O-243-03

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO. 2265949
IN THE NAME OF
CHESTERTON INTERNATIONAL PLC

AND

IN THE MATTER OF
OPPOSITION NO 90964
THERETO BY
DKV DEUTSCHE KRANKENVERSICHERUNG AG

IN THE MATTER OF
APPLICATION NO. 2265949
IN THE NAME OF
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OPPOSITION NO. 90964 THERETO
BY DKV DEUTSCHE
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BACKGROUND

1. On 30 March 2001 Chesterton International Plc filed an application under No. 2265949 to register the trade mark CareMANAGER in classes 9, 35, 36, 37 and 42.

2. On 15 August 2002 notice of opposition to the application was filed by DKV Deutsche Krankenversicherung AG. The opponents say they are the proprietor of Community Trade Mark No. 294041 for the word CareManager protected for the following services in Class 36:

"Insurance; financial affairs"

3. The grounds of opposition are, in the alternative, under Section 5(1), Section 5(2)(a) and Section 5(2)(b) of the Trade Marks Act 1994. The opposition is directed at all the goods and services of the application.

4. The applicants filed a counterstatement acknowledging the existence of the opponents' mark. They admit that their mark is "practically identical" to the opponents' mark, however, they deny that the goods and services covered by their application are identical or similar to those covered by the opponents' registration and therefore deny that there would be a risk of confusion including a likelihood of association.

5. The application was published with the following goods and services:

Class 9:
Computers; computer programmes; computer software products all relating to buildings, real estate and commercial and domestic property, including facilities management, general management, investment, maintenance, repair, renovation, development, leasing, rental and letting of buildings, real estate and commercial and domestic property; data processing apparatus and instruments; parts and fittings for all the aforesaid products in class 9; computer software products to allow the logging, management and delivery of requests from occupants and site managers within a building; computer software products to allow buildings occupants to book conference rooms and facilities, hot desks,

catering, assets and car parking; call logging apparatus and instruments, call monitoring and call information apparatus and instruments; but none relating to residential care or day care, or care in the home or in or by the community.

Class 35:
Business management and administration of buildings, real estate and commercial and domestic property; business project management, advertising and promotion services; consultancy, information and advisory services relating to the aforesaid services; but none relating to residential care or day care, or care in the home or in or by the community.

Class 36
Property portfolio management; financial administration, acquisition, investment, rental, leasing and letting of buildings, real estate, commercial and domestic property; real estate agency services; administration of real estate; management services relating to residential and commercial real estate, but none relating to residential care or day care, or care in the home or in or by the community.

Class 37:
Construction, maintenance, repair, cleaning, renovation, restoration, demolition, upgrading and enhancement of buildings; building and repair services and information; plastering, roofing, painting, decorating, glazing, joinery, dry lining, insulation, sealing, plumbing and electrical services relating to buildings; consultancy, information and advisory services relating to the aforesaid services; but none relating to residential care or day care, or care in the home or in or by the community.

Class 42:
Architectural and building design services; surveying services, preparation of reports relating to commercial and residential real estate; planning and design of real estate development; inspection of buildings, landscaping, gardening, and interior design services; housekeeping; consultancy, information and advisory services relating to the aforesaid services, including such services provided on-line from a computer database or via the Internet; counselling, information and advisory services relating to computers, computer software and computer systems but none relating to residential care or day care, or care in the home or in or by the community.

6. The applicants did, however, offer to amend the specification to remove some goods and services in classes 9 and 36 and subsequently filed a Form TM21. The amendment was accepted and the specification of goods and services in these classes now read:

Class 9:
Computer programmes and computer software products all relating to buildings, real estate and commercial and domestic property, including facilities management, general management, maintenance, repair, renovation, leasing and

letting of buildings, real estate and commercial and domestic property; data processing apparatus and instruments; computer software products to allow the logging, management and delivery of requests from occupants and site managers within a building; computer software products to allow building occupants to book conference rooms and facilities; hot desks, catering and car parking; call logging apparatus and instruments and call monitoring and call information apparatus and instruments; but none relating to residential care or day care, or care in the home or in or by the community.

