting of contracts relating to intellectual property rights; Legal advice and representation relating to intellectual property rights; Preparation of legal reports and documents relating to intellectual property; Trademark watch services for legal advisory purposes; information services and information provided on-line from a computer database or from the Internet, provision of information and advisory services, all relating to the aforementioned services.

52. In light of my earlier finding, the application will proceed to registration in the UK in relation to the following services, against which the opposition has failed:

Class 38: Providing access to and leasing access time to computer databases concerning intellectual property matters.

## **Costs**

53. Both parties have succeeded in part. However, I consider that the opponent has enjoyed a greater measure of success. As such, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016, with an appropriate reduction to reflect Mr Kingsley-Williams' degree of success. In the circumstances, I award the opponent the following:

Preparing a statement and considering Mr Kingsley-Williams' counterstatement	£200
Preparing written submissions	£300
Official fee <sup>17</sup>	£100
<b>Total</b>	<b>£600</b>

54. I hereby order Mark Kingsley-Williams to pay Vault IP Limited the sum of **£600**. 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 the proceedings if any appeal against this decision is unsuccessful.

**Dated this 12<sup>th</sup> day of April 2023**

**James Hopkins**  
**For the Registrar**

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<sup>17</sup> Although the official fee is not subject to a reduction due to Mr Kingsley-Williams's degree of success, the £200 fee paid by the opponent relates to oppositions which are based on, or include, grounds other than sections 5(1) and/or 5(2). Given that the 5(3) ground was withdrawn for want of supporting evidence, it would not be appropriate to award this level of official fees. Rather, I consider it appropriate to award costs for the opponent's official fees in line with oppositions based on sections 5(1) and/or 5(2) of the Act.