

O/0685/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER UK00003923361
BY THE PRINKAPP LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:**

Prink

IN CLASS 9

AND

**AN OPPOSITION THERETO UNDER NUMBER 600003099
BY PRINKER KOREA INC.**

BACKGROUND AND PLEADINGS

1. On 15 June 2023, The PrinkApp Limited (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 25 August 2023 and registration is sought for goods in Class 9.¹

2. On 31 October 2023, Prinker Korea Inc. (“the opponent”) filed a fast track opposition opposing the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).² The opponent relies upon UK trade mark number UK00918202723, PRINKER, which has a filing date of 27 February 2020 and a registration date of 22 September 2020.³ For the purposes of this opposition, the opponent relies upon some of the goods for which its mark is registered, in Class 9.⁴

3. The opponent opposes the application on the basis that the respective marks are phonetically, visually and conceptually highly similar, and the goods are identical or similar, resulting in a likelihood of confusion.

4. Given its earlier filing date, the opponent’s mark is an earlier mark in accordance with section 6(1) of the Act. Further, in accordance with section 6A of the Act, the earlier mark is not subject to proof of use and so the opponent may rely upon all the goods identified for the purposes of this opposition.

5. The applicant filed a defence and counterstatement denying a likelihood of confusion on the basis that neither the marks nor the goods are identical or similar.

6. The opponent is represented by Beck Green LLP; the applicant is unrepresented.

¹ These will be listed in the goods comparison, at my paragraph 19.

² 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.

³ This mark is a comparable mark and so retains the filing date of the EU trade mark from which it was created.

⁴ These will be listed in the goods comparison, at my paragraph 19.

7. The opponent filed a fast track opposition. Rule 6 of the Trade Marks (Fast Track Opposition (Amendment) Rules 2013, S.I. 2013 2235 disappplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but it provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

8. The effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. Further, Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

9. In this case, neither party sought leave to file evidence. A hearing was neither requested nor was it considered necessary. Only the opponent chose to file written submissions, which I will address at the relevant points in this decision. This decision is made following a careful consideration of all the papers before me.

DECISION

10. Sections 5(2)(b) and 5A of the Act are as follows:

“5. [...]

(2) A trade mark shall not be registered if because –

(a) [...]

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood 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.”

Relevant law

11. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must 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

12. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

13. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281 for assessing similarity between goods also include an assessment of the users and channels of trade of the respective goods.

14. Further, in *Kurt Hesse v OHIM*,⁵ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,⁶ 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.”

15. In *Gérard Meric v OHIM*, the GC confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):⁷

⁵ Case C-50/15 P.

⁶ Case T-325/06.

⁷ Case T-133/05.

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

16. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:⁸

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

17. Section 60A of the Act is also relevant, which states that:

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

(a) are not to be regarded as being similar to each other on the ground that they appear to be 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 Purpose of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

⁸ BL O/399/10.

18. Finally, the judgment of Jacob J (as he then was) in *Avnet Incorporated v Isoact Limited* is also relevant:⁹

“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 are shown below:

The applicant's goods

Class 9 *Mobile application software; Downloadable smart phone application software; Software for online messaging.*

The opponent's goods

Class 9 *Document printers; bar code printers; photo printers; printer parts, namely, printer cables; downloadable smart phone application software for mobile printing; document printers for wirelessly connecting to mobile devices; network servers; printer servers; printheads for ink-jet document printers; unfilled ink cartridges for computer printers; downloadable computer ecommerce software to allow users to perform electronic business transactions via a global computer network; consumer electronic coupons downloaded from a global computer network; downloadable image files containing coupons for mobile printing; downloadable controlling software for computer printers; ink jet document printers; carrying cases specially adapted for computer document printers; print heads for computer document printers; digital media servers; downloadable software for downloading consumer*

⁹ [1998] F.S.R. 16.

coupons; downloadable software for downloading event tickets; downloadable printer programs for operating printers and printing.

20. I will now compare the parties' goods, taking each of the applicant's goods in turn, and grouping terms together where appropriate.

Mobile application software; Downloadable smart phone application software

21. These terms in the applicant's specification are broad terms relating to mobile or smart phone application software. Neither term is limited to a particular purpose, and the *mobile application software* is limited neither to downloadable nor non-downloadable software. These broad terms would encompass the opponent's term *downloadable smart phone application software for mobile printing*. In accordance with *Meric*, these goods are considered identical.

