

O-617-17

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3174629
BY I GO 4 LIMITED
TO REGISTER THE SERIES OF THREE TRADE MARKS**



IN CLASSES 36 AND 38

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 407876 BY
BE WISER INSURANCE SERVICES LIMITED**





BACKGROUND



1) On 14 July 2016, i Go 4 Limited (hereinafter the applicant) applied to register the trade marks shown on the front page of this decision in respect of the following services:

- In Class 36: Insurance; Insurance brokerage; car insurance; insurance information; real estate insurance services; insurance consulting and advisory services.
- In Class 38: Telematics services.

2) The application was examined and accepted, and subsequently published for opposition purposes on 19 August 2016 in Trade Marks Journal No.2016/034.

3) On 14 November 2016 Be Wiser Insurance Services Limited (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:


Mark	Number	Dates of filing & registration
BE WISER INSURANCE Be Wiser Insurance A series of two marks	3009812	13.06.13 17.01.14
BE WISER Be Wiser A series of two marks	3068135	12.08.14 20.03.15
 Buy Wiser	2627958	12.07.12 12.10.12
 Insure Wiser	2627960	12.07.12 12.10.12
 Quote Wiser	2627961	12.07.12 12.10.12
 World Wiser	2629364	25.07.12 26.10.12

	2627963	12.07.12 26.10.12
	3068422	13.08.14 05.12.14

All the above marks rely upon the following identical specifications in Classes 35 and 36;

35	Advertising; business management; business administration; office functions; price analysis services; price comparison of the goods and services of other vendors, enabling customers to conveniently view and compare the goods and services of those vendors; advertising of the goods or services of other vendors, enabling customer to conveniently view and compare the goods and services of those vendors.
36	Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage, financial services; financial affairs; travel insurance brokerage; breakdown insurance and membership brokerage.

The opponent also relies upon the following mark and services:

	2627957	12.07.12 12.10.12	35	Advertising; business management; business administration; office functions; price analysis services; price comparison of the goods and services of other vendors, enabling customers to conveniently view and compare the goods and services of those vendors; advertising of the goods or services of other vendors, enabling customer to conveniently view and compare the goods and services of those vendors; compiling of information into computer databases; dissemination of data relating to business; provision of commercial business information by means of a computer database.
			36	Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage, financial services; financial affairs; travel insurance brokerage; breakdown insurance and membership brokerage.

a) The opponent contends:

i) that it has reputation and goodwill in the above marks;

ii) that its marks and the marks applied for are very similar as it claims that the distinctive element of its marks is the word WISER and the distinctive element of the marks in suit is the word WISE;

iii) that the services applied for are similar to the services for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Act.

4) On 11 January 2017 the applicant filed a counterstatement, basically denying all the grounds other than accepting that the “insurance services” in class 36 of the opponent’s marks are identical to the class 36 services for which registration is sought. It also points out that the opponent’s marks all post-date registration of its earlier trade mark UK 2612627 WISE DRIVING.

5) Both parties filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 23 November 2017 when Ms Cookson of Messrs Filemot Technology Law Limited represented the applicant; the opponent chose not to attend but instead provided written submissions which I shall refer to as and when necessary in my decision.

APPLICANT’S EVIDENCE

6) The applicant filed two witness statements. The first, dated 8 May 2017, is by Jess Brown Legal Counsel of the applicant company a position she has held since January 2014. She states that the mark in suit is only used upon telematics based insurance where a black box is fitted to the car and encourages safe driving by offering reductions in premiums based on evidence of safe driving. Although the specification is not restricted, the applicant would be willing to consider a limitation. The applicant has been trading under the term WISE DRIVING since 2012 and currently has 24,000 customers, approximately 5% of the telematics market.

7) The second witness statement, dated 10 May 2017, is by Barbara Cookson the applicant’s Trade Mark Attorney. She points out that the phrase “as wise as an owl” is commonplace traditional knowledge, reinforced by books and films such as Winnie the Pooh. She contends that although, as the opponent’s marks are registered, they must be regarded as valid, they are of minimal distinctive character, and that the average consumer is unlikely to pick out the word WISE from within BE WISER.

