

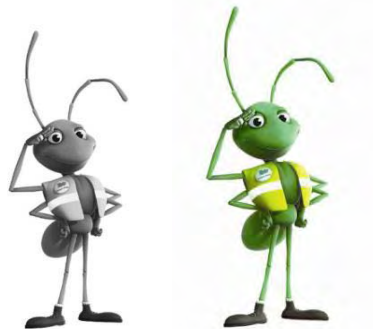
O/334/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
Nos. 2558698 & 2558700
BY GREEN FLAG LIMITED
TO REGISTER THE SERIES OF TWO TRADE MARKS**



**IN CLASSES 9, 16, 18, 25, 28, 36, 37 & 39
AND THE SERIES OF TWO TRADE MARKS**



IN CLASSES 9, 16, 18, 25, 28, 36, 37 & 39

AND

**IN THE MATTER OF THE CONSOLIDATED OPPOSITIONS THERETO
UNDER Nos. 100271 and 100270 BY
GROUPAMA INSURANCE COMPANY LIMITED**

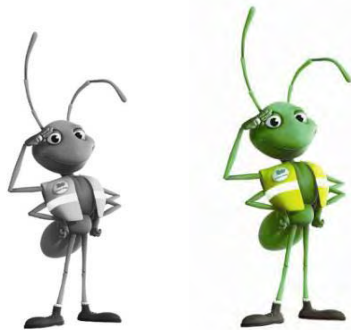
BACKGROUND

1) On 15 September 2010 Green Flag Limited ("Green") applied to register the following two marks both of which consist of a series of two trade marks:

2558698



2558700



2) Both series of trade marks are sought to be registered in respect of the following goods:

Class 9: Computer software; computer applications; computer software, namely, operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; computer programs; handheld and mobile digital electronic devices for the sending and receiving of telephone calls, faxes, electronic mail, video, instant messaging, music, audiovisual and other multimedia works, and other digital data; handheld computers, personal digital assistants, electronic organizers, electronic notepads; telephones, mobile phones; computer hardware and software for providing integrated telephone communication with computerized global information networks; vehicle tracking apparatus; global positioning apparatus and instruments; parts and fittings for all the aforesaid goods.

Class 16: Printed matter; reports; newsletters; stationery; instructional and teaching material; binders; book markers; calendars; coasters; car stickers; printed publications; books; maps; guides, photographs; handbooks; educational publications; catalogues; indexes; manuals; magazines; newsletters; periodicals.

Class 18: Bags, umbrellas, key rings.

Class 25: Clothing, headgear and footwear

Class 28: Games and playthings; toy ants; toy ant key rings.

Class 36: Insurance brokerage (other than ship brokerage); insurance agency services; insurance underwriting services.


Class 37: Motor repair services; vehicle repair services; inspection, repair, maintenance, cleaning and painting of motor vehicles and their parts; installation services for vehicle parts; tyre, exhaust and windscreen fitting services; vehicle service stations; accident management services; sign posting services; vehicle lubrication services; arranging the provision of all the aforesaid services; information and advisory services relating to all aforesaid services.




Class 39: Recovery of vehicles; vehicle towing services; delivery and storage of spare parts for motor vehicles; transport services; travel arrangement services; travel agency; advisory services relating to travel; route planning; agency services for arranging and planning travel; services for the provision of information relating to travel routes, traffic and road conditions and motor and rail transport; services for arranging for the transportation (including the re-patriation from overseas countries) of unwell travellers and their vehicles and their luggage; rescue service for travellers; storage and delivery services, all for spare parts of vehicles; car parking, car rental, bus transport; park and ride services; recovery of land vehicles.

3) Both applications were examined and accepted, and subsequently published for opposition purposes on 8 October 2010 in Trade Marks Journal No.6856.

