

O-533-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3110259
BY CANDEY PARKER LIMITED
TO REGISTER THE TRADE MARK
CANDEY PARKER
IN CLASSES 35 & 45
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 405275 BY
CANDEY LIMITED**

BACKGROUND

1) On 25 May 2015, Candey Parker Ltd (hereinafter the applicant) applied to register the trade mark “Candey Parker” in respect of the following services:

In Class 35: Accountancy; Accountancy services; Accounting; Accounting for third parties; Accounting services; Acquisition and merger consultation; Acquisition (business-) searches; Acquisition of business information relating to company activities; Acquisition of business information relating to company status; Acquisition of commercial information; Acquisitions (Advice relating to -); Advertising; Advertising services; Accountancy services; Accounting services; Administrative accounting; Advertising and promotion services and related consulting; Advertising and publicity services; Advertising particularly services for the promotion of goods; Advertising services for promoting the brokerage of stocks and other securities; Business consultation services; Business management consultancy and advisory services; Business organisation and management consulting services; Clerical services; Cost accounting; Information services relating to business matters; Secretarial and clerical services; Business networking services; Business planning services; Brand creation services (advertising and promotion); Corporate identity services; Advertising and business services; Advertising and marketing services; Advertising and promotion services; Advertising services for the promotion of e-commerce; Advertising services provided via the internet; Advertising, marketing and promotion services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Advisory services for business management; Book-keeping and accounting; Book-keeping and accounting services; Business advisory and consultancy services; Business advisory and information services.

In Class 45: Advisory services relating to consumers rights [legal advice]; Advisory services relating to copyright; Advisory services relating to intellectual property licensing; Advisory services relating to intellectual property protection; Advisory services relating to intellectual property rights; Advisory services relating to patents; Advisory services relating to regulatory affairs; Advisory services relating to the law; Alternative dispute resolution services; Attorney services; Attorney services [legal services]; Bailiff services (legal services); Barrister services; Company registration services; Compilation of legal information; Compilation of regulatory information; Computer licensing; Consultancy (Intellectual property -); Consultancy on regulations on safety at work; Consultancy (Security -); Consultancy services relating to health

and safety; Consultancy services relating to the legal aspects of franchising; Conveyancing; Conveyancing services [legal services]; Copyright management; Copyright management consultation; Copyright (professional advisory services relating to-); Copyright (professional advisory services relating to infringement of-); Copyright (professional advisory services relating to licensing of-); Copyright protection; Enforcement of intellectual property rights; Enforcement of testaments; Enforcement of trade mark rights; Expert witness services; Granting of licences on intellectual property; Granting of licenses relating to the copying of broadcast television programmes; Granting of licenses relating to the copying of cable television programmes; Guardianship services; Identity validation services; Information services relating to consumer rights; Intellectual property consultancy; Intellectual property consultation; Intellectual property (Licensing of -); Intellectual property services; Intellectual property watching services; Judicial inquiry services; Legal administration of licences; Legal advice; Legal consultancy services; Legal consultation in the field of taxation; Legal document preparation services; Legal enquiry services; Legal information research services; Legal information services; Legal investigation services; Legal mediation services; Legal research; Legal services; Legal services relating to intellectual property rights; Legal services relating to wills; Legal support services; Licensing of computer software [legal services]; Licensing of industrial property rights; Licensing of intellectual property; Licensing of patents; Licensing services; Litigation advice; Litigation consultancy; Litigation services; Litigation support services; Management (Copyright -); Management of authors' copyright; Management of intellectual property; Management of patents; Management of trademarks; Mediation; Mediation [legal services]; Mediation services for marital disputes; Notarial services; Notary public services; Paralegal services; Provision of judicial information; Provision of legal information; Provision of legal research; Registration of domain names for identification of users on a global computer network [legal service]; Registration of domain names [legal services]; Registration services (legal); Solicitors' services.

2) The application was examined and accepted, and subsequently published for opposition purposes on 14 August 2015 in Trade Marks Journal No.2015/033.

