

O-441-15

TRADE MARK ACT 1994

**IN THE MATTER OF APPLICATION NO. 3071593
BY ASTRO MEDIA LTD**

TO REGISTER THE TRADE MARK:

iFixed

IN CLASS 37

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 403146 BY SIMON J LASOTA**

BACKGROUND

1. On 8 September 2014 Astro Media LTD (“the applicant”) applied to register the mark **iFixed** for the following services in class 37:

Repair or maintenance of computers.

2. The application was published for opposition purposes on 26 September 2014.

3. The application was subsequently opposed by Simon J Lasota on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the services in the application.

4. Mr Lasota relies upon the two earlier UK marks shown below:

Mark details	Services
<p>UK Trade Mark 3015751</p> <p>iFix</p> <p>Disclaimer: The applicant disclaims any exclusive right to use of the first small letter 'i' within the mark.</p> <p>Filing date: 29 July 2013</p> <p>Date of entry in the register: 1 November 2013</p>	<p>Class 37 Repair or maintenance of computers.</p>
<p>UK Trade Mark 3036746</p> <p>iFix</p> <p>Filing date: 6 January 2014</p> <p>Date of entry in the register: 11 April 2014</p>	<p>Class 37 Repair, maintenance and installation of telephones, mobile phones, cellular phones, computers and electric and electronic equipment; provision of information relating to the aforementioned services; Repair of computer hardware; Repair of telecommunication machines and apparatus; Repair or maintenance of computers; Repair or maintenance of telecommunication machines and apparatus; Repair or maintenance of telephone apparatus.</p>

5. The applicant filed a counterstatement in which it denies the basis of the opposition on the ground, inter alia, that the competing marks are being used in a different form and that the parties are trading in different market segments.

6. Neither side filed evidence, although Mr Lasota did file written submissions during the course of the evidence rounds. Neither party asked to be heard, nor did they file

written submissions in lieu of attendance at a hearing. I give this decision following a review of all the material before me.

DECISION

7. Section 5(2)(b) of the Act states:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

8. An earlier trade mark is defined in Section 6 of the Act, which states:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) Reference in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. Given their dates of filing, Mr Lasota’s marks constitute earlier marks in accordance with Section 6 of the Act. The earlier marks had not been registered for more than five years at the date on which the applicant’s mark was published meaning that the proof of use provisions contained in Section 6A do not apply. Mr Lasota can, as a consequence, rely upon all of the services he has identified.

Section 5(2)(b) case law

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

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.

Mr Lasota's best case

11. The opposition is based upon two earlier marks. They each consist of the same word but differ in that the first mark is in bold text, whereas the second is in normal typeface, the same used in the applicant's mark. The second mark contains, inter alia, the same services that appear in the first mark and is not subject to any disclaimer. Accordingly, Mr Lasota would be in no better position relying on the first

mark even taking the different filing dates into account. His best case rests in the second mark (UK 3036746) and it is to this mark that I shall limit my comparison.

The correct approach to the comparison of services and marks

12. Both the applicant in its counterstatement and Mr Lasota in his written submissions refer to how, where and the form in which the competing marks are actually used.

13. These submissions are based upon a misunderstanding of how the comparison of services and marks must be carried out in the instant case and, as such, do not have a bearing upon the outcome of this opposition. This is because Mr Lasota's registration is less than five years old and so I must assume 'notional' use of his mark across the full range of services for which it is registered and entitled to be used i.e. across all sectors of the market. The comparison that has to be made is between the services as registered and the services as applied for, not between the services actually offered under the marks at present. Accordingly, considerations relating to use are not pertinent when comparing the services and the fact that the parties trade in different locations and target different segments of the market is, therefore, irrelevant.

14. Similarly, with regards to the comparison of the respective marks, what I must compare is the marks in their entirety as they have been registered and applied for and not in whatever form they might actually have been used.

15. Having established the above, I shall now proceed to assess the merits of Mr Lasota's opposition.

Comparison of services

16. The services to be compared are as follow:

Mr Lasota's services	Applicant's services
Class 37 Repair, maintenance and installation of telephones, mobile phones, cellular phones, computers and electric and electronic equipment; provision of information relating to the aforementioned services; Repair of computer hardware; Repair of telecommunication machines and apparatus; Repair or maintenance of computers; Repair or maintenance of telecommunication machines and apparatus; Repair or maintenance of telephone apparatus.	Class 37 Repair or maintenance of computers

17. As both parties' specifications either contain or consist of the phrase 'repair or maintenance of computers', the competing services are identical.

Average consumer

18. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue; I must then determine the manner in which these services will be selected in the course of trade. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

19. The services at issue may be of interest to any person using a computer whether for professional use (i.e. a business user) or for private purposes (i.e. member of the general public). They are, in my view, most likely to be selected on the basis of a review of websites, advertisements, company literature etc. all of which suggests the prevalence of visual considerations in the selection process, however, I do not ignore aural considerations in the form of, for example, personal recommendations or requests for the service placed by telephone.

20. As to the degree of care that will be displayed during the selection process, bearing in mind the potential technical nature of the services at issue, the likely infrequency of the purchase, the level of investment that may be involved, the possible inclusion within the selection process of both verbal/written quotations and considerations about the compatibility of a chosen service provider with a specific computer system, the average consumer’s level of attention is likely to range from average to above average.

