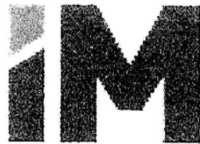


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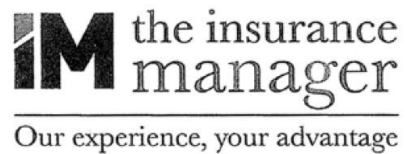
REDACTED VERSION

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS IN THE MATTER OF APPLICATIONS
2455552 & 2455549
IN THE NAME OF THE INSURANCE MANAGER LTD
IN RESPECT OF THE TRADE MARKS:**



&



IN CLASSES 36 & 45

AND

OPPOSITIONS THERETO (NOs 97666/97667) BY IRWIN MITCHELL LLP

TRADE MARKS ACT 1994

Consolidated proceedings in the matter of applications 2455552 & 2455549 in the name of The Insurance Manager Ltd

and

Oppositions thereto (nos 97666/97667) by Irwin Mitchell LLP

The background and the pleadings

1) Both of the above trade mark applications were filed on 15 May 2007 by The Insurance Manager Ltd (“Manager”). The two trade marks, together with the services for which Manager seeks to register them, are set out below:



Class 36: Insurance services; risk management relating to insurance and insurance claims; claims handling services; information, advice and consultancy services, all relating to insurance.

Class 45: Safety inspections and risk inspections and advice

2) Both applications were published in the Trade Marks Journal on 2 May 2008.

3) Irwin Mitchell LLP (“Mitchell”) opposes both applications. Its oppositions were filed on 1 August 2008. It opposes only the services in class 36. Its grounds of opposition are under sections 5(2)(b), 5(3) and 5(4(a) of the Trade Marks Act 1994 (“the Act”). In relation to sections 5(2)(b) & 5(3), Mitchell relies on its Community trade mark registration 2523389. It relies on the class 36 & 42 services of its earlier mark. The mark relied upon and the services in classes 36 & 42 for which it is registered are as follows:



Class 36:Debt recovery; administration and advice in relation to pension schemes; investment management; supply of insurance products.

Class 42:Legal services; registration and management of intellectual property rights; company formation and registration services; trade mark

agency services; legal advisory services; conveyancing services; legal information research services; services for the preparation of medical reports; consultancy services relating to information technology; computer software development and maintenance services; licensing of software; web site and intranet design and development services; including the provision of all such services on-line, electronically or by telephone; document management services, namely, document scanning services.

A further mark was initially relied upon (UK registration 2139564b). Mitchell withdrew its reliance on the basis of this earlier mark on 16 February 2010.

4) Mitchell's mark was filed on 21 December 2001 (so making it an earlier mark as defined by section 6 of the Act) and it completed its registration procedure on 10 June 2003. The consequence of this latter date is that the proof of use provisions contained in section 6A of the Act do not apply and the earlier mark may be taken into account in these proceedings for its specification as registered, to the extent relied upon in the pleadings.

5) Under section 5(4)(a) Mitchell relies upon its use of three signs, namely: i) the letters IM, ii) a sign corresponding to the earlier mark depicted above and iii) a sign corresponding to the earlier mark together with the words IRWIN MITCHELL/IRWIN MITCHELL SOLICITORS.

6) Manager filed a counterstatement denying the grounds of opposition. It put Mitchell to proof of use in relation to its now withdrawn (from the proceedings) earlier mark. The request for proof of use is, therefore, no longer relevant. Manager also put Mitchell to proof in relation to its claims that its earlier mark/signs enjoy a reputation/goodwill.

7) Both sides filed evidence. The matter then came to be heard before me on 20 January 2011. Mitchell were represented by Mr Tom Alkin, of Counsel, instructed by Mitchell themselves (Mitchell being a firm of lawyers). Ms Alison Cole of Graham Watt & Co represented Manager.