OPPONENT'S EVIDENCE IN REPLY

8) The opponent filed a witness statement, dated 11 July 2017, by Andrew John Dunkerley the Director of Marketing for the opponent. He states that since its inception in 1997, the opponent has used owl logos in conjunction with the words "Be Wiser Insurance", "Be Wiser" and, as he states, "more recently various other WISER marks". He states that the company has six offices (five in Andover) and 700 staff. He provides the following figures for turnover, number of policies and advertising/promotion:

Year end	Turnover £millions	Policies	Advertising and promotion £millions
May 2012	17.3	102,000	6.0
May 2013	21.5	142,000	7.6
May 2014	25.8	175,000	9.2
May 2015	28.2	201,000	9.3
May 2016	31.0	206,000	10.5

9) Mr Dunkerley states that his company acts for over thirty of the largest UK based insurance companies such as *Aviva, Axa, Royal and Sun Alliance* and *Zurich*. They offer motor vehicle and home insurance and have 210,000 clients. They sell their policies on-line and by telephone. He states: "All marketing material displays variations of the marks ensuring extensive use of the marks in relation to the products and services sold by the company". The opponent claims that it has promoted the company by:

- advertising in directories such as Yellow pages, Thomson directory and BT phone books;
- advertising on hoardings in motorway services, petrol stations, shopping centres, cinemas and alongside arterial roads;
- television adverts on ITV, Sky channel 4 and 5;
- newspaper advertisements in the *Daily Express, Daily Telegraph, Daily Mail, Daily Star, Sunday Times, Daily Mirror* and *Metro*;
- sponsoring sports events such as a team competing in the British Superbike series; motocross events; football, rugby, cricket and netball matches; golf events and race days.

10) He states that in July 2016 the opponent was classed as the 26th largest broker in the UK by the *Insurance Post* magazine. He estimates that the opponent accounts for 6% of the total UK personal lines broking market. He states that the company has sold over 800,000 policies in the last five years.

He provides a single exhibit AD1; this has 100 pages and encompasses an array of uses of Owl devices and the words “Be Wiser” but none of the pages appear to show actual use of the marks relied upon by the opponent. Every use shown includes a large device of an Owl, usually but not always, looking sideways at the reader and words such as “Be Wiser insurance” or, underneath a banner headline such as Van Insurance / Motorbike Insurance /Home Insurance, the words “Be wiser...save money” in small print. Some uses have two owl devices usually an owl sideways on, looking at the reader over its shoulder, and another fully facing the reader. All the devices are realistic looking owls. The only instances of use of the word “Wiser” solus is on pages 5 and 13. The first is undated, the second dated 5 December 2016 (after the relevant date) and relates to final artwork. Both show two large owl devices and the words “Be Wiser” but begin with the headline “Wiser Commercial Insurance for your Business”. The following demonstrates the marks shown in the exhibit:

