

O-223-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2429825
BY POPPIES UK LTD TO REGISTER A
TRADE MARK IN CLASSES 37 & 44**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 95839 BY NIGEL BEARMAN**

BACKGROUND

1. On 14 August 2006 Poppies UK Ltd (Poppies) applied to register Poppins as a trade mark. Following examination, the application was accepted and published for opposition purposes on 16 November 2007 in Trade Marks Journal No.6710 for the following services in classes 37 and 44:

Class 37: Wallpapering, painting, domestic cleaning services, polishing and laundering services, services for the washing, cleaning and repair of buildings and of the contents thereof; linen ironing services; interior decorating; all included in Class 37.

Class 44: Gardening.

2. On 7 January 2008 Nigel Bearman filed a notice of opposition. This consists of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). In his Statement of Grounds, he indicates that the opposition (which is based upon the following trade mark), is directed against all of the services in the application for registration:

Trade Mark	No.	Application Date	Registration date	Services
Daily Poppins	2132714	18.04.1997	19.12.1997	37 - Domestic cleaning services (residential homes), office cleaning, interior cleaning of buildings.

3. On 19 March 2008 Poppies filed a counterstatement which consists, in essence, of a denial of the ground upon which the opposition is based. That said, I note that in their counterstatement Poppins accept that:

“...some of the services referred to in [the] application are identical to some of those referred to in [Mr Bearman’s] registered trade mark...”

4. Both parties filed evidence. While neither asked to be heard, both filed written submissions which I will refer to as necessary below. After a careful consideration of all the material before me, I give this decision.

EVIDENCE

Mr Bearman’s evidence-in-chief

5. This consists of a witness statement, dated 23 June 2008, from the opponent in these proceedings, Nigel Bearman. Mr Bearman explains that he is the proprietor of Daily Poppins Ltd (DPL) a position he has held since 1997. He explains that the information in his statement comes from his own knowledge or from the records of DPL to which he has access. A good deal of Mr Bearman’s statement consists of his views on the similarity in the respective parties’ trade marks and the competing services at issue. As

this does not constitute evidence, it is neither necessary or appropriate for me to summarise these submissions here. I will, of course, keep them in mind when making my decision.

6. I note that in paragraph 6 of his statement Mr Bearman says, inter alia:

“The opponent intends to prove that the mark DAILY POPPINS has been used continually since the time of its registration, and is widely known and recognised in both the geographic areas where it is used and in the field of domestic and office cleaning.”

7. He states that DPL was incorporated on 29 May 1997 (exhibit NB1, which consists of a print from the Companies House WebCheck service, refers). He adds that since that date, he has licensed the Daily Poppins trade mark to DPL for its use. He explains that as DPL operates through franchise agreements, it is able to service over five thousand domestic properties a month (when I refer to DPL later in this decision, it should be read as a reference to DPL and its franchisees). Exhibit NB2 consists of an undated list of franchisees who use the Daily Poppins trade mark, together with the areas in which use has been licensed. I note that the list contains the names of twelve franchisees (one of whom is Mr Bearman himself), and that it covers the following areas: Peterborough, Newbury, Basingstoke, Swindon, Thatcham, Bracknell, Wokingham, Barnet, Enfield, Southampton, Winchester, Andover, Oxford, Cirencester, Wallington, Wantage, Didcot, Tiverton, Maidenhead, Reading, Henley, Windsor, Caversham, Woodley and Lower Earley.

8. Exhibit NB3 consists of a page from www.dailypoppins.co.uk/slough dated 24 June 2008. I note that the page is headed “Daily Poppins – Slough” and refers prominently to “Domestic Cleaning Services”. The page contains, inter alia, the following text:

“At Daily Poppins we specialise in cleaning domestic homes to a very high standard and at affordable prices. Since the business started in 1997 Daily Poppins has become established as one of the market leaders in domestic cleaning services and regularly cleans over 5000 homes per month.....”

In a box at the bottom of the page appears, inter alia, the following text:

“...we poppin so you can pop out”.

