BL O/0237/25

TRADE MARKS ACT 1994

Before the Appointed Person

In the matter of:

UK Trade Mark Application No.UK00003732661 UberPro (stylised) in Classes 3 and 37 in the name of UberPro AB and Simon Jonas (the "**Appellant**")

and

Opposition No. OP000432611 thereto by Uber Technologies, Inc. (the "**Respondent**")

DECISION

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1. This is an appeal in this matter from the decision of the Hearing Officer, A Cooper, dated 5 June 2024.

2. On 14 December 2021 the **Appellant** applied to register the trade mark (the "**Mark**")

The application has number UK 3732661 and was made in relation to the following goods and services:

Class 3: Cleaning sprays; Carpet cleaning preparations; Dry cleaning preparations; Household cleaning substances; Dry-cleaning preparations.

Class 37: Carpet cleaning; Rug cleaning; Domestic cleaning; Dry cleaning;

Cleaning (Dry -); Cleaning of mats; Domestic cleaning services; Cleaning of clothes; Cleaning of leather; Cleaning of upholstery; Cleaning of textiles; Cleaning of furnishings; Cleaning of fabrics; Cleaning of clothing; Clothing (Cleaning of -).

3. Registration was opposed by the Respondent under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

4. Under the section 5(2)(b) ground the Respondent relied upon the earlier registered UK Trade Mark No 3633057 **UBER DIRECT**.

5. Under the section 5(3)(b) ground the Respondent relied upon the following earlier registered UK Trade Marks:

    a. UK TM No 3171549: **UBER**
    b. UK TM No 918055443: **UBER**
    c. UK TM No 913759394: **UBEREATS**
    d. UK TM No 91441422: **UBERPOOL**

    All the Respondent's earlier marks were registered for a very large number of goods and services. These are listed in the Annexes to the Decision, and it is unnecessary to set them out in detail here.

6. The attack under section 5(2)(b) failed in relation to class 37 goods (on the basis that the goods for which UBER DIRECT was registered were dissimilar to the class 37 goods). However, as the attacks based under section 5(3) and 5(4)(a) succeeded in their entirety, the opposition succeeded.

Standard of Appeal

7. This appeal is by way of a rehearing. The approach to such a rehearing was summarized by Mr. Daniel Alexander KC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* [2017] RPC (17) 655 (AP), at [14]-[56] and subsequently approved and applied by Joanna Smith J in *Axogen v Aviv* [2022] EWHC 95 (Ch) as follows:

"24. Although I was referred to numerous cases on the subject …, the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);

ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);

iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], REEF at [28] and Fine & Country at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], Actavis Group at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (Shanks at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], Fage at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

8. I also I bear in mind the guidance given by the Supreme Court in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 (albeit I understand this guidance to be consistent with the decision in *Axogen*), where Lords Briggs and Kitchin explained at [49]-[50]:

> "… on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.
>
> On the other hand, it is equally clear that, for the decision to be "wrong" under CPR 52.21(3), it is not enough to show, without more, that the appellate court might have arrived at a different evaluation."

First Ground of Appeal

9. The Appellant's first Ground of Appeal is summarized in paragraph 2.1 of its Grounds of Appeal as follows:

> The word "uber" is a ubiquitous English word. It is, in our view, a consistently flawed reasoning on the part of the judge that the word "uber" would not be a common word with which people are familiar. The view on "Distinctiveness of the word "UBER" is thus incorrect.

10. The underlying argument concerns whether UBER, which is in origin a German word, would be regarded by a significant number of average consumers as having a meaning in English. Thus, in its counterstatement, the Appellant submitted to the Hearing Officer that:

> It is not possible to trade mark a generic and fundamental word belonging to the German language. "Uber" [meaning] "over" such as; "overbearing", "over the mountain" or "over there".