Comparison of marks

21. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (CJEU) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

22. It would be wrong, therefore, artificially to dissect the marks, although, it is necessary to take into account the distinctive and dominant components of the 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.

23. The respective marks are shown below:

Mr Lasota's mark	Applicant's mark
iFix	iFixed

24. Both marks consist of a lower case letter "i" followed by the element "Fix" and "Fixed" respectively. As I explain in more detail below, the letter 'i' is likely to be seen as either a reference to the personal pronoun 'I' or as a reference to technologically related concepts, whereas the "Fix/Fixed" elements of the marks, given the services at issue, will convey a purely descriptive message. Although both marks contain two identifiable elements, in my view, no one element dominates the other. The overall impression of the competing marks is of single invented phrases, their distinctiveness resulting from the combinations each creates.

Visual similarity

25. Mr Lasota's mark consists of the first letter "i" in lower case, followed by the sequence "Fix" where the letter "F" is presented in upper case and the letters "ix" in lower case. The applicant's mark starts with the same four letters with the same casing. The marks differ only to the extent that the applicant's mark contains the additional letters "ed" at the end of the phrase. Overall, I find the degree of visual similarity to be reasonably high.

Aural similarity

26. The applicant contends that the aural pronunciation of the two marks is very different. I disagree with this view. Aurally, both marks consist of two syllables. While Mr Lasota's mark will be articulated as /AHY(as in EYE)/FIKS, the applicant's mark will be pronounced as /AHY(as in EYE) /FIKST. The phonetic pattern of the competing marks is much the same because the first four letters are identical. The letters "ed" means that the ending of the applicant's mark's will, on careful pronunciation, be slightly different, however, the additional letters do not add an extra syllable and its sound in normal use will be articulated less clearly, particularly given the propensity in spoken English to stress the beginning of the words. The aural similarity is, in my view, also reasonably high.

Conceptual similarity

27. In his written submissions, Mr Lasota states that "iFix" is an invented word, nevertheless, he makes the point that "iFixed" is the past tense of "iFix". I think there is some merit in this argument. Although the overall impression that both marks convey will be of single invented phrases, the average consumer can be expected to recognise that both marks derive from the juxtaposition of the letter "i" which is commonly used, as I will explain below, in the context of technologically related services or goods, and the English words "Fix" and "Fixed" respectively. The natural

break produced by the capital “F” after the first letter “i” in lower case, will aid this perception.

28. The elements “Fix” and “Fixed” in the competing marks will bring to mind the act of fixing. This is all the more so, given the nature of the services in question, i.e. repair or maintenance services. As regards the letter “i” at the beginning of the marks, in my experience this is commonly used to refer to a variety of concepts in relation to technologically related services, e.g. intelligent or interactive. Alternatively, the letter “i” may be seen by the average consumer as a reference to the personal pronoun “I” indicating the subject of the act of fixing (I fix, I fixed).

29. Overall, although neither Mr Lasota’s mark nor that of the opponent are in themselves dictionary words they both have a conceptual connotation that will be perceived by the average consumer. Whichever meaning is given to the letter “i”, the fact remains that the consumer will see the same meaning in both marks, whilst the element “Fix/Fixed” will unequivocally convey information about the purpose of the services themselves. Either way, the conceptual association of both marks will be very similar.

Distinctive character of Mr Lasota’s trade mark

30. The distinctive character of a mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of the use made, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). The distinctive character of a mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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).”

31. Despite the parties' comments about the use of the marks, including the applicant's reference to an Internet search he has conducted, all indicating that the competing marks are actually in use, no evidence has been filed. As a consequence, I have only the earlier mark's inherent characteristics to consider.

32. Earlier in this decision, I found that Mr Lasota's mark is an invented phrase. Invented phrases (and words) have a high inherent distinctive character per se; however, I should also consider that Mr Lasota's mark includes two elements, one with a clear descriptive meaning and one with a more ambiguous significance, although the combination of these elements is, in my view, somewhat unusual. I consider that, as a whole, the earlier mark is endowed with a less than average degree of distinctiveness.

Likelihood of confusion

33. In determining whether there is a likelihood of confusion, 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 marks may be offset by a greater degree of similarity between the respective services and vice versa. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

34. Earlier in this decision, I concluded that:

- the parties' services are identical;
- the average consumer is either a member of the general public or a business user, visual considerations are likely to dominate the selection process (but the aural significance has not been ignored) and the level of attention ranges from average to above average;
- the competing marks are visually and aurally similar to a reasonably high degree and conceptually very similar;
- the opponent's earlier mark is possessed of a less than average degree of distinctive character.

35. In my view, taking all these factors into account, particularly the concept of imperfect recollection, as identical services are involved, the similarity of the marks is such that, even allowing for the consumer paying an above average level of attention, I find that there will be direct confusion i.e. one mark will be mistaken for the other.

Conclusion

36. The opposition has succeeded.

Costs

37. As Mr Lasota has been successful, he is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, and bearing in mind that he has not been legally represented, I award costs to Mr Lasota on the following basis:

Official fees: £100

Preparing a statement and considering the other side's statement: £100

Written submissions: £50

Total: £250

38. I order Astro Media LTD to pay Mr Simon J Lasota the sum of £250 as a contribution towards his costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 21st day of September 2015

**Teresa Perks
For the Registrar
The Comptroller - General**