4) On 7 December 2010, Groupama Insurance Company Limited (“Group”), filed identical notices of opposition, which were consolidated. The grounds of opposition, subsequently amended, are in summary:

a) Group is the registered proprietor of the following trade marks:

Mark	Number	Date of filing and registration date	Class	Specification
	2502142	11.11.2008 / 01.05.2009	36	Insurance; financial affairs; financial analysis; financial evaluations; banking affairs; monetary affairs; real estate affairs; insurance contract management; insurance consultancy, consulting, information and inquiries services for insurance products, savings banks, insurance subscription services; mutual funds; savings services; insurance services provided by means of the Internet; insurance brokerage; reinsurance and return insurance services; insurance underwriting; insurance claims assessment and adjustment services; financial services relating to insurance;

 <p>A series of six marks</p>				<p>services relating to insurance, including help and assistance for policy holders concerning the notification of claims, the assessment and settlement of losses and the settlement of claims; consultancy, advisory and information services relating to all of the aforesaid.</p>
 <p>A series of two marks</p>	2549311	03.06.2010 / 03.09.2010	36	<p>Insurance; financial affairs; financial analysis; financial evaluations; banking affairs; monetary affairs; real estate affairs; insurance contract management; insurance consultancy, consulting, information and inquiries services for insurance products, savings banks, insurance subscription services; mutual funds; savings services; insurance services provided by means of the Internet; insurance brokerage; reinsurance and return insurance services; insurance underwriting; insurance claims assessment and adjustment services; financial services relating to insurance; services relating to insurance, including help and assistance for policyholders concerning the notification of claims, the assessment and settlement of losses and the settlement of claims; consultancy, advisory and information services relating to all of the aforesaid.</p>
			45	<p>Security services for the protection of property and individuals; baby-sitting services; bodyguard services; personal body guarding; safety services; buying of goods on behalf of individuals; personal shopper services; escorting services; guardianship services; house monitoring for absent occupants; house sitting services; pet sitting; key holding services; key returning services; housekeeping services; social work services.</p>

b) Group contends that the marks applied for are similar to the marks shown in their registered marks. They also contend that the goods and services are similar and that their marks have a high reputation in the UK. They contend that the marks in suit offend against Section 5(2)(b).

c) Group also contend that due to their reputation, the relevant public will believe that there is an economic link between the two parties or Green will ride on the coattails of Group and gain benefits associated with a highly reputed and distinctive mark without the associated cost of developing or maintaining such a reputation and thereby gain an unfair advantage from Group's reputation and the distinctiveness of its marks. Further, use of Green's marks may tarnish Group's reputation on account of its involuntary association with third party goods or services which may be of lower quality. This would cause detriment to Group's reputation. Group also contends that due to the high distinctiveness of their marks,

use of the marks in suit by Green may erode the distinctiveness of Group's marks and impair the marks' ability to be instantly recognised as indicating the trade mark origin of Group's services. This will make it less likely that consumers will purchase Group's services and will result in a corresponding change of economic behaviour causing detriment to the opponent's mark. For these reasons the marks in suit offend against Section 5(3).

d) Group contends that they have used the eight signs shown in paragraph a) above in London and throughout the UK since January 2009. They contend that they have used the signs in relation to insurance services and financial services. Group contends that it has accrued goodwill as a result of the use it has made of the eight signs and that use of Green's marks could construe a misrepresentation that Green's goods and services are connected with Group's goodwill. This would cause damage to Group by means of diversion of sales, tarnishment of reputation or erosion of distinctiveness of Group's marks. The marks in suit therefore offend against Section 5(4) (a).

5) On 7 March 2011, Green filed counterstatements which basically denied Group's, and put Group to strict proof in relation to its claims regarding use, goodwill and reputation.

6) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 30 May 2012. At the hearing, Green was represented by Mr Malynicz of Counsel instructed by Messrs Murgitroyd & Company; Group was represented by Mr Wilkes of Messrs Groom Wilkes & Wright LLP.

GROUP'S EVIDENCE

7) Group filed a witness statement, dated 20 September 2011, by James Marchant the Marketing and Communications Director of Group, a position he has held since 2002, having been with the company since 1986. He states that the opponent is a subsidiary of Groupama Group "a well-known European insurance and financial services business. He states the opponent has been trading in the UK since 1999. He states that the range of products includes all common forms of general insurance (including, inter alia, home, car, travel & accident insurance) as well as a range of insurance products specifically for businesses. These are marketed through independent insurance brokers and a growing proportion of the business is carried out online. He states that the website received over 350,000 visits in 2010. The website allows brokers to access quotes and purchase SME insurance products on behalf of their customers online. He states:

"5. The long standing and well-established nature of GICL has also translated to financial success in the UK. Set out below are headline sales figures for recent years."