11. This submission was rejected by the Hearing Officer, for the reasons he gave in detail at paragraph 54 of his decision:

> While the applicants claim that 'UBER' will be understood as German for 'over', I have

> nothing to suggest how many consumers in the UK would be aware of this. I appreciate that some consumers familiar with the German language may be aware of this but without evidence, I am not willing to find that these consumers make up a significant proportion of consumers. Further on this point, I accept that 'UBER' might appear in some dictionaries, as a superlative. However, there is no evidence of how well known and used it is and while it is a word that I have personally heard of, it is not one that strikes me as being in common parlance. So while I find that some average consumers may have heard of it, I am not convinced that this would form a significant proportion of consumers. As a result of the above, my finding here is that the majority of consumers in the UK will simply understand it as a foreign language word with no obvious meaning

12. I reject the Appellant's criticism of this finding. In my view, the Hearing Officer was entitled to find that a) evidence was required to prove the meaning of UBER to the relevant public and b) there was no such evidence. The only circumstances where this would not be the case is where the Hearing Officer was able to take judicial notice of such meaning. This is an extremely high bar. It requires the fact to be proved to be so notorious or well known, that they can be accepted without further enquiry (see *Phipson* on evidence, 20th ed para 3.02). It is a bar which does not come close to being satisfied in this case.

13. I turn now to the question of whether I should admit the extra evidence.

14. The Appellant also sought to introduced on appeal evidence the following:

    a. print outs of dictionary definitions of "UBER" (OED, Cambridge and Collins), and

    b. print outs of online articles showing use of the word UBER on the websites of the following concerns: CNBC, CNN, ftadvisor, abc News, Daily Mail, the Guardian, whatson, the Muse, the Robb Report, Forbes, Wiseadvisor, Topspeed, EEworld, NSN Nevada, Motoring Research).

15. The Respondent submitted (and this was not disputed by the Appellant) that the test for admitting new evidence in this forum on appeal is as set out by Mr Justice Carr in *Consolidated Developments v Cooper* [2018] EWHC 1727 (Ch), namely:

"The cases to which I have referred establish the following principles in respect of the admissibility of fresh evidence in trade mark appeals, sought to be introduced for the first time on appeal:

i) the same principles apply in trade mark appeals as in any other appeal under CPR part 52. However, given the nature of such appeals, additional factors may be relevant;

ii) the *Ladd v Marshall* factors are basic to the exercise of the discretion, which are to be applied in the light of the overriding objective;

iii) it is useful to have regard to the *Hunt-Wesson* factors;

iv) relevant factors will vary, depending on the circumstances of each case. Neither the *Ladd v Marshall* factors nor the *Hunt-Wesson* factors are to be regarded as a straightjacket;

v) the admission of fresh evidence on appeal is the exception and not the rule;

vi) the Gucci decision does not establish that the Court or the Appointed Person should exercise a broad remedial discretion to admit fresh evidence on appeal so as to enable the appellant to re-open proceedings in the Registry; and

vii) where the admission of fresh evidence on appeal would require that the case be remitted for a rehearing at first instance, the interests of the parties and of the public in fostering finality in litigation are particularly significant and may tip the balance against the admission of such evidence."

16. The *Ladd v Marshall* factors referred to by Carr J are set out in the judgment in that case at [1954] 1 WLR 1489 at 1491 as follows:

a. it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial;
b. the evidence must be such that, if given, it would probably have an important influence on the result of the case, though it need not be decisive; and
c. the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, though it need not be incontrovertible.

17. Likewise, the *Hunt-Wesson* factors are set out in the judgment in that case at [1996] R.P.C 234, as follows:

    a. whether the evidence could have been filed earlier and, if so, how much earlier;
    b. if it could have been, what explanation for the late filing had been offered to explain the delay;
    c. the nature of the mark;
    d. the nature of the objections to it;
    e. the potential significance of the new evidence;
    f. whether or not the other side would be significantly prejudiced by the admission of the evidence in a way which could not be compensated, e.g. by an order for costs;
    g. the desirability of avoiding multiplicity of proceedings; and
    h. the public interest in not admitting onto the register invalid marks.

18. In considering whether to exercise my discretion to admit the Appellants new evidence, I have taken into account all the factors discussed above, save for the last Hunt-Wesson factor (which cannot be relevant when considering the admission of evidence to support the admission of a mark to the register).

