

**O-023-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3168343**

**BY ARC INFORMATICS LTD**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 9 AND 44:**



**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 60000465**

**BY SEFTON METROPOLITAN BOROUGH COUNCIL**

## **Background and pleadings**

1. On 7 June 2016, Arc Informatics Ltd (“the applicant”) applied to register the following trade mark:



The specification has been subject to amendment in the course of proceedings and now stands as follows:

Class 9      Monitoring units [electric];Monitoring apparatus, electric;Safety apparatus [for the prevention of accident or injury]; all the aforementioned being in relation to providing non-medical in-home personal monitoring and none being in relation to tracking by GPS.

Class 44      Monitoring of patients;Health-care;Healthcare;Health care;Health care services;Healthcare services;Health-care services.

2. The application was published for opposition purposes on 29 July 2016. It is opposed by Sefton Metropolitan Borough Council (“the opponent”) under the fast-track opposition procedure.

3. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods and services in the application. The opponent relies upon its UK trade mark registration number 3092808 for the trade mark **ArcAngel**, which was applied for on 24 February 2015 and for which the registration procedure was completed on 15 May 2015. The opponent relies upon all of the goods and services in its trade mark registration, namely:

Class 9      GPS tracker and alarm.

Class 38     Telecommunications.

Class 45     Security Services.

4. The applicant filed a counterstatement denying the grounds of opposition. I will return to the applicant's comments later in this decision.

5. Rules 20(1)-(3) of the Trade Marks Rules ("TMR") (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

6. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Both parties filed written submissions, which I have read carefully and will refer to, as necessary, below.

8. Both parties have been professionally represented throughout, the opponent by its Regulation and Compliance Corporate Legal Services department and the applicant by Birketts LLP.

9. Both sides seek an award of costs.

**Section 5(2)(b)**

10. The opposition is based upon section 5(2)(b) of the Act, which reads 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”.

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“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) References 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”.

12. In these proceedings, the opponent is relying upon the trade mark shown at paragraph 3, above, which qualifies as an earlier trade mark under the above provisions. As the opponent's earlier mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

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

## Comparison of goods and services

### *Restriction of the opposition*

14. The applicant asserts at paragraph 2 of its counterstatement that:

“The Application Mark and the Earlier Right only coincide in respect of one class, namely class 9, in respect of which the Opponent’s specification is limited. [...]

The remaining class under which the Applicant Mark is made is class 44 which is not similar to any of the classes of the Earlier Right”.

15. In its written submissions, the opponent states that “[t]he Opposition accepts paragraphs 1 to 4 of the Applicant’s Counterstatement”.<sup>1</sup>

16. The opponent has accepted that the applicant’s services in class 44 are not similar to the goods and services in any of the classes for which the earlier mark is registered. If there is no similarity between the goods and services, there can be no likelihood of confusion.<sup>2</sup> The opposition against class 44 is hereby dismissed.

### *Limitation of the applicant’s specification*

17. In *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), Arnold J. provided the following guidance on the criteria to be applied when assessing whether a limitation to a specification is valid (the *POSTKANTOOR* principle):

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<sup>1</sup> Paragraph 6.

<sup>2</sup> *Waterford Wedgwood plc v OHIM*, C-398/07P (CJEU)

“43. *The POSTKANTOOR principle.* In *POSTKANTOOR* the applicant applied to register the word *POSTKANTOOR* (Dutch for *POST OFFICE*) in respect of goods and services in Classes 16, 35–39, 41 and 42. The Benelux Trade Mark Office refused registration on the grounds that the sign was descriptive. On appeal, the *Gerechtshof te s’-Gravenhage* (District Court of The Hague) referred nine questions of interpretation of the Directive to the Court of Justice, of which the eighth was as follows:

“Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign ‘Postkantoor’ for the services of direct-mail campaigns and the issue of postage stamps, provided they are not connected with a post office’)?”

44. The Court of Justice answered this question as follows:

“113. ... when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.

114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.



115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties — particularly competitors — would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”

45. The guidance given by the Court of Justice must be seen in the context of the question to which it was addressed, namely whether it was acceptable to restrict the goods or services by reference to the absence of “a specific quality”. What the District Court of The Hague meant by this can be seen from the example it gave, viz. “the services of direct mail campaigns and the issue of postage stamps provided that they are not connected with a post office”. When the Court of Justice referred in its answer to “a particular characteristic”, it must have meant the same thing as the District Court meant by “a specific quality”.

