

O-159-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2431060
BY COMMUNICATIONS ADVISORY SERVICE LTD TO REGISTER
A TRADE MARK IN CLASSES 35, 38 AND 42**

AND

**IN THE MATTER OF OPPOSITION NO 95121 BY
INDEPENDENT COUNSELLING & ADVISORY SERVICES LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2431060
By Communications Advisory Service Ltd to register
a trade mark in Classes 35, 38 and 42**

and

**IN THE MATTER OF Opposition No 95121
By Independent Counselling & Advisory Services Ltd**

BACKGROUND

1. On 29 August 2006, Communications Advisory Service Ltd (“CAS”) applied to register the following trade mark¹:



2. Registration is sought for:

Class 35:

Business management consultancy and services, recruitment consultancy and services.

Class 38:

Communications Consultancy.


Class 42:

IT consultancy.

3. On 5 April 2007, Independent Counselling and Advisory Services Ltd (“ICAS”) filed a notice of opposition to this application based on grounds under Section 5(2)(b) and Section 5(4)(a) of the Trade Marks Act 1994 (“The Act”). In relation to these grounds, ICAS relies upon its earlier UK trade mark and CTM², together with its claimed common law right. The earlier registered trade marks are shown below:

¹ The application contains the following statement “The colours shown in the mark are blue Pantone 2757 and grey Pantone 8040”

² Community Trade Mark

UK Trade Mark 1461432	Specification:
ICAS	Class 35: Personnel management consultancy services and advisory services relating thereto; all included in Class 35.
CTM 752576	Specification:
	<p>Class 16: Printed matter; printed publications; books, booklets and leaflets; instructional and teaching materials.</p> <p>Class 35: Personnel management consultancy services and advisory services relating thereto; business management consultancy and advice; counselling for employees; workplace counselling; human resource consultancy; stress auditing; work life services and information and guidance relating thereto.</p> <p>Class 41: Education and training; education and training for employees; workplace skills training; stress management training.</p> <p>Class 42: Personal counselling; counselling to employees; work life services and information and guidance relating thereto.</p>

4. CAS filed a counterstatement denying the grounds of opposition.

5. Both sides filed evidence, a summary of which follows. Neither side requested a hearing, although ICAS did, however, file written submissions in lieu of a hearing. Although CAS did not file formal written submissions, it did make a number of submissions in its counterstatement and evidence which I will take into account.

ICAS's evidence

6. This consists of a witness statement, dated 31 March 2008, from Jeremy Garman, a director of ICAS. Mr Garman explains that the company's core business is to provide companies and organisations with assistance and support with regard to behavioural and practical issues affecting an employee's ability to perform their best at work. In reality this includes assistance in managing stress, improving attendance and developing people. The company also provides services in crisis management, a national occupational health service and it designs change programmes which assist in managing the human element of major transitions such as redundancy, restructuring, acquisitions or mergers. According to Mr Garman, ICAS first used the ICAS stylised trade mark (the CTM minus the words Independent Counselling and Advisory Services Limited) in relation to business support and counselling services in the UK during 2000 and that the mark has been used continuously since then. Exhibit JG2 shows an example of this stylised mark. Exhibit JG3 is a list of materials on which the ICAS (stylised) trade mark has been used. Those that are dated prior to the relevant date (29 August 2006) include:

- A research bulletin (July 2002);
- Press announcement of new managing director (May 2003);
- Brochure distributed in seminars (July 2003);
- Promotional brochure for ICAS seminar (21 October 2003);
- ICAS Briefing – Corporate periodical (June 2004);
- Supporting Employees Brochure (May 2005);
- Employee workshop handout regarding Work-Life Balance (2005);
- Poster Campaign (March 2005)

7. Turnover figures from the years 2005-2007 are then provided, namely:

Year	Sales Turnover	Gross profit	% Margins
2005	-	£4,315,465	-
2006	£10,610,905	£4,638,651	43.72%
2007	£11,148,520	£4,594,194	41.21%

8. JG4 shows use of the ICAS stylised mark on company stationery, which, according to Mr Garman, has also been used consistently.