The evidence

8) Mitchell's evidence¹ consists of an 18 page witness statement together with over 1500 paginated pages of exhibits. Also included is a further witness statement subject to a confidentiality order. Any references to the information contained in the confidential evidence will be redacted from the public version of this decision. Manager's evidence (from its director, Ms Kate Underdown) consists, essentially, of a critique of Mitchell's evidence with little by way of factual evidence. Some of the key facts that come from Mitchell's evidence are:

¹ This was given by way of witness statement of Mr Ian Powell, Mitchell's Business Development and Communications Director.

- Mitchell was established in 1912 and has grown to become a national law firm ranked in the top 20 law firms of the UK and the 5th largest litigation firm.
- Mitchell provides a range of legal services. It is a leading personal injury firm and one of the largest volume or “commoditised” legal firms in the insurance sector.
- Since 2002, Mitchell has used what it calls its IM roundel (the subject of its earlier mark). Prior to this it used a similar roundel. Various documents show the use of this sign on promotional material etc. It is primarily used alongside the name of the legal firm, but there is some use of it on its own.
- A substantial part of Mitchell’s business is in respect of legal services provided to insurance companies and to their customers/policyholders. This part of the legal practice employs 530 full time staff. Such legal advice includes: recovery of outlays made by the policy holder, personal injury cases, claims for losses but not involving injury, criminal negligence, consumer disputes, employment law and professional negligence. The evidence in relation to this type of business (such as statistics as to the number of calls it receives) appears to be significant. [REDACTED]
- Mitchell recommends ATE (after the event) insurance to its clients as part of its legal work. It has also worked with a company called First Assist to develop an ATE product to meet its clients’ needs. An example of the provision of an ATE is shown in a letter in Exhibit 13. I note that the product itself is from Great Lakes Reinsurance (UK) Plc.
- Mitchell has offered, since 2003, a commercial service called IMHR+. This appears to be package of services offered to employers and it includes insurance cover in respect of tribunal awards which may be awarded against the client. I note that the insurer itself is Great Lakes Reinsurance (UK) Plc and
- that it is administered by First Assist Insurance Services Ltd. [REDACTED]
- The confidential evidence shows that significant sums are spent on the marketing etc. of Mitchell’s various services. I do not consider it necessary to detail the sums here.

Preliminary points

9) Two preliminary points were discussed at the hearing:

- i) That despite Mitchell's pleaded case under section 5(2)(b) of the Act not relying on the class 35 services of its earlier mark, Mitchell were nevertheless attempting to rely on these services at the hearing (this was foreshadowed by its skeleton argument). Mitchell requested an appropriate amendment to the pleadings, a request that Manager contested.
- ii) That part of Mitchell's evidence was missing from the bundles in front of the parties and me. The "missing" evidence was referred to in paragraphs 62 & 63 of Mr Powell's witness statement as being a third party investigation report regarding Manager's business. I was not, however, exhibited. Mitchell explained that the document could be provided if required.

10) I did not consider that the requested amendment was something that could be undertaken and acted upon at the hearing. The question as to the similarity of services is one on which Manager must be fully able to consider and to provide evidence if so required in advance of any hearing. It represents a different basis for the opposition and a different consideration as to whether there exists a likelihood of confusion. If the request were to be allowed then the parties would have had to have been given an opportunity to provide evidence and to provide further arguments. The same can be said in relation to the missing evidence. I informed the parties that in order to save time and money on their behalf, I would return to these points and what to do about them only if they became relevant to my decision. For example, if Mitchell succeeds in its opposition under its other classes then there is little point in returning to the question of whether they would also have been able to succeed in respect of its class 35 services. I will, therefore, come back to these issues at the end of my decision.

Section 5(2)(b) of the Act

11) This section reads:

"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.”

12) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

13) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective services are similar, other factors are relevant including:

The nature of the average consumer of the services in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective services, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

14) As one of Manager’s marks is a composite mark made up of a number of elements it is worth setting out some of the guidance that has come from the ECJ in relation to the likelihood of confusion when such marks are involved. I particularly note the judgment in *Medion v Thomson Multimedia* [2006] ETMR 13 where it was stated:

“29 In the context of consideration of the likelihood of confusion, 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. On the contrary, 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 (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35 Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by

the composite sign is attributed by the public also to the owner of that mark.”

15) Also, the judgment in *OHIM v Shaker di L Laudato & Co Sas* (C-334/05 P, 12 June 2007) where it was stated:

“41. It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, 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. On the contrary, 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 (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42. As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element”

The average consumer

16) The average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on the particular goods or services in question (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

17) The services at issue range from insurance type services in class 36 to legal services in class 45. These services could be utilized by both members of the general public and by businesses. The services involved are not casually acquired. At the very least, a reasonable degree of care and attention will be displayed. The process may in fact be slightly more considered than the norm, but perhaps not of the highest degree.

Comparison of 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 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.”

19) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (a) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

20) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

“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).”

21) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark

specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”² and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning³. However, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

“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.”

22) The (opposed) services Manager seeks to register are:

Class 36: Insurance services; risk management relating to insurance and insurance claims; claims handling services; information, advice and consultancy services, all relating to insurance.

23) The (relied upon) services covered by the earlier mark are:

Class 36: Debt recovery; administration and advice in relation to pension schemes; investment management; supply of insurance products.

Class 42: Legal services; registration and management of intellectual property rights; company formation and registration services; trade mark agency services; legal advisory services; conveyancing services; legal information research services; services for the preparation of medical reports; consultancy services relating to information technology; computer software development and maintenance services; licensing of software; web site and intranet design and development services; including the provision of all such services on-line, electronically or by telephone; document management services, namely, document scanning services.

24) I will make my assessment, term by term, with reference to the services sought to be registered by Manager. However, before doing so, I will deal with Mitchell’s claim that its “legal services” in class 45 are “highly similar to the point of identity”⁴ to Manager’s services in class 36. The argument can be best illustrated by considering the term “claims handling services” in class 36. The argument is that because a legal firm may be instructed to act on someone’s behalf against an insurance company then this is, effectively, exactly the same as

² See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

³ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

⁴ Words used by Mr Alkin at the hearing before me.

when a claim is being handled by an insurance company or by a specific claims handling firm on behalf of the insured. Applying the guidance in *Avnet*, a legal service will encompass the provision of legal advice or representing a party in legal disputes. Whilst this can centre on disputes about insurance related matters, it is not the same thing as someone's insurance claim being handled by an insurance company or a claims handling company. The nature of the service is different given the different specialisms being brought to the table. I would assume the method of use is different in terms of how one engages the respective service providers. The services are not competitive as the choice relates to what is required (simple claims handling or legal advice/representation). The services do not strike me as complementary as neither is indispensable for the use of the other. Even if there was a degree of complementarity there is no evidence to suggest that this would be of such a nature that consumers would think that the responsibility for the respective service lies with the same undertaking (a legal firm is a legal firm, a claim handling company is a claims handling firm – they are distinct and unrelated). The users could be the same, but this can be said about many services – the purpose may superficially be similar as the end goal of one possible branch of a legal service could be to assist in getting an insurance based payout from an insurance policy and that this is the role of a claims handling service. However, this is removed from the core of the meaning of legal services. All things considered, I do not consider these services to be similar. I will move on to consider the terms sought to be registered by Manager in comparison to Mitchell's class 36 services (specifically "supply of insurance products" which appears to represent Mitchell's best prospect of success).