9. Exhibit NB4 consists of two pages which resulted from a search conducted on 24 June 2008 of www.yell.com in the UK for the words “daily poppins”. Mr Bearman notes that the first five results are exact matches, adding that all five are franchisees of DPL.

10. Exhibit NB5 consists of two pages which resulted from a Google search also conducted on 24 June 2008 for the words “daily poppins”. Of these results Mr Bearman says:

“..Such a search generates over 100 results, which are almost exclusively connected with franchisees of Daily Poppins Limited or a review of its services and those of its franchisees, sold in relation to the trade mark DAILY POPPINS.”

11. Mr Bearman states that DPL franchisees:

“..regularly undertake all domestic and office maintenance and cleaning, which differs and thus is tailored to the individual needs of clients.”

12. Exhibit NB6 consists of a page taken from www.dailypoppins.co.uk (again on 24 June 2008) in which Mr Bearman notes it says:

“...the beauty of Daily Poppins is that we fit in with your lifestyle and provide a service which is tailored to meet the needs of each individual client. For example we can change linen, iron clothes in your own home and hang them back in the wardrobe.”

13. Mr Bearman goes on to say that franchisees of DPL will undertake all cleaning and maintenance duties which can include: painting, cleaning, sweeping, mopping, wallpapering, polishing, ironing and other associated tasks. He adds that gardening is also within the scope of a franchisees work, with typical duties including: sweeping paths and yards, removing weeds and watering flowers and lawns.

14. Mr Bearman explains that since 1997 £10k has been spent on the creation and development of the www.dailypoppins.co.uk website, the front page of which (again from 24 June 2008) is shown at exhibit NB7. He adds that DPL has advertised in many media. Exhibit NB8 is said to consist of examples of advertisements placed in Yellow Pages. All of the pages contain the words “Daily Poppins”, on a number of occasions I note the words are accompanied by a device of a female figure holding what I take to be a vacuum cleaner. As far as I can tell, none of the pages are dated.

15. Mr Bearman states that the licensing of the Daily Poppins trade mark has generated the following turnover:

Year	Turnover (£)
2003	600k
2004	800k
2005	800k
2006	1million
2007	2million

Poppin’s evidence-in-chief

16. This consists of a witness statement, dated 21 November 2008, from Susan Rorstad who is the Managing Director of Poppies. Ms Rorstad explains that she established Poppies and began trading in 1980. In 1983 Poppies began granting franchises and

now has twenty five outlets covering an area from Edinburgh to Lyme Regis. She adds that since 1986 Poppies has owned registered word and device trade marks for POPPIES and logo. The remainder of Ms Rorstad's statement consists of a commentary on Mr Bearman's evidence, together with her views on the degree of similarity between the respective parties' trade marks and the services at issue. As I mentioned earlier in this decision, it is neither appropriate or necessary for me to summarise these comments here. However, as before, I will keep Ms Rorstad's comments in mind when making my decision.

Mr Bearman's evidence-in-reply

17. This consists of three witness statements. The first, dated 26 February 2009, is from Mr Bearman. As Mr Bearman's statement simply responds to that of Ms Rorstad, I shall not summarise it here; I shall of course keep its contents in mind when making my decision. That said, there is one aspect of his statement that I must deal with. I note that at various points in his statement Mr Bearman refers to goodwill and/or the law of passing off. For example, in paragraph 7 of his statement he says, inter alia:

“..As was stated in the Notice of Opposition, I claimed passing off rights (pursuant to section 5(4)(a) Trade Marks Act 1994). Those passing off rights entitle us to claim that registration of the sign POPPINS for all the services for which protection is sought would infringe those “earlier rights”.”

18. I have reviewed both the Notice of Opposition and, although not strictly in evidence in these proceedings, as it is open to public inspection, the contents of the Trade Marks Registry's official file. Having done so, I note that in their letter of 3 January 2008 which accompanied the filing of Mr Bearman's Notice of Opposition, his professional representative Brand Protect LLP said:

“Please find enclosed form TM7 relating to an application to oppose the above cited trade mark application on the basis of our client's earlier rights (UK trade mark registration 2132714 POPPINS in the name of Nigel Bearman.”

