

O-320-09

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2480362

BY JULIE A SLACK

TO REGISTER IN CLASS 35 THE TRADE MARK:



mothership
PUBLIC RELATIONS

AND

IN THE MATTER OF OPPOSITION NO 97431 BY

DAVID ABREHART AND TIMOTHY ISSAC

TRADE MARKS ACT 1994

In the matter of application No 2480362
By Julie A Slack
to register in class 35 the trade mark:



and

In the matter of opposition No 97431 by
David Abrehart and Timothy Issac

Background

1. Ms Julie A Slack applied for the above trade mark on 20 February 2008. She seeks registration for:

Class 35: Advisory services relating to public relations. Assistance to management in commercial enterprises in respect of public relations. Consultancy relating to public relations. Public relations. Public relations agency. Public relations consultancy. Public relations services. Public relations studies.

2. On 26 June 2008 opposition to the registration of Ms Slack's application was made, jointly, by Mr David Abrehart and Mr Timothy Issac under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). Mr Abrehart and Mr Issac rely on two trade marks of which they are joint proprietors. The details of the two trade marks are:

Trade mark details	Goods and services
Community trade mark ("CTM") registration 5513262 for the mark: MOTHERSHIP Filing date: 30 November 2006 Registration date: 19 September 2007	Class 09: Downloadable electronic publications; digital music downloadable from the Internet; sound, video and data recordings, including downloadable recordings. Class 35: Advertising, marketing and promotional services, including such services provided by means of the internet. Class 38: Communication services, including such services provided by means of an interactive website; operation of message boards; leasing access time to a website; operation of chat rooms. Class 41: Entertainment services; organisation,

	<p>production and presentation of competitions and contests; including such services available by means of an interactive website; publishing; provision of digital music (non-downloadable) and on-line electronic publications (non-downloadable).</p> <p>Class 45: Dating services and introduction agency services, including such services provided by the internet.</p>
<p>UK trade mark registration 2437104B for the mark:</p> <p>MOTHERSHIP</p> <p>Filing date: 30 October 2006</p> <p>Registration date: 12 October 2007</p>	<p>Class 09: Electronic business directories identifying commercial organisations and traders; downloadable electronic publications from an interactive website.</p> <p>Class 16: Guides; printed publications; stationery; goods made of paper and card all for promotion of an interactive website.</p> <p>Class 35: Compilation of business directories; advertising, marketing and promotional services, all provided by means of an interactive website.</p> <p>Class 41: Entertainment services; organisation, production and presentation of competitions and contests; including such services available by means of an interactive website; publishing.</p>

3. Both the above trade marks were filed before Ms Slack's application. Ms Slack's application does not benefit from an international priority date. The joint opponents' trade marks, therefore, count as earlier trade marks as defined in section 6(1)(a) of the Act. Neither of the earlier marks completed their registration procedures five years or more before Ms Slack's application was published in the Trade Marks Journal. The consequence of this is that the proof of use provisions contained in section 6A¹ of the Act do not apply. The relevance of this to the case before me becomes apparent when one considers Ms Slack's counterstatement where, when denying the grounds of opposition, she states (emphasis added):

"The services provided by our business are neither identical nor similar to those services covered by the opponents' registration. Our business extends to the provision of advice to our clients to improve the client's image with the public using buyer editorial strategy but without carrying out any advertising, marketing or promotional activity (cited by the opponent as class 35 services). Our business is a public relations agency; The opponents' mark provides an on-line dating service!"

¹ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

4. For the benefit of Ms Slack, who is not professionally represented in these proceedings, I should say a little more about the proof of use provisions. Had the joint opponents' trade marks been registered for five years or more (measured at the point in time when Ms Slack's application was published in the Trade Marks Journal) then the joint opponents' earlier trade marks would only have been taken into account to the extent that they had been used. Therefore, if the joint opponents had only used their marks in relation to an on-line dating service or other related goods and services (as Ms Slack claims) then my assessment would have been limited to that circumstance. However, given that the proof of use provisions do not apply (at the point in time when Ms Slack's application was published in the Trade Marks Journal the earlier marks had been registered for less than one year), the joint opponents' are entitled to rely on the full list of goods and services for which their marks are registered. My assessment must be made upon that basis. I note, though, Ms Slack's claim that her public relations services are carried out without any advertising, marketing or promotional activity; I will return to this point later.