Software for online messaging

22. The opponent's best case for similarity with the above term is one or more of the following terms: *downloadable smart phone application software for mobile printing; downloadable computer ecommerce software to allow users to perform electronic business transactions via a global computer network; downloadable controlling software for computer printers; downloadable software for downloading consumer coupons; downloadable software for downloading event tickets; downloadable printer programs for operating printers and printing*. This is on the basis that all of these terms, as well as the applicant's term, relate to software. The opponent attests to their high degree of similarity on the following basis:¹⁰

"Online messaging is broad in that it can generally encompass instant messaging through computers or mobile devices, including embedded chat functions within a website or app. The term "*Software for online messaging*" does not limit the type of software or medium of online messaging. Therefore, this type of software could also be used as part of other software applications

¹⁰ See the opponent's written submissions dated 2 April 2024.

such as those in the Opponent's goods. For instance, the term "*downloadable smart phone application software for mobile printing*" relates to a phone app for mobile printing which could encompass chat functions. Similarly, the following term relates to software to be used for e-business transactions which again could also encompass chat functions: "*downloadable computer ecommerce software to allow users to perform electronic business transactions via a global computer network*". Therefore, in particular the highly complementary nature of "*Software for online messaging*" with the Opponent's goods means that it is at least similar."

23. It is clear from the wording of each of the terms that the core purpose of the parties' various software goods is entirely different. The applicant's software is for the purpose of online messaging; the opponent's is for the purpose of business transactions, printing, and downloading coupons and tickets. The opponent's submission that its software could encompass a chat function is not persuasive. I am mindful of the comments in *Avnet* which, whilst relating to services, provide helpful focus when considering the core meaning of terms. Should the opponent's software products encompass a chat function, that is one which is entirely incidental to the core purpose of those products. In considering the core meaning of the parties' terms, I find their nature and purpose entirely different and, as such, so are their users. The goods are not in competition: consumers will not choose between software for online messaging and software for business transactions, printing, or downloading coupons or tickets. I also consider there to be no complementary relationship between the goods: they are not important for one another to the extent that consumers would believe them to be provided by the same undertaking. There may be an overlap in the way in which these software goods are accessed and used, however, I consider those factors to be insufficient, alone, for a finding of similarity. Taking everything into consideration, I find no similarity between the applicant's *software for online messaging* and any of the opponent's goods. Aside from the opponent's goods listed in the previous paragraph, there are no other goods in its specification that takes its case any further.

24. In accordance with *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA, if there is no similarity between goods, there is no likelihood of confusion to be

considered. Consequently, the opposition has failed in relation to the following goods, which may proceed to registration:

Class 9 *Software for online messaging.*

The average consumer and the purchasing act

25. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods 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. described the average consumer in these terms:

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

26. The relevant goods are those for which I have found identity. The average consumer will vary and could include businesses or members of the general public. For either group of consumers, the goods will require thought as to the suitability for their needs, though some applications can be downloaded, often without much consideration, and then deleted again. The cost will also be considered, which is likely to vary: none will be prohibitively expensive but some mobile phone applications, for example, are downloaded for free. Overall, consumers will pay an average degree of attention during the purchasing process of the goods.

27. The goods are likely to be purchased by self-selection from mobile applications or websites or following perusal of printed advertisements. I consider the purchasing process to be mainly visual, however, given that word-of-mouth recommendations for

certain applications might be made, I do not discount an aural component to the selection.

Comparison of marks

28. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. 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 relevant 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.”

29. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

30. The trade marks to be compared are as follows:

The opponent's mark	The applicant's mark
PRINKER	Prink

31. The opponent's mark comprises a single component, in which the overall impression solely resides. The same applies to the applicant's mark. That the

opponent's mark is presented in upper case and the applicant's in sentence case does not affect the mark comparison since fair and notional use of a word mark extends to the use of any case.

32. Visually, the marks coincide in the letters "PRINK"; the entirety of the applicant's mark is contained, as the first five letters, in the opponent's mark, creating clear visual similarity. The additional letters "ER" in the opponent's mark create the visual difference, as well as the difference in length: a seven- versus five-letter word. Overall, the marks are visually similar to a high degree.

33. The applicant's mark will be pronounced as one syllable and the opponent's as two, with the letters "PRINK" being articulated identically in each mark. The letters "ER" forming the second syllable in the opponent's mark create the aural difference. Overall, there is a high degree of aural similarity between the marks.

34. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*.¹¹ The assessment must be made from the point of view of the average consumer.

35. Neither party has provided a definition of their own, or the other's mark. Having consulted *Collins dictionary* "prink" is defined as a verb meaning to dress finely or to preen oneself. "Prinker" is a noun with the same meaning. There will be some consumers who are aware of these definitions but, in my view, more who are not. When considering the marks with these definitions, there is a high degree of conceptual similarity, though not for a significant proportion of average consumers.

36. There will also be consumers (in my view, accounting for a significant proportion) who see "prink" and "prinker" as invented words. For clarification, for those consumers who do not see in "prink" a clear definition, there will be no clear definition for "prinker", and vice versa. In this scenario, the marks have no clear concept and are, therefore, conceptually neutral.

