

O-541-19

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3359077
BY LUCIA PASCALI:

F.A.B. Method

AND

THE OPPOSITION THERETO UNDER NO 600001094
BY JON FINN

Background and pleadings

1. On 6 December 2018, Lucia Pascali (the applicant) applied to register the above trade mark in class 41.¹

Class 41

Training and education services; Coaching services; Coaching [training].

2. The application was published on 8 February 2019, following which it was opposed under the fast track opposition procedure by Jon Finn (the opponent).

3. The opponent bases his case on section 5(2)(b) of the Trade Marks Act 1994 (the Act). He relies upon the following earlier UK Trade Mark (UKTM):

Mark details and relevant dates	Services relied upon
UKTM: 3237966 F.A.B. Filed: 16 June 2017 Registered: 17 November 2017	Class 41 Sport, business, education and personal development training programmes.

4. The opponent's mark is an earlier mark which is not subject to proof of use. This is because, at the date of publication of the application, it had not been registered for five years.²

5. The applicant filed a counterstatement in which she denied the ground raised by the opponent.

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013/2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that rule 20(4) shall continue to apply. Rule 20(4) states that:

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

7. The effect is to require the parties to seek leave in order to file evidence in fast track oppositions. Neither side made such a request.

8. 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.

9. Neither party requested to be heard nor filed submissions in lieu of a hearing. I make this decision based on careful consideration of the papers before me.

10. Neither party is represented.

Preliminary issues

11. In her TM8, the applicant draws my attention to the fact that there are ‘many existing trade marks’ in class 41 which include FAB. The applicant has not provided any examples of these marks.

12. Even where examples are provided, such evidence is often unhelpful, for the reasons provided in *Zero Industry Srl v OHIM*³ in which the General Court stated:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found,

³ Case T-400/06.

in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

13. The applicant has not given any indication of how the presence of other trade marks which include a FAB element can assist her case nor has she provided any details of those marks which indicate whether or not they are in force, how they are used, nor to which particular services they relate. I will say no more about this submission.

Decision

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

“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,

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

15. 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.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent

distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

16. The goods to be compared are as follows:

The opponent's services:	The applicant's services:
Class 41 Sport, business, education and personal development training programmes.	Class 41 Training and education services; Coaching services; Coaching [training].

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁴ the General Court ("GC") stated that:

⁴ Case T- 133/05

“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”.

18. The terms in the applicant’s specification are included within the broader terms, ‘education and personal development training programmes’ in the opponent’s specification. As such, these are identical services.

The average consumer and the nature of the purchasing act

19. In accordance with the case law, cited at paragraph 15, above, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade.

20. 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*⁵, 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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

21. The average consumer for all of the services is a member of the general public, a professional or a business. The respective services are made available through a

⁵ [2014] EWHC 439 (Ch)

variety of trade channels including inter alia, through a website, via brochures or by attending trade shows. The purchase is primarily a visual one, though I do not rule out an aural element where word of mouth recommendation or consultation prior to purchase plays a part.

22. The level of attention paid to the purchase will vary depending on the nature of the services. These services would include brief online training modules as well as detailed one to one coaching over a longer period of time. A business purchasing training for its staff is likely to pay a higher level of attention than an individual accessing a short online course via a training app. In any event the level of attention paid will be that necessary to achieve, inter alia, the correct type of training, coaching or education service at the required level. Accordingly, the average consumer will pay at least a reasonable level of attention to the purchase of the services.

Comparison of marks

23. The marks to be compared are as follows:

Opponent	Applicant
F.A.B.	F.A.B. Method

24. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁶, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

⁶ Sabel v Puma AG, para.23

25. The applicant's mark is the letters, F A B, each followed by a dot. It is followed by the word 'Method'. It is presented in plain black type with no additional stylisation. The overall impression of the applicant's mark rests in the mark as a whole.

26. The opponent's mark is the letters, F A B, each followed by a dot. It is presented in upper case and in plain black type with no additional stylisation. The overall impression of the opponent's mark rests in the mark as a whole.

Visual similarity

27. Visual similarity rests in the fact that both marks include the letters F.A.B. presented in the same way, which is the totality of the opponent's earlier mark and the first part of the application. The visual difference rests in the addition of the word 'Method' in the application. I find these marks to be visually similar to a medium degree.