CAS's evidence

9. This consists of two witness statements, from Mr David Jones, a director of CAS and Mr Graham Channon, a director of See Design Ltd. See Design Ltd were responsible for the creation of the CAS company logo. The witness statement from Mr Channon confirms the content of Mr Jones's statement to the extent that it refers to the creation and design of the CAS logo. Exhibit CAS2 shows an example of the logo created by Mr Channon and exhibits CAS3 and CAS4 are invoices relating to the design of this logo, dated September 1997 and March 1998 respectively. Mr Jones confirms that this logo has been used continuously since September 1997

throughout the whole of the UK. Exhibits CAS5 – CAS10 show documents and materials claimed to have been in use since this date, including headed stationery, A4 folio cases, business cards, baseball caps and sweatshirts (along with an invoice in relation to the latter two, dated 9 December 2000). In addition to this, CAS8 shows seminar presentation materials (in the form of Power Point slides), dated 5 September 2008; CAS9 shows proposals and bid documentation sets. These are dated from January 2000 to March 2002, with one documented undated (though it is claimed to be from pre-2000) and show a range of companies and organisations for which bids were prepared; CAS10 is a print out from the CAS website and CAS11 is a client list which appears on the website.

10. Mr Jones explains that the overall core of the CAS business is to provide companies and organisations with information technology technical consultancy. Providing services of this nature usually involves an initial technical evaluation, business audit and report writing phase leading to selection of a suitable technical supplier. In most instances, this is then followed by providing project or programme management to implement the chosen technology. Mr Jones asserts that CAS is not in any way involved in what he terms “people centric” skills.

11. Finally, Mr Jones confirms that to the best of his knowledge there has never been any erroneous contact made to CAS which should have been made to ICAS or vice versa. Mr Jones, in fact, argues that the two have such a different product set that it would be almost impossible for confusion to occur.

DECISION

The ground of opposition under Section 5(2)(b)

Proof of use regulations

12. In opposition proceedings, earlier marks for which the registration procedure was completed before the end of the five year period ending with the date of publication of the applied for mark (CAS’s mark) may only be relied upon to the extent that they have been used (or that there are proper reasons for non-use)³. CAS’s mark was published on 5 January 2007. ICAS’s UK mark completed its registration procedure on 8 October 1993 and ICAS’s CTM completed its registration procedure on 2 July 1999. Consequently, the proof of use regulations apply to both of ICAS’s earlier marks.

13. In its notice of opposition, ICAS made statements of use in relation to its earlier marks. This is a requirement (given the applicability of the proof of use provisions) of rule 13(2)(d) of the Trade Marks Rules 2000 (as amended) (“the Rules”). In its counterstatement, CAS did not require ICAS to provide actual proof of use. Therefore, I must accept that ICAS has used its marks to the extent claimed, namely “all services for which the mark is registered” in the case of both the UK mark and the CTM mark.

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

The law and the leading authorities

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

“(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.”

15. When making my determination, I take into account the guidance from the case-law of the European Court of Justice (“ECJ”) on this issue, notably: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-334/05P Shaker di Laudato & C.Sas v OHIM (“LIMONCHELLO”)* and *Case C-120/04 Medion* [2005] ECR I 8551, it is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) the assessment of similarity can only be carried out solely on the basis of the dominant element in a mark if all of its other components are negligible (*Limonchello*, para 42)

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

Average consumer and the purchasing act

16. As the ECJ states in *Sabel BV v. Puma AG*, matters must be judged through the eyes of the average consumer. I must, therefore, assess who this is. Both CAS and ICAS have confirmed, in their evidence, that their client base is companies and organisations and that the core business of both is consultancy of some form. Whether or not the respective consultancy services offered by ICAS and CAS are identical or similar will be discussed later. However, it is clear that the average consumer for these services is the business user, whether it be private or public sector.

17. With regards to the purchasing act, it seems to me that the purchase of consultancy services of any description is likely to represent a significant monetary investment for any organisation. Such a purchase would also potentially have a significant impact on the running of and the success of the business and choosing the most appropriate service provider is key. It is, therefore, not unreasonable to assume that all this equates to a considered purchase and that a high degree of care and attention will be displayed both before and during the purchasing process.

Comparison of the services

18. All relevant factors relating to the services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of its judgment:

“In assessing similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all 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.”

19. Other factors may also be taken into account such as, for example, the relevant channels of distribution (see paragraph 53 of the judgment of the CFI⁴ in Case T-164/03 *Ampafrance S.A. v OHIM – Johnson & Johnson GmbH (monBebe)*).

The respective specifications are shown below for ease of reference.