3) On 12 October 2015 Candey Ltd (hereinafter the opponent) filed a notice of opposition, subsequently amended. The grounds of opposition are in summary

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
CANDEY	2633617	04.09.12 14.12.12	45	Legal Services

- b) The opponent contends that its mark and the mark applied for are very similar and that the services applied for are identical or similar to its services. It contends that the application offends against Section 5(2)(b) of the Act.
- c) The opponent contends that the similarity between the marks of the two parties will give rise to a link between the two parties' businesses. Use of the mark in suit would take unfair advantage of the reputation of the earlier mark. The link will also dilute the reputation of the earlier mark which would affect the economic behaviour of the relevant public as it will assume that the applicant has the same level of knowledge and expertise as the opponent. They point out that legal services can include activities such as assistance with commercial negotiations, advising on corporate strategy and advising on the development of intellectual property. The mark in suit therefore offends against section 5(3) of the Act.
- d) The opponent contends that it has used its earlier mark since 12 March 2009 and point out that legal services are often provided under the names of the principal individuals or founders of those providers. They contend that due to the similarity of the marks and services of the two parties there would be misrepresentation and consequently damage. The mark in suit therefore offends against section 5(4)(a) of the Act.
- 4) On 10 February 2016 the applicant filed a counterstatement, basically denying that the marks are similar. It accepts that some of the services are identical whilst others are similar but does not provide details of which services it feels fall into which category. It states:

“However, many are not similar, or only have a low degree of similarity. These include all the services (many relating to accountancy and advertising) for which protection is sought under class 35 and all the services except “legal services” (many relating to advisory, intellectual property, licensing, management, research or other services) for which protection is sought under class 45.”

It also admits that the average consumers of legal services are aware that names used by solicitors' practices and other businesses offering professional and related services frequently consist of or include the names of the principal or founding individuals involved in those practices or businesses. It contends that "Candey" is not an unusual name, that consumers take considerable care when selecting legal advice. The applicant claims:

"The name CANDEY PARKER was chosen as a phonetic derivation of the managing partners surname "KHANDEPARKER". "KHANDEPARKER" is derived from the Portuguese name "CANDIAPARCAR" and a close English phonetic derivation of "CANDIAPARCAR" is "CANDEY PARKER".

5) Only the opponent filed evidence. Both sides seek an award of costs in their favour. Neither side wished to be heard. Neither side provided written submissions.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 24 May 2016, by Ashkhan Darius Candey the Managing Director of the opponent company and also Managing Partner of Candey Law LLP, both of which he founded. His statement says very little other than to state that the turnover for the opponent company for the year ending 31 March 2015 was £3,294,014, but he provides no details of the services this amount relates to, or even if was all in relation to business conducted in the UK. He states that the opponent has won awards i.e. second place in *The Lawyer's* Boutique Firm of the year 2014-15, and second place in the *Legal Business Awards* 2015. He provides various exhibits:

- a copy of a High Court claim dated April 2015, although no comment is made regarding the outcome.
- Copies of the applicant's website which mentions "Candey Parker is a commercial law practice based in London aimed at delivering effective value based services to its clients across the spectrum of their business and legal issues globally and locally." And "Our members have extensive experience and expertise in international legal matters particularly laws of India, in which jurisdiction most of our members are qualified to practice."
- copies of pages from the opponent's website which states that it is:

“...a leading niche litigation firm specialising in high value commercial disputes and international arbitrations, often on a contingency basis. Regularly instructed to act against the world’s largest law firms, the firm has a solid track record of successive and substantial wins in the High Court and in arbitrations including ICC, LCIA, UNCITRAL, SIAC and DIAC*.

Principal areas of work. The firm is acknowledged as a leader in the field of multimillion pound shareholder, joint venture and private equity disputes and high value professional negligence claims against lawyers. Technology and financial services are key sectors but the firm is active in a wide range of industries including insurance, energy, international trade and hotels.”

Although the website does not specify what the acronyms * above mean, I assume they are references to: The International Chamber of Commerce (based in Paris); The London Court of International Arbitration; United Nations Commission on International Trade Law (based in Vienna and New York); Singapore International Arbitration Centre and Dubai International Arbitration Centre.

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

8) I shall first consider the ground of opposition under section 5(2)(b) which 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.”

9) An “earlier trade mark” is defined in section 6, the relevant part of 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 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.”

10) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The applicant did not request proof of use.

11) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

12) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer 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.”

13) Whilst the opponent’s services are simply “legal services”, the applicant’s has applied for services which cover a swathe of activities. These range across, inter alia, accountancy (including book keeping), advertising, management consultancy, intellectual property advice and legal services. Such services would be required by the general public including businesses. Such services would probably be researched on-line and the average consumer would be exposed to the trade mark in advertising materials (either on-line or in printed form) and also from high street offices. They will also be chosen after receiving recommendations from friends and acquaintances, and in many instances after contact with the service provider either in person or via telephone. The average consumer will therefore select such services mainly by visual means, although I must also take into account aural considerations.

14) Although I accept that the average consumer’s level of attention may vary somewhat depending on precisely the service required, all the services of both parties would lead a consumer to pay attention to at least a medium degree with most services being given a very high degree of attention in their selection.

