

O/0569/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION  
NO. WO0000001660123 BY  
PVH EUROPE B.V.  
TO REGISTER AS A TRADE MARK:

**HATCH**

IN CLASSES 41 & 42

AND

OPPOSITION THERETO  
UNDER NO. 437319 BY  
NANOCO LIMITED

## Background & Pleadings

1. PVH Europe B.V. (“**the applicant**”) is the holder of the International Registration no. WO0000001660123 (“IR”) in respect of the mark shown on the front page of this decision with a UK designation date of 7 January 2022. The applicant claims a priority date of 21 October 2021 from the registration at the Benelux Office for Intellectual Property (BOIP) with filing number 1452390. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 5 August 2022. I note that on 11 May 2023 the applicant filed a Form TM21B, published on 27 July 2023, with which Classes 9, 35, and 36 were removed from the specification, proceeding with the following services:

**Class 41:** Sales training services; sales training services for retailers; education services.

**Class 42:** Software development, programming and implementation; constructing an internet platform for electronic commerce; development of computer platforms; hosting of platforms on the internet; software as a service [saas]; platform as a service [paas]; platform as a service [paas] featuring software platforms for transmission of images, audio-visual content, video content and messages; programming of software for e-commerce platforms; design services for display systems for presentation purposes; the aforementioned services being provided only in relation to clothing, footwear and fashion accessories; the aforementioned services exclude the development and programming of software and mobile apps for operating nightlights, clocks and sound machines.

2. Nanoco Limited (“**the opponent**”) initially opposed the application on the basis of Sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”)<sup>1</sup>. The opponent is the proprietor of the following mark:

<b>Trade Mark no.</b>	UK00003439866
<b>Trade Mark</b>	HATCH
<b>Goods &amp; Services for which the mark is registered</b>	Classes 7, 9, 35, 38 & 40
<b>Relevant Dates</b>	Filing date: 28 October 2019
	Date of entry in register: 21 February 2020

3. Following the applicant’s TM21B, the opponent limited the grounds of the opposition to Section 5(2)(a) of the Act, relying only on its goods and services under Classes 9, 35, and 38 for the purposes of this opposition.
4. Under Section 6(1) of the Act, the opponent’s trade mark clearly qualifies as an earlier trade mark. Further, as protection of the opponent’s earlier mark was conferred less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
5. The opponent in its notice of opposition claims that the competing marks are identical, and the goods and services are either identical or similar. I note that these contentions were made before the filing of the applicant’s TM21B.
6. The applicant filed a defence and counterstatement denying the grounds of the opposition in their entirety. Thus, it requests that the opposition

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<sup>1</sup> The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

under 5(1) and 5(2)(a) be rejected, and the application to be accepted for registration in full.

7. A hearing was neither requested nor was it considered necessary. Both parties filed written submissions in lieu of a hearing, which will not be summarised but will be referred to as and where appropriate during this decision. This decision has been taken following a careful consideration of the papers.
8. In these proceedings, the opponent is represented by Maucher Jenkins, and the applicant is represented by HGF Limited.

### **Preliminary Issue**

9. I note that the opponent's submissions erroneously state that the opposition is limited to Section 5(2)(b) of the Act only, when in actual fact it is based on Section 5(2)(a). This is evident from the body of the submissions where the opponent makes reference to the marks being identical. As such, any submissions made would be considered to be referring to 5(2)(a) grounds. I will, therefore, proceed on that basis and will consider only Section 5(2)(a) of the Act.

### **Decision**

#### **Section 5(2)(a) of the Act**

10. Section 5(2)(a) of the Act is as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

11. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 Trade Marks**

12. It is a pre-requisite of Section 5(2)(a) of the Act that the marks be identical. I note that the applicant in its submissions admits that the competing marks are identical. Although there is nothing for me to assess in this regard, for completeness, I note that the competing marks share the identical word "HATCH" and are self-evidently identical.