19. Mr Kjellqvist, who appeared on behalf of the Appellant submitted that the Appellant's new evidence demonstrated the word UBER had a clear meaning as a superlative to the average consumer in the UK:

> We ask the Appointed Person to recognise that 'uber' is indeed a common word in the English language. The previous judgment's conclusion on this point was incorrect. The evidence shows that "uber" is widely known, used and understood by people with a reasonable knowledge of the English language, particularly in the UK. No one can claim exclusive ownership of a single descriptive or non-distinctive term such as 'uber', just as no one can monopolise a single descriptive or non-distinctive term such as 'excellent' or 'the best'.

20. Furthermore, Mr Kjellqvist also submitted that the additional evidence did no more than support a conclusion which the Hearing Officer could in any event have taken judicial notice of.

21. Finally, Mr Kjellqvist submitted that the evidence was not "new" in the sense that it already existed, was already in the public domain and was material that the Hearing Officer could himself have looked up.

22. It was common ground that all the material was publicly available. The material varies in stated publication date (insofar as this can be seen on the face of the documents) from January 2017 to June 2024. Much postdates the date of the application for Mark although I accept that this material may potentially throw some light on the situation at the application date. More importantly, whilst some material (e.g. the Guardian, ft, the Daily Mail) is extracted from publications with a large UK circulation, much of it is material apparently published overseas and whose UK readership cannot, in my view, be assumed. Finally, the bulk (but not all) of the online publication material relates to the use of UBER in the context of wealth (e.g. the ft and Daily Mail articles).

23. Its common ground that insofar as the material in the new evidence pre-dates the date of the hearing before the Hearing Officer it could have been obtained by the Appellant with reasonable diligence. Self-evidently that is not the case in relation to material which post-dates the hearing date. However, it was not suggested that the material that postdated the hearing date fell into a special category (i.e. it proved something that could not have been proved with equivalent material reasonably obtainable before the hearing date). Instead, the Appellant's submission was that all the evidence did the same thing, that is to illustrate what it was submitted the Hearing Officer should have found in any event - namely that the average consumer in the UK would have regarded UBER as a descriptive word indicating a superlative.

24. The Appellant conceded that it could have assembled the new evidence prior to the hearing date and had no excuse, save for the following, as to why it had not done so. As to this, the Appellant submitted that it should not have been necessary to file this evidence because what it showed ought to have been apparent to a Hearing Officer who had carried out appropriate research for the hearing. I reject that submission. No part of the Hearing Officer's function requires him/her to carry out factual research of the kind proposed by the Appellant. Indeed, there are few if any circumstances in which such research would be appropriate (although this is not a point I need to address further here).

25. I do not believe that the new evidence would probably have had an important influence on the outcome of the Hearing Officer's decision. My reasons are as follows:

    a. the dictionary definitions take matters no further forward. As the Hearing Officer made clear in paragraph 54 of the Decision, he accepted that UBER appeared as a word in UK dictionaries, but found, as I have upheld, that the mere appearance of a word of foreign origin in an English dictionary does not prove how well known and used it is.

    b. the remaining evidence whilst consistent with the Appellant's submissions is, in my view, far from strong support for them. The evidence shows that the word UBER is used in the press on occasion as a superlative. In relation to articles which have a clearly substantial UK circulation it does so to only a very limited extent and it does not, in my view, demonstrate a widespread use of the word. It therefore, falls short of showing that as a result a significant number of average consumers would understand the word, taken out of the context of an article, have a meaning in English.

26. The next question I must address is the potential prejudice to the Respondent if I admit the evidence. In my view such prejudice does exist, albeit it is comparatively limited. The Respondent could, and did, address me on the weakness of the evidence itself. However, what it could not do is to submit its own evidence on the point. It is arguable that the scope of such evidence is limited (essentially it would be evidence attempting to proving a negative) but nonetheless I accept, with some hesitation, that there is scope for some limited evidence in this regard. If additional evidence were to be admitted on the part of the Respondent it would, in my view, require this matter to be remitted to the UKIPO.

27. Drawings these points together, and reminding myself of the criteria set out above, I am of the firm view the evidence should not be admitted.

28. I therefore (a) dismiss the application to introduce the new evidence and (b) dismiss Ground 1 of the Appeal.

Ground 2 of the Appeal

29. This Ground asserts that that the Hearing Officer failed to take into sufficient account the effect of the stylised effect of the logo element of the Mark.