15) In summary, the average consumer will be a member of the public (including businesses); the visual aspect will be the most important element in selection although I must also take into account the possibility of word-of-mouth recommendations and so aural considerations must be considered. In selecting such services the average consumer would, in my opinion, take at least a medium degree of care, with the majority of the services at issue attracting a very high degree of care.

Comparison of services

16) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

17) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

18) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

19) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...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”.

20) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

21) The services of the two parties are set out in paragraphs 1 and 3 above. Neither side has provided written submission regarding the similarity or otherwise of the services. I must therefore use my own knowledge and judgment. I shall first compare the class 45 services of both parties. The opponent’s services in Class 45 are “Legal Services”. The following class 45 services applied for by the applicant are all self-identified as legal services or are clearly encompassed by the term. These are clearly identical to the opponent’s services.

Advisory services relating to consumers rights [legal advice]; Advisory services relating to the law; Attorney services; Attorney services [legal services]; Bailiff services (legal services); Barrister services; Compilation of legal information; Consultancy services relating to the legal aspects of franchising; Conveyancing; Conveyancing services [legal services]; Judicial inquiry

services; Legal administration of licences; Legal advice; Legal consultancy services; Legal consultation in the field of taxation; Legal document preparation services; Legal enquiry services; Legal information research services; Legal information services; Legal investigation services; Legal mediation services; Legal research; Legal services; Legal services relating to intellectual property rights; Legal services relating to wills; Legal support services; Licensing of computer software [legal services]; Litigation advice; Litigation consultancy; Litigation services; Litigation support services; Mediation [legal services]; Notarial services; Notary public services; Paralegal services; Provision of judicial information; Provision of legal information; Provision of legal research; Registration of domain names for identification of users on a global computer network [legal service]; Registration of domain names [legal services]; Registration services (legal); Solicitors' services.

22) To my mind the following services do not consist solely of legal services but each could include legal services within their remit. As such all of the class 45 services listed below also are encompassed within the term "legal services":

"Advisory services relating to copyright; Advisory services relating to intellectual property licensing; Advisory services relating to intellectual property protection; Advisory services relating to intellectual property rights; Advisory services relating to patents; Advisory services relating to regulatory affairs; Alternative dispute resolution services; Company registration services; Compilation of regulatory information; Computer licensing; Consultancy (Intellectual property -); Consultancy on regulations on safety at work; Consultancy (Security -); Consultancy services relating to health and safety; Copyright management; Copyright management consultation; Copyright (professional advisory services relating to-); Copyright (professional advisory services relating to infringement of-); Copyright (professional advisory services relating to licensing of-); Copyright protection; Enforcement of intellectual property rights; Enforcement of testaments; Enforcement of trade mark rights; Expert witness services; Granting of licences on intellectual property; Granting of licenses relating to the copying of broadcast television programmes; Granting of licenses relating to the copying of cable television programmes; Guardianship services; Identity validation services; Information services relating to consumer rights; Intellectual property consultancy; Intellectual property consultation; Intellectual property (Licensing of -); Intellectual property services; Intellectual property watching services; Licensing of industrial property rights; Licensing of intellectual property; Licensing of patents; Licensing services; Management (Copyright -); Management of authors' copyright; Management of

intellectual property; Management of patents; Management of trademarks; Mediation; Mediation services for marital disputes.”

23) **The result of the above finding is that the class 45 services of both parties are identical.** I now turn to compare the opponent’s “legal services” to the applicant’s class 35 services. These appear to fall into two distinct groups. There are accountancy and acquisition services (see (a) below), all of which may require legal advice/input, and advertising services (see (b) below) which would not, on the face of it, involve any legal issues.

a) Accountancy; Accountancy services; Accounting; Accounting for third parties; Accounting services; Acquisition and merger consultation; Acquisition (business-) searches; Acquisition of business information relating to company activities; Acquisition of business information relating to company status; Acquisition of commercial information; Acquisitions (Advice relating to -); Accountancy services; Accounting services; Administrative accounting; Business consultation services; Business management consultancy and advisory services; Business organisation and management consulting services; Cost accounting; Information services relating to business matters; Business planning services; Advisory services for business management; Book-keeping and accounting; Book-keeping and accounting services; Business advisory and consultancy services; Business advisory and information services.

b) Advertising; Advertising services; Advertising services for promoting the brokerage of stocks and other securities; Advertising and promotion services and related consulting; Advertising and publicity services; Advertising particularly services for the promotion of goods; Clerical services; Secretarial and clerical services; Business networking services; Brand creation services (advertising and promotion); Corporate identity services; Advertising and business services; Advertising and marketing services; Advertising and promotion services; Advertising services for the promotion of e-commerce; Advertising services provided via the internet; Advertising, marketing and promotion services; Advertising, marketing and promotional services; Advertising, promotional and marketing services;

