

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2256868
BY PATRICIA OGUNFEIBO
TO REGISTER A TRADE MARK IN CLASS 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 52551
BY LAWGIC BEHEER B.V.**

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**IN THE MATTER OF Opposition thereto
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BACKGROUND

1. On 27 December 2000 Patricia Ogunfeibo applied to register the following series of three trade marks in Class 42 for a specification of: "Legal advice, legal consultancy, legal services, legal advice online, legal consultancy online, legal services online; legal advice, consultancy and services for businesses; legal advice, consultancy and services for individuals; online legal advice, consultancy, and services for businesses; online legal advice, consultancy, and services for individuals; legal information offered on a subject basis in return for a subscription or otherwise, online legal information offered on a subject basis in return for a subscription or otherwise" -

LawGym
LAWGYM
lawgym

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. In May 2000 Kings Patent Agency on behalf of Lawgic Beheer N.V. filed a Notice of Opposition against the application under Section 5(2)(b) of the Act because the trade mark applied for is confusingly similar to the following UK registered trade mark owned by the opponent and registered for the same and similar services and there is therefore a likelihood of confusion on the part of the public:-

NUMBER	MARK	REGISTRATION EFFECTIVE	CLASS	SPECIFICATION
2141311	LAWGIC	1 August 1997	9	Telecommunications equipment and apparatus, including control apparatus; mobile communications apparatus and equipment (digital and non-digital); telecommunications network systems and apparatus, computer hardware, firmware and software; media carrying computer programmes and data; CD-ROM and optical data storage apparatus and media; electronically programmable and readable cards including SIM cards (subscriber identity module) and SMART cards; computer software and data relating to conditions, rules, law, policy and regulations.
			41	Electronic and non-electronic publishing services; education and training courses relating to new information technology, retrieval techniques and processing techniques; legal educational and training services relating to methods of making rules, laws and regulations and the subsequent implications.

			42	<p>Consultancy services related to legislation and regulations as well as their implications; research and consultancy services related to legal and technical aspects; arbitration and dispute settlement services; company formation services; acquisition, management and exploitation of intellectual and industrial property rights; research, development and design related to telecommunications, digital and or electronic data-exchange and/or mobile communications, as well as value-added services, particularly with respect to the Internet, and information services related thereto; professional consultancy in the area of electronic highway communication eg the Internet; computer programming particularly for the purpose of electronic data processing; production, management and exploitation of digital and/or electronic data sets and legal information on the Internet; design, execution and exploitation of web-sites; access control to electronic data.</p>
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3. The applicant filed a Counterstatement denying the grounds of opposition. Both sides filed evidence and asked for an award of costs in their favour. Neither party requested a hearing.

Opponents Evidence

4. This consists of a witness statement by James Bertram King dated 17 September 2001. Mr King is a director of Kings Patent Agency Limited, the trade mark agents acting on behalf of the opponents.

5. Mr King draws attention to Exhibit 1 to his statement which comprises a four page listing of live trade marks in Class 42 beginning with the prefix LAW. He then goes on to refer to Exhibit 2 to his declaration which is a list showing the only two trade marks having the prefix LAWG, the one mark being the mark applied for and the other the opponent's registration.

6. Next, Mr King states that both marks include the combination LAWGI and LAWGY, both being pronounced with a soft G in a similar manner to the letter J. He adds that both marks are word only marks and that the applicant's and opponent's services are essentially similar particularly as regards on-line services and services offered through the Internet.

Applicant's Evidence

7. This consists of a witness statement by Patricia Ogunfeibo, the applicant, which is dated 25 September 2001. Ms Ogunfeibo is a qualified solicitor.

8. Ms Ogunfeibo explains the background to her search for a suitable name by which she would provide legal services over the Internet. She explains that, while she was working out in the gym in November 2000, it struck her that there was an analogy between people going to the gym to keep fit, and people and businesses seeking pro-active advice in order to keep ahead of their peers. As she wished her business to be thought of in that context, Ms Ogunfeibo considered LAWGYM to be the perfect name.