## Comparison of Goods and Services

13. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

14. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

15. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

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

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

16. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole

basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

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

18. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

19. The competing goods to be compared are shown in the following table:

<b>Opponent’s Goods &amp; Services</b>	<b>Applicant’s Goods</b>
<p><b>Class 9:</b> E-commerce software for mobile phones, smart phones, tablet computers and other electronic devices; cases for mobile phones, smart phones, tablet computers and other electronic devices; accessories for mobile phones, smart phones, tablet computers and other electronic devices; electronic equipment for point-of-sales systems, namely, terminals, advertisement display monitors, keyboards and printers;</p>	<p><b>Class 41:</b> Sales training services; sales training services for retailers; education services.</p> <p><b>Class 42:</b> Software development, programming and implementation; constructing an internet platform for electronic commerce; development of computer platforms; hosting of platforms on the internet; software as a service [saas]; platform as a service [paas]; platform as a service</p>

<p>audio speakers; headphones; batteries and battery chargers; none of the aforesaid class 9 goods relating to weighing scales, baby care, kids monitors, nightlights, alarms and other sleep related products.</p> <p><b>Class 35:</b> Retail services, retail store services and on-line retail services connected with the sale of mobile phones, smart phones, tablet computers and other electronic devices and cases and accessories therefor; business management and consultancy services relating to franchising, all connected with the sale of mobile phones, smart phones, tablet computers and other electronic devices and cases and accessories therefor.</p> <p><b>Class 38:</b> Telecommunication services; business telecommunications; provision of on-line portals and trading platforms.</p>	<p>[paas] featuring software platforms for transmission of images, audio-visual content, video content and messages; programming of software for e-commerce platforms; design services for display systems for presentation purposes; the aforementioned services being provided only in relation to clothing, footwear and fashion accessories; the aforementioned services exclude the development and programming of software and mobile apps for operating nightlights, clocks and sound machines.</p>
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20. For the avoidance of doubt, pursuant to Section 60A of the Act, goods and services are not to be regarded as similar or dissimilar simply because they fall in the same or different Class.
21. Both parties have made lengthy submissions, which I have taken into consideration. I do not propose to reproduce them in full here and will refer to them where this is deemed necessary.

22. I note that the opponent has made reference to points of similarity between the competing specifications based on the EUIPO's similarity tool and has annexed the relevant printouts demonstrating the given results. However, I note that these are not binding upon me, and I will conduct my assessment based on the principles set out above and the competing terms before me.
23. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.<sup>2</sup>

### **Class 41**

#### *Sales training services; sales training services for retailers*

24. In its submissions, the opponent claims similarity between the contested services and Class 35 services in the earlier specification. The opponent submits that the competing services are complementary as follows:

“While training services per se are not in competition with retail services, the fact that these services are specified as being for sales training and training services for retailers indicates that they are at least complementary, since the provision of retail services requires well-trained staff. Moreover, consultancy and external business management usually involves training activities providing the client and its workers with new tools and strategies to face ongoing market endeavours. The Applicant's Training Services are therefore indispensable to the provision of the Opponent's retail and business management and consultancy services.”

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<sup>2</sup> *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

25. In accordance with *Avnet*, I must consider the core meaning of the services. The contested services in question relate to sales training which are used to improve the skills and knowledge of those undertaking the training. The opponent's services "*Retail services, retail store services and on-line retail services connected with the sale of mobile phones, smart phones, tablet computers and other electronic devices and cases and accessories therefor*" concern the retail (in-store and online) of the said goods to the consumers. Whilst the subject matter of the contested services being provided is that of sales, I do not consider that the average consumer will consider that the competing services will be provided by the same providers. Thus, the training services are not complementary to the retail services in the sense that one is indispensable for the other, nor are they in competition. The competing services differ in nature, purpose, and method of use. Although there is the potential for the users to coincide at a very general level, this is not sufficient to create overall similarity between the competing services. I consider the respective services to be dissimilar.
26. Moreover, the opponent also submits that the applicant's services should be considered as indispensable to the "*business management and consultancy services relating to franchising*" services. I disagree with this submission. In my view, all of the Class 35 business management and consultancy services are intended to support and provide businesses and other commercial entities with the administrative tools to improve the efficacy, effectiveness and practical running of a business including training businesses. I find this to be a step further away from the contested services as they do not share the same nature or purpose. The users may overlap on a superficial level as the services may all be used by businesses, but the methods of use and trade channels are different, and there is no competition of complementarity of the type where "customers may think that responsibility for the goods lies with the same undertaking". Therefore, I find these to be dissimilar.