24) Despite my belief that the services shown at (a) above may also involve legal advice/services this does not make them similar as whilst the users would be the same, the services themselves and the trade channels are different and they would not be in competition. Nor, to my mind, are the services

complementary as one is not indispensable or important for the use of the other, nor would consumers think that the responsibility for these services would lie with the same undertaking. **The result of the above finding is that the class 45 services of the opponent are not similar to the class 35 services of the applicant. This finding means that the opposition in respect of Class 35 services must fail.** I take into account the views expressed in *Waterford Wedgwood plc v OHIM* – C-398/07 P by the CJEU and in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

25) However, for the sake of completeness I shall continue with the issues under section 5(2)(b).

Comparison of trade marks

26) 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 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.”

27) It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features

which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
CANDEY	Candey Parker

28) Both marks have as their first element the word "CANDEY /Candey". The fact that one is in capitals whilst the other is a mix of upper and lower case does not alter the fact that the elements are identical. The applicant's mark also has as a second element the word "Parker". To my mind neither word in the applicant's mark is more dominant than the other, save for the fact that the first element in a mark assumes slightly more importance than subsequent elements. In respect of the services for which the marks are registered / applied for, these words have, to the best of my knowledge, no meaning. It is standard practice for such services to be delivered by companies or partnerships which have the names of the founder/s or senior partners. **Overall the marks of the two parties are similar to at least a medium degree.**

Distinctive character of the earlier trade mark

29) 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 *WindsurfingChiemsee 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).”

30) The earlier mark consists of a single word which has no meaning in respect of the services for which it is registered and will, in my opinion, be seen as the name of the founder of the business. **The mark is inherently distinctive to a medium to high degree.** The opponent has provided evidence of use of its mark but it is not clear to what extent it refers to its activities in the UK. **To my mind the use shown is such that the earlier mark cannot benefit from an enhanced distinctiveness.**

Likelihood of confusion

31) 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 trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. 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 trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the services by predominantly visual means, although not discounting aural considerations and they will, on average, pay a medium to high degree of attention to the selection of such services.
- the class 45 services are identical. The class 45 services of the opponent are not similar to the class 35 services of the applicant.
- the marks of the two parties are similar to at least a medium degree.
- the opponent’s mark has a medium to high degree of inherent distinctiveness but cannot benefit from enhanced distinctiveness through use.

32) In view of all my conclusions, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the services in Class 45 applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2)(b) therefore succeeds in relation to the services in Class 45.**

33) In view of all my conclusions, and allowing for the concept of imperfect recollection, there is no likelihood of consumers being confused into believing that the services in Class 35 applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. Nor will consumers believe that “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 services lies with the same undertaking”. The services are not complementary. **The opposition under Section 5(2)(b) therefore fails in relation to the services in Class 35.**

34) I next turn to the ground of opposition under section 5(3) of the Act which reads:

“5(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

35) In determining the issue I take into account the relevant case law which can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

36) The guidance in relation to reputation under Section 5(3) was set out in *General Motors Corporation v Yplon SA* [2000] RPC 572 in paragraphs 23 to 27. Paragraphs 26 & 27 indicate the standard that must be reached:-

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

37) The onus is upon the opponent to prove that its trade mark enjoys such a reputation or public recognition. In the present case it is clear that the opponent provides its services both in the UK and internationally. It has simply provided a turnover figure of just over £3 million for the year ending 31 March 2015. It does not state what services this figure relates to, nor does it provide any details of where these services were provided. No mention is made of market share. Whilst it would appear to have won awards no details are provided, other than the name, of the organisation awarding the prize. I assume that these names refer to publications but no details are provided as to where these publications are distributed, to whom or the numbers involved, nor who decides how or who wins the award. There are no details provided regarding any promotion or marketing of the opponent. I am unable to say with any confidence that the opponent's CANDEY mark is known by a significant part of the relevant public for such services. **The opposition under section 5(3) therefore fails.**

38) Lastly I turn to the ground of opposition under section 5(4)(a) of the Act which reads:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

39) When considering the issue under this ground of opposition I look to Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) which at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

40) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

41) I also take into account the comments in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), where Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

42) In *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

43) To my mind the evidence filed is not sufficient to show, prima facie, that the opponent has a reputation in the UK in respect of the provision of legal services. **The opposition in respect of section 5(4)(a) fails.**

CONCLUSION

44) As the opposition has only been successful in relation to the section 5(2)(b) with regard to the class 45 services the application will be registered for the Class 35 services.

COSTS

44) As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

Dated this 16th day of November 2016

George W Salthouse
For the Registrar,
the Comptroller-General