

O-485-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3075655
BY
ADEPT CONSULTING AND SERVICES LIMITED
AND NITIN DEHERKAR
TO REGISTER THE TRADE MARK SERIES:**



IN CLASSES 35, 41 AND 42

AND

OPPOSITION 403655 THERETO BY AKKA TECHNOLOGIES

Background and pleadings

1. Adept Consulting And Services Limited and its Managing Director Nitin Deherkar (the Applicants) applied to register the trade marks above in the UK on 6 October 2014. The application was accepted and the marks published in the Trade Marks Journal on 24 October 2014 in respect of the following services:

Class 35

Consulting and project management services for businesses, namely analysing, assessing, planning and developing strategies, information, processes, and organisations for businesses in order to enhance the efficiency and effectiveness of those businesses; and outsourcing services, namely providing staffing to others in order to operate helpdesks, customer care centers, software maintenance and network support functions; and production hosting and support facilities.

Class 41

Training services, namely providing training to others in the fields of computers, databases and project management.

Class 42

Consulting services, namely analysing, assessing, planning and developing information-based and ecommerce based systems for businesses including system implementation, online internet based services and system integration of custom and package software.

2. AKKA TECHNOLOGIES (the Opponent) oppose the trade marks on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier International Trade Mark 'AKKA RESEARCH', number 1221232 which designated the United Kingdom for protection on 10 March 2014 (claiming priority of 13 September 2013 from an earlier filing in France). The Registrar considered the request satisfied the requirements for protection and protection was conferred on 21 April 2015.
3. The Opponent's form TM7 indicates that all of its registered goods and services are relied upon for the purpose of these proceedings. These include goods in Class 9, and services in Classes 36 – 39 and 45. However, as the Opponent makes submissions only in relation to its services in Classes 35, 41 and 42, I will focus initially on them.

Class 35

Business management assistance; business management and organization consultancy; business management; business advice, assistance, information and research; business management consultancy; professional business consultancy; efficiency experts; business information; marketing; coaching, aid and assistance to companies (administrative and commercial assistance in business management) in their project for creating and developing industrial installations; business inquiries; advisory services for business management; systematization of information into computer databases; personnel recruitment services; advisory services for company business and

administrative management in the field of information technology; business administration; business information; business advice and assistance (business management assistance) in the fields of customer management, risk management, alliances and commercial relations with other companies, acquisition of other companies, sale of business assets, operational efficiency and financial management.

Class 41

Training; academies [education]; videotaping; practical training [demonstration]; education information; entertainment information; organization of exhibitions for cultural or educational purposes; organization of competitions [education or entertainment]; organization and conducting of training workshops; organization and conducting of colloquiums; organization and conducting of conferences; organization and conducting of congresses; organization and conducting of symposiums; organization and conducting of seminars; publication of texts other than advertising texts; publication of electronic books and journals on-line; writing of texts other than advertising texts; game services provided on-line from a computer network.

Class 42

Research and development of new products for others; biological research; chemical research; mechanical research; physics research; technical research; construction drafting; technical project study; providing search engines for the Internet; research and development of new products for others; industrial analysis and research services; technical research; consultancy and research in connection with drafting scientific or technical documentation for companies; aeronautical engineering; automotive engineering; railway engineering; maritime engineering; systems engineering, namely design, creation of computer systems for companies in the aeronautic, automotive sector; systems engineering, namely design, creation of computer systems for companies in the sector of the construction of vehicles and apparatus for locomotion by land, rail, air, water; systems engineering, namely design, creation of computer systems for companies in the sector of transportation by land, rail, air and water; maintenance engineering; multimedia engineering; technical project study; engineering work; database design and development; computer system design; industrial design (industrial design services); technical design (industrial design services); graphic arts designers' services; computer-assisted creation of images; conversion of data or documents from physical to electronic media; creation and maintenance of Internet sites for others; technical inspection of vehicles and apparatus for locomotion by land, rail, air, water; quality control services; research and development of new products for the aeronautic industry, the automobile industry, the railway industry, the waterway industry, the maritime industry; electronic archives; storage and preservation of computer files or data and all data media and documents stored in electronic format; information on electronic storage and archiving; information in the field of electronic storage and archiving on computer networks.