30. The Hearing Officer addressed the stylised effect of the logo at paragraph of the Decision as follows [52]:

> Visually, the marks share the word 'UBER'. While presented differently in the applicants' mark, the opponent's mark is a word only mark registered in black and white so may, therefore, be presented in any colour and in any standard typeface. As such, the difference in stylisation of the words has no impact here. The marks differ in the presence of 'DIRECT' in the opponent's mark and the word 'Pro' in the applicants' mark. Further, the device element and border of the applicants' mark have no counterpart in the opponent's mark. While the points of differences all play different and lesser roles in the respective marks, they are still points of visual difference, albeit slight ones. Taking all of this into account and bearing in mind the overall impression of the mark together with the fact that the beginning of the marks are similar (being where consumers tend to focus), I consider these marks to be similar to between a medium and high degree.

31. The Appellant puts this ground as follows in its Grounds of Appeal at [3.1]-[3.3]:

> UberPro's logo is also similar to a "retro" logo, which makes it hard to believe that Uber Technologies, Inc. would use at all in its graphic design, and which Uber Technologies, Inc. would not want to use, and (exactly why Uber Technologies, Inc. would not want to use), is a graphic design that people would not in any way associate with the company. That the red border element would thus play a negligible role due to its alleged nature as a banal border element, seems like a strange assessment.
>
> It is also not the case, in the light of section 3.1, as the judgment makes it appear, that the difference in the stylisation of the words would have no effect. The difference in logos is therefore not as small as claimed in the form that it would be "similar to between a medium and high degree".
>
> Consequently, we do not share the view that the marks could be confused with each other from the consumer's point of view or that UberPro would in any way result in Uber Technologies, Inc. "losing control over its reputation".

32. The Appellant did not suggest that the Hearing Officer had misdirected himself to the law. As the paragraphs set out above make clear, its submissions are to the effect that the balancing process carried out by the Hearing Officer's in his evaluative process was wrong. Importantly, these submissions do not in my view identify a flaw (as meant by the Supreme Court in *Lifestyle Equities*) in the Hearing Officer's reasoning. Furthermore, there is in my view no basis for concluding that the Hearing Officer's finding was one that no reasonable Hearing Officer could have reached on the facts. This Ground of Appeal must therefore fail.

Ground 3

33. The third ground of appeal is based on an assertion that the Respondent itself uses the "UBER" prefix as a superlative. Thus, paragraphs 4.1 – 4.3 of Grounds of Appeal the Appellant state as follows:

> Uber Technologies, Inc. themselves use the "uber" prefix to suggest a superior and revolutionary service. The founders have derived the name because "uber" has a superior meaning and is "above all the rest", which is a bedrock principle for the company, implying the ultimate cab company.
>
> In the beginning, when the company was founded in San Francisco, it was called UberCab, Inc. The company was later renamed Uber Technologies, Inc. This was after complaints from San Francisco taxicab operators. An alternative scenario would be that the company would initially have been called "Excellent Cab", "The Best Cab" or why not "Pro Cab", and then switch to using the name "Excellent", "The Best" and "Pro Cab".
>
> "Uber" is an often used prefix to indicate superiority or excessiveness. "Uber" was chosen to represent a service that transcends traditional taxi services, offering users a more convenient, efficient, and high-quality transportation experience. This name conveys a sense of superiority, excellence, and innovation, reflecting the company's mission to surpass conventional transportation options. The vision extended beyond providing an alternative to taxis; it aimed to revolutionize the entire urban transportation experience.
>
> That you cannot use UberPro because of Uber Technologies, Inc. is like saying that you cannot use the word "Pro", because another company uses "Pro" or "Professional" in its name. If, per section 4.2 it had been "Pro" instead of "Uber", UberCab would be ProCab, and after removing "Cab", the company would be named "Pro Technologies, Inc." and called "Pro" instead. If it is now argued that Uber Technologies, Inc. "owns" a description in the form of the ubiquitous prefix "Uber" it would, according to this argument, be the same as a company "owning" the ubiquitous word "Pro" or "Professional".

> Thus, it is not possible to prevent UberPro from using the trade mark UberPro if one considers that it is not possible to "own" descriptive words such as "Pro", "Professional", "Excellent" or "The Best".