19. Although this letter wrongly describes Mr Bearman's trade mark (it consists of the words Daily Poppins), in my view, it clearly supports the proposition that this opposition was filed solely on the basis of a claim under section 5(2)(b) of the Act. Fortunately, this matter has now been put beyond doubt, given that in the written submissions provided by Brand Protect LLP they say:

“This opposition is founded upon Section 5(2)(b) of the Act...”

That being the case, I need make no further reference to this issue in this decision.

20. The remaining two witness statements, both dated February 2009, are from Clemence Mandzo of Southampton Cleaning Services Ltd and Agnieszka Gasecka of

Charisma Cleaning Services Ltd both of whom are franchisees of DPL. They say that since October 2006 and November 2003 respectively:

“..we have offered various DIY services such as painting walls and paintwork, especially when those surfaces have been damaged by children.

If our customers ever require gardening support, such as mowing the lawns or cutting hedges then we have always been willing to provide these services.”

21. Attached to Mr Mandzo’s statement are two invoices dated 18 December 2008 and 6 January 2009 on which the words Daily Poppins appear. I note that the invoices refer to:

“..remove or patch up scuff marks in hallway” (18 December)

“..plus garden, hedge trimming and litter picking and bagging of birchwood” (6 January).

22. Attached to Ms Gasecka’s statement is a receipt dated 11 January 2008 on which the words Daily Poppins appear and which reads:

“Repair paint wall in child’s bedroom”.

23. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

24. Section 5(2)(b) of the Act 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, or

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

25. 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.”

26. In these proceedings, Mr Bearman is relying on the registered trade mark shown in paragraph 2 above, which has an application date of 18 April 1997 which is prior to that of the application for registration which was filed on 14 August 2006; as such, it qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 16 November 2007 and Mr Bearman’s trade mark was registered on 19 December 1997. As a result, Mr Bearman’s earlier trade mark is subject to The Trade Marks (Proof of Use, etc) Regulations 2004. I note that in their counterstatement Poppins ask Mr Bearman to provide evidence of the use that he has made of his trade mark. The relevant sections of the Proof of Use Regulations read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Proof of use

27. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of Poppins application for registration i.e. 17 November 2002 to 16 November 2007.

28. The leading authorities on the principles to be applied when determining whether there has been genuine use of a trade mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following principles:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

29. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

"29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for

motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

30. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the

umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

31. Finally, the comments of the Court of First Instance in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

"45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

32. In reaching a conclusion on whether genuine use has been made of the Daily Poppins trade mark, I am mindful that the evidence filed by Mr Bearman suffers from a number of defects to which I have alluded above i.e. some exhibits are undated (NB2 and NB8) and others are after the material date in these proceedings (NB3, NB4, NB5, NB6 and NB7). In addition, in exhibit NB8 the use shown is of the words Daily Poppins accompanied (on occasion) by a device of a female figure holding a vacuum cleaner.

33. In their evidence and written submissions, I note that Poppies focus their attention on what they consider to be the limited geographical area of use in which the Daily Poppins trade mark has been used, and in addition they question the number of properties DPL claim they are able to service

34. In his evidence Mr Bearman explains that in the period 2003 to 2007, turnover generated by the licensing of the Daily Poppins trade mark amounted to some £5.2m, adding that £10k had been spent on the creation and development of the Daily Poppins website. While no expenditure figures are provided for placement of the advertisements in Yellow Pages/Yell.com, costs have inevitably also been incurred in this regard.

35. Having considered Mr Bearman's evidence in totality, and whilst bearing in mind both my own concerns and the extent of Poppies' criticisms of his evidence, I have come to the conclusion that on the totality of the evidence provided, the use made of the Daily Poppins trade mark has been neither token nor internal; it has been use with a view to preserving a share in the market concerned. **I therefore find that during the relevant period, DPL made use of their Daily Poppins trade mark within a sufficiently wide geographical area for its use to be considered genuine.**

36. However, notwithstanding the various references in the evidence to use in relation to office cleaning services, in the absence of turnover figures directed at the different arms of the business, it appears to me that the overwhelming use (and promotion) of the Daily Poppins trade mark has been in the context of a cleaning service for domestic homes. To support this conclusion, I would point to the various extracts from the evidence I have reproduced above, in addition to which I note that the vast majority of the references to the trade mark in exhibits NB4, NB5 and NB8 are in the context of a domestic cleaning service.