Insurance services

25) Manager drew a distinction between Mitchell's supply of insurance products and Manager's "insurance services". The latter were argued to be the insurance products themselves (insurance policies etc.) but the former to a supply service offered by a third party. Reference was made to Mitchell's evidence showing that it offers its clients insurance products (of others) that can be taken out if required. It must be borne in mind, however, that the earlier mark is not subject to proof of use. I must consider the matter at face value and what, notionally speaking, the term(s) actually cover. Applying the principles in *Avnet*, the term "insurance services" would cover activities such as the provision of insurance of various types. This could be as the policy provider or, possibly, insurance brokerage. Mitchell's specification covers "supply of insurance products". Both services therefore provide or supply insurance to members of the public or to businesses, be it by the policy itself or by the brokerage of policies. Both specifications cover, in my view, both circumstances. The services are identical. In any event insurance services at large (Manager's term) would undoubtedly cover both the provision of a policy and the supply (via brokering) so the services are identical in any event. **Identical services must be held to be in play.**

Information, advice and consultancy services, all relating to insurance

26) The meaning of these terms is reasonably clear and obvious. There is a clear degree of similarity when one considers that a company supplying insurance services may also provide information, advice and consultancy in relation to such products. The nature and method of use may not be identical, but the key purpose is to put a person or a company in an informed position so that they are adequately insured against the particular risk of interest to them. The users overlap as will the channels of trade. The supply of an insurance product may well simply follow on from the provision of information etc. This is a type of relationship whereby consumers would believe that the responsibility for the respective services lies with the same undertaking. **I consider there to be a reasonably high degree of similarity between these services.**

Risk management relating to insurance and insurance claims

27) At the hearing both parties gave similar (although not identical) descriptions as to what such a service entailed. Both descriptions related, effectively, to the identification and management of risks relating to the particular thing to be insured. Manager also explained that such a service provider may then go on to insure that risk after some of that advice has been taken on board. There is no evidence on this matter, but what has been put forward seems a sensible interpretation. The service though, given that it falls in class 36, must relate to insurance specific impacts rather than general risk advice (such as, for example health and safety risks). Given that the service is, effectively, one of advice relating to insurance (focusing on risks) this strikes me as little different from the service assessed in the preceding paragraph. It could form part and parcel of the supply of insurance products. It would give rise to the type of relationship whereby customers would think that the responsibility for the respective services lies with the same undertaking. **I consider there to be a reasonable degree of similarity between these services.**

Claims handling services

28) Again, the parties gave similar (although not identical) descriptions of what this service entailed. Both described it, effectively, as the handling of a claim on behalf of the insured. This could be a service used by an insured person against another insured person or their insurance company or, even, by an uninsured person against an insured person or their insurance company. It is about the advancing of an insurance claim on behalf of someone, negotiating with the insurance company etc. Although the purpose is different (the supply of a policy as opposed to ensuring compliance with it) there is a degree of similarity in that both are concerned with insurance, the same users are involved and the channels of trade may overlap. The services are not competitive. However, there is a degree of complementarity due to the ancillary relationship between the two,

a claims handling service being the final aspect (if a claim is made) following the provision of the insurance. This is likely to give rise to the type of relationship whereby customers would think that the responsibility for the respective services lies with the same undertaking. The differences do not outweigh the similarities. The consumers are the same and it strikes me that the same service providers could provide both services so bringing the trade channels together. **I consider there to be reasonable degree of similarity.**

Comparison of the marks

29) In terms of the marks themselves, they are, for ease of reference, replicated below.

Mitchell's mark	Manager's marks
	

30) 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 the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

31) In terms of distinctive and dominant components, there can be little doubt that the letters IM constitute the dominant and distinctive element of Mitchell's mark. The elements that surround IM are certainly more than mere quotation marks (this is what Mr Alkin compared them to at the hearing), but they nevertheless play a subordinate role in the mark as a whole. In respect of Manager's mark, the first mark depicted above consists of just the letters IM albeit in a stylised form of presentation. The stylisation is applied to the letters so the letters/stylisation are not separate elements per se. However, whilst the stylisation will not be ignored in my comparison, the letters are likely to be perceived as the most important part of the mark. The letters are the thing most likely to form the conceptual hook of the mark. In terms of the word and device mark above, the stylised letters IM are accompanied by the words THE