Class 36:
Property portfolio management.

The specification of services in classes 35, 27 and 42 remain as originally advertised.

7. The opponents chose not to file evidence but requested that the opposition continue. As the grounds of opposition are based solely on another trade mark registration, the Registrar supports this course of action, subject to the opponents' confirmation of their intention to file submissions at the appropriate time and to proceed to a substantive decision. This confirmation was received, the opposition continued and the applicants were therefore invited to file their evidence. The applicants did so and the opponents did not file evidence in reply.

8. Following the completion of the evidence rounds, the parties submitted that they were content for a decision to be made from the papers and without recourse to an oral hearing. This course of action was agreed and the parties were invited to file their written submissions in lieu of attendance at a hearing. Only the opponents filed submissions. Both sides ask for an award of costs.

9. After a careful review of all the papers before me, I now give this decision.

Applicants' evidence

10. This consists of a witness statement of Charles Henry Edward Jennings dated 4 February 2003. Mr Jennings is the registered Trade Mark Attorney responsible for prosecuting the registration on behalf of the applicants. The witness statement is not evidence in the true sense of the word but contains submissions which I will refer to as necessary in this decision.

DECISION

11. The relevant statutory provisions read:

> **"5.** –(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because-

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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."

The term "earlier trade mark" is defined in Section 6 of the Act as follows:

"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 is question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,"

12. It is not disputed that the opponents' trade mark is an earlier mark within the meaning of Section 6 of the Act.

13. In reaching my decision I take into account the guidance given by the European Court of Justice in the cases of *Sabel BV v Puma AG* [1998] RPC 199, *Canon v MGM* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co. v Klijsen Handel BV* [2000] FSR 77. It is apparent from these cases that the likelihood of confusion must be appreciated globally, taking account of all the relevant factors. Confusion for this purpose, includes association of the type that leads consumers to wrongly assume that the respective marks are used by the same undertaking or by undertakings with an economic connection.

14. In this connection, it has been noted that a lesser degree of similarity between the respective goods and services may be offset by a greater degree of similarity between the respective marks, but the goods and services must share similarities in order to fall within the scope of section 5(2).

15. Furthermore, 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.

The Marks

16. I first consider whether the opponents' mark is identical to that of the applicants. The issue was considered by the European Court of Justice in the case of *SA Societe LTK Diffusion v SA SADAS* Case C-291/100 where it said:

> " a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

17. For ease of reference, I set out below both the applicants' and the opponents' trade marks.

Applicants' Mark	Opponents' Mark
CareMANAGER	CareManager

18. The applicants' mark consists of the words Care and Manager conjoined with the initial letter C of the word Care and all of the word Manager being in upper case, the remaining letters being in lower case. The opponents' mark also consists of the words Care and Manager conjoined but with the initial letter of each word appearing in upper case and all others being in lower case. The applicants admit that the marks are "practically identical".

19. The only differences between the two marks are in their respective use of upper and lower case letters. Visually these differences are wholly insignificant and would, I believe be easily overlooked by the average consumer of the goods and services in question.

20. Conceptually and aurally, the marks are identical. I therefore find that the mark applied for is identical to that of the opponents.

21. If I had come to the opposite view on this, I would have found that the marks are as closely similar as it is possible to be without being identical.

22. Both the word CARE and the word MANAGER are ordinary dictionary words which need no further explanation. In combination, the whole has no dictionary meaning but it is not a particularly unusual pairing of words and the whole is suggestive of a person or service intended to provide help or have protective or supervisory control over something. In respect of the goods and services at issue the marks are towards the lower end of the spectrum of distinctiveness.

23. The opponents do not claim that their mark had acquired an enhanced level of distinctiveness as a result of any use made of it in the United Kingdom prior to the relevant date in these proceedings i.e. 30 March 2001.

24. I therefore go on to consider the similarity of the respective goods and services.

The Goods and Services

25. The opponents claim that in respect of the specifications in class 36 the services of the respective marks are identical. In the alternative, they say that these, as well as the goods and services applied for in the other classes set out earlier in this decision, are similar.