37. I therefore find that within the relevant period, DPL have made genuine use of the Daily Poppins trade mark in relation to: "domestic cleaning services". Having reached that conclusion, I must now go on to determine what constitutes a fair specification of services. The trade mark currently stands registered for:

"Domestic cleaning services (residential homes), office cleaning, interior cleaning of buildings."

38. Having applied the case law at paragraphs 29, 30 and 31 above, and because in my view: (i) the words "residential homes" are, in the context in which they appear superfluous, (ii) the words "interior cleaning of buildings" broader in scope than the interior cleaning of domestic buildings, and (iii) as there is no discernible use in relation to "office cleaning," I believe that on the basis of the evidence provided, the average consumer would describe DPL's services as "domestic cleaning services." Such services represent, in my view, a clear sub-category of the services for which the trade mark stands registered. **As such, I consider them to represent a fair specification, and it is on the basis of this specification that I intend to conduct the comparison under section 5(2)(b) of the Act.**

Section 5(2)(b) – case law

39. In reaching my decision I must take into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments germane to this issue, some of which I note were specifically mentioned by the parties in their written submissions. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05),

It is clear from all these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;
- (f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;
- (g) 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;

(h) 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;

(i) 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;

(j) 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 + Adidas Benelux BV*, paragraph 41;

(k) 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.

The average consumer and the nature of the purchasing decision

40. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services, and then to determine the manner in which these services are likely to be selected by the average consumer in the course of trade.

41. Insofar as DPL is concerned, the average consumer of its (now restricted services), would be any member of the general public who has a property they want to be cleaned. In this regard, I agree with Mr Bearman when he suggests in his statement that this would include home owners, letting agents and landlords. Poppies' specification is of course much broader in scope. It would include all of the above groups as well as, for example, other business users such as officer managers responsible for, for example, the cleaning of offices and similar buildings.

42. I have no evidence as to how the services are likely to be purchased. However, in my limited experience (speaking as a member of the public rather than a business user), the selection of such services is likely to consist of a visual act having inspected, for example, trade directories such as Yellow Pages or having conducted a search on-line. Equally, it may be on the basis of oral recommendations from colleagues, friends or family. I think that similar considerations are also likely to apply to business users i.e. that visual and oral considerations will both play a part in the selection process. That said, I accept that the nature of the sources business users may consult, and the origin of the oral recommendations they may receive, are far more likely to be business related than the rather more general sources available to the public.

43. Having determined who I consider the average consumer to be, I must now determine the nature of the purchasing decision. The amount of money a member of the public is likely to spend on, for example, routine home cleaning, gardening or ironing is

likely to vary; regardless, the sums involved are (for the most part) not likely to be substantial (although large or unusual jobs will be more expensive). The same may not be true of, for example, having one's home decorated which is likely to result in a significant level of expenditure. Insofar as business users are concerned (and of course depending on the size and nature of the business), it is far more likely that much more significant sums will be in play.

44. Regardless, it appears to me that whether the average consumer is a business user selecting, for example, a company to clean a large office block, or a member of the public selecting a company to clean their home, **both are, in my view, likely to pay a reasonably high degree of attention to their purchase.** I say this, because both sets of consumers (whether selecting a service provider on a one-off or long term basis), will need to satisfy themselves that the provider concerned is in a position to satisfy their particular requirements, in an appropriate timescale and at an appropriate cost; other factors such as trusting others to work in one's home and insurance for those individuals will also need to be borne in mind. While I have focused here on cleaning services, the same considerations also apply to the other services in Poppies' application.