4. The Opponent argues that the services claimed by the Applicants in Classes 35, 41 and 42 are identical or similar to those covered by the earlier mark, and that the marks are visually and phonetically similar.
5. The Applicants filed a counterstatement denying that the marks are similar. The Applicants offered no submissions in relation to the Opponent's claim that the services are identical or similar. Whilst it may have been open to me to consider the Applicants to admit that part of the Opponent's claim, I will nevertheless consider exemplary services from each applied for class which are identical to that of the Opponent's specification. If the opposition fails in respect of identical services it will not succeed in respect of merely similar services.
6. Given its date of filing, the Opponent's mark constitutes an earlier mark in accordance with section 6 of the Act. The earlier mark had not been registered for more than five years at the date on which the Applicants' marks were published meaning that the proof of use provisions contained in section 6A do not apply. The earlier mark may, consequently, be taken into account in these proceedings for its specification as registered.
7. Both sides filed written submissions which will not be summarised but will be referred to where appropriate. No hearing was requested and so this decision is taken following a careful perusal of the papers.

DECISION

Section 5(2)(b)

8. Sections 5(2)(b) of the Act is as follows:

“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”.

9. 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.

Comparison of services

10. In class 35 the Applicants claim:

“Consulting and project management services for businesses, namely analysing, assessing, planning and developing strategies, information, processes, and organisations for businesses in order to enhance the efficiency and effectiveness of those businesses”

Whilst the Opponent’s earlier mark covers:

“Business management and organization consultancy”

11. In Case T- 133/05 *Gérard Meric v OHIM*, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

12. In the present case, the services designated by the application are covered by the more general term ‘business management and organization consultancy’ and can therefore be considered identical.

13. Similarly, the applied for “training services, namely providing training to others in the fields of computers, databases and project management” clearly falls within the more general term “training” in the Opponent’s specification under Class 41. They are identical under the principle in *Gérard Meric*.

14. Finally, and reliant on the same principle, in Class 42 the Applicants claim:

Consulting services, namely analysing, assessing, planning and developing information-based and ecommerce based systems for businesses including system implementation, online internet based services and system integration of custom and package software.

Whilst the Opponent’s specification covers the more general “computer system design.”


Comparison of marks

15. Case C-251/95 *Sabel BV v. Puma AG* (particularly paragraph 23) 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. 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.”

16. The respective trade marks are shown below:

Earlier trade mark	Contested trade marks
AKKA RESEARCH	

17. The Opponent’s mark consists of the words ‘AKKA RESEARCH’. In terms of the word ‘RESEARCH’, contrary to the Applicants’ submissions, I consider that this will be seen by the average consumer as descriptive of the services, indicating that the company produces research, or offers research and development focussed services. Therefore the word ‘AKKA’ will play the greater role in the overall impression of the mark. The word ‘AKKA’ is not a common one in the English language, and no submissions have been received as to its meaning, if any. It is a palindrome with a double ‘K’. In my view it would be pronounced as it is written, to rhyme with the Māori ‘haka’.

18. The Applicants’ series consists of the stylised depiction of the word ‘ACAS’ in both colour and greyscale. The word ACAS has no meaning of which I am aware, and would most likely be viewed as an acronym or invented word. It could be pronounced in a number of ways, most likely *ex-kas*, but I do not discount that some may pronounce it *a-kas*. The colour version features the in and outstrokes of the initial ‘A’ in blue, whilst the bars and other letters appear in red. The other elements of the marks are common to both in the series. The first letter ‘A’ is the most highly stylised, represented by two thin triangles whose upper points slope inwards towards each other and are surmounted with a circle at the apex. The bar is formed of a ‘tick’ device. The remaining three letters are conjoined, and the bar of the second ‘A’ is formed of a crescent device appearing to encircle the strokes. The stylisation makes an important contribution to the overall impression of the mark, though the word itself carries the greater weight.

19. In terms of conceptual similarity, neither AKKA nor ACAS have been shown to have any meaning and can be considered invented words. Insofar as these elements are concerned, there is neither conceptual similarity nor dissimilarity, and conceptual considerations are therefore neutral. This is so notwithstanding the presence of the descriptive word ‘RESEARCH’ in the earlier mark, which given its descriptiveness has only a very slight conceptual bearing.

20. In terms of visual similarity, the Applicants refer to the final two letters of each word, “KA” and “AS” as being visually dissimilar. I agree in so far as the words

have different terminal letters. That being said, these are clearly two short words both sharing the initial 'A' and a second letter 'A' in roughly similar positions (the third and fourth letters respectively) towards the ends of the words.

21. Differences between the marks include the middle letters (KK and C), the terminal letters (A and S), and the stylisation of the applied for mark, particularly in the first A. The colours of the applied for mark should not feature in the comparison because the earlier mark could equally be presented in blues and reds. Given the similarities I have identified it cannot be said that there is no visual similarity, but weighing these factors against the stylisation of the applied for marks and other differences I have identified, and bearing in mind my assessment of the overall impression of the mark, including the presence of the descriptive word 'RESEARCH' in the earlier mark, I consider there to be only a very low level of visual similarity.