Year	Revenue £million
2007	408.7
2008	432.6
2009	450.3

8) However, it is not explicitly stated that these figures relate to use of the two marks shown above, a breakdown between the marks is not provided, nor is it clear what goods and services the figures relate to or whether they relate solely to the company's activities in the UK. In the evidence Group's marks are referred to as GiANTS, derived from the figures being the **Group Insurance ants** He also states:

“7. The Groupama GiANTS permeate every part of GICL's marketing and promotions, both offline and online, and are used across the whole GICL brand in relation to all products and communications. In particular, the GiANTS have been used extensively in the promotion of GICL products including most recently the launch of GICL's new “Exclusively Recruitment” and “Exclusively Security” products, which offer insurance to cover business risks for companies operating in the recruitment and security sectors (Exhibit JM3), and GICL's new Optima Business Plus commercial combined insurance product that is traded online with brokers and offers a broad range of different business critical insurances in one easy to access package (Exhibit JM4).”

9) Mr Marchant states that in 2008 Group introduced its brand GiANTS which exemplify Group's key proposition of “big enough to deliver, small enough to care”. He states that Group is “unique in introducing a light hearted and consumer orientated brand icon into the insurance broking market place, which has hitherto been dominated by staid and traditional “business to business” brand messages”. He states that the GiANTS have been used extensively in the promotion of Group's products both on and off line. In particular he points to the extensive use in the recent promotion of new products offering insurance to cover business risks for companies operating in the recruitment and security sectors. Mr Marchant states that his company produces a magazine, Face2Face, three times a year which is sent to insurance brokers to inform them of developments in Group's products. Circulation of print copies and email copies is approximately 6000 for each edition. In addition Group publishes a light hearted magazine called “The Buzz” for its own staff to keep them informed of developments which includes use of the Giants. He states that the GiANTS are also used in a large proportion of email marketing communications to its client base. Between December 2008 and February 2011 over 40,000 emails featuring the ant branding were sent out to insurance brokers.

10) Mr Marchant states that Group has a high profile presence at trade fairs for the insurance profession in the UK. The two key events, the annual conference of the British Insurance brokers Association (BIBA) and the annual conference of the Association of Medical Insurance Intermediaries (AMII) are both attended each year. Since their launch in 2008 the GiANTS have featured prominently at these fairs. The

company has given away GiANT soft toys and in 2010 also developed a computer game featuring them. In addition the company has used the marks on a range of promotional items (see exhibits). Mr Marchant states that his company has spent over £600,000 promoting their marks in the years 2009-2011. This included over £350,000 spent on advertising in the insurance trade press. It is not specifically stated that this relates solely to the UK or to which mark the expenditure relates. He provides a number of examples, however virtually all are after the relevant date. As a result of all of the activities of his company he states:

“It is my belief that the Groupama GiANTS have by now become a well-recognised brand icon among insurance professionals in the UK.”

11) Mr Marchant also provides the following exhibits:

- JM1: extracts from Group’s website which are all dated July 2011. These show bugs or ants in poses other than those registered.
- JM2: Papers relating to the 2009 Insurance Times Award for the insurance marketing initiative of the year. These show use of trade mark No. 2502142 but do not show any use of trade mark No. 2549311.
- JM3: Recent promotion of recruitment and security sector products using images of bugs or ants (GiANTS) some of which are registered. These show use of trade mark No. 2502142 but do not show any use of trade mark No. 2549311. However, none of the pages are dated. The only possible mark that could be a date is shown on page 20, in the fold, where the text “GR204 04-11” appears.
- JM4: This is said to relate to the company’s online access package. However, it would appear to be a leaflet advertising the fact that this will soon be available, as it bears the legend “Optima Business Plus launching soon”. Again none of the pages are dated, although on page 22 the code “GR289 05/11” appears.
- JM5: Copies of Face2Face magazine. The first is dated Summer 2009. In this edition there is a reference to the soft GiANT toys being popular at BIBA. This magazine also refers to the Optima PI Online package for brokers. There are also editions dated Autumn 2009, Winter 2009, Spring 2010, Autumn 2010, Winter 2010 and Spring 2011. I note that the Spring 2011 edition refers to the launching of the Optima Business Plus Online package. All of the above show use of trade mark No. 2502142 but do not show any use of trade mark No. 2549311. They all show that Group offers a range of insurances for businesses via brokers.
- JM6: Copies of The Buzz magazine which is for internal use only.
- JM7: Pictures of the GiANT soft toys which are based upon trade mark No. 2502142. These are not dated.