Comparison of services

45. The leading authorities on how to determine similarity between goods and services are considered to be the *Canon* case (supra) and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) 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;
- (f) 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.

46. The services to be compared are as follows:

Poppies' services	Mr Bearman's services on which use has been proven
<p>Class 37: Wallpapering, painting, domestic cleaning services, polishing and laundering services, services for the washing, cleaning and repair of buildings and of the contents thereof; linen ironing services; interior decorating; all included in Class 37.</p> <p>Class 44: Gardening.</p>	<p>Domestic cleaning services</p>

47. In reaching a conclusion on the degree of similarity in the respective services, I must also bear in mind the comments of Jacob J (as he then was) in *Avnet Incorporated v Isoact Ltd*, [1998] FSR 16 when he said:

"... definitions of services are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as "boots and shoes".

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."

48. In their written submissions Poppies say:

"2(2) The services referred to in the Application fall into two groups. The first consists of services relating to the cleaning of buildings and laundry and ironing. These are similar or identical to those for which the prior mark is registered....

The second consists of services relating to the repair and decoration of buildings and gardening....these services are not similar to those for which the prior mark is registered..."

49. Although this concession was made in the context of all the services for which the Daily Poppins trade mark is registered, I do not think that the limited specification which survives following my proof of use assessment is likely to change the position to any material extent. That being the case, and in view of the concession made by Poppies, I **agree that:**

Domestic cleaning services, polishing and laundering services, services for the washing and cleaning of buildings and of the contents thereof, and linen ironing services

contained in Poppies' application are either the same as, or are similar to a high degree, to those services on which the Daily Poppins trade mark has been used.

That leaves:

Wallpapering, painting, services for the repair of buildings and of the contents thereof, interior decorating and gardening services.

50. In their written submissions Poppies' comment on the second category of services in the following terms:

“7....In the case of wallpapering, painting, interior decorating and repair of buildings and the contents thereof, they differ in many respects, including the frequency with which and circumstances under which they are required, one being a minor but frequent housekeeping task and the other being required only at much longer intervals or in emergencies. They differ in the likely suppliers/channels of supply, cleaning being generally provided by domestic cleaners of the type supplied by [Mr Bearman] and decoration and repair work being generally supplied by specialist tradesman who are skilled and experienced in that work. They also differ substantially in cost, one being a significant or major item of expenditure, the other being a small, regular, housekeeping expense. They are not competitive with nor substitutes for each other, except to a very limited extent which is insufficient to make them “similar” within the meaning of section 5 of the Act. The average consumer would not regard decorating and cleaning as substitutes for each other.

8. Gardening..is also not similar to the domestic and office cleaning protected by the earlier trade mark. The suggestion by [Mr Bearman]...that watering indoor plants is a form of gardening is simply incorrect on either a dictionary definition (“cultivate, work in garden”) or the ordinary language of consumers...neither gardening nor the watering of indoor plants is not similar (in the relevant sense) to the services of cleaning..The respective services of gardening and cleaning are not similar, either in relation to the work done, the subject of the work or the suppliers/channels of supply of the services; gardening services tend to be carried out not only by different individuals from cleaning services but also supplied by separate companies of gardeners, landscape gardeners or estate managers.”

51. In his first statement Mr Bearman comments on the second category of services in the following terms:

“29. The remaining services....are “similar” to those for which [I] enjoy “earlier rights”. Those “similar services” are “wallpapering, painting, repair of buildings and of the contents thereof; interior decorating and gardening”. The said services are similar to those services for which [I] own “earlier rights” because:

- a. The people specifying and purchasing those services are likely to be identical. In the case of domestic situations they could be landlords or letting agents...
- b. The type of service provided is very similar. Although [I] enjoy exclusive rights for cleaning services, wallpapering, painting and repairing of property is similar to cleaning in this context. If for example a child has used a crayon on a painted wall and if the owner has the same paint then our cleaners would be happy to paint small areas of walls or woodwork, as this is likely to provide a better solution to the problem than spending ages trying to scrub the stain of the wall.
- c. Our cleaners also provide gardening services (albeit of a limited nature). Our cleaners are happy to water indoor plants if requested to do so. This is a form of gardening and is regularly provided by reference to the mark. Thus “gardening” is a service that is either “identical” to “earlier rights” enjoyed by [me] or are “similar”...”