22. In terms of aural similarity, both parties made submissions. The Opponent submits:

1. That the word 'AKKA' in its mark is phonetically identical to the 'ACA' portion of the applicant's marks.
2. That consumers may pronounce the earlier mark with a terminal 'S', rendering it phonetically identical to what it submits is the most likely pronunciation of the applicant's mark, 'a-kas'.

23. For their part, the Applicants submit:

1. That ACAS is an acronym and would be pronounced letter by letter, as A.C.A.S.
2. That the terminal S in their mark is significant enough to differentiate it from the earlier mark.

24. I accept that the Applicants' mark is likely to be pronounced with a hard 'C'. However, in my experience and as a general rule, a double consonant serves to shorten the pronunciation of the preceding vowel, whereas a single consonant serves to lengthen the pronunciation of the preceding vowel. See for example Bitter / Biter; Dinner / Diner; Furry / Fury; Hopping / Hoping; Pinning / Pining. I therefore consider that, consciously or otherwise, the average consumer would read the double K as qualifying the initial A in the earlier mark, and the single C as qualifying the initial A in the applicants' mark, leading the average consumer to the dissimilar pronunciations I refer to at paragraphs 17 and 18 above; ei-kas for the applicant and 'a-ka' for the opponent.

25. As mentioned there, I do not discount that some may pronounce ACAS as 'a-kas', which would be reasonably similar to the earlier mark. The presence of the descriptive word 'RESEARCH' in the earlier mark contributes to aural dissimilarity to a minimal, but not negligible degree. Taking all of these factors into consideration I find that there is a degree of aural similarity below the medium, though not the lowest.

Average consumer and the purchasing act

26. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: Case C-342/97 *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*.

27. 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.”

28. The average consumer of what I shall broadly term ‘business support services’ of the sort in question is a broad spectrum of individuals and companies seeking advice and services in a business setting. The nature of these services is such that there will be slightly more than an average level of care and attention paid during the purchasing process because the consumer needs to ensure that the particular package of services is selected correctly and is appropriate to the needs of their business. The purchasing process will primarily be visual with the services being selected from brochures and the like and also the online equivalents, or from specific tender submissions. There may also be word-of-mouth recommendations and bookings by telephone where aural considerations will play a part.

29. I also note that unlike the services in classes 35 and 42, the services in class 41 are not specified as being for business purposes. Therefore the average consumer for these services may be different; a similarly broad spectrum of individuals and companies seeking training in ‘IT’ and related areas, not necessarily in a business context. The level of care and attention will be likewise slightly above average, as the services will be selected to fit the training requirements of the recipient. The purchasing process will be as above primarily visual but with a possibility of word of mouth recommendations and I do not discount aural considerations.

Distinctive character of the earlier trade mark

30. In Case C-342/97 *Lloyd Schuhfabrik Meyer*, 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. The earlier mark consists of the two words 'AKKA' and 'RESEARCH'. The word 'RESEARCH' is descriptive. The word AKKA is an invented word with no allusive significance in relation to the services and as such the mark as a whole bears a reasonably high degree of inherent distinctive character

Likelihood of confusion

32. I have found that the selection of the services will be primarily visual with the possibility of an aural element, and with a degree of care slightly above average; that the earlier trade mark had a reasonably high degree of inherent distinctive character; that the marks have a low degree of visual similarity and a degree of aural similarity below the medium, though not the lowest. The conceptual considerations are neutral. The services I am considering are identical.

33. Notwithstanding the reasonably high distinctive nature of the earlier mark, and notwithstanding the identity of the services, (both being factors which go in favour of the Opponent), taken as a whole the marks are simply not similar enough for the average consumer to confuse one for the other, even taking into account imperfect recollection. This is so particularly given the circumstances here where the average consumer makes a primarily visual selection with a degree of care slightly above average (although I would have found the same even if the services had been less considered ones).

Conclusion

34. Accordingly the opposition fails and the application may proceed to registration.

COSTS

35. The Applicants have been successful and are entitled to a contribution towards their costs. In the circumstances I award the Applicants the sum of £300 as a contribution towards the cost of the proceedings. I note that the Applicants

represented themselves. The sum is calculated in accordance with Tribunal Practice Notice 4/2007¹ as follows:

Preparing a statement and submissions and considering the other side's statement and submissions: **£300**

36. I therefore order AKKA TECHNOLOGIES to pay Adept Consulting And Services Limited and Nitin Deherkar (jointly) the sum of £300. The above sum should 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 19th day of October 2015

**Andrew Wall
For the Registrar**

¹ <http://www.ipo.gov.uk/pro-types/pro-tm/t-law/t-tpn/t-tpn-2007/t-tpn-42007.htm>