- JM8: A photograph of a screen at what looks to be an exhibition and print outs from a website providing information regarding the GiANT computer game. None of these are dated.
- JM9: Photographs of Group's presence at BIBA 2009. These show use of trade mark No. 2502142 but do not show any use of trade mark No. 2549311.
- JM10: Photographs of Group's presence at BIBA 2010. These show use of trade mark No. 2502142 but do not show any use of trade mark No. 2549311. It also shows a computer screen with the ANTics computer game.
- JM12: Photographs of Group's presence at AMII 2009. These show use of trade mark No. 2502142 but do not show any use of trade mark No. 2549311.
- JM13: Photographs of Group's presence at AMII 2010. These show use of trade mark No. 2502142 but do not show any use of trade mark No. 2549311.
- JM14-18: These show photographs of various promotional items. Specifically, a Christmas card 2009, a 2011 desk calendar, scribble pads from 2009 and 2011, a phone holder (undated) and a coaster undated. These show use of trade mark No. 2502142 but do not show any use of trade mark No. 2549311.
- JM33: This shows that Group won The Health Insurance Award in 2010.
- JM34: The item is said to be examples of promotional activity showing use of the mark. These show use of trade mark No. 2502142 but do not show any use of trade mark No. 2549311. They do not specify where they were used or when. Only one page has a date upon it and this appears to relate to BIBA 2010.

12) I note that in all of the exhibits, whilst use is made of the six figures registered under 2502142, there is also extensive use of figures which whilst similar are not those registered.

GREEN'S EVIDENCE

13) Green provided a witness statement, dated 21 November 2011, by Natalie Charlick their Trade Mark Attorney. She states that Green's registrations consist of a representation of an ant whereas Group's marks consist of unidentifiable creatures. She then analyses the marks of the two parties in great detail which I shall not summarise here as it is more akin to submissions regarding the similarity of the marks than actual evidence. She also makes a number of criticisms of Group's evidence which do not assist me in my decision. She does make the following points and provides various exhibits:

- The spanner in 2558698 is not a cartoon drawing and is disproportionate to the size of the ant.

- An ant is easily identified by a distinctive node like structure that frames a slender “waist”. Ants have elbowed antennae which naturally fall forward, have six legs, a strong jaw line, and are blind. Group’s creatures she states do not have any of these characteristics and in addition they are striped and do not have any inanimate objects such as tools.
- Green’s marks would naturally be referred to as ants whereas Group’s creatures would be referred to as turtles, bugs or creatures.
- Green’s services are aimed at the public whereas Group’s are aimed at insurance brokers.
- Ants and bugs have been used by a number of organisations in relation to insurance and related services.
- Exhibit NC01: a photograph of a real meat eater ant, which bears only a passing resemblance to either parties marks.
- Exhibit NC05: examples of other insurances being promoted by the use of cartoon or actual images of ants. The cartoons include: Ant Insurance (2006) and the Post Office (2004). Actual images include: RGA Underwriting (2010), NIBC (2007), RAC (2007), Grant Thornton (2006), HSBC (2006), Lloyd’s PLC (2003), AWD plc (2004), Sesame Bankhall Group (2005) and Barclays Bank (2003).

GROUP’S EVIDENCE IN REPLY

14) Group filed a witness statement, dated 21 December 2011, by Kathryn Boyd their Trade Mark Attorney. She provides a number of exhibits but does not say why these have been filed. There is no comment at all regarding their content. I assume that it is to show that creatures such as those in Group’s marks are referred to as ants.