46. The application of this guidance has caused some difficulty in subsequent cases. In *Croom’s Trade Mark Application [2005] R.P.C. 2* at [28]–[29] Geoffrey Hobbs QC sitting as the Appointed Person held that the *POSTKANTOOR* principle precluded the applicant from limiting a specification of goods in Classes 18 and 25 by adding the words “none being items of haute couture” or “not including items of haute couture”. He went on at [30] to refer to “characteristics that may be present or absent without changing the nature, function or purpose of the specified goods”. Mr Hobbs QC made the same distinction in *WISI Trade Mark [2007] E.T.M.R. 5; [2006] R.P.C. 22* at [16].

47. In *Oska's Ltd's Trade Mark Application [2005] R.P.C. 20* at [56] I observed *en passant* when sitting as the Appointed Person that I did not consider that it would be permissible to limit the specification by reference to the applicant's intended target market.

48. In *MERLIN Trade Mark (BL O/043/05) [1997] R.P.C. 871* at [27]–[28] I held when sitting as the Appointed Person held that the disclaimer “but not including the provision of venture capital” was acceptable, because it was not framed by reference to the absence of particular characteristics of the services, but rather it was a restriction on the scope of the services embraced by the specification. Accordingly, “the effect of [the disclaimer] is simply to excise a particular service from the specification. The mere fact that it is more convenient to express it in negative than positive terms does not make it objectionable.”

49. I also allowed a second disclaimer “and not including the provision of any such services to the pharmaceutical biotechnological [or] bioscientific sectors” for reasons which I expressed at [29] as follows:

“The position with regard to the second disclaimer is more debatable, but in my judgment the disclaimer does not relate to a characteristic of the services. I consider that there is a distinction between goods and services here. An article of clothing is an article of clothing regardless of whether it is of a particular style or quality and regardless of the identity and proclivities of the intended purchaser. By contrast, services can be defined in part by the recipient of the service. The opponent's registration is an example of this, since both the Class 35 and the Class 36 specification are limited to services provided to the pharmaceutical biotechnological and bioscientific sectors. In my view *POSTKANTOOR* does not make it impermissible to define

services in this way. That being so, I consider that it makes no difference if the definition is expressed negatively rather than positively.”

50. In *Patak (Spices) Ltd's Community Trade Mark Application (R746/2005-4) [2007] E.T.M.R. 3* at [28] the Fourth Board of Appeal at OHIM refused to allow a proposed limitation “*none of the aforesaid being dart games or darts*” to a class 28 specification as offending the *POSTKANTOOR* principle. I find this decision difficult to follow, since the exclusion related to categories of goods, rather than the characteristics of goods. It appears that the objection may have been down to the fact that the exclusion was negatively worded, but as I explained in *MERLIN [1997] R.P.C. 871* that is a matter of form, not substance, and so should not have been determinative”.

And

“56. Against this background, counsel for Swiss submitted that the limitation “intended for a scientific or industrial application in measuring, signalling, checking, displaying or recording heat or temperature (including such having provision to record heat or temperature over a period of time and/or to display the time of day)” contravened the *POSTKANTOOR* principle because it purported to restrict the specification of goods by reference to whether the goods possessed particular characteristics.

57. I do not accept that submission for the following reasons. First, if and insofar as the *POSTKANTOOR* principle depends on the limitation being expressed in negative terms, the limitation in the present case is expressed in positive terms. Secondly, and more importantly, I do not consider that the limitation refers to whether the goods possess particular characteristics in the sense in which the Court of Justice used that term in *POSTKANTOOR*. Rather, the limitation refers to the functions of the goods. To revert to the

analogy discussed above, it is comparable to a limitation of “clocks” to “clocks incorporating radios”. Accordingly, in my judgment it falls on the right side of the line drawn by Mr Hobbs QC in *Croom’s Trade Mark Application [2005] R.P.C. 2* and *WISI Trade Mark [2007] E.T.M.R. 5; [2006] R.P.C. 22*”.

18. The parties have made no submissions regarding the acceptability of the limitation applied to the applicant’s specification. The limitation consists of two parts, the first expressed in positive terms, the second negative. That is not, of itself, problematic. However, the first part of the limitation refers to “all the aforementioned being in relation to providing non-medical in-home personal monitoring”. I consider that this part of the limitation, which relates to the way in which the goods are used, seeks to exclude potential characteristics of the goods, rather than to exclude a category or sub-category.

19. The latter part of the limitation, which reads “none being in relation to tracking by GPS” and refers to all of the preceding goods, strikes me as relating to the function of the devices. As it excludes goods of a particular sub-category, this represents a valid limitation.

