

O-575-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3062961
BY CHINA CAPITAL BRANDS LIMITED**

TO REGISTER THE TRADE MARK:

 **TRADEMARKERS**

IN CLASSES 16, 35 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 403598
BY MARK KINGSLEY-WILLIAMS**

BACKGROUND

1. On 5 July 2014 China Capital Brands Limited (“the applicant”) applied to register the mark shown on the cover page of this decision in respect of the following goods and services:

Class 16

Books and printed publications in the field of intellectual property; printed reports; newsletters; brochures, guides, manuals, pamphlets and leaflets; information circulars; stationery and writing instruments; diaries; calendars; photographs; photocopies; drawings; instructional and teaching material.

Class 35

Advertising services; market research services; business information and advisory services; business research services; business inquiries and investigations; business franchising advisory services; marketing advice and consultancy. Operations, management and administration and commercial operations, all related to intellectual property rights in the public and private business, commercial and production sectors.

Class 42

Information services relating to patents, trademarks, designs, copyright and licensing of intellectual property rights; research, investigation, design and translation services, all relating to intellectual property or technology.

2. The application was published for opposition purposes on 10 October 2014.

3. The application was subsequently opposed by Mark Kingsley-Williams on a number of grounds, i.e. Sections 5(2)(b), 5(3), 5(4)(a) and Sections 3(1)(b) and (c) of the Trade Marks Act 1994 (the Act). In relation to the grounds of opposition based on Sections 3(1)(b) and (c) and Sections 5(3) and 5(4)(a) of the Act, Mr Kingsley-Williams filed no evidence and the opposition based on these sections of the Act were deemed withdrawn. This was not challenged by Mr Kingsley-Williams. Consequently, I need only consider the opposition based upon Section 5(2)(b) of the Act. The opposition under this ground is directed against all of the goods and services in the application.

4. Mr Kingsley-Williams relies upon the earlier UK mark shown below:

Mark details	Services relied upon
UK 2544591	Class 38
TRADE MARK DIRECT	<i>Providing access to and leasing access time to computer databases concerning intellectual property matters.</i>
Filing date: 14 April 2010	Class 45
Date of entry in the register: 30 July 2010	<i>Advisory services relating to intellectual property protection; advisory services relating to intellectual property rights; consultancy relating to intellectual property; intellectual property services; preparation and provision of reports relating to intellectual property; information services and information provided on-line</i>

	<i>from a computer database or from the Internet, provision of information and advisory services, all relating to the aforementioned services.</i>
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5. In his Notice of Opposition, Mr Kingsley-Williams contends that the mark in suit is confusingly similar to his registered mark and that the goods and services are identical or highly similar.

6. The applicant filed a counterstatement in which it denies the basis of the opposition.

7. Whilst neither side filed evidence, the applicant filed written submissions during the evidence rounds. Neither side asked to be heard, nor did they file written submissions in lieu of attendance at a hearing. I make this decision following a review of all the material before me.

DECISION

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

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

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

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

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

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

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

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

10. Given its date of filing, Mr Kingsley-Williams’ 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 applicant’s mark was published meaning that the proof of use provisions contained in Section 6A do not apply. Mr Kingsley-Williams can, as a consequence, rely upon all of the services he has identified.

Section 5(2)(b) case law

11. 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.

The specification of the application

12. Some of the services included in the specification applied for in Class 42 appear to have been classified incorrectly.

13. *Translation services...*, according to the Nice Classification, is proper to Class 41.

14. *Information services relating to patents, trademarks, designs, copyright and licensing of intellectual property rights* must include, broadly speaking, services aimed at providing information about protection and licensing of intellectual property rights. As such, these services would appear to be proper to Class 45, which is where *Intellectual property services* fall. I think the same would apply to *Research, investigation (services)*...in so far as that term relates to intellectual property.

15. For reasons that will become apparent, I will focus my decision, initially, on the information services relating to intellectual property, as this would appear to be the closest services to those of the earlier mark. If the opponent does not succeed here then it is unlikely to succeed for the other goods and services. To this extent, I will therefore proceed on the basis that the services were incorrectly classified and that they properly fall in Class 45.