Page 10: April 2016



Page 11: April 2016

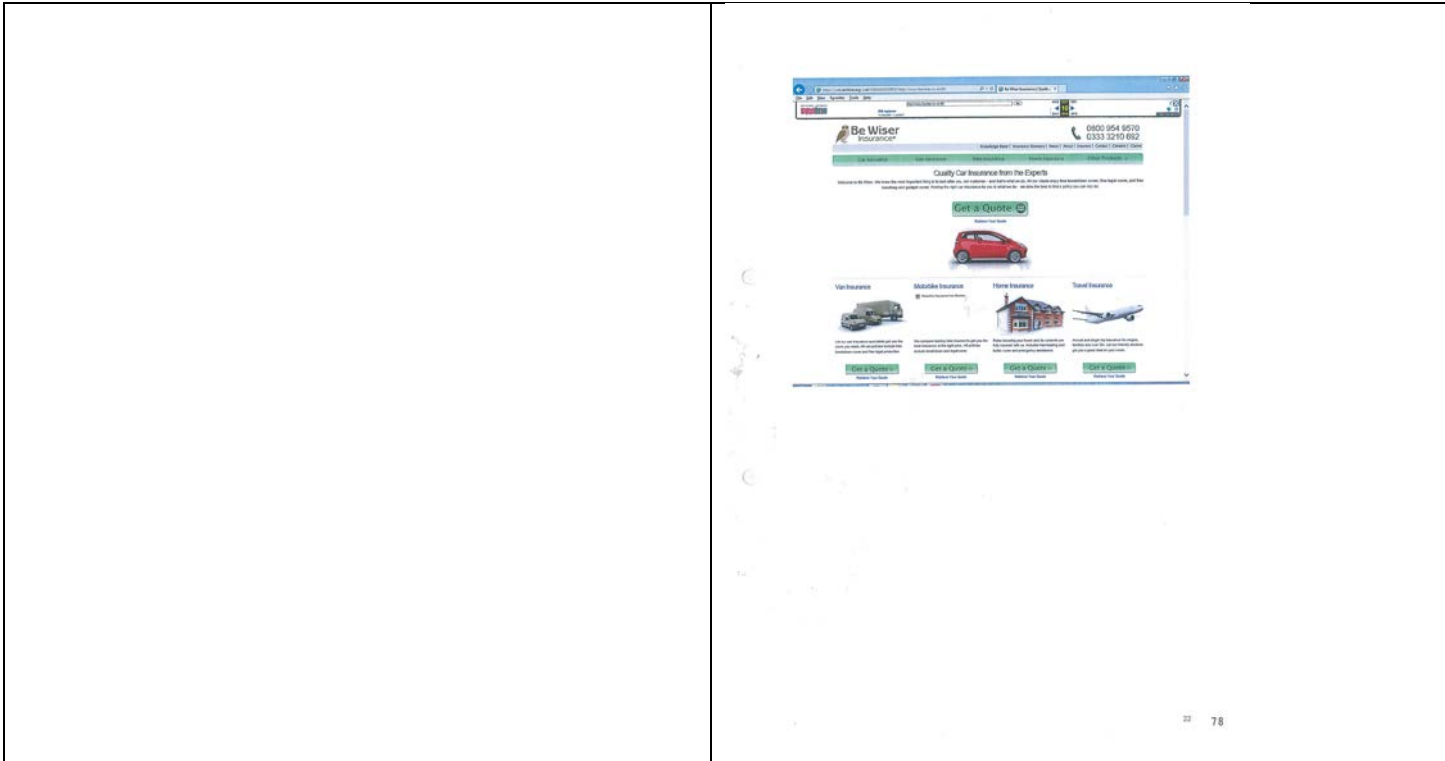


Page 15: 2015



Page 17: 2015





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

DECISION

12) The only ground of opposition is 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.”

13) 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.”

14) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. Given the interplay between the dates that the opponent’s marks were registered (12 October 2012 -20 March 2015) and the date that the applicant’s mark was published (19 August 2016), the proof of use requirements do not bite.

15) 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

16) 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.”

17) I must consider the relevant class 36 services of both parties, which broadly speaking are insurance services. Such services are going to be purchased by the general public including businesses. Such consumers are likely, in my opinion, to select the services mainly by visual means, initially from an on-line search or advertisement. Once selected, even if the transaction is carried out on-line the average consumer is going to take considerable care in the selection as personal details will have to be provided and the service is going to be relied upon by the consumer to be robust and legitimate as the consequences of dealing with a less than scrupulous operator could be severe. Whilst the visual issues are likely to be the most important I also must take into account aural issues as it is possible that word of mouth recommendations may play a part in the selection. For the reasons I have stated, the nature of the services are such that the average consumer will pay a **medium to high degree of attention to the selection of such services.**

Comparison of services

18) In the judgment of the Court of Justice of the European Union (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”.

19) 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.

20) I note that in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

21) 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.”

22) 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 (GC) 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”.

23) In *Sanco SA v OHIM*, Case T-249/11, the GC 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.

24) The opponent is relying upon a number of marks which all have exactly the same specification in Class 36. The relevant terms in the opponent’s services are shown below:

Applicant’s services	Opponent’s services
In Class 36: Insurance; Insurance brokerage; car insurance; insurance information; real estate insurance services; insurance consulting and advisory services.	In Class 36: Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage,
In Class 38: Telematics services.	

25) The opponent’s services clearly encompass the applicant’s class 36 services, and indeed they share many identical words. On the *Meric* principle, these services are identical. Moving on to

consider the applicant's class 38 services, telematics is an interdisciplinary field that encompasses telecommunications, vehicular technologies, road transportation, road safety, electrical engineering (sensors, instrumentation, wireless communications, etc.), and computer science (multimedia, Internet, etc.). In the instant case it has been explained that "telematics services" relate to the provision of a black box which is fitted to a car and relays information regarding speed etc. thus enabling the insurance provider to have evidence of the drivers' actual performance and hence adjust the insurance premium. For young drivers in particular it is a method which enables them to get affordable insurance albeit at the cost of some privacy. Whilst such services can be linked to the provision of car insurance they are not essential to its provision, whilst such technology plays no part in the provision of other forms of insurance, such as household insurance. **In summary, the class 36 services of both parties are identical, the applicant class 38 services are not similar to the opponent's class 36 services.**

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 opponent does not put forward any of its marks as providing it with its strongest case. Instead it treats them as though they are all equal. It contends that the dominant element of the applicant's mark is the word "WISE" as the word is highlighted in a bold coloured font "making it the most noticeable and memorable element of the mark". The opponent states that the dominant element of all its marks is

the word “WISER”, and that the “WISER concept is further highlighted by the opponent’s use of a wise owl logo”. They also contend that:

“the average consumer, having an imperfect recollection of the marks would not recall the minor elements of the marks i.e. the insignificant additional words BE, INSURE, DRIVE etc. In the alternative, if he/she did recall the distinction, he/she would assume the marks must emanate from the same source due to the high degree of similarity of the dominant elements of the marks. The opponent further submits that the enhanced distinctiveness it enjoys in its marks adds to this degree of similarity.”