20. As a consequence of the opponent’s concession that there is no similarity between the services applied for in class 44 and the goods and services in the earlier mark, and my findings regarding the limitation of the applicant’s specification, the competing goods and services are as follows:

<b>Opponent’s goods and services</b>	<b>Applicant’s goods</b>
Class 9: GPS tracker and alarm.  Class 38: Telecommunications.  Class 45: Security Services.	Class 9: Monitoring units [electric]; Monitoring apparatus, electric; Safety apparatus [for the prevention of accident or injury]; none being in relation to tracking by GPS.

21. The applicant has made a number of submissions regarding the goods at issue, which focus on the differences between the actual goods offered by the parties, such as:

“There is no tracking function to the Applicant’s goods and as a result the uses of the respective goods are different, as will be the users of the goods. The consumer intending to use the Opponent’s goods will be looking for a device which enables tracking of the individual that is wearing the device and involves human interaction. The goods of the Opponent will appeal to those looking for a personal safety device”.<sup>3</sup>

22. Although the actual goods offered by the parties may differ, the comparison must be made on the basis of notional use of the mark across the full width of the specification, as explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) and endorsed by the Court of Appeal in *Roger Maier v ASOS* ([2015] EWCA Civ 220 at paragraphs 78 and 84).

23. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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<sup>3</sup> Written submissions, paragraph 7.2.1.

24. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- 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.

25. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

"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 fur 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".

26. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question".

27. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

28. The applicant's "monitoring units [electric]" and "monitoring apparatus [electric]" are very broad terms which would cover a wide range of goods, from units and apparatus to monitor, for example, temperature or energy consumption, to baby monitors. The terms at large would include the opponent's "GPS tracker". Although the limitation on the applicant's specification, which excludes goods which use GPS tracking, must be borne in mind, I consider that the goods remain highly similar. The intended purpose of the applicant's monitoring units and apparatus is to observe or record the movements or activity of someone or something: the same is true of the opponent's goods. The

physical nature of the goods and the users are likely to be identical, as are the methods of use. The channels of trade may coincide and there may be a competitive relationship.

29. "Safety apparatus [for the prevention of accident or injury]; none being in relation to tracking by GPS" is also a broad term, which would include safety alarms. The purpose of an alarm is to warn of danger and is a purpose shared by the goods at issue. The nature, method of use and users of the goods are all likely to be identical. The goods may be in competition and reach the market through the same channels of trade. That being the case, I consider that there is a high degree of similarity between these goods and the opponent's "GPS alarms".

30. The specification of the application is much wider than that of the earlier right and could, notionally speaking, cover goods which are not similar to the goods or services of the opponent's mark. As matters stand, no fall-back specification has been provided and I will proceed on the basis that the goods are highly similar, though I will return to this point when I address the likelihood of confusion.

31. Bearing in mind my findings, above, I do not intend to assess the level of similarity between the opponent's remaining services and the applicant's goods, as the opponent's position would not be improved were I to do so.

### **The average consumer and the nature of the purchasing act**

32. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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”.

33. The goods at issue are unlikely to be particularly expensive, though I accept that they will vary both in cost and in their technical specifications. The average consumer will comprise members of the general public but, given the width of the applicant’s specification, may also include professional business consumers. Although the level of attention will vary across the category, depending on factors such as the precise reasons for purchase or the particular goods, the member of the public is likely to pay an average degree of attention, no higher or lower than the norm, in selecting these goods. For the business user, who may be laying out considerable sums or for whom compatibility with existing infrastructure may be a concern, the level of attention is likely to be reasonably high.

34. The general public purchasing the goods at issue is most likely to do so by selecting the items from shelves in a retail shop or its online equivalent. The goods may also be purchased following inspection of catalogues or brochures. The specific retail premises will depend on the goods but may include DIY stores, builders’ merchants, shops on the high street or more specialist outlets, such as shops selling disability aids or outdoor equipment.

35. The methods of selection outlined above, i.e. self-selection from a shelf or following consideration of websites and printed publications, involve primarily visual considerations. I do not, however, discount that aural considerations may play a part, as the selection may be discussed with sales representatives or, for the business user, technical advisors.


## Comparison of trade marks

36. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, 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”.

37. 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 the marks.

38. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
ArcAngel	 The logo for ARC Angel features the letters 'ARC' in a blue, sans-serif font, followed by the word 'Angel' in a blue, cursive script. A stylized blue flame or wing graphic is positioned above the 'l' in 'Angel'.