Comparison of services

16. On the basis indicated above, the comparison is as follows:

Mr Kingsley-Williams' services	Applicant's services
Class 38 <i>Providing access to and leasing access time to computer databases concerning intellectual property matters.</i>	Class 45 <i>Information services relating to patents, trademarks, designs, copyright and licensing of intellectual property rights.</i>
Class 45 <i>Advisory services relating to intellectual property protection; advisory services relating to intellectual property rights; consultancy relating to intellectual property; intellectual property services; preparation and provision of reports relating to intellectual property; information services and information provided on-line from a computer database or from the Internet, provision</i>	

<i>of information and advisory services, all relating to the aforementioned services.</i>	
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17. Information services relating to patents, trademarks, designs, copyright and licensing of intellectual property rights, are self-evidently identical to the services on which the opposition is based, i.e. *Provision of information and advisory services, all relating to [...] intellectual property services*. Even if I am wrong on that and, for example, the services are properly classified in Class 42, then they will be highly similar instead as they are of a similar nature, purpose and methods of use and will likely be provided by the same undertakings.

The average consumer and the nature of the purchasing process

18. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue; I must then determine the manner in which these services will be selected in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

19. The services I am considering are not everyday selections and will be used by businesses rather than members of the public. There will be at least a reasonable degree of care applied, given the likely investment and long-term impact of choosing an appropriate service provider.

20. The selection process is predominantly visual, with the marks being encountered on websites or in brochures etc., although, there is some potential for aural considerations, as I do not exclude that, for example, the services may be acquired following word of mouth recommendations.

Comparison of marks


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

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their

relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

22. It would be wrong, therefore, artificially to dissect the marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

23. The respective marks are shown below:

Mr Kingsley-Williams’ mark	Applicant’s mark
TRADE MARK DIRECT	

Overall impression

24. The earlier mark consists exclusively of the phrase ‘TRADE MARK DIRECT’ presented in upper case as three separate words. The words ‘hang together’ as a unit, the overall impression and distinctiveness resting in the trade mark as a whole rather than in its individual elements.

25. As to the applicant’s mark, the device element makes up the first part of the mark and consists of three overlapping squares placed in a domino arrangement and seen from a perspective projection. The phrase ‘TRADEMARKERS’ appears to the right of the device, is in block capitals and in a slightly stylised typeface. Although the words ‘TRADE’ and ‘MARKERS’ are conjoined, the use of a larger font for the letters ‘T’ and ‘M’ creates a separation in the combination.

26. Both parties make submissions on the distinctive character of the device. Not surprisingly, while the applicant claims, in paragraph 10 of its written submissions, that the “square device is particularly eye-catching and distinctive”, Mr Kingsley-Williams opines that this element has a very low degree of distinctive character. The device is constituted of three squares, which are, in themselves, basic geometrical shapes and, as such, are not inherently distinctive per se. Both elements of the mark have some distinctiveness. However, on account of the size and consequent impact that the word has on the mark as a whole, it is the word that plays the greater role in the overall impression the mark conveys.

Visual similarity

27. Both marks share the common word ‘TRADE’ followed by the word ‘MARK’ (in the case of the earlier mark) and the letters ‘MARK-’ (in the applied for mark). Given what I have said about the way in which the applied for mark breaks down (due to the larger font used for the letters ‘T’ and ‘M’) the conjoining of the words in the applied for mark is not significant and does little to distinguish the marks visually. What creates notable points of difference are, in my view, the following elements: the final word ‘DIRECT’ in the registered mark, the device element at the beginning of

the applied for mark and the suffix 'ERS' at the end of the applied for mark. Overall, I conclude that there is a moderate degree of visual similarity.

Aural similarity

28. The device element in the applied for mark will not be articulated and the space (or lack of it) between the words 'TRADE' and 'MARK(ERS)' does not affect the pronunciation of the word(s) so that the first part of both marks will be articulated in an identical way. Even allowing for a longer pause between 'TRADE' and 'MARK' in the registered mark, as claimed by the applicant in paragraph 11 of its written submissions, the difference in the pronunciation of this part of the marks will be nearly imperceptible. The earlier mark will be articulated 'TRADE-MARK-DIRECT'. The applied for mark will be articulated 'TRADE-MARK-ERS' and the emphasis in 'MARK-ERS' will fall on the initial part of the mark rather than on the ending (although I do not, of course, ignore the ending of the mark). Overall, weighing the similarities and differences, I find that the level of aural similarity is above moderate, despite the identical sounding elements 'TRADE MARK'.

Conceptual similarity

29. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹ The assessment must be made from the point of view of the average consumer.

30. In term of conceptual comparison, both marks contain a reference to 'trade mark', which is a specific category of intellectual property right. The term 'trade mark' refers to both a sign used to distinguish the goods or services of one undertaking from those of other undertakings and the intellectual property right attached to it.

31. The normal meaning of the words in the mark 'TRADE MARK DIRECT', in the context of intellectual property services, will create in the average consumer's mind the concept of a trade mark-related service offered directly to the public or provided directly over the Internet or telephone.

