

O/0788/24

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3853576
IN THE NAME OF ZIP MEDIAWORKS LTD
TO REGISTER AS A TRADE MARK:**

Zip Media

IN CLASS 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 439619
BY ZIP DATING LIMITED.**

BACKGROUND AND PLEADINGS

1. On 27 November 2022, Zip Mediaworks Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 9 December 2022, in respect of services in Class 42.¹

2. The application is opposed by Zip Dating Limited. (“the opponent”). The opposition was filed on 9 March 2023 and is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the services in the application. The opponent relies upon its UK trade mark number 3650812 (“the earlier mark”) for the word “ZIP”, which was filed on 3 June 2021 and became registered on 29 October 2021. For the purposes of these proceedings the opponent relies on all its goods and services in Classes 9, 35, 38, 42 and 45.²

3. On 21 August 2023, the applicant filed a Form TM21B requesting a limitation to all the services claimed in its application. However, notwithstanding the limitation filed by the applicant, the opponent confirmed its intention to continue with the opposition.

4. The opponent’s mark qualifies as an earlier mark under section 6(1) of the Act. As it had not completed its registration procedure more than five years before the application date for the contested mark, it is not subject to the use provisions contained in section 6A of the Act.

5. The opponent submits that its earlier mark is similar to the applicant’s mark due to the shared element ‘ZIP / Zip’, and that the goods and services at issue are similar, resulting in a likelihood of confusion.

6. The applicant filed a defence and counterstatement denying the claims.

¹ These are listed in the goods and services comparison, at my paragraph 14.

² These are listed in the goods and services comparison, at my paragraph 14.

7. Neither party filed evidence in these proceedings. Neither party requested a hearing nor filed written submissions in lieu of a hearing. Therefore, this decision is taken following careful consideration of the papers.

8. In these proceedings, the opponent is represented by Briffa and the applicant by Lewis Silkin LLP.

DECISION

Relevance of EU law

9. 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 that predate the UK's withdrawal from the EU.

Section 5(2)(b)

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

“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.”

11. Section 5A of the Act states:

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

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

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

b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;

h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

13. Pursuant to section 60A of the Act, the goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

14. The goods and services to be compared are as follows:

The applicant's services

Class 42 Web site design; Design and graphic arts design for the creation of web sites; Web site design consultancy; Internet web site design services; Design and graphic arts design for the creation of web pages on the Internet; Web site design services; Web portal design; Design of web sites; Web site design and creation services; Web page design services; Design, creation and programming of web pages; Graphic design for the compilation of web pages on the internet; Computer site design; Design of web pages; Website design; Design of home pages and web sites; Website design and development; Webpage design services; Homepage and webpage design; Design and creation of homepages and web pages; Design and creation of web sites for others; Website design consultancy; Design and maintenance of web sites for others; Website design services; Design and creating web sites for others; Consultancy relating to the creation and design of websites for e-commerce; Logo design services; Consultancy relating to the design of home pages and Internet sites; Design and development of homepages and websites; Design and development of software for website development; Design and construction of homepages and websites; Designing and developing web pages; Graphic design services; Consultancy relating to the creation and design of websites; Design and updating of home pages and web pages; Graphic design; Programming of customized web pages; Consultancy with regard to webpage design; Database design and development; Database design; Development, design and updating of home pages; Design of websites; Consultancy relating to the design of homepages and Internet pages; Creation of internet web sites; Commissioned writing of computer programs, software and code for the creation of web pages on the Internet; Creating, designing and maintaining web sites; Designing and implementing web sites for others; Designing and creating web sites for others; Creating and designing web pages for others; Planning, design, development and maintenance of online websites for third parties; Programming of web pages; Custom design services; Consultancy relating to the design and development of computer database programs; Consultancy relating to the design and development of computer programs; Computer programming and software design; Computer system design and development; Consultancy in the field of software design; Design and development of computer software; Computer design and programming services; Design and development of computer database software;

Programming of software for website development; **None of the aforesaid services being in the field of dating, social interaction and/or social networking services.**

The opponent's goods and services

Class 9 Mobile application software **for dating, social introduction and social networking**; computer application software for mobile phones **for dating, social introduction and social networking**; downloadable mobile applications **for dating, social introduction and social networking**; downloadable applications for mobile devices **for dating, social introduction and social networking**; computer software **for dating, social introduction and social networking**; application software **for dating, social introduction and social networking**; media content **in the field of dating, social introduction and social networking.**

Class 35 Advertising services **in the field of dating, social introduction and social networking**; marketing services **in the field of dating, social introduction and social networking**; promotional services **in the field of dating, social introduction and social networking**; information, advisory and consultancy services in relation to the aforesaid services.

Class 38 Providing access to computer databases **in the field of dating, social introduction and social networking**; providing access to multimedia content online **in the field of dating, social introduction and social networking**; providing access to platforms on the internet **in the field of dating, social introduction and social networking.**

Class 42 Providing temporary use of non-downloadable software **for dating, social introduction and social networking**; providing, updating and maintaining on-line non-downloadable software **for dating, social introduction and social networking**; hosting, developing and managing a website or online platform **for the purposes of dating, social introduction and social networking**; providing customised on-line web pages and data feeds **featuring information on dating, social introduction and social networking**; information, advisory and consultancy services in relation to the aforesaid services.