39. In terms of the visual similarities between the marks, the opponent states that “the alleged differentiation between the two marks is unclear from the design of the Application Mark. There is only a very small gap between the 3 letters “ARC” and the word “Angel””.<sup>4</sup> It also states that:

“The Opposition asserts that the wing element of the design is devoid of any distinctive character and the immediately apparent similarity in the two marks lies in the fact that the same eight letters are used in the same order rather than any style difference between the two marks”.<sup>5</sup>

40. The opponent submits that the marks are aurally identical and states that “it is disputed that emphasis falls on the first part of the word “Arc” or the second part of the word “Angel” as alleged by the Applicant”.<sup>6</sup> The opponent submits that the marks at issue are both “a play on the word “Archangel” in order to promote their aims of a benevolent presence watching over those seeking to maintain independent living or otherwise in a vulnerable situation”.<sup>7</sup>

41. For its part, the applicant submits that:

“6.1.1 Visually the marks are different. The Application Mark is highly stylised featuring colours and a wing over the dominant part of the Application Mark. The Applicant is known as “Arc Informatics Limited”, the Application Mark takes the Applicant’s name and uses it in conjunction with “Angel”.

6.1.2 Aurally, the marks are also distinct. There is a clear gap between the letters at the beginning of the Application Mark meaning that the Application Mark is read as A R C Angel rather than a whole word “arcangel”.

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<sup>4</sup> Submissions, paragraph 9.

<sup>5</sup> *Idem*, paragraph 10.

<sup>6</sup> Paragraph 11.

<sup>7</sup> Paragraph 14.

6.1.3 Lastly, conceptually, these marks are also different, the Application Mark combines the use of the Applicant's name (A R C) with the word "Angel" and this combined use is a play on words due to the Applicant's name. The Opponent has no link to "arc" in any respect other than linking their product to being a guardian angel".

42. I also note the applicant's comments at paragraph 8.1 of its written submissions, where it argues that:

"[t]he distinctive and dominant components within the Application Mark are the elements of "Angel" and the stylised wing falling at the end of the Application Mark and attributing nothing to the front element ARC. There is no doubt that the Application Mark is comprised of two elements with the latter element being of greater dominance".

43. The earlier mark consists of the words "Arc" and "Angel", which are conjoined. Both words begin with a capital letter, while the remaining letters are in lower case. Notwithstanding the fact that the mark consists of two words, I consider that the distinctiveness of the mark rests in its totality, as the word "ArcAngel", with neither word dominating.

44. The applicant's mark has a number of different elements. The first is a stylised representation of the word "ARC", where the letter "A" is depicted with one upright in black, the other in a bold blue font and without a horizontal bar. The letter "R" is missing its vertical line and is in black, as is the letter "C". Despite the stylisation, I am satisfied that the average consumer will recognise the forms as the letters "ARC" in capitals. Alongside these letters is the word "Angel", shown with a capital "A" and the remaining letters in lower case. The word is presented in a sloping, cursive font. Above the word "Angel", in blue, is a stylised representation of a wing. The letters "TM" appear after the letters "ARC", in very small superscript. I consider that the words, neither of which dominates the other, play the greatest part in the overall impression. A lesser role is

played by the wing device, while the stylisation and use of colour have less importance. The letters “TM” are entirely non-distinctive and, if they are noticed at all, will be given no trade mark significance.

45. In terms of the visual similarities and differences between the marks, both share the same eight letters “ArcAngel”/“ARCAngel”, which I have found to be dominant in the overall impression of each mark. The wing device in the applicant’s mark is not present in the earlier mark. There are also presentational differences between the marks, including the stylised lettering in the applicant’s mark. Given the role of these aspects in the overall impression, however, such differences are not greatly significant, though I do not disregard them. The difference in the use of upper and lower case is unlikely to be noticed by the average consumer. As a consequence, I consider that the marks are visually similar to a medium degree.

46. I consider that the earlier mark will be articulated as the dictionary word “archangel”, notwithstanding the fact that it is not spelled correctly. As far as the application is concerned, the wing device will not be articulated, nor will the stylisation of the letters “ARC”. However, I do not think that there is only one way in which the applicant’s mark will be vocalised. The first is that the average consumer, although noticing the different fonts and the use of capital letters, will read the mark as the known word “archangel”. In this scenario, which I think more likely, the mark will be aurally identical to that of the opponent. The second possibility is that the average consumer would pronounce the first part as the single letters “A-R-C” and the second part as the word “angel”. In that case, there would be a clear difference at the beginning of the marks and identity only for the last five letters, resulting in the marks being similar only to a medium degree.