5. Both sides filed evidence, this is summarised below. Neither side requested a hearing, although the joint opponents filed written submissions in lieu of attendance. The applicant, Ms Slack, did not file any written submissions.

The evidence

The joint opponents' evidence – witness statement of Mr David Abrehart

6. Mr Abrehart is one of the joint proprietors of the earlier trade marks relied on in the opposition. He explains that he works in partnership with the other opponent (and the other joint proprietor), Mr Timothy Issac.

7. Mr Abrehart begins by referring to basic details about the earlier trade marks and Ms Slack's application. I will not repeat this information here as the details are already set out in the background to this decision. He also refers to the Registrar's preliminary indication; I will say no more about this because it is irrelevant to my determination².

8. Reference is made to a number of exhibits which are provided to support the proposition that the services covered by the respective marks are identical or similar. These are:

Exhibit DA2. This consists of an extract from Dictionary.com relating to the term "public relations". It provides definitions such as "the actions of a corporation, store, government, individual etc., in promoting goodwill between itself and the public...", "the art or science of establishing and

² See the judgment in *esure Insurance Limited v Direct Line Insurance Plc* [2007] EWHC 1557 (Ch)

promoting a favourable relationship with the public”, “a promotion intended to create goodwill for a person or institution”. Mr Abrehart notes the use of the words promotion/promoting in these definitions and highlights that the earlier marks cover promotional services.

Exhibit DA3. This consists of an extract from www.managementhelp.org which provides further definitions for the term “public relations” as well as for “marketing” and “promotion”. Mr Abrehart notes from this that public relations is often considered as one of the primary activities included in promotions, that marketing includes public relations, and that public relations is considered an aspect of promotion.

Exhibit DA4. This is an extract from Wikipedia.org that defines “promotion (marketing)” as including public relations. It describes two types of promotion, namely, above the line promotion such as advertising, and below the line promotion which is meant to be more subtle and which could include activities such as sponsorship, product placement and, amongst other things, public relations.

Exhibit DA5. This is another extract from Wikipedia but this time in relation to the the term marketing. Mr Abrehart notes that public relations is defined as a distinct stage of marketing communications and also falls under “areas of marketing specialization”.

Exhibit DA6. This is a letter from Mr Adrian Wheeler who is an independent public relations consultant and who is currently chairman of the Professional Practices Committee of the Chartered Institute of Public Relations. He letter covers two matters. He firstly explains that whilst public relations takes a number of precise forms, it is wholly concerned with the promotion of a company’s reputational, brand and sales interests, and is correctly described as a promotional activity. He also refers to public relations work being involved with marketing (which he describes as encouragement of sales to new and existing customers) and that there is a quantitative link between public relations investment and sales targets. He adds that in pursuit of sales growth, public relations practitioners will often work alongside other marketing communication specialists like advertising agencies – the purpose of the work being identical.

The applicant’s evidence – witness statement of Jules Slack

9. I presume that Jules Slack is Julie A Slack who made the trade mark application. She states that she works in partnership with Ms Lucy Melling, but I note that Ms Melling is not listed as an applicant; noting turns on this point.

10. Ms Slack refers to the definitions set out by Mr Abrehart and states that she does not wish to reiterate them as the definition of PR [public relations] is not

what she is questioning. She also refers to the letter from Mr Adrian Wheeler (whom she knows) and she states that he is a suitable person to clarify the definition of PR given that he has worked in the industry since 1972.