34. There are two difficulties with these submissions. First, as the Respondent submitted, they are not supported by evidence. Second, and in my view more importantly, they reveal no material flaw in the reasoning of the Hearing Officer (e.g. that this evidence was before him, and he failed to take it into account).

35. I therefore dismiss this ground of appeal.

Ground 4

36. The fourth ground of appeal is headed "Far-Fetched Arguments and the Issue of Difference Classes". The heart of this ground of appeal is directed to the Decision insofar as it relates to likelihood of confusion in the cases where the Hearing Officer had concluded that the Mark and Earlier Marks Goods were dissimilar. Paragraph 5.4 of the Grounds of Appeal state as follows:

> The goods and services for which the opponent enjoys a reputation are thus minimal. But according to the judgment, while the goods and services are dissimilar, it is not the end of the matter. The judgment does not elaborate on any reason for the view that usage of UberPro on dissimilar goods or services would cause consumers to believe that there is a connection with the ride-share provider. There is no elaboration on why there is no hesitation in finding that the opponent's mark would be brought to mind when consumers view the applicants' mark.

37. Although not put this way, this is a submission directed to the Hearing Officer's findings in relation to the opposition under section 5(3). That is clear, as the Hearing Officer dismissed that part of the section 5(2)(b) opposition that related to the class 37 goods because he had found that those goods were dissimilar to those of the Earlier Mark Relied upon.

38. The Hearing Officer's conclusions on section 5(3) are set out at paragraphs 87-89 of the Decision as follows:

> 87. In the case of confusion under section 5(2)(b) grounds, a degree of similarity between goods and services is required for a finding of confusion, which is based on the normal expectations of

> average consumers. Therefore, in the normal course of events, where there is no similarity between goods and services, there would be no confusion. That being said, the provisions of section 5(3) grounds offer additional protection which takes into account the repute and distinctiveness of the earlier marks. For example, some marks are so distinctive and well known that there is likely to be some confusion almost irrespective of the goods or services on which the marks are used. As such, the present assessment requires me to decide whether, in this particular case, the average consumer would be caused to believe that the user of 'UberPro' for the dissimilar goods and services is connected to the user of the opponent's second mark. In my view, use of 'UberPro' on dissimilar goods or services would still probably cause consumers to believe that there was a connection with the ride-share provider, such as a licence or, further, a diversion of business interests.
>
> 88. Taking all of the above into account, I find that the repute and distinctiveness of the opponent's second mark would result in a significant number of average consumers being confused. Although the opponent has no reputation of any sort for the applicants' goods or services and, whilst the consumer may be surprised at a foray into cleaning products or services, the reputation of the opponent's second mark is likely to lead the average consumer to think that there is an economic connection between the users of the marks.
>
> 89. Even if it is not right that there would be confusion where dissimilar goods are concerned, when all of the above is taken into account, I have no hesitation in finding that the opponent's second mark would be brought to mind when consumers view the applicants' mark. Therefore, I am satisfied that the reputation of the opponent's second mark and its similarities with the applicants' mark will create the necessary link across the contested specification.

39. Before reaching these conclusions, the Hearing Officer addressed the applicable law (Decisions at paragraphs 66-68). The Hearing Officer's statement of the law is, in my view, accurate and sufficiently complete for the matters he had to address. It was not criticised in any material way by the Appellant. The Hearing Officer then went through an analysis of the relevant facts in order to address the questions required by the legal approach he had set out. The Appellant's criticism of those findings is effectively threefold:

    a. they proceed on a wrong factual basis because of the reasons given in Ground 1;
    b. there is no elaboration to explain why the usage of UberPro on dissimilar goods or services would cause consumers to believe that there is a connection with the ride-share provider, and
    c. there is no elaboration to explain why the opponent's mark would be brought to mind when consumers view the applicants' mark.

40. I have already addressed, and dismissed, the first of these submissions. I also reject the second and third submissions. The Hearing Officer, by going through the various steps in his section 5(3) analysis (as I have described above) provided himself with a reasoned basis for reaching his conclusions on section 5(3). It is also clear that all those steps

were taken into account by the Hearing Officer when reaching his overall conclusions on section 5(3) (he expressly states that his conclusions are based on "taking into account all of the above"). For those reasons I find that the Hearing Officer did provide sufficient elaboration (and more importantly set out sufficient basis) for his conclusions.