- KB1: A cover of a dvd titled “A Bugs Life”. This shows a creature which has a number of points of similarity to the creatures in Group’s trade mark number 2502142. The dvd was released on December 2010.
- KB2: Further images from the film which show creatures which have a number of points of similarity to both of Group’s marks.
- KB3: A print out from a website which provides the story line to the film and makes it clear that the creatures are intended to be ants, and are identified as such in the film.
- KB4: A screen shot from a Walt Disney film The Grasshopper and the Ants. The ant has a number of points of similarity to the creatures in both of Group’s marks, but also a number of differences.

- KB5: A printout from a website which provides information regarding the film at KB4 and provides a release date of 1934.
- KB6: Screen shots of a computer game called Ant War. This shows a copyright date of 2011, and so is after the relevant date.

15) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

16) At the hearing Group amended its pleadings to exclude its mark 2549311 from its 5(3) and 5(4)(a) pleadings. Mr Wilkes also accepted that there was no similarity between the goods applied for and the services for which the Group's is registered. Therefore, the ground of opposition in relation to 5(2)(b) is withdrawn in relation to the goods applied for in Classes 9, 16, 18, 25 & 28. Mr Wilkes also refined the 5(2)(b) opposition against the services in Classes 37 & 39 by withdrawing the opposition in relation to the following:

In Class 37: inspection, repair, maintenance, cleaning and painting of motor vehicles and their parts; installation services for vehicle parts; tyre, exhaust; vehicle service stations; sign posting services; vehicle lubrication services;

In Class 39: delivery and storage of spare parts for motor vehicles; transport services; travel arrangement services; travel agency; advisory services relating to travel; route planning; agency services for arranging and planning travel; services for the provision of information relating to travel routes, traffic and road conditions and motor and rail transport; storage and delivery services, all for spare parts of vehicles; car parking, car rental, bus transport; park and ride services;

17) Thus the only services being opposed under Section 5(2)(b) are as follows:

Class 36: Insurance brokerage (other than ship brokerage); insurance agency services; insurance underwriting services.

Class 37: Motor repair services; vehicle repair services; windscreen fitting services; accident management services; arranging the provision of all the aforesaid services; information and advisory services relating to all aforesaid services.

Class 39: Recovery of vehicles; vehicle towing services; services for arranging for the transportation (including the re-patriation from overseas countries) of unwell travellers and their vehicles and their luggage; rescue service for travellers; recovery of land vehicles.

18) Mr Malynicz, representing Green, accepted that, in relation to both Group's marks, the services of the two parties in Class 36 were identical for Section 5(2)(b) purposes. I shall first consider the ground of opposition under Section 5(2)(b) of the Act which reads:

"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."

19) An "earlier trade mark" is defined in section 6, the relevant part of which states:

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

20) Group is relying upon its trade marks 2502142 and 2549311 which are clearly earlier trade marks, being registered on 1 May 2009 and 3 September 2010 respectively. Because of the interplay between the date the application was advertised and the dates of registration of Group's marks they are not subject to the proof of use requirements set out in Section 6A of the Act.

21) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by 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 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* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10) Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(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;

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

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

22) In essence the test under section 5(2)(b) is whether there are similarities in marks and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion

must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the services, the category of services in question, how they are marketed, who the relevant consumer is and the nature of the purchasing act. Furthermore, I must compare Green's mark and the marks relied upon by Group on the basis of their inherent characteristics assuming normal and fair use of the marks on the services in their specifications.

23) In the instant case Group has provided turnover and advertising figures. However, it is not clear that these figures relate solely to its activities in the UK. Nor is it clear which trade mark and services these figures relate to, and they have not been put into context of the market for the extensive range of services for which the two marks shown at paragraph 4 above are registered. Both marks are registered for, inter alia, insurance which in the UK is a huge market worth billions, Group's turnover figures appear to be somewhat modest. Nor has Group filed evidence from the trade or independent witnesses. At the hearing Mr Wilkes asked me to consider paragraphs 5 and 7 of the first witness statement of Mr Marchant. He stated that these paragraphs provided the context and that whilst they did not state exactly which country the income was derived in, or which mark it referred to I could infer from the statements that it was all from the UK and in relation to mark 2502142. I declined to make any such inference, and pointed out that it was for Group to state its position clearly. I note that Group is part of a European conglomerate and that it may not be confined in its activities to the UK. In addition it has another mark registered (2549311) and uses other marks (see paragraph 12 above) in its literature. It cannot therefore, in relation solely to mark 2502142, benefit from an enhanced reputation. In my opinion, Group's marks have a high degree of inherent distinctiveness given that the image of a bug or ant is meaningless in relation to the services for which they are registered. However, this distinctiveness has been slightly diluted due to the use of further similar unregistered marks, see paragraph 12 above.