11. The rest of her evidence consists of a comparison between her services (offering a unique mix of strategic consultancy supported by a flexible freelance network, specialists providing communications and advocacy to businesses targeting women and those whose lives they influence) and those of the joint opponents (a pioneering gay dating and gay social networking site for men in the UK and Ireland). Ms Slack's views can be summed up when she states:

“Ultimately, we are a team of PR professionals and mothers working from home, targeting businesses that target women like us. To suggest that there would be some confusion between this and a gay dating social networking site with a sci-fi theme seems unrealistic.”

The section 5(2)(b) - decision

Legislation and the relevant authorities

12. 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,

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

13. In my consideration of whether there is a likelihood of confusion, I take into account the guidance from the case-law of the European Court of Justice (“ECJ”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Matratzen Concord v OHIM C-3/03* [2004] ECR I-3657, and *Shaker di L. Laudato & C. Sas v OHIM C-334/05 P* (LIMONCELLO). 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*,

(b) the matter must be judged through the eyes of the average consumer of the services in question; *Sabel BV v Puma AG*, 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.*,

(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*,

(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; *Sabel BV v Puma AG*, 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; *Shaker di L. Laudato & C. Sas v OHIM*

(e) nevertheless, the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components; *Matratzen Concord v OHIM*,

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

(g) 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*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of s.5(2); *Sabel BV v Puma AG*,

(i) 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.*

The average consumer and the purchasing act

14. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who this is. Both sets of services (or at least where, on the face of it, there seems to be the

greatest degree of overlap) relate to various public relations, promotional, marketing and advertising services. These are predominantly business to business services, although I cannot rule out the possibility that someone may wish to utilise a public relations service even if they are not a business, perhaps if they are a person in the public eye who is concerned about their public image. Either way, it strikes me that the use of these types of services will be undertaken relatively infrequently and will be a relatively important choice.

15. The case-law informs me that the average consumer is to be regarded as reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). This general presumption can, however, change depending on the particular goods or services in question (see, for example, the decision of the CFI³ in *Inter-Ikea Systems BV v OHIM* (Case T-112/06). Given the infrequency of purchase and the importance of choice, these services strike me as ones where a higher degree of care and attention than the norm will be used when selecting an appropriate service provider.

16. Neither side has highlighted how a service provider is selected or how the service is utilised. It strikes me that the services will be brought to the attention of potential customers by way of the Internet or perhaps through specialist trade directories. Whilst this may indicate a process where visual considerations apply most, aural consideration should not be ignored completely, for example, would be service providers may be identified by a would be customer making enquiries with relevant trade bodies.

Comparison of the services

17. The joint opponents' best case lies with its services in class 35 of its CTM, namely:

Advertising, marketing and promotional services, including such services provided by means of the internet

18. The above must be compared with the services applied for by Ms Slack, namely:

Advisory services relating to public relations. Assistance to management in commercial enterprises in respect of public relations. Consultancy relating to public relations. Public relations. Public relations agency. Public relations consultancy. Public relations services. Public relations studies.

19. All relevant factors relating to the services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of its judgment:

³ The Court of First Instance of the European Communities

“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.”

20. Other factors may also be taken into account such as, for example, the distribution channels concerned (see, for example, paragraph 53 of the judgment of the CFI in Case T-164/03 *Ampafrance S.A. v OHIM – Johnson & Johnson GmbH*).

21. I should stress again (a point that is also stressed in the joint opponents' submissions) that the only comparison I can make is between the earlier mark's registered specification and that applied for by Ms Slack (see my explanation in paragraph 4). It matters not that the joint opponents may or may not be running an online dating agency. It is the notional breadth of the opponents' specification that must be considered. Taking this into account, I note that the joint opponents' specification includes the terms “promotional services” and “marketing”. The evidence provided by Mr Abrehart demonstrates that public relations services perform, essentially, a promotional function. This is also supported by the letter filed in evidence from Mr Wheeler who states that public relations can be properly described as promotional activity. I also note that Ms Slack does not challenge any of this in her evidence. Indeed, she states in evidence that Mr Wheeler (whom she knows) is well placed to provide the explanation he has provided. Despite the fact that Mr Wheeler has not provided evidence himself, the endorsement Ms Slack gives means that this letter should be given some weight. Furthermore, although it is not clear whether the definitions provided by Mr Abrehart reflect the position in the UK market, Ms Slack has not challenged them nor has she filed counter-evidence.