¹¹ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

37. I bear in mind that, given the opponent's goods (including those for which I have found identity with the applicant's goods) relate to printing, some consumers may see the opponent's mark as an amalgamation of the words "printer" and "ink". I am not convinced, however, that for a significant proportion of average consumers this will be "immediately grasped" (see *Ruiz Picasso*, cited above). As a matter of completeness, I will make a finding based on this possibility. The applicant's goods are not related to printing and so consumers are unlikely to see, in "prink" the words "print" and "ink". In this scenario, there is no conceptual similarity between the marks for the average consumer: one is a word comprised of "printer" and "ink" and the other is an invented word with no meaning.

38. Overall, the most likely scenario for a significant proportion of average consumers is that the words are invented and the marks are conceptually neutral. This is the position from which I will consider a likelihood of confusion.

Distinctive character of the earlier mark

39. 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 *Windsurfing Chiemsee*, paragraph 51).”

40. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

41. The opponent has filed no evidence of use of its earlier mark and so I have only the inherent position to consider. I have already found that the mark is most likely to be seen as an invented word. It is therefore inherently distinctive to a high degree. Even in the case of consumers seeing, in the mark, the words “printer” and “ink” and noticing the link to the goods and services for which it is registered, it is an unusual amalgamation of those words, which still result in an invented word. In this scenario, the mark remains inherently distinctive to a high degree. Consumers seeing “princker” as meaning someone who dresses finely or preens themselves is unlikely. Even so, that word is an unusual one and has no meaning in relation to the goods and services. If I am wrong and consumers understanding the dictionary definition is more likely than I have considered, the mark is inherently distinctive to a medium to high degree.

Likelihood of confusion

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater

degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

43. I have found the marks to be visually and aurally similar to a high degree but, for the majority of consumers, conceptually neutral (on the basis of invented words). There are other possibilities for the conceptual comparison, however, it is prudent to consider the matter from whichever group of consumers are most likely, if at all, to be confused. For those consumers, I have found the earlier mark to have a high degree of inherent distinctive character. I have identified the average consumer to be either a business or a member of the general public who, paying an average degree of attention, will select the goods predominantly by visual means, though I do not discount an aural element to the purchase. I have found the goods to be identical (save for those which have survived the opposition and will proceed to registration).

44. I will discuss direct confusion first. The shared element, "PRINK", is found at the beginning of both marks and is the sole component of the applicant's mark. The additional two letters "ER" appear at the end of the opponent's mark. This is important since the beginning of marks tend to have more visual and aural impact on consumers than the ends.¹² Whilst the opponent's mark is slightly longer than the applicant's mark, I am of the view that consumers paying just an average degree of attention to identical goods may misremember "PRINK" as "PRINKER" or vice versa. That the marks are conceptually neutral means there is no strong conceptual hook for either mark for consumers to remember. There is a likelihood of direct confusion.

45. For completeness, I will briefly address indirect confusion. Indirect confusion was described in the following terms by Iain Purvis KC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*¹³

¹² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

¹³ BL O/375/10.

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

46. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹⁴

47. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC, sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

48. Despite the opponent’s submission that the suffix “ER” is commonly added to the end of an adjective, adverb or noun,¹⁵ I do not see this to be a proper basis for indirect confusion. For the majority (and a significant proportion) of consumers, the marks are invented. I see no clear reason why, if the differences between the marks are noticed, the addition of “ER” to an invented word would cause consumers to believe the marks originate from the same or related undertakings. There is no likelihood of indirect confusion.

CONCLUSION

49. There is a likelihood of direct confusion. The opposition under section 5(2)(b) has been successful in relation to the following goods, which are refused registration:

Class 9 *Mobile application software; Downloadable smart phone application software.*

50. The opposition has failed in relation to *Software for online messaging* in Class 9. The application will proceed to registration for these goods.

¹⁴ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82].

¹⁵ See the opponent’s written submissions dated 2 April 2024.

COSTS

51. The opponent has been successful in relation to approximately two thirds of the application. I consider it is entitled to a contribution towards its costs, albeit slightly reduced to reflect its partial success. Awards of costs in fast track proceedings are governed by TPN 1/2023,¹⁶ which caps awards at £600, excluding official fees. I award the opponent the sum of £420, calculated as follows:

Official fee	£100
Preparing a notice of opposition	£250
Preparing written submissions	£250
Sub-total	£600
Minus 30% reduction for partial success	- £180
Total	£420

52. I therefore order The PrinkApp Limited to pay Prinker Korea Inc. the sum of £420. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 18th day of July 2024

MRS E FISHER
For the Registrar

¹⁶ TPN 1/2023 applies to proceedings commenced on or after 1 February 2023.