24) As the case law in paragraph 21 above indicates I must determine the average consumer for the services of the parties. I must then determine the manner in which these services are likely to be selected by the said average consumer. Mr Malyincz contended that all of Group's services were supplied to brokers and not to the general public. However, there are no restrictions with regard to the specifications of either party. The average consumer would be those members of the general public who, broadly, require a form of insurance, financial advice, banking, vehicle services or security. This encompasses the majority of the adult population of the UK. The services which could be included within the specifications of both parties vary enormously in terms of price and complexity. Some items for cars such as windscreen wipers, even if installed, are quite cheap and will not be the subject of lengthy consideration. However, other items such life insurance can be very expensive and would be given a great deal of thought. Overall, given the nature of the services I believe that the vast majority of the services covered by the registrations will not be purchased or selected without a reasonable amount of care.

25) I shall now consider the services of the two parties, taking into account the concessions granted at the hearing. I have only put in the Class 36 services once as these are identical in Group's two marks. For ease of reference, I set out the specifications of both parties below:

Green's specification	Group's specification
<p>Class 36: Insurance brokerage (other than ship brokerage); insurance agency services; insurance underwriting services.</p>	<p>Class 36: Insurance; financial affairs; financial analysis; financial evaluations; banking affairs; monetary affairs; real estate affairs; insurance contract management; insurance consultancy, consulting, information and inquiries services for insurance products, savings banks, insurance subscription services; mutual funds; savings services; insurance services provided by means of the Internet; insurance brokerage; reinsurance and return insurance services; insurance underwriting; insurance claims assessment and adjustment services; financial services relating to insurance; services relating to insurance, including help and assistance for policy holders concerning the notification of claims, the assessment and settlement of losses and the settlement of claims; consultancy, advisory and information services relating to all of the aforesaid.</p>
<p>Class 37: Motor repair services; vehicle repair services; windscreen fitting services; accident management services; arranging the provision of all the aforesaid services; information and advisory services relating to all aforesaid services.</p>	<p>Class 45: Security services for the protection of property and individuals; baby-sitting services; bodyguard services; personal body guarding; safety services; buying of goods on behalf of individuals; personal shopper services; escorting services; guardianship services; house monitoring for absent occupants; house sitting services; pet sitting; key holding services; key returning services; housekeeping services; social work services.</p>
<p>Class 39: Recovery of vehicles; vehicle towing services; services for arranging for the transportation (including the re-patriation from overseas countries) of unwell travellers and their vehicles and their luggage; rescue service for travellers; recovery of land vehicles.</p>	

26) As stated in paragraph 17 Green accepts that the services in Class 36 are identical. Group contended:

“Consideration has to be given to the nature of the services of respective interest in the “real world”, and in this regard insurance relating specifically to, say, repair of motor vehicles and recovery of motor vehicles would, in the opponent’s submission, be considered to be a similar service to the insurance per se.

It is, of course, quite usual for companies to insure against repair / breakdown (AA, RAC) and this should be borne in mind when considering the similarity of the services for which the Opponent’s mark is registered vs the services in Classes 37 and 39 for which registration is sought.”

27) Mr Wilkes also pointed out that Green is owned by RBS who are one of the biggest insurers in the UK. He contended that this showed “there is a clear overlap between the insurance of individuals and vehicles and so on and the ancillary services that result from the provision of that insurance”. However, Group did not provide any evidence as to why the services of the two parties should be regarded as similar or complementary.

28) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods 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 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 in the same or different sectors.

29) 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.”