22. I must of course be conscious not to give a listed service too broad an interpretation. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J stated:

“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.”

23. Despite the above, the term “promotional services” seems to me to one that must be taken to include any business to business service that has the purpose of promoting the customer's business to the public. Based on Mr Abrehart's unchallenged evidence, public relations would clearly be considered as a promotional service. Given that all of Ms Slack's services are, essentially, public relations type services, and given that they would all fall within the ambit and

scope of the joint opponents' term "promotional services", I have no option other than to regard the respective services as identical⁴. In this assessment I have not ignored Ms Slack's comments in her counterstatement that her public relations services are carried out without any advertising, marketing or promotional activity. However, the fact that public relations services have as its primary purpose a promotional role, this means that it must still be considered as a promotional service even though it may not use a more direct promotional or marketing activity such as direct advertising.

24. Even if I am wrong on the scope of the term promotional services, it nevertheless strikes me that Ms Slack's public relations specification must be highly similar to both promotional services and marketing services covered by the joint opponents' specification; the purpose and end users are very similar if not identical, the nature and methods of use whilst not identical are nevertheless similar and, furthermore, there could well be an element of competition as the average consumer may make a choice about using a public relations service or using some other form of promotional or marketing activity.

Comparison of the marks

25. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). The marks to be compared are:

Applied for mark:



Earlier mark:

MOTHERSHIP

26. The marks in my view are unquestionably similar. I say this because there is a virtual identity on an aural and conceptual level, the only difference being the presence in the applied for mark of the words PUBLIC RELATIONS, which, in view of the descriptive nature of these words, does little to assist in distinguishing. Furthermore, in relation to visual similarity, whilst the applied for mark also contains two contrasting colours and that the letter O is represented by

⁴ If a terms falls within the ambit of another then, either way, it must be regarded as identical – see to that effect *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05

a fairly distinctive device element, the word MOTHERSHIP is clearly present which produces an obvious and strong visual similarity with the earlier mark. The respective marks are similar to a very high degree.

Distinctive character of the earlier trade marks

27. The distinctiveness of the earlier mark is another factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). No use of the earlier mark has been filed so I have only its inherent qualities to consider. To this extent, the word MOTHERSHIP has no meaning, be it suggestive or otherwise, that relates to the goods and services provided under the mark. Indeed, it seems to me to be a fanciful choice of word. I must conclude that the mark is distinctive to a reasonably high degree.

Likelihood of confusion

28. It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

29. The respective marks are highly similar. The services are identical or highly similar. The earlier mark has a reasonably high degree of distinctive character. All these factors point towards a likelihood of confusion. Indeed, I can find little to add to the analysis that would skew my assessment away from a likelihood of confusion. All things considered, it seems to me, having regard to all the relevant factors, that there is not only a likelihood of confusion, but confusion is inevitable when one considers the notional breadth of specification of the joint opponents' earlier mark. The opposition to the registration of Ms Slack's application succeeds.

Costs

30. In its written submissions the joint opponents have requested costs over and above the published scale due to what it considers to be unreasonable conduct on the part of Ms Slack. The conduct relates to delays that have occurred in the prosecution of these proceedings. I have considered this request but have not found any behaviour on the part of Ms Slack that can genuinely be regarded as unreasonable or abusive. Nevertheless, the joint opponents have been successful and are entitled to a contribution towards their costs from the published scale. I hereby order Ms Julie A Slack to pay Mr David Abrehart and Mr Timothy Issac the sum of £1500. This sum is calculated as follows:

- a) Preparing a statement and considering the other side's statement - **£500**
 - b) Preparing evidence and considering and commenting on the other side's evidence - **£600**
 - c) Preparing written submissions - **£400**
- Total - **£1500**

31. The above sum should 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 14th day of October 2009

**Oliver Morris
For the Registrar
The Comptroller-General**