ICAS's specification	CAS's specification
<p>UK Trade Mark 1461432:</p> <p>Class 35: Personnel management consultancy services and advisory services relating thereto; all included in Class 35.</p> <p>CTM 752576:</p> <p>Class 16: Printed matter; printed publications; books, booklets and leaflets; instructional and teaching materials.</p> <p>Class 35: Personnel management consultancy services and advisory services relating thereto; business management consultancy and advice; counselling for employees; workplace counselling; human resource consultancy; stress auditing; work life services and information and guidance relating thereto.</p> <p>Class 41: Education and training; education and training for</p>	<p>Class 35: Business management consultancy and services, recruitment consultancy and services.</p> <p>Class 38: Communications Consultancy.</p> <p>Class 42: IT consultancy.</p>

⁴ Court of First Instance of the European Communities

employees; workplace skills training; stress management training.	
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Class 42:

Personal counselling; counselling to employees; work life services and information and guidance relating thereto.

20. In order to fairly compare the respective services, I must consider what each of the terms cover. In terms of my approach, I bear in mind the following guidance:

a) In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 where Jacob J held 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.”

b) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 the court held that words should be given their natural meaning within the context in which they are used and cannot be given an unnaturally narrow meaning.

21. I will consider each class sought by CAS in turn. Looking at the class 35 services first of all, I note both CAS and ICAS (in its CTM specification) use identical terms, namely “business management consultancy”. ICAS end this particular description with “...and advice”, CAS with “...and services”, however nothing really turns on this point. These services are self evidently identical. The remainder of CAS’s class 35 specification reads “recruitment consultancy and services”. ICAS’s CTM specification uses the term “human resource consultancy”. Although the parties have not used identical terms, it seems to me that recruitment related services falls within the wider term of human resource consultancy as recruitment consultancy represents a definable sub set within the wider term and indeed, is a primary activity of any human resource capability. As such, I find that these services are also identical, or at least, very similar.

22. The class 38 services of CAS are “Communications Consultancy” and its class 42 services are “IT Consultancy”. ICAS have argued that these services are complementary to those of its earlier marks and are, therefore, similar. In addition to the case-law I have already described, I also take into account the judgment in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06, where the CFI stated:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T- 169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685,

paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

23. The findings of the CFI in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-316/07 are also useful:

54 The mere fact that the information, booking and reservation services covered by the trade mark at issue are exclusively provided via the internet and therefore require software support such as that provided by the goods and services covered by the earlier trade mark does not suffice to remove the essential differences between the goods and services concerned in terms of their nature, their intended purpose and their method of use.

55 Computer goods and computer services are used in nearly all sectors. Often, the same goods or services – for example, a certain type of software or operating system – may be used for very different purposes, and that does not mean that they become different or distinct goods or services. Conversely, travel agency services do not become something else – in terms of their nature, intended purpose or method of use – solely because they are provided via the internet, particularly since, nowadays, use of computer applications for the provision of such services is almost essential, even where those services are not provided by an internet shop.

56 Moreover, the goods and services concerned are not substitutable, since they are intended for different publics. Therefore, the Board of Appeal was right to find that those goods and services are not in competition with each other.

57 Finally, those same goods and services are also not complementary. It must be recalled in this respect that goods or services which are complementary are those where 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 consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gómez Frías (euroMASTER)*, not published in the ECR, paragraph 35; and Case T-420/03 *El Corte Inglés v OHIM – Abril Sánchez and Ricote Saugar (Boomerang TV)* [2008] ECR I-0000, paragraph 98).

58 That case-law definition implies that complementary goods or services can be used together, which presupposes that they are intended for the same public. It follows that there can be no complementary connection between, on the one hand, the goods and services which are necessary for the running of a commercial undertaking and, on the other, the goods and services produced or supplied by that undertaking. Those two categories of goods or services are not used together since those in the



first category are used by the relevant undertaking itself whilst those in the second are used by customers of that undertaking.”

24. I consider that ICAS’s best case for a finding of similarity against CAS’s class 38 and 42 terms, lies with “business management consultancy” services. To my mind, these services involve advice and guidance on the managing of a business being provided to a particular organisation or company. “IT Consultancy” is also a service that is aimed at and can be supplied to the same end user, but it is specialist in nature and relates to guidance regarding appropriate IT tools and functionality for a particular business. This view applies equally to “communications consultancy”. This service is in class 38 and, as such, encompasses advice on the technical tools available (e.g. telephone or email services) to allow communication to take place rather than the techniques or methods that may be employed by an organisation to ensure the effective dissemination of information.