52. In his written submissions, Mr Bearman comments on, inter alia, what he considers to the complementary nature of some of these services. He says:

“Those buyers are likely to see the services as being complementary. For example, a busy professional who purchases our client’s services will prefer that the garden and house cleaning are undertaken at the same time by the same person because the organisation of this work is easier for the busy professional to undertake. The level of skill it takes to mow a lawn or water some plants is not great and can be undertaken by most people and indeed all of the persons employed by or franchised by our client. Similarly, a professional landlord who needs to clean a house after the end of a tenancy is likely to be attracted to an offer from our client to clean and repair the house ready for the next tenant. The service of cleaning and repair are again complementary.

53. Insofar as the second category of services are concerned, Mr Bearman places reliance on the statements of Ms Gasecka and Mr Mandzo who indicate that since November 2003 and October 2006 respectively (the latter is of course after the material date in these proceedings) they have:

“..offered various DIY services such as painting walls and paintwork, especially when those surfaces have been damaged by children.

If our customers ever require gardening support, such as mowing the lawns or cutting hedges then we have always been willing to provide these services.”

54. I note that while invoices and a receipt have been provided to support these claims, once again they are all after the material date. Finally, I note the following comment which appears in Ms Rorstad's statement (which was of course filed prior to Mr Bearman's second statement and to those of Ms Gasecka and Mr Mandzo). Ms Rorstad says:

“..[Mr Bearman] does not say that he or his franchisees have ever provided gardening or decorating services....In contrast, the Applicant's franchisees do provide such services.”

55. Having applied the case law mentioned to the comparison between Mr Bearman's domestic cleaning services and Poppies' services in the second category mentioned above, and while I am prepared to accept that in certain situations the users of the respective services may be the same, it appeared to me that the services in the second category are (and for many of the reasons suggested by Poppies) unlikely to be considered similar to those of Mr Bearman. In this regard, I felt that the uses of the respective services were different as were their nature. I also felt that they were unlikely (in any meaningful way) to be considered either in competition with or complementary to one another, nor were they likely (for the most part) to be provided by the same service providers or acquired by the average consumer through the same trade channels.

56. While that remains my view of the matter, from the evidence provided by both parties, it appears that some service providers in the field of domestic cleaning will carry out on request small repairs or interior decoration jobs, and will also undertake routine gardening tasks such as mowing lawns, hedge trimming and watering plants. Ms Gasecka's and Mr Mandzo's witness statements say as much, and Ms Rorstad's comment above confirms that Poppies also provide such services to their clients. All of these factors combine to suggest that while my initial view of the matter may not be wrong, there is an argument that insofar as routine repairs, routine decoration and routine gardening tasks of the type mentioned above are concerned, there may in fact be in an element of competition with traditional bespoke service providers (e.g. gardeners) and an element of complementarity with domestic cleaning services. **If that is right, there may indeed be a degree of similarity between Mr Bearman's domestic cleaning services and Poppies' services in the second category mentioned above, albeit I would suggest, similarity at a very low level.**

Comparison of trade marks

57. For the sake of convenience, the trade marks to be compared are as follows:

Poppies' trade mark	Mr Bearman's trade mark
Poppins	Daily Poppins

58. It is well established that the average consumer is considered to be someone who is reasonably well informed, circumspect and observant, who perceives trade marks as a

whole and who does not pause to analyse their various details; in addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion, I must also identify what I consider to be the distinctive and dominant components of the respective trade marks.

59. Poppies' trade mark consists of the seven letter word Poppins presented with the letter P capitalised; Mr Bearman's trade mark consists of two words containing five and seven letters respectively. Both words in Mr Bearman's trade mark are presented with the initial letters capitalised and with the remaining letters presented in lower case. I note that in the written submissions Poppins say:

“Whilst the trade marks are similar, the degree of similarity is low....”