41. Finally, the Hearing Officer's conclusions under the section 5(3) head of opposition, fell within the range of conclusions open to any reasonable Hearing Officer based on the material before him. For all these reasons this ground identifies no flaw (within the meaning of *Lifestyle Equities*), and I therefore dismiss it.

Ground 5

42. Ground 5 relates to the Hearing Officer's visual and conceptual comparisons of the Mark and the Earlier Marks, his, and to his assessment of the likelihood of confusion.

43. The paragraph of the Hearing Officer's decision relevant to the visual comparison. states as follows [52]

> Visually, the marks share the word 'UBER'. While presented differently in the applicants' mark, the opponent's mark is a word only mark registered in black and white so may, therefore, be presented in any colour and in any standard typeface. As such, the difference in stylisation of the words has no impact here. The marks differ in the presence of 'DIRECT' in the opponent's mark and the word 'Pro' in the applicants'. **Further, the device element and border of the applicants' mark have no counterpart in the opponent's mark. While the points of differences all play different and lesser roles in the respective marks, they are still points of visual difference, albeit slight ones.** Taking all of this into account and bearing in mind the overall impression of the mark together with the fact that the beginning of the marks are similar (being where consumers tend to focus), I consider these marks to be similar to between a medium and high degree.

44. In relation to the visual comparison, the Appellant submitted that the Hearing Officer was:

    a. wrong to consider that the opponent's word mark, whilst registered in black and white, could be presented in any colour and any standard typeface, and,

    a. failed to give proper weight to the stylisation of the Mark.

45. The first point is wrong in law. At the point in the analysis when the visual comparison is made the Hearing Officer must consider notional and fair use of the Earlier Mark. It is trite law that that use includes use in any standard typeface and any standard colour. The second point is purely one of weight and as such identifies no specific error in the analysis carried out by the Hearing Officer.

46. Thus, the Appellant has failed to identify a flaw as such in the manner in which the Hearing Officer carried out his visual comparison. In my view there is no such flaw and the Hearing Officer's finding lay within the range of findings open to a reasonable Hearing Officer.

47. Ground 5 does not criticise the Hearing Officer's aural comparison.

48. The arguments in relation to the Hearing Officer's conceptual comparison are underpinned by the issue of whether or not a substantial proportion of average consumers would understand the word UBER to have a meaning. I have already addressed, and dismissed, this issue in the context of Ground 1.

49. The Appellant also submitted that the Hearing Officer was wrong to find that as UBER had no meaning it was conceptually neutral. I reject that submission. If the word is found to have no meaning to the average consumer, then it necessarily follows that, save in relation to issues of distinctiveness and reputation which are separately considered, it carries no concept with it (i.e. it is conceptually neutral).

50. The Appellant also sought to challenge the Hearing Officer's finding in relation to the distinctiveness of the Earlier Marks. However, its basis for doing so was effectively the same as its submissions under Ground 1.

51. Finally, the Appellant challenged the Hearing Officer's finding in relation to the existence of a likelihood of confusion. That challenge raised no points of principle that have not been addressed already.

52. For all these reasons I dismiss Ground 5.

The Decision under Section 5(4)(a)

53. Finally, I note that the Grounds of Appeal make no reference to the Hearing Officer's decision under section 5(4)(a) and therefore do not seek to overturn that decision. Even if the Appellant had succeeded on its Grounds of Appeal, it would have had to overturn the decision under section 5(4)(a). Whilst I accept that some of the matters raised in relation section 5(2)(b) and section 5(3) could have had an impact on the evaluation necessary under section 5(4)(a), the matters need nonetheless to be raised properly on appeal which they were not. I any event having rejected those matters as set out above, they do not arise. I would therefore have rejected this appeal in any event based on the Hearing Officer's finding under section 5(4)(a).

Conclusion

54. This appeal fails. The Respondent is entitled to a contribution to its costs which I assess to be £1500. In addition, the Respondent is now entitled to the £1300 contribution to costs order by the Hearing Officer. These sums shall be paid within 21 days of the date of this Decision.

GEOFFREY PRITCHARD
APPOINTED PERSON
10 March 2025