28) The applicant applied for a series of three marks. I have chosen the mark without a coloured background as I believe this is the opponent’s strongest case. I have also chosen to compare this with the opponent’s word only mark 3068135 as again this provides the opponent with its strongest case. I come to this conclusion as the only other word only mark 3009812 has the descriptive word “insurance” included. Whilst this would be seen as descriptive it also creates a visual and aural difference which is not present in the mark I have selected. All the other marks relied upon by the opponent have a large logo which again provides a visual and potentially conceptual difference which is absent from the opponent’s mark I have chosen for the comparison. The two marks to be considered are as follows:

Opponents’ trade mark	Applicant’s trade mark
BE WISER Be Wiser	



29) Clearly, the opponent’s mark consists of a series of two marks one which is in all upper case the other which features upper and lower case. The average consumer will pay no attention to this difference. Visually there are obvious differences in that the opponent’s mark has the word “Be” as its first element and a letter “r” at the end of the word “wise” changing it to “wiser”. The applicant’s mark technically does not have the word “wise” in it. It has the letters “W” and “se” with a device element of road markings between which leads the average consumer to “see” the letter “i” and hence form the word “wise”. The road marking device element is reinforced by the word “driving”. The mark in suit is likely to be pronounced as “wise driving” so there are aural similarities and differences. To my mind the words “Be Wiser” will be seen as an instruction, an exhortation or advice to the consumer that smarter consumers will chose the opponent’s services. The two words effectively form a unit. Similarly

the whole of the applicant’s mark forms a unit with the device element helping the consumer to form the word “wise” and reinforcing the driving element. It is accepted practice that the beginnings of word tend to have more visual and aural impact than the ends (*El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02). I also note that in *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

30) Whilst I accept that conceptual differences do not always overcome (*Nokia Oyj v OHIM*, Case T-460/07) in the instant case there are very obvious visual, aural and conceptual differences and few similarities. **Overall the marks have a low degree of similarity.**

31) In case the opponent believes that I am wrong in my selection of marks to compare I will also consider its mark 2627963 which appears to me to provide its next best case.

Opponents’ trade mark	Applicant’s trade mark
	

32) I do not accept the opponent’s contention that the dominant element of its mark is the word “wise”. To my mind, the owl logo, positioned at the start of the mark and being much larger than the words is an independent and distinctive element. It could be said to reinforce the message of the company being the smarter choice as owls are generally credited as being wise. However, the visual, aural and conceptual differences far outweigh any minor visual and aural similarity, on the same lines as set out previously in this decision. **Overall the marks have a low degree of similarity.**

33) The opponent contended that it has a “family of WISER marks”. I do not accept this contention and the evidence does not support this simplistic view of its marks. I would suggest that it has a family of realistic owl device marks, which also have various exhortations which include the word WISER.

Distinctive character of the earlier trade mark

34) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

35) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out".

36) The opponent's marks, for the most part, have a large distinctive and independent owl logo coupled with an instruction such as "Buy wiser", "insure wiser", "quote wiser" and "be wiser". All imply that the smarter consumer will use the services of the opponent. Unless educated otherwise, I consider it entirely possible that some consumers may assume that the company is called "owl insurance" and that they too can be as wise as an owl if they purchase the services of the opponent. The opponent's marks are **inherently distinctive to a medium degree. The opponent has not shown use of its marks in the form that they are registered. As none of the marks relied upon has the owl logo and the words "be wiser" (apart from 3068422) the two marks I have chosen as providing the opponent's strongest case cannot benefit from enhanced distinctiveness through use.**

Likelihood of confusion

37) 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 goods and 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 goods and 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 for the services is the general public including businesses who will select the services by predominantly visual means, although not discounting aural considerations and that the degree of care and attention they pay will vary depending upon the cost of said services. They are, however, likely to pay a medium to high degree of attention to the selection of such services.

- the opponent's marks have a low degree of similarity to the marks of the applicant.
- the opponent's marks have medium degree of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the class 36 services of the applicant are identical to the opponent's services in the same class. The applicant's services in class 38 are not similar to the opponent's services in class 36.

38) In view of the above, and allowing for the concept of imperfect recollection, even when used on identical services in class 36, there is no likelihood of consumers being confused into believing that the services 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 fails.**

39) As a fall-back position the opponent contended that if I did not agree with their contention that there was a likelihood of confusion then there was a likelihood of association between the mark "because the distinctive elements of the marks are highly similar" and the services are identical and/or similar. In determining this question I look to the comments of Mr Iain Purvis Q.C. as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, where he noted that:

"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).”

40) To my mind the differences between the marks is such that the average consumer would not associate the marks of the applicant with those of the opponent. **There is no likelihood of association.**

CONCLUSION

41) The opposition in relation to all the services applied for has failed under section 5(2)(b).

COSTS

42) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£300
Preparing evidence / considering and commenting upon the applicant’s evidence	£1000
Attendance at the hearing	£600
TOTAL	£1,900

43) I order Be Wiser Insurance Services Limited to pay I Go 4 Limited the sum of £1,900. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of December 2017

**George W Salthouse
For the Registrar,
the Comptroller-General**