47. Conceptually, the meaning attributed to the opponent’s mark will be that of an archangel (i.e. a principal angel). For the average consumer who perceives the applicant’s mark as evoking the concept of an archangel, there will be conceptual identity. I think it unlikely that the average consumer will perceive the mark as the words “arc” and “angel” without making the conceptual link with the notion of “archangel”.

However, I acknowledge that there may be some average consumers who perceive “ARC” as individual letters with no particular concept, perhaps indicating a business name. For those average consumers, the conceptual similarity lies in the idea of an angel in each mark, albeit, in the opponent’s mark, of a particular type of angel. In that situation, I consider that there remains a medium degree of conceptual similarity.

### **Distinctive character of the earlier trade mark**

48. The distinctive character of a trade 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 determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. 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-2779, 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)".

49. The opponent has neither claimed nor filed any evidence to show that its mark has an enhanced level of distinctive character. Invented words usually have the highest degree of inherent distinctive character; words which are descriptive of the goods and services relied upon normally have the lowest. The earlier mark references the dictionary word "archangel" but with an unusual spelling. It is neither descriptive nor allusive to any significant extent of the opponent's goods. I consider that the earlier mark has an average degree of inherent distinctive character, no higher or lower than the norm.

### **Likelihood of confusion**

50. 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 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 bear 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, relying instead upon the imperfect picture of them he has retained in his mind.

51. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related. Indirect confusion was described in the following terms by Iain Purvis, Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).



(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example”).

52. I note that the categories identified by Mr Purvis are not exhaustive.<sup>8</sup> Even taking into account the effects of imperfect recollection, I am of the view that the visual differences between the marks will be remembered by the consumer, despite the goods being selected with only, at its lowest, an average degree of attention. In circumstances where the selection will be made through primarily visual means, I am satisfied that one mark will not be mistaken for another and that there is no likelihood of direct confusion. However, I take the view that, while the presentational differences between the marks will be identified, the identical—and dominant—verbal elements, when coupled with the average distinctiveness of the earlier mark and the high degree of similarity between the goods at issue, will cause the average consumer to assume that the goods are those of the same, or an economically related, undertaking. There is a likelihood of indirect confusion.

## **Conclusion**

53. The opposition has succeeded in respect of all of the goods applied for in class 9 but has failed in respect of class 44. The application will proceed to registration for the following services:

Class 44      Monitoring of patients; Health-care; Healthcare; Health care; Health care services; Healthcare services; Health-care services.

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<sup>8</sup> *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at [29]

54. I indicated at paragraph 30 that the specification applied for covers a wide range of goods, some of which are likely to be dissimilar to the goods and services covered by the earlier mark. Given that the application is to be refused in part, paragraph 3.2.2 of Tribunal Practice Notice ("TPN") 1/2011 applies. It states:

"In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account and the proposed wording being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer will indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services".

55. This practice reflects the comments of Mann J in *Giorgio Armani SpA v Sunrich Clothing Ltd* [2010] EWHC 2939 (Ch) in relation to partial refusals of registration. He stated that:

"[...] the proper scope of registration [...] is the [potential area of dispute]. In some cases it will not be a real area of dispute because the answer is obvious - it might be possible to isolate the permissible part by blue pencilling that which is not admissible, or it might be obvious that a plain express qualification ("save for [the goods in respect of which the opposition succeeded]") will do the trick, in which case there is no real area of dispute there either. On the other hand, it might be that the answer to that part of the case is more disputed - particular formulations might be objected to as falling on one side of the line or the other. Procedures ought to allow for all these possibilities".

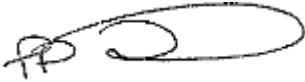
56. The Tribunal's letter of 2 November 2016 invited the applicant to file a fall-back specification. No fall-back position has been offered. There is nothing in the parties' submissions to suggest that the applicant's interest lies in goods which are materially different from the goods and services covered by the earlier mark. In such

circumstances, I do not consider it appropriate to provide the applicant with a further opportunity to consider the position.

**Costs**

57. Both parties having achieved a roughly equal measure of success, I direct that the parties bear their own costs.

**Dated this 24<sup>th</sup> day of January 2017**

A handwritten signature in black ink, appearing to be 'H. Harrison', written in a cursive style.

**Heather Harrison  
For the Registrar  
The Comptroller-General**