*Education services*

27. These are education services which are rendered by educational institutions. The opponent compares the contested services to its Class 35 services. Following the approach in the preceding paragraph, I find that there is a no similarity for the same reasons advanced above.

#### **Class 42**

*Software development, programming and implementation; programming of software for e-commerce platforms*

28. The contested services concern the software development and programs, including e-commerce platforms, which will be supplied to third parties who wish to have the software tailored to their own particular requirements. The opponent's term "*E-commerce software for mobile phones, smart phones, tablet computers and other electronic devices*" in Class 9 is the closest comparable term. The applicant submits that "the fact that the Opponent's software is limited to a particular field means there is no similarity or overlap with the services provided by the Applicant under Class 42." However, I do note that the contested specification includes programming software services for e-commerce platforms. In this regard, I consider the earlier goods to be the end result of software development. As a result, there exists a complementary relationship as without the software development and programming services there would be no end product in the form of the programs/software. While some of the earlier software products are specified as being for electronic devices, the contested software services are not limited or they pertain to the same field (e-commerce) and so could include the development of such specific software. As such, it would not be unreasonable for the consumer to expect both goods and services to be provided by the same or economically linked undertakings. There will be some overlap in trade channels, as the earlier goods would be purchased from websites or app stores, sometimes directly from software producers, and the contested services are provided by specialist software companies. However, while the services relate to software and computer programming, the nature,

purpose, and method of use are different to that of the goods themselves. Overall, I consider the competing goods and services to be similar to a medium degree.

29. I must add that the limitations “*none of the aforesaid class 9 goods relating to weighing scales, baby care, kids monitors, nightlights, alarms and other sleep related products*” added to the earlier specification, and “*the aforementioned services being provided only in relation to clothing, footwear and fashion accessories; the aforementioned services exclude the development and programming of software and mobile apps for operating nightlights, clocks and sound machines*” added to the contested specification, do nothing to materially affect matters.

Software as a service [saas]

30. The contested services enable the distribution of software to users through online channels via a ‘portal’ or ‘cloud’. Following the same approach made in the preceding paragraph, there is similarity between the earlier goods “*E-commerce software for mobile phones, smart phones, tablet computers and other electronic devices*” in Class 9 and the contested services. The competing goods and services both involve software, but the nature of the applicant’s goods differs from the opponent’s services. The method of use will differ as the applicant’s software will be accessed by consumers online via a portal or cloud, but the opponent’s software will be purchased and downloaded to a device. Trade channel overlap is possible as the same undertaking might provide both software as goods and software as a service in the given fields. There will also be an overlap in users. I consider there will be a degree of competition between the goods and services as users may be faced with the choice of selecting the contested services to use via an online portal or purchasing the appropriate software as goods. The respective goods and services are not important nor indispensable from one another to the extent that the average consumer would believe that the goods and services are derived from the same undertaking. As such, there is no complementary relationship to be found. Therefore, I

consider the competing goods and services to be similar to a medium degree.

*Platform as a service [paas]; platform as a service [paas] featuring software platforms for transmission of images, audio-visual content, video content and messages*

31. The contested services are a type of cloud computing service that provides a cloud platform for developing, running and managing software applications, including the transmission of images, audio-visual content, video content and messages. Following the same approach in the preceding paragraph, I consider that the earlier term “*E-commerce software for mobile phones, smart phones, tablet computers and other electronic devices*” in Class 9 and the contested services are similar to a medium degree.

