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Report of Trade Mark Cases

For the CIPA Journal

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Trade mark decisions

Decisions of the General Court (GC) and Court of Justice (CJ)

Distinctiveness in the global assessment

Revive a Phone Ltd v WeFix (Ian Karet sitting as a Deputy High Court Judge; [2022] EWHC 2195 (Ch); 19 August 2022)

Ian Karet, sitting as a Deputy High Court Judge, dismissed Revive a Phone's appeal against the Hearing Officer's decision to invalidate its UK registrations for variations of the mark WEFIX, based on the existence of an earlier EUTM registration for a mark incorporating the verbal element WeFix. Amelia Barling reports.

Background

Revive a Phone Limited had registered the word mark WEFIX in the UK for 'repair and maintenance of computer, telecommunications hardware and smartphones' services in class 37, among other things. It had also registered the WE FIX figurative mark shown below in the UK for the same services, as well as financial services in class 36.



WeFix's earlier EUTM registration for the figurative mark shown below covered smartphones etc. in class 9, and the retail and repair of such hardware in classes 35 and 36.



Revive a Phone argued that the Hearing Officer's assessments of the similarity of the marks and likelihood of confusion had not properly considered the low distinctive character of the common elements, the words WE FIX. No other issues were contested on appeal.

The Hearing Officer's decision

The Hearing Officer had found that the word mark WEFIX was similar to the earlier mark to a medium degree, and that the figurative version was similar to the earlier mark to a medium or medium to high degree depending on the services concerned. Revive a Phone accepted this. Further, the Hearing Officer had held that the earlier mark was inherently distinctive to a low degree because of the meaning of WeFix as 'we repair'.

Taking these factors into consideration in the global assessment, it was held that there was a likelihood of direct and indirect confusion between the word mark and the earlier mark, and a likelihood of indirect confusion only between the figurative mark and earlier mark.

Assessment of the similarity of the marks

Revive a Phone argued that the descriptiveness and low distinctive character of the words WE FIX should have influenced the Hearing Officer's assessment of the visual, aural and conceptual similarities of the marks.

In that regard, it cited the Appointed Person's decision in *JAC Travel Ltd's Application* (O/330/19), in which the assessment of similarity of the marks was impacted by the low distinctiveness of the word HOTELS – for example, since the only conceptual similarity between the marks was by reason of the shared word HOTELS, the conceptual similarity was "superficial" and only a low degree of weight was given to it in the global assessment.

However, the Judge held that the Hearing Officer had properly considered the low distinctiveness of WE FIX, and had underpinned her conclusions on the similarity of the marks with that in mind.

Likelihood of confusion

Secondly, Revive a Phone argued that the Hearing Officer had not correctly applied the principle that there would not normally be a likelihood of confusion where the only similarity between the marks consisted of a common element of low distinctive character.

However, the Judge held that whilst that was a relevant factor for consideration, it did not preclude a finding of confusion. The Judge held that the Hearing Officer had correctly carried out the global assessment. The Hearing Officer had noted that the earlier mark had a low degree of distinctiveness as a whole, as did the element WE FIX on its own, and she had drawn the conclusion that there was "very little for the consumer to grasp onto to differentiate between the marks", so there was a risk of direct and indirect confusion for the word mark.

She had concluded that there was no risk of direct confusion between the figurative mark and earlier mark because the differences between them would have been noticed and recalled by consumers. However, she had found a risk of indirect confusion because consumers would have thought that the contested mark was an updated version or variant of the earlier mark. In conclusion, the Hearing Officer had made no error of principle, so the appeal was dismissed.

The CJ and GC decisions can be found at https://curia.europa.eu/jcms/jcms/j_6/en/. Cases marked with a * can be found at <http://www.bailii.org/>.



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