26. Taking the class 36 services first, the opponents submit that property portfolio management is necessarily a financial affair and is unlikely to be managed other than as an investment. Any form of management of a portfolio of property must, they say, involve financial management as well as some form of insurance.

27. The opponents' case centres on what it calls the "strong financial aspect" involved in business management and the administration of buildings, real estate and commercial and domestic property. They say that these are administered and managed for third parties who generally hold that property as a form of investment.

28. Mr Jennings for the applicants, denies that these services are identical or similar to those of the opponents. Insurance business, he says, is usually dealt with by specialist insurance brokers or by insurance companies who do not usually provide a property portfolio management service. Mr Jennings says that the applicants have no interest in the financial services market which is normally operated by banking institutions, finance companies or investment firms selling stocks and shares and submits that such organisations do not normally operate a property portfolio management business. Mr Jennings argues that the opponents' argument is fatally flawed and that many other products or services would require some form of insurance or finance.

29. The opponents say that in respect of the class 36 services the main purpose of property management and administration is to provide income and to serve as an investment and therefore its main purpose is financial. They apply the same argument to the remaining classes of goods and services.

30. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] ETMR 1 the European Court of Justice stated, at paragraph 23 of its judgement, that:

> "23. 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 end users and their method of use and whether they are in competition with each other or are complementary."

31. 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."

32. Although I have no evidence on the point, it seems to me that insofar as the applicants' services in Class 36 are concerned, the term "property portfolio management" appears to be the global term for many of the specific services which were listed in the Class 36 specification as originally published including "financial administration, acquisition, investment, rental, leasing and letting of buildings".

33. The opponents' services in Class 36 are "Insurance; financial affairs". The term "financial affairs" is somewhat open-ended, however it is the term used in the class heading of Class 36 in the Nice Agreement. This same class heading distinguishes between "financial affairs" and "real estate affairs", the latter covering property portfolio management. In view of this distinction, which I believe reflects a true distinction in the market place, I find that the respective services are not identical. I therefore go on to consider whether the respective services are similar.

34. The term "financial affairs" covers a multitude of financial dealings including many forms of financial investment. Some forms of financial investment involve the purchase and management of, and investment in, property. Other forms of financial investment are in competition with property investment services. Insurance services are complementary to property investment, for example, insurance of the property itself or insurance of the investor's employment. The nature of both the respective services are at least similar and the end users of those services could easily be the same. I therefore find the respective services in class 36 to be similar.

35. In respect of the applicants' remaining goods and services, I find that there is no similarity with the services of the opponents. They are several steps removed from the opponents' services such that their nature, purpose and end users are different. Neither do I think that the goods or services are in competition with or complementary to those of the opponents.

36. The applicants' mark has a low degree of inherent distinctiveness. It is identical to the opponents' mark and, in respect of the services in class 36 only, is for similar services to the services of the opponents. Taking a global appreciation, I think the average consumer, who is deemed to be reasonable well informed and reasonably circumspect and observant, would be likely to be confused in respect of the services in class 36 only.

37. Consequently, the opposition under Section 5(2)(a) succeeds in respect of the services in class 36 only. The application will be allowed to proceed to registration for the goods and services in all other classes if, within one month of the end of the period allowed for appeal against this decision, the applicants file a Form TM21 to remove the class 36 specification from the application. If the applicants do not file the Form TM21 restricting the application as set out above, the application will be refused in its entirety.

38. The opposition as filed sought refusal of the application in its entirety. The application covered five classes although I have only found for the opponent in respect of one of those classes. Early on in the proceedings the applicants had amended the application and removed some goods and services in classes 9 and 36 in an attempt to avoid potential conflict.

39. Taking the best view I can of the matter, I have a situation where, if the applicants file a Form TM21 as set out above, each party will have succeeded in part and the position will be something of a "score draw". I am therefore of the view that each party should bear their own costs. If, however, the applicant fails to file a Form TM21 as set out above, I will review the position and issue a further decision on costs.

Dated this 20th day of August 2003

Ann Corbett
For the Registrar
The Comptroller-General