25. ICAS argue that both effective communication and IT functionality are key to any aspect of good management of a business and, as such, these services are complementary to those of its earlier CTM mark. However, this argument does not, of itself, persuade me that the services are complementary. Applying the case law with regard to what can be seen as complementary, CAS’s services are not indispensable or important for the use of those of ICAS. However, I have also indicated that, in my view, these services are aimed at the same (or very similar) end users and it seems to me that they have the same underlying purpose, namely facilitating business improvement. On this basis, I conclude that there is some similarity between these services, but the degree of similarity between them is not high.

Comparison of the marks

26. In assessing this factor, I must consider the visual, aural and conceptual similarities between the respective trade marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG, para 23*). The respective trade marks are reproduced below for ease of reference.

ICAS's earlier trade marks	CAS's trade mark application
UK trade mark 1461432: ICAS	
Community trade mark 752576: 	

27. As shown above, the ground under Section 5(2)(b) is based upon two earlier marks, therefore, comparisons must be made between each of the earlier marks and the applied for mark as there may be quite different issues to consider.

Comparison with UK Trade Mark 1461432

28. Visually, I consider that the distinctive and dominant component of CAS's mark is the letter string CAS. There is one component of ICAS's mark namely the letter string ICAS. Though I note that the earlier mark is presented in upper case whereas the applied for mark is in lower case, I do not consider this to be particularly significant. There is also only one letter difference between them, the letter "l". I also bear in mind that the letter strings are very short. In the Court of First Instance ("CFI") decision in *Inter-Ikea Systems BV v OHIM*, the court said:

"54 As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter "d" in the contested mark and the letter "k" in the earlier word marks. However, the Court has already held in Case T-185/02 *Ruiz –Picasso and Others v OHIM – DaimlerChrysler (PICARO)* [2004] ECR II-1739, paragraph 54 that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them.

55 Accordingly, the degree of visual similarity of the earlier word marks and the verbal element of the contested mark must be described as low."

29. The differing first letter does have an impact and can in no way said to be lost in the overall visual impression it gives. The CAS mark also includes a circular device (which is also coloured) with additional swirls either side which provides some impact. I am of the view overall, that although the marks have a point of similarity in the common presence of the letters CAS, the differences identified result in this being only a low degree of visual similarity.

30. Aurally, it seems to me that the marks will be pronounced as complete words rather than letter strings; as “ICAS” and “CAS” (as opposed to “I-C-A-S” and “C-A-S”). There is an additional letter (and syllable) in the earlier mark, which create a point of difference which is unlikely to go unnoticed. However, the endings of both marks will be identical. Therefore, there is some aural similarity, however, I consider this to be only a low degree.

31. Conceptually, both marks have the look and feel of random letter strings, though in reality they are both acronyms of the respective business names. To my mind, the average consumer will view each mark as a random letter string rather than as an acronym. Consequently, neither mark has a meaning which is shared (or differs), therefore, the conceptual impact is neutral.

Comparison with CTM 752576

32. Visually, again, the dominant and distinctive components of both marks are the letter strings and that there is a point of similarity between them(as identified above). Additionally, the ICAS mark also has an ellipse, though it is not the same nor particularly similar to the CAS ellipse. The respective letter strings are also presented in differing typeface, but this is not a significant factor. Though the words “Independent Counselling and Advisory Services Limited” are also present in the earlier mark, this does not lessen the impact of the letter string which retains its dominant and distinctive status. Overall, therefore, my conclusion is the same as that in relation to the plain typeface ICAS mark. There is a low degree of visual similarity between these marks, the addition of the device in ICAS’s mark does not make it any more or any less similar to CAS’s mark.

33. Aurally, my earlier conclusions with regard to the word only ICAS mark are equally applicable here. Though I note the addition of the extra words in the CTM, I am of the view that it is more likely that the mark would be referred to solely as “ICAS” as opposed to “ICAS Independent Counselling and Advisory Services Limited”. I, therefore, conclude that there is a low degree of aural similarity between them as per my earlier findings.

34. Conceptually, I must consider what effect, if any, the additional words “Independent Counselling and Advisory Services Limited” have when making the comparison. It is possible to argue that these words inform the average consumer that the letters ICAS have a defined meaning, i.e. that it is the name of the company. This would of course contrast with the CAS mark, which, I have already found, would be seen as a random letter string and have no particular meaning. However, despite the addition of these words, I have already found that the ICAS letter string remains the dominant and distinctive component of the mark. It is these letters that will be most noticed by the average consumer and they may not link ICAS with the words

below it. I therefore conclude, as with ICAS's other earlier mark, that the conceptual impact is neutral.