32. The applied for mark, on the other hand, is made up of a device and the word element 'TRADEMARKERS'. The device has no clear conceptual meaning thus, I will restrict the conceptual comparison to the word element. The term 'TRADEMARKERS', whilst an invented word, is, nonetheless, composed of elements that would convey a message to the average consumer. This is because the term 'TRADEMARK' is combined with the ending '-ERS' which, in the English language, is used to form nouns that indicate, among other things, 'a person engaged in a profession or occupation'². To that extent, I agree with the applicant that its mark will be taken as some form of reference to people that deal with trade marks. However, I disagree with the applicant in that I do not believe that this would require the average consumer "taking considerable mental steps". The use of a slightly larger font size for the letters 'T' and 'M' does not prevent an immediate reading of the phrase 'TRADEMARKERS' and there is no hidden or blend of meaning to unpack. The

¹ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

² Collins English Dictionary

phrase cannot be said, strictly speaking, to be a portmanteau word, as contended by the applicant, because there is no fusion of two words but only addition of a suffix to a well-known word that, in my view, the average consumer will see instantly. Overall, I find that there is a medium degree of conceptual similarity because both marks evoke the meaning of trade marks, albeit in different contexts.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

34. Despite Mr Kingsley-Williams’ comments about the use of his mark (indicating that the registered mark is actually in use), no evidence has been filed. Consequently, I have only the earlier mark’s inherent characteristics to consider.

35. In assessing the distinctiveness of the phrase ‘TRADE MARK DIRECT’, I bear in mind that a registered trade mark must be assumed to have ‘at least some distinctive character’³. That said, registered marks may be endowed with varying degrees of distinctive character, ranging from the very low to the very high, depending on whether they are, inter alia, suggestive or allusive of a characteristic of the services, or, alternatively, completely fanciful or invented. In the present case, the words ‘TRADE MARK’ describes a particular category of intellectual property rights while the word ‘DIRECT’ is, at best, allusive of a channel of trade through which the

³ *Formula One Licensing BV v OHIM*, Case C-196/11P

services are offered. The mark is, therefore, possessed of only a low degree of inherent distinctive character for intellectual property services.

Likelihood of confusion

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

37. The applicant relies on the existence of various Community and UK trade marks all including variations of the phrase “trade mark(s)” to suggest there will be no likelihood of confusion. I reject this approach. The existence of other similar marks does not in itself mean that there is no likelihood of confusion between two specific marks and each case must be assessed on its own merit.

38. Turning to the facts of the present case, the services I am considering are identical, the competing marks share a moderate degree of visual similarity, a degree of aural similarity above moderate and a medium degree of conceptual similarity. I also note that the earlier mark has only a low degree of distinctiveness. Notwithstanding the identity of the services, I do not believe there is likelihood of confusion, even taking into account imperfect recollection, for the reasons which I outline below.

39. In reaching this finding, I have guarded against the dangers expressed in *L’Oréal SA v OHIM* Case C-235/05 P, where the CJEU stated:

“43 It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

...

45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected

a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

40. The common aspects of the marks consist of, or are based upon, the word ‘trade mark’. Such a word is descriptive of what, in my view, is likely to be the principal services of interest to the parties (trade mark related services) and it is, therefore, possessed of no distinctive character in relation to such services. Even taking into account the ruling in *L’Oréal SA v OHIM*, the presence of other distinctive elements in the applied for mark (the device and the suffix ‘ERS’), which equally contribute to the overall impression, together with the presence of the word ‘DIRECT’ in the earlier mark (whose distinctive character resides in the combination the words create), are sufficient, in my view, to avoid a likelihood of confusion when all the relevant factors are balanced together.

41. Even for services which are based upon other intellectual property rights, the same perception of the marks will be in play and there will still be no likelihood of confusion.

42. Taking all of the above into account, I find that even the opponent’s ‘best case’ on the basis of the closest services fails. I extend this finding to all of the other goods and services, indeed, the position is even starker as the goods and services are further away from the services of the earlier mark. The opposition fails in its entirety.

Conclusion

43. The opposition has failed.

Costs

44. The applicant has been successful, and is entitled to a contribution towards its costs. I note that the applicant is self-represented and as such, it has not incurred the costs of legal representation. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, and bearing the above in mind I award costs to the applicant on the following basis:

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

Written submissions: £200

Total: £ 300

45. I order Mr Mark Kingsley-Williams to pay to China Capital Brands Limited the sum of £300 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 7th day of December 2015

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