Aural similarity

28. With regard to aural similarity, the average consumer will pronounce the F.A.B. element in both marks as the individual letters since the inclusion of the dots causes the letters to be separated and sounded individually. Some average consumers may pronounce this part of the respective marks as the word 'Fab' but where they do elect that pronunciation, it would be the same for both marks. The aural difference can be found in the addition of the word 'Method' in the application, a word which is common in the English language, and will be known to the average consumer. I find these marks to be aurally similar to a medium degree.

Conceptual similarity

29. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁷ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.⁸

30. Both marks include 'F.A.B.' which is likely to be seen as an acronym. Without further education as to what those letters may stand for, the average consumer is unlikely to give this element any further meaning. There is a possibility, though I find it less likely, that the average consumer will see F.A.B. as referring to the word 'Fab' meaning wonderful or excellent. The parties have not provided any submissions with regard to the average consumer's understanding of their respective marks, but whatever meaning the consumer gives to 'F.A.B.', it will be the same for both marks. The application includes the additional word 'Method' after 'F.A.B.'. In the context of the services which are training and coaching services, the mark as a whole is likely to be seen as a training method. Taking these factors into account, I find these marks to be conceptually similar to a medium degree.

Distinctive character of the earlier marks

31. 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 goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.⁹

32. No evidence has been filed in this case, so I have only the inherent distinctiveness of the earlier mark to consider. 'F.A.B.' is an acronym which does not allude to nor

⁷ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

⁸ See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee*, *BL O/048/08*, paragraphs 36 and 37.

⁹ Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

describe the services or any characteristics of them and I find the earlier mark to be a trade mark of average distinctive character.

Likelihood of confusion

33. In assessing the likelihood of confusion for the remaining goods where I have found similarity, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.¹⁰ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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 vice versa.

34. I have found the following:

- The services are identical.
- The average consumer is a member of the general public, professional or business. The level of attention paid to the purchase will be at least average and the purchase will be primarily a visual one.
- The respective marks possess a medium degree of visual, aural and conceptual similarity.
- The earlier mark has an average degree of inherent distinctive character.

35. The types of confusion were explained in *L.A. Sugar Limited v By Back Beat Inc*,¹¹ by Mr Iain Purvis Q.C., sitting as the Appointed Person:

“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

¹⁰ Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V paragraph 27

¹¹ BL O/375/10

confusion, on the other hand, only arises where the consumer has actually recognised 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.”

36. Furthermore, in *Duebros Limited v Heirler Cenovis GmbH*,¹² Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association, not indirect confusion.

37. With regard to the ‘common element’, I bear in mind *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which 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

¹² BL O/547/17

alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

38. 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.

39. In terms of direct confusion, the visual differences between the marks are sufficient to avoid the consumer thinking that one mark is the other mark. With regard to indirect confusion, I remind myself of the question asked by Mr Purvis above, ‘what is it about the earlier mark that gives it its distinctive character?’. In this case, it is the ‘F.A.B.’ element which is the entirety of the earlier mark. It is duplicated at the beginning of the application. These marks are both used in respect of training, coaching and education services which, in my view, leads to a conclusion that a consumer familiar with F.A.B. training services would, when encountering the applicant’s mark, simply see it as being training services using the F.A.B. Method. In other words, another mark from the F.A.B. stable. There is a likelihood of indirect confusion between these marks.

CONCLUSION

40. The opposition succeeds prima facie, under section 5(2)(b) of the Act.

COSTS

41. The opponent has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the opponent is unrepresented, at the conclusion of the evidence rounds the Tribunal invited him, in the official letter dated 8 July 2019, to indicate whether he wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of its actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition; it was made clear to the opponent that if the pro-forma was not completed then no costs will be awarded. The opponent did not respond

to that invitation. Consequently, I make no order as to costs, other than the official fee of £100 for filing the opposition.

42. I order Lucia Pascali to pay Jon Finn the sum of £100. These costs should be paid within 21 days of the date of this decision or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 13th day of September 2019

Al Skilton

For the Registrar,

The Comptroller-General