60. As both trade marks share an identical element, in their written submissions the parties have, not surprisingly, concentrated on the significance (or otherwise) of the word Daily appearing in Mr Bearman's trade mark, whether this constitutes a distinctive and dominant element of the trade mark, and what impact it has on the conceptual message the trade mark is likely to convey. I will return to these points in a moment, but first I must, as the case law dictates, compare the trade marks from the visual and aural perspectives.

Visual/aural similarity

61. As both trade marks share the same word Poppins (presented in an identical fashion), there must be a degree of both visual and aural similarity between them. In their written submissions, Poppins say in relation to the word Daily:

“as the first word in the earlier trade mark, it is likely to be perceived as the more significant, or at least an equally significant part of the earlier trade mark.”

62. I agree that as the first word in Mr Bearman's trade mark, it is the first word that the average consumer will see and articulate. **However, in my view the respective trade marks still share a reasonable degree of visual and aural similarity.**

Distinctive and dominant elements & conceptual similarity

63. In their written submissions Poppins say:

“The word “Daily” is not descriptive of the services...and the fact that it is an ordinary word of the English language is not sufficient to regard it as an unimportant or diminutive part of the earlier trade mark or to regard the other word of that trade mark as dominant.”

“..they are also conceptually different. [Poppies’] mark is an abstract word (if it calls to mind anything, it might be the fictional character Mary Poppins), whilst [Mr Bearman’s] mark is a phrase which conveys the concept of daily visits.”

64. In his written submissions Mr Bearman says:

“The essential question to ask is if the word “Daily” in the earlier trade mark is distinctive in itself. In other words, would members of the public addressed describe [Mr Bearman’s] services as “DAILY” and not “DAILY POPPINS”. When this question is asked the significance of that word in the whole of the earlier trade mark is disclosed. The word “DAILY” in this context serves to limit the meaning of “POPPINS”. The word “DAILY” does not stand by itself, it merely serves to limit the noun “POPPINS.”

“[Mr Bearman] also endorses....that [Mr Bearman’s] mark is a phrase which conveys the concept of daily visits.”

“Given the fact that “DAILY” is descriptive or defines the extent of “POPPINS”, its role is subservient to that of “POPPINS”. In other words “POPPINS” is the dominant element of the earlier trade mark...”

“The concept underlying the choice of the word “POPPINS” by [Mr Bearman] is to convey the service of “popping” into an establishment to clean, repair and decorate it on several occasions. It alludes to the service of a series of “pop ins”. [Poppies] are quite right that the word “poppins” is an “abstract word” in the context that in itself it has no standard dictionary meaning. That said,...given the strong allusive meaning of “poppins” to the service provided...”

65. Poppies argue that when used alone the word Poppins is an abstract word which, if anything, calls to mind the fictional character Mary Poppins. However, when combined with the word Daily, they argue that this changes its meaning to one which conveys the concept of daily visits; I note that Mr Bearman agrees that his trade mark sends the conceptual meaning Poppies suggest.

66. It is clear from the case law that I must compare the respective trade marks as totalities. Only when all other components of a trade mark are considered to be negligible, would it then be permissible for me to carry out my assessment on the basis of what I considered to be the dominant element. Equally, I must keep in mind that it is possible for an element within a trade mark to play an independent distinctive role within it without necessarily being the dominant element.

67. In my view, neither element of Mr Bearman’s trade mark can be considered to be truly dominant. Each element contributes to the trade mark as a whole, and in so doing conveys, in the context of the services for which it is has been used (and on which I note both parties agree), the concept of daily visits. Considering Poppies’ trade mark in the context of the services for which registration is sought, the word Poppins is, in my

view, far more likely to convey to the average consumer the concept of a service in which the service provider concerned “pops in”, as opposed to a reference to the fictional character Mary Poppins. In those circumstances, I agree with Mr Bearman’s submissions to the effect that the word Daily in his trade mark would be seen as qualifying the word Poppins. **In my view, both trade marks send very similar conceptual messages, albeit that Mr Bearman’s services would be construed as being provided on a daily, as opposed to, for example, a weekly, fortnightly or monthly basis.**