INSURANCE MANAGER and what would be perceived as a strap-line “Our experience, your advantage”; this strap-line is fairly weak in distinctiveness. In my view, the letters still dominate the mark – they have greater visual impact and even though they may be perceived as being short for “insurance manager” the letters constitute the dominant and distinctive element of the mark. The words THE INSURANCE MANAGER nevertheless still plays an important role, but they are subordinate in impact and also in distinctiveness as the words have some suggestive qualities (that the service provider will manage your insurance issues); this does not negate my view that IM is distinctive (and dominant) because it is the impact as a whole that is important.

32) I will begin by comparing Mitchell’s mark with Manager’s stylised word mark. In both marks the most dominant and memorable aspect resides in the letters IM. Both marks are, though, stylised so creating a visual difference. Despite the visual difference, the fact that the letters IM are the most distinctive and memorable element means that the marks are visually similar to a reasonably high degree. The marks are aurally identical. Both will be referred to simply by the letters IM. In terms of concept, the respective stylisation does not change the conceptual hook. The concept is that simply of the two common letters IM which, on face value, do not relate to anything specific. Taking all of this into account, I consider the net result of all this to be that there is a high degree of similarity between the marks.

33) In terms of Mitchell’s mark compared to Manager’s composite mark, there is clearly a lesser degree of similarity to that assessed above on the basis of the additional elements in Manager’s mark (compared to its other mark) – these create additional differences in the comparison. However, given that I have found the letters IM to still be the dominant and distinctive element in Manager’s mark then there is still a degree of visual similarity – the visual differences residing in the stylisation, the words “the insurance manager” and the strap-line do not outweigh the point of similarity. I would say that there is a moderate degree of visual similarity. This follows through to the aural comparison with the IM element being the element that will be pronounced first and the element that is more distinctive and memorable. The strap-line, when the mark is referred to aurally, may not even be pronounced. I consider there to be a reasonable degree of aural similarity. In terms of concept, I do not consider the addition of the words THE INSURANCE MANAGER to create a significant conceptual difference. Whilst the words give the letters IM in Manager’s mark a context and that such a context is not apparent, on face value, in Mitchell’s mark, the letters will still be remembered as letters. Furthermore, I agree with Mitchell’s submission that even if the conceptual context of the letters IM in Manager’s mark is recalled, when IM is subsequently encountered (by way of Mitchell’s mark) then the concept may be carried forward. This reduces the significance of the conceptual context argument. Overall, I consider the net result of the comparison to be that there is a reasonable degree of similarity (neither high nor low).

Distinctiveness of the earlier mark

34) The degree of distinctiveness of the earlier mark is another important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent starting point I consider the earlier mark to possess a reasonable (neither high nor low) degree of distinctiveness. Whilst the stylization does not imbue the letters with a significant degree of distinctiveness, the letters IM have no real allusive or suggestive qualities in relation to the services at issue. The letters may be presumed to mean something, letter marks often do, but without knowing what they mean then this has little bearing. There can be no automatic rejection of letter marks as not possessing distinctive character⁵ (or by extension that they possess only a particular degree of distinctiveness). All things considered, I consider the earlier mark to be a mark of a reasonable degree of distinctive character. It is neither highly distinctive but nor is it a mark of only a low degree of distinctiveness.

35) In terms of the use made of the earlier mark, I do not consider that Mitchell's position is improved. Whilst its use may demonstrate a reputation in the field of the provision of legal services, the evidence falls a long way short of demonstrating that it has a reputation in relation to the supply of insurance products. Whilst it may offer an insurance product in conjunction with some of its legal services, the nature of this use does not give rise to a reputation as a supplier of insurance products. Its reputation is as a legal services provider. As I have found legal services not to be similar to Manager's services then Mitchell's reputation is not a relevant reputation for the purposes of the analysis.