*Design services for display systems for presentation purposes*

32. The contested service primarily involves designing displays that present visual information to users. The opponent submits that there is similarity between the contested services and the earlier “*telecommunications services*” in Class 38 for the following reasons: “on the basis that these services have the same nature, purpose and method of use, are in competition, are provided by the same entities, through the same distribution channels, and are used by the same consumers. They are also complementary.” However, it is my view that, on an ordinary and commonsense construction of the term “*telecommunications services*”, the core of the service is the facilitation of communication and the exchange of information between one party and another, for instance, via broadcasting or data transmission. Regarding the opponent’s submission on complementarity, neither party’s offering is important or indispensable to the other, and I consider it very unlikely that the average consumer would presume that a telecommunications company would also provide services in designing display systems. Bearing in mind the purposes,

users, trade channels, methods of use of the parties' services, together with the matter of competition, I do not consider the contested services to bear any similarity to the earlier services. Therefore, I consider them to be dissimilar.

*Constructing an internet platform for electronic commerce; hosting of platforms on the internet; development of computer platforms*

33. The contested terms relate largely to the construction and the provision of digital services that facilitate online users to interact and participate in networked sites. The opponent argues that the contested terms are similar to its "*telecommunications services*". However, in the absence of evidence and further guidance from the opponent, it is not obvious to me how these services could be similar. For example, construction or hosting of internet platforms is a particular field of expertise and will have different uses and trade channels to telecommunication services. The competing services have different nature, purpose, method of use, users, and trade channels. There is no complementary relationship between the competing services as they would not be indispensable to each other. I find that they are dissimilar.
34. For completeness, I will compare the contested services to the opponent's goods "*E-commerce software for mobile phones, smart phones, tablet computers and other electronic devices*" in Class 9. The contested services concern the construction/hosting/development of such platforms which essentially form the infrastructure, whereas the earlier goods are the means, i.e. software, for the end-users to access e-commerce platforms through their devices. These clearly have a different nature and purposes. Regarding methods of use, the opponent's software is likely to be accessed via a device where the user can access e-commerce as opposed to the applicant's services, which are likely to be accessed via contact with a provider because of the need to discuss complex requirements and needs for the development/hosting of platforms. Therefore, their methods of use are different. Even if the applicant's services can be accessed via a

computer, a general similarity does not result in any shared methods of use. The e-commerce software for the given devices is in no way indispensable or important to the provision of the applicant's services.<sup>3</sup> I see no reason why the consumers would consider them to be provided by the same undertakings. Thus, there is no complementary relationship between the respective terms. There will be no overlap in the trade channels and there is no degree of competition between them. I do not consider there to be any similarity between the goods and services.

35. I have considered the other goods and services in the opponent's specification and, in the absence of any further submissions to assist me, I see no other point of similarity with the applicant's services which improves the opponent's position.
36. The likelihood of confusion does not arise in relation to the application's services in Classes 41 and 42 which are dissimilar to the goods and services of the earlier mark.<sup>4</sup> **The opposition cannot succeed against dissimilar goods and services and, therefore, is dismissed insofar as it concerns the following terms:**

**Class 41:** Sales training services; sales training services for retailers; education services.

**Class 42:** Design services for display systems for presentation purposes; Constructing an internet platform for electronic commerce; hosting of platforms on the internet; development of computer platforms; the aforementioned services being provided only in relation to clothing, footwear and fashion accessories; the aforementioned services exclude the development and programming of software and mobile apps for operating nightlights, clocks and sound machines.

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

<sup>4</sup> Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

## Average Consumer and the Purchasing Act

37. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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 goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

38. In relation to the goods at issue, they cover a range of items. The average consumer of the goods will be a member of the general public without excluding business users. Such goods can be selected from stores, including specialist ones, brochures, catalogues, and online. In retail premises, the goods will be displayed on shelves, where they will be viewed and self-selected by consumers. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment. Such goods range, in my experience, from low to those of medium value, such as smartphones or tablet computers. Even for those at the inexpensive end of the scale, the average consumer may examine the product to ensure that they select the correct type and that it is fit for purpose. Thus, the average consumer will pay a medium degree of attention, heightened slightly for more expensive goods such as smartphones.