Distinctive character of the Daily Poppins trade mark

68. As the case law dictates, I must also assess the distinctive character of the Daily Poppins trade mark in relation to the services for which it has been used. Mr Bearman accepts that in the context of his services the word Poppins has a strong allusive quality, and that the combination Daily Poppins is likely to convey to the average consumer the concept of daily visits. That said, I note that the Trade Marks Registry accepted Mr Bearman’s trade mark absent use of its distinctiveness, and there is nothing to suggest that his trade mark was not one possessed of sufficient distinctive character to justify acceptance on this basis; **it is, in my view, a trade mark deserving of a reasonable level of protection.** While there are claims made by Mr Bearman for an enhanced level of protection based on his use of the trade mark since 1997, given what appears to be the relatively modest annual turnover figures and somewhat limited geographical area in which the trade mark has been used, and in the absence of contextualising information such as the size of the market for domestic cleaning services and Mr Bearman’s position in that market, I am not prepared to infer that his use of the trade mark has enhanced its distinctive character to any appreciable extent.

Likelihood of confusion

69. 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 also necessary for me to keep in mind the distinctive character of the Daily Poppins trade mark, as the more distinctive this trade mark is (either inherently or as a result of any use that has been made of it), the greater the likelihood of confusion. The distinctive character of the Daily Poppins trade mark must be appraised by reference to the services in respect of which it is has been used and also by reference to the way it will be perceived by the average consumer. I must also keep in mind the average consumer for the services and the nature of the purchasing process.

70. In summary, I have concluded that: (i) Mr Bearman has used his Daily Poppins trade mark in relation to “domestic cleaning services”, and that this represents a fair specification, (ii) these services are the same as or are similar to a high degree to: “domestic cleaning services, polishing and laundering services, services for the washing and cleaning of buildings and of the contents thereof, and linen ironing services”, and

are (iii) similar to a very low degree to: “wallpapering, painting, services for the repair of buildings and of the contents thereof, interior decorating and gardening services”, (iv) given the nature of the services at issue both visual and aural aspects of the comparison are likely to play a part in the selection process, (v) the average consumer will pay a reasonably high degree of attention to the selection of the services, (vi) the respective trade mark share a reasonable degree of visual and aural similarity and are likely to send very similar conceptual messages, and (vii) there is insufficient evidence provided for me to conclude that Mr Bearman’s use of his Daily Poppins trade mark has improved upon its inherent distinctive character to any material degree.

71. I must now apply the global approach advocated to my findings to determine whether direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the services would be assumed to come from economically linked undertakings) is likely to occur. Having done so, I have no hesitation in concluding that in relation to the services which Poppies accept are the same as or similar to those for which Mr Bearman has secured registration (a concession which, in my view, is unaffected by my assessment of his use of the trade mark), confusion be it direct or indirect is likely to occur.

72. Insofar as the second category of services is concerned, I have found this a much more difficult decision to reach. However, having considered the evidence in the round, and keeping in mind Ms Rorstad’s comment in paragraph 54 above and the principle of interdependence, I have, albeit with some hesitation, come to the conclusion that the degree of similarity in the respective trade marks combined with the reasonable level of protection the earlier trade mark enjoys, and notwithstanding the allusive quality of the word Poppins, is, just sufficient to offset what I consider to be the very low level of similarity in the respective services to result in a likelihood of confusion.

Outcome

73. In summary, the opposition has been wholly successful and the application should be refused in its entirety.

Costs

74. As Mr Bearman has been successful he is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Mr Bearman on the following basis:

Preparing a statement and considering the other side’s statement:	£200
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Official fee:	£200
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Preparing evidence and considering and
commenting on the other side's evidence: £500

Written submissions: £300

Total: £1200

75. I order Poppies UK Ltd to pay to Nigel Bearman the sum of £1200. This sum is 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 29th day of July 2009

**C J BOWEN
For the Registrar
The Comptroller-General**