Conclusions under section 5(2)(b)

36) It is clear that the factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

37) I will consider the position firstly in respect of Manager's composite mark. If Mitchell succeeds here then it is an inevitable conclusion that it will also succeed in respect of the Manager's stylized word mark. I have found Mitchell's earlier mark to be reasonably distinctive, that the services are identical or, at the least, reasonably similar, but that where the services are not identical there is a clear

⁵ See *OHIM v Borco-Marken-Import Matthiesen, Case 265/09 P*.

relationship between them of the sort that consumers may consider the services to be offered by the same economic undertaking. I have found the marks to be reasonably similar particularly bearing in mind the dominant and distinctive elements of the marks. Whilst the degree of similarity may militate against the impact of direct confusion, there is still the issue of indirect confusion to consider whereby, because of the similarities between the marks and the respective services, the average consumer will believe, even though they are alive to the differences between the marks, that the services are being offered by the same or an economically linked undertaking⁶. In my view there is a likelihood of such confusion. Notwithstanding the reasonably considered way in which a financial service provider will be selected, the common and dominant aspect of both marks is the letters IM. This is what will be most remembered. Whichever way around the marks are encountered it is my view that the distinctive and dominant component which is common to both marks, in the circumstances where that element and the earlier mark as a whole is reasonably distinctive, will be put down to economic connection rather than co-incidence. The additional context and visual difference created by the words in the mark do not militate against this, particularly when one bears in mind that undertakings often present their marks in differing ways for differing circumstances, albeit retaining a core aspect of it – in this case the distinctive and dominant letters IM. This common theme is what results in confusion, confusion in respect of all the services sought to be registered which all relate to insurance services of one type or another. Mr Alkin referred at the hearing to the judgment of Arnold J in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochocki* [2011] ETMR1 to the extent that the likelihood of confusion includes a likelihood of initial interest confusion (although Mr Alkin did not limit his case to such confusion). I agree that in this case there will, at the very least, be initial interest confusion. Given the analysis in this paragraph I do not consider that confusion will be limited to initial interest confusion, the notional use of the mark in respect of the respective services will also be likely to lead to transactional confusion.

38) Given the above finding, I am of the clear (and stronger view) that there is also a likelihood of confusion in respect of the stylized word mark. Indeed, confusion could easily be direct rather than indirect given that the only difference resides in the stylization and this may not form part of the imperfect way in which the respective marks will be stored away and recalled. The opposition succeeds in its entirety against both the opposed marks. Given Mitchell's success, it is not necessary to revisit the preliminary points mentioned earlier in this decision.

39) I do not consider it necessary to consider the grounds of opposition under section 5(3) and 5(4). Mitchell is in no stronger position. Indeed, given where Mitchell's reputation/goodwill exists (as a legal services provider, even if this relates to work relating to insurance) then it would have been in a more difficult position.

⁶ This is a relevant form of confusion - see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*.

Costs

40) Mitchell has been successful and is entitled to a contribution towards its costs. In his submissions Mr Alkin highlighted the large amount of evidence filed and the time that would have been expended in collating this and prosecuting the case and, therefore, that any award in its favour should be at the higher end of the scale. Manager, on the other hand, argued that the evidence was unnecessarily voluminous and that if Mitchell were to be successful then its costs award should be reduced. I agree with Manager that the evidence of Mitchell could have been produced more efficiently and succinctly. I will therefore reduce this aspect of my costs decision so that it is more towards the lower end of the scale than the upper. I hereby order The Insurance Manager Ltd to pay Irwin Mitchell LLP the sum of £2300. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£700

Opposition fee x2
£400

Filing evidence and considering the other side's evidence
£600

Attending the hearing
£600

41) The above sum should 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 22 day of March 2011

**Oliver Morris
For the Registrar,
The Comptroller-General**