Class 45 Dating services; internet dating services; computer dating services; internet-based dating, matchmaking and personal introduction services; dating services provided through social networking; social introduction services.

15. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account.

Those factors include, *inter alia*:³

- the physical nature of the goods or acts of service;
- their intended purpose;
- their method of use / uses;
- who the users of the goods and services are;
- the trade channels through which the goods or services reach the market;
- in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors)
or
- whether they are complementary to each other. Complementary means “*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*”.⁴ I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.⁵

16. When interpreting the terms in a specification I bear in mind:

³ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

⁴ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

⁵ *Kurt Hesse v OHIM*, Case C-50/15

- (i) that it is “*necessary to focus on the core of what is described..*” and that “*... trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise*”, although “*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*”.⁶

17. With regard to the similarity of the goods and services, in its statement of grounds the opponent submits the following:

“The applicant’s services in class 42 have a clear crossover with the services offered by the Opponent in classes, 9, 35, 38 and class 42. In respect of class 9, the goods protected by the Opponent include 'downloadable applications for mobile devices for dating, social introduction and social networking; computer software for dating, social introduction and social networking; application software for dating, social introduction and social networking; media content in the field of dating, social introduction and social networking.' The Applicant carries an inherent element of creating software and applications as it is predominantly being used to create and develop web sites, which can include web sites for dating, social interaction, or social networking.

Turning to a comparison between class 35 and class 42. Undoubtedly the goods and services being provided by the Opponent are strongly associated with advertising, marketing, promotion, and public relations being, as they are, a highly effectively tool to promote and market brands (e.g., with the brand being heavily marketed on social media). This is equally true of exhibitions, road shows, trade shows, business events and other services connected with dating, public relations, social networking, and social interaction. All these services would be highly likely to employ a website developer/ content creator to improve and further their services, accordingly they would share a highly similar purpose with distribution to identical members of the public.

⁶ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

Turning to a comparison between class 38 and class 42. The Earlier Mark has protection for 'Providing access to computer databases in the field of dating, social introduction and social networking; providing access to multimedia content online in the field of dating, social introduction and social networking; providing access to platforms on the internet in the field of dating, social introduction and social networking.' The Opponent's services naturally generate a large amount of recorded media, whether this is in the form of video or photographs, it's users will be creating and uploading content onto the Opponent's platform. The hosting of digital content is part-and-parcel of the promotion of any dating / social network website. It is reasonable therefore to suggest that this class would also be protected from any organisation responsible for creating content predominately for the internet, in that sense there is a high likelihood of association.

This can be extended further as website designers/ content creators/ software development naturally involve substantial database management with online commercial information and directory services, information compilation services and provision of commercial and business contact information. It also involves a large amount of business networking, social media strategy and commercial and business introductions. The most direct crossover however comes in the form of providing online platform. These services clearly equate to either or all of dating, social interaction and social networking as offered by the Opponent. Accordingly, all of these services are likely to relate to a highly similar purpose.

The services in class 42, although not quite identical, are highly similar to the services offered by the Opponent in class 42, not least due to the fact that they share the same class. The Opponent's Earlier Mark in class 42 protects, 'Providing temporary use of non-downloadable software; Updating and maintaining on-line non-downloadable software; Hosting, developing and managing a website or online platform; Providing customised on-line web pages and data feeds; all featuring dating, social introduction and social networking; and including information, advisory and consultancy services in relation to the aforesaid services.' Conversely, the Applicant is seeking to

protect the design and development software. Create, design, develop and maintain websites. Graphic design for the compilation of web pages on the internet. The Applicant's class 42 services go further and specify the consulting of web page design, development, and maintenance. Consulting on creating, developing software and databases. All such services would be well at home within an online SaaS company and as a result it can be safely assumed that a SaaS company offering online dating, social introduction and social networking services are highly likely to include services relating to "consultation and advice in the field of content creation, website creation, development and maintenance". Accordingly, this would suggest that the services specified by the Applicant in class 42 are highly similar to the services in the Opponent's Earlier Mark in class 42."

18. It is acknowledged that these are the only submissions made by the opponent regarding the similarity of the respective goods and services. Therefore, I bear in mind that as these submissions were made in the opponent's statement of grounds, they do not take into account the limitation applied to the applicant's services as a result of their Form TM21B,⁷ namely, *none of the aforesaid services being in the field of dating, social interaction and/or social networking services.*

19. With regard to the similarity of the goods and services, in its counterstatement, the applicant submits the following:

"With regard to the comparison of goods and services, it is not admitted that the services in Class 42 of the application in suit are identical or similar to the goods and services covered by the Opponent's Mark. Even if the Registry were minded to find that there is some similarity, this does not equate to there being a likelihood of confusion, including a likelihood of association with the Opponent's Mark.

[...]

⁷ Filed on 21 August 2023.