Distinctiveness of the earlier mark(s)

35. The guidance in *Sabel BV v Puma AG* states that there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se*, or because of the use that has been made of it. There are two earlier marks to consider. The earlier ICAS word only mark has the look and feel of a random letter string. This impression adds to its impact and, as such, I consider it to have a reasonably high degree of distinctive character, *per se*. The ICAS plus ellipse mark also has ICAS as its distinctive and dominant component. As such, this leaves me with the view that this mark also has a reasonably high degree of distinctive character, *per se*.

36. What is the impact, if any, of the evidence of use filed by ICAS? The evidence shows that both earlier marks have been used. However, there is very little put into context which could justify a finding that the ICAS marks have acquired an enhanced distinctive character. For example, some of the evidence is employee facing and it is unclear as to whether it was ever in the public domain; ICAS seminars and associated handouts are referred to and shown, but no detail of scale and frequency is provided; magazine articles are exhibited, but without circulation figures; a poster campaign is evidenced, but with no context provided. The remainder of the evidence are prints from the ICAS website. Turnover figures are also provided, but again, with no context from the particular industry having been provided. There is insufficient evidence to show that ICAS is entitled to claim enhanced distinctive character (and therefore a greater penumbra of protection) for its earlier marks than that to which they are entitled to *per se*.

Likelihood of confusion

37. In reaching a decision on whether there is a likelihood of confusion, I must consider the possibility of both direct and indirect confusion. I begin by considering direct confusion which occurs when the average consumer mistakes one mark for the other and is confused as to the economic origin of the goods sold under the respective marks. The case-law makes it clear that there is an interdependency between the relevant factors (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*) and that a global assessment of the factors must be made when determining whether there is a likelihood of confusion (*Sabel BV v. Puma AG*). I must, therefore, consider the relevant factors from the viewpoint of the average consumer I have identified to determine whether it is likely to be confused.

38. I have found both of ICAS's earlier marks to have only a low degree of similarity to CAS's mark, but ICAS's CTM mark has a much broader specification, including some services which I have already found to be identical or at least very similar. The CTM therefore represents ICAS's best prospects for success.

39. I must factor in the fact that that acquisition of services of this nature are likely to represent a significant monetary investment for the average consumer and are,

therefore, likely to be considered purchases with a high degree of care and attention displayed. This mitigates strongly against imperfect recollection causing confusion.

40. Though the class 35 services are identical or at least, very similar, I have already found that there is only a low degree of visual similarity and aural similarity between the respective marks and that the conceptual impact is neutral. Despite the reasonably high degree of distinctive character of the ICAS marks, bearing in mind the high degree of care and attention that I consider would be displayed and even allowing for imperfect recollection, **I conclude that there is no likelihood of direct confusion.**

41. Turning now to indirect confusion, namely where the average consumer makes an association between the marks, due to some similarity between them, which leads them to believe that the goods come from the same or an economically linked undertaking. The question is whether the presence of the letters "CAS", the common element between the two marks, is enough to make the average consumer believe that the services are the responsibility of the same or an economically linked undertaking.

42. I have already found that the letter strings in all three respective marks are their distinctive and dominant components. However, the letter "I" in ICAS's mark does have a significant impact and is unlikely to go unnoticed. It serves to distinguish between the marks and I have already found that the marks are not similar enough to cause confusion. Consequently, after factoring in all relevant considerations, I do not believe that the average consumer would link that the CAS mark as a variation of, or is otherwise linked to, the earlier ICAS mark. **There is no likelihood of indirect confusion.**

The objection under Section 5(4)(a)

43. In its evidence, ICAS states that the mark that has been used (and consequently the basis of its claim under section 5(4)(a)) is essentially the earlier CTM registration shown above minus the words "Independent Counselling and Advisory Services Limited". In light of my earlier findings that the ICAS letter string is the distinctive and dominant component of all the earlier marks, ICAS are in no better position under this ground. Consequently, I do not consider it necessary to deal with this ground in any more detail, as this ground of opposition will fail on misrepresentation.

COSTS

44. As the opposition has failed, CAS is entitled to a contribution towards its costs. Accordingly, I order Independent Counselling & Advisory Services Ltd to pay Communications Advisory Service Ltd the sum of £1250. This amount is calculated as follows:

Considering notice of opposition - £200

Filing counterstatement - £300

Considering Evidence - £250

Filing Evidence - £500

TOTAL £1250

45. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 9th day of June 2009

**L White
For the Registrar
The Comptroller-General**