39. For the services at issue, the average consumer will be a member of the general public or business users/professionals. The consumers will select such services by looking through brochures, websites, or signs on a physical property so the visual element will be important. However, I do not discount the aural element, as word-of-mouth recommendations may influence consumers' decisions. The cost of some services will be relatively significant, such as software as a platform service, contributing to the selection process of the service provider. Given the more specialist nature of the services in play, especially those selected by business users, I consider that the average consumer will pay a slightly higher than average degree of attention in choosing the service provider.

### **Distinctive Character of the Earlier Trade Mark**

40. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public

which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

41. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
42. The opponent has not shown use of its mark and, thus, it cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the earlier mark to consider. The earlier mark consists of the word “HATCH” which is a well-known dictionary word with no suggestive or allusive significance in relation to the goods for which it is registered. Thus, I consider that the earlier mark is inherently distinctive to a medium degree.

### **Likelihood of Confusion**

43. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.<sup>5</sup> It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater may be the likelihood of confusion. I must also keep in mind that the average consumer rarely has the

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<sup>5</sup> See *Canon Kabushiki Kaisha*, paragraph 17.

opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.<sup>6</sup>

44. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

45. Earlier in this decision I have concluded that:

- the competing marks are identical;
- the goods at issue range from similar to a medium degree;
- the average consumer for the goods and services at issue will be a member of the general public and business users/professionals, and the selection process is predominantly visual without discounting aural considerations. The level of attention paid for the goods will be medium, heightened slightly for more expensive goods. As for the services, the average consumer will pay a slightly higher than a medium degree of attention in choosing the service provider;
- the earlier mark has a medium degree of inherent distinctiveness.

46. Taking into account the above factors and considering the principle of interdependency, there is a likelihood of confusion. Due to the identity of the marks, which offsets a lesser degree of similarity between the goods, and the distinctiveness of the earlier mark being of a medium degree, I consider that the average consumer, in this case, will mistakenly believe that the respective goods and services come from the same or economically-linked undertakings. As for the latter instance, the average consumer will not put this all down to a coincidental use of the same mark

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<sup>6</sup> See *Lloyd Schuhfabrik Meyer*, paragraph 27.

and will regard it as an economic connection possibly as an expansion of the business to IT services. There is, therefore, a likelihood of confusion.

## **Outcome**

47. Part of the opposition under Section 5(2)(a) **succeeds and, subject to an appeal against this decision, the application will be refused for the following goods and services:**

**Class 42:** Software development, programming and implementation; programming of software for e-commerce platforms; Software as a service [saas]; Platform as a service [paas]; platform as a service [paas] featuring software platforms for transmission of images, audio-visual content, video content and messages; the aforementioned services being provided only in relation to clothing, footwear and fashion accessories; the aforementioned services exclude the development and programming of software and mobile apps for operating nightlights, clocks and sound machines.

48. Part of the opposition **fails, and the application may, subject to appeal, proceed to registration for the following goods:**

**Class 41:** Sales training services; sales training services for retailers; education services.

**Class 42:** Design services for display systems for presentation purposes; Constructing an internet platform for electronic commerce; hosting of platforms on the internet; development of computer platforms; the aforementioned services being provided only in relation to clothing, footwear and fashion accessories; the aforementioned services exclude the development and programming of software and mobile apps for operating nightlights, clocks and sound machines.

## **Costs**

49. As both parties have achieved what I regard as a roughly equal measure of success, I direct that both parties should bear their own costs.

**Dated this 19<sup>th</sup> day of June 2024**

**Dr Stylianos Alexandridis**

**For the Registrar,**

**The Comptroller General**