Further the Applicant has added the limitation "None of the aforesaid services being in the field of dating, social interaction and/or social networking services" to make it very clear that they do not operate, and do not intend to operate, in the field of dating which the Opponent's goods and services are very much tailored to (as dating services is what the Opponent's business provides).

In relation to the comment above, the average consumer of the Opponent and the Applicant are very different. The Opponent's audience is that of individuals looking for a dating platform and seeking a potential partner, therefore the Opponent's business functions Business to Consumer. On the other hand, the Applicant has a very different business, which operates Business to Business. As mentioned above, the Applicant has made it clear it has no intention to have any association with the dating business by adding a very clear limitation.

[...],

It is evident from the Applicant's specification that the Applicant intends to use the mark in relation to for example, web design and consultancy services, whereas the Opponent has made it evident by the goods and services covered in their registration that they are a dating platform, and their goods and services relate to dating services e.g. "mobile application software for dating" in Class 9, "advertising services in the field of dating" in class 35, "providing access to platforms on the internet in the field of dating, social introduction and social networking", in Class 38, "hosting, developing and managing a website or online platform for the purposes of dating, social introduction and social networking" in Class 42, "Dating services" in Class 45. Further, the Applicant has added a limitation, as previously mentioned in paragraph 15, stating "None of the aforesaid services being in the field of dating, socio/ interaction and/or socio/ networking services". This should provide the Opponent with firm assurances that the Applicant is in a very different field of business and there would be no confusion between the Applicant and the Opponent's businesses. The respective specifications further compound that the end users of the services are also very different, there is a clear differentiation between an audience looking for a dating service and those that are not. It is clear that there is no

competition between the Applicant's services and that of the Opponent's services. However, the Opponent is still pursuing the Applicant despite the differences in the services and the end users.”

The contested services in Class 42

20. Broadly speaking, the contested services, concern, inter alia, design services in relation to software, websites, web pages, graphic arts, web portals, computer sites, home pages, logos, internet sites, databases, computer programmes, and computer systems. However, it is noted that all the contested services have been limited to ***none of the aforesaid services being in the field of dating, social interaction and/or social networking services***. Conversely, the opponent's goods and services, which include, inter alia, computer software, advertising, promotional services, providing access to computer databases, platforms and multimedia content, online downloadable software, hosting, developing and managing a website or online platform, and providing customised on-line web pages and data feeds, have been specifically limited to the field of ***dating, social introduction and social networking***.⁸

21. Accordingly, despite any potential similarity between the respective goods and services, the limitations serve to create a clear distinction between the core purposes of the goods and services at issue, meaning that there can be no overlap in purpose between the competing goods and services. Therefore, whilst it is acknowledged that the nature and methods of use of some of the goods and services may overlap to a degree, and that ordinarily complementarity may be found between some of the goods and services, such as *computer software* (at large) versus the *design and development of computer software* (at large), in the present case, due to the said limitations, I do not consider that complementarity exists, nor is it likely that users and trade channels will overlap, with the respective goods and services targeted at different consumer audiences. I say this as I have no evidence to suggest that the competing goods and services would be produced or provided by the same undertakings.

⁸ As highlighted in the list of the opponent's goods and services under paragraph 14.

22. Therefore, for a finding of similarity between the restricted goods and services at issue, I would need to conclude, for example, that all types of software and software design are similar, despite having different specified purposes, user bases and trade channels, etc. However, in my view this would be artificial and would offer a scope of protection that is far too broad and not within the parameters of the limited specifications at issue. It is important to recall that the overall purpose of considering similarity between goods and services should not be forgotten. That purpose is to identify similarities which might be relevant to the question of a likelihood of confusion, and on this point, any finding of similarity requires the exercise of common sense.⁹

23. Accordingly, in view of the aforementioned limitations to the specifications, I find that any link between the respective goods and services is tenuous and not sufficient for finding that the average consumer would expect those goods and services to be provided by the same or economically linked undertakings. As such, I consider that the contested services share no direct similarities and that there is no likelihood of confusion. Overall, I find the applicant's services to be dissimilar to all the opponent's goods and services.

24. In conclusion, owing to the absence of any similarity between the goods and services, neither any potential similarity between the marks nor the degree of distinctiveness of the earlier trade mark can have an effect upon the outcome. Accordingly, as some degree of similarity between the goods and services is required for a successful opposition under section 5(2)(b) of the Act, the opposition must fail.

25. The opposition based upon section 5(2)(b) of the Act is dismissed in its entirety.

CONCLUSION

26. The opposition is unsuccessful, and the application may proceed to registration.

⁹ *Unicorn Studio Inc v Veronese* Case CH-2023-000214

COSTS

27. The applicant has been successful and is therefore entitled to a contribution towards its costs based upon the scale set out in Tribunal Practice Notice (“TPN”) 1/2023. Applying the guidance in that TPN, I award the applicant the sum of £250, calculated as follows:

Considering the notice of opposition and preparing a counterstatement	£250
Total	£250

28. I therefore order Zip Dating Limited to pay Zip Mediaworks Ltd the sum of £250. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of August 2024

Sam Congreve
For the Registrar