9. Ms Ogunfeibo submits that there are clear aural, visual and conceptual differences between the marks. She states that the final consonants in both marks are dominant, that the marks applied for would be perceived as two words and the opponent's registration one word and that the mental picture conveyed by the marks is different.

10. The bulk of Ms Ogunfeibo's further submissions relate to events after 27 December 2000 (the date of application for the marks in suit) and therefore fall outside the relevant date for these proceedings.

11. I now turn to the decision.

DECISION

12. The ground of opposition is under Section 5(2)(b) of the Act which reads as follows:-

"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 right is defined in Section 6, the relevant parts of which state:-

6.-(1)

(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. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;

- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

15. In the present opposition I have no evidence relating to the use of the marks in suit or the opponents' registration prior to the relevant date. I must therefore compare the series of marks applied for and the opponent's mark assuming normal and fair use of these marks.

16. The services specified within the application in suit and the opponents' Class 42 specification both include (inter-alia) legal consultancy, legal advice and the provision of legal information on-line/on the Internet. I have no doubt that the respective specifications cover the same and similar services.

17. In essence the test under Section 5(2)(b) is whether there are similarities in marks and services which would combine to create a likelihood of confusion. In my considerations of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of services in question and how they are marketed.

18. The opponent's registration comprises the invented word LAWGIC which could, but not necessarily would, be seen as an indirect allusion to the word "logic". The application comprises a series of three trade marks ie. LawGym; LAWGYM; and lawgym. The first mark in the series consists of two well known dictionary words which, in my view, in their totality have no reference to the services applied for; whereas the second and third marks both comprise one word as the separate elements (the words LAW and GYM) are conjoined, the difference between these marks being that the second mark is presented in upper case and the third mark in lower case. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind in my considerations.

19. In my comparisons of the marks, while I do not lose sight of the fact that the application is for a series of three marks, it seems to me that the opponent's strongest case lies in a comparison of their registration with the second and third marks in the series ie. LAWGYM presented as one word, as the presentation of the mark as two words ie. LawGym, goes to accentuate visual and possibly conceptual differences. For practical intents and purposes I shall limit my comparisons to the marks LAWGIC and LAYGYM.

20. Mr King, in his evidence, states that the marks LAWGIC and LAWGYM are the only two registered trade marks commencing with the prefix LAWG. I do not find evidence as to the state of the register to be of any great assistance as it does not demonstrate the position in the market place but, in any event, it seems extremely unlikely to me that the purchasing public would perceive either trade mark as possessing the prefix LAWG. In my view the relevant

public are likely to consider the marks in totality but may perceive the distinctive and dominant components of the opponent's mark to be "LAW" and "GIC" and the applicants mark to be "LAW" and "GYM".

21. While both marks start with the prefix LAW, this element is highly descriptive in relation to the relevant services. Furthermore, similarity must be considered in relation to overall impression and it seems to me notwithstanding that the marks share the same fourth letter, in their totality the marks are visually distinct and would be distinguished visually in use.

22. Turning to oral use I believe the opponent's case to be of similar weight. Both marks share the same beginnings, and I bear in mind that it is widely accepted in relation to the spoken use of trade marks that customers have a propensity to slur the endings of words. However, in my view this is of limited significance in the present comparison as both marks commence with a highly descriptive element the terminations of the respective marks sound very different. In my view the marks in their totality are likely to be distinguished aurally.

23. Next, I go to a conceptual comparison of the marks. Both marks consist essentially of invented words but as they both commence with the prefix LAW it may well be that the relevant public would perceive an allusion to legal services. However, I do not believe that, in their totality, the marks share a conceptual similarity.

24. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must consider who the average customer is and make appropriate allowance for imperfect recollection. While I have no evidence before me on the point it seems to me that the customer for legal services would be relatively careful and this is not a casual "bag of sweets" case.

25. On a global appreciation, allowing for an appropriate level of defective recollection, I do not believe the average customer is likely to confuse the applicant's and opponent's trade marks. I conclude that the opposition fails.

26. The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay them the sum of £450. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18 day of April 2002

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General