30) The question of complementary goods/services has been considered by the CFI in *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 the CFI stated:



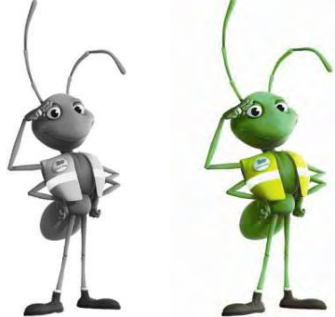
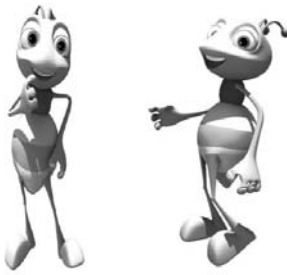
“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057 ; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757 , paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48).”

31) Group identified its strongest case as being its insurance services in Class 36 being compared to the Class 37 and 39 services of the applicant. I do not accept Mr Wilkes contention regarding the AA or RAC because these are typical insurance companies. Firstly, Group has not provided any evidence of the activities of either organisation. If I take judicial notice of their existence and activities I must also reflect that they both started life as motoring organisations offering mechanical assistance at the roadside to members of the respective club. They gradually branched out to offer other services such as insurance. The vast majority of insurance companies do not offer roadside assistance; at best they offer free membership to the AA, RAC or similar organisation such as Green. I note that whilst it is claimed that the parent company of Green sells insurance it was stated at the hearing by Group that it does so under its name RBS, I therefore fail to see the relevance of the submission because the consumer is unlikely to be aware of company ownership of businesses that he deals with unless it is specifically pointed out in marketing. No evidence has been adduced to this in the instant case.

32) Clearly, insurance services covers the selling of car insurance and I accept that such policies include the payment for repairs to all parts of a vehicle and that they can include the payment for recovery of both the vehicle and also the driver and passengers even if they are abroad. Therefore, the users of Group’s insurance services and the various vehicle repair and recovery services offered in Classes 37 and 39 by Green may be the same. However, the uses of the two sets of services are different. One does not require an insurance company in order to get a vehicle repaired or recovered or vice versa and so the trade channels are also different. Nor can they be said to be competitive with each other. Whilst it is true that there is a close connection between the selling of motor insurance and the various repair and recovery services offered by the applicant it cannot be said that *one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking. An insurance policy is simply a method of ensuring that the repairs/recovery can be paid for. The average consumer will not expect the insurance company to actually be responsible for carrying out these functions, the average consumer will be aware that such functions will be carried out by other commercial entities, skilled in the relevant field with the insurance company simply providing the necessary means to pay for their services.

33) In conclusion Green has accepted that the Class 36 services of both Group's marks are identical to the Class 36 services it is seeking to register. In my opinion, Group's services in class 36 are not similar to Green's services in either class 37 or class 39. Nor are the services complementary. Group did not offer any submissions regarding its Class 45 services and in my opinion this was very wise as they are clearly dissimilar to the services sought to be registered.

34) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Green's Trade Marks	Group's Trade Marks
<p data-bbox="224 600 349 632">2558698</p> 	<p data-bbox="789 600 914 632">2502142</p> 
<p data-bbox="224 1106 349 1138">2558700</p> 	<p data-bbox="789 1106 914 1138">2549311</p> 

35) Group referred me to Case O/354/01 where the Hearing Officer said:

“31) I believe that this case is one where the words of Evershed J. in *Smith and Hayden Co.’s Application* (1946) 63 R.P.C. 97 at 102 are particularly relevant:

“When all is said, the question is in truth, as observed by Lord Justice Luxmore and the House of Lords in the *ARISTOC* case, one of first impression, on which no doubt different minds may reach different conclusions. It is not profitable in

such a case to indulge in a minute analysis of letters and syllables, a process indeed notoriously productive of confusion in regard to words.”

32) Although this case was determined under the 1938 Act and was concerned with “word” marks, the views are still relevant when considering cases under the 1994 Act and device marks.”

36) Group also referred me to Case O511/02 *Lacoste v Alligator Books* where the Hearing Officer said:

“38. What reptile is represented in ABL’s trade mark? This argument strikes me as being artificial to the extreme. My considerations relate to the average consumer of the relevant goods. The average consumer is not an expert on reptilian biology. The average consumer, in my view, will see the word alligator inside the drawing in ABL’s trade mark and assume that the word describes the picture. He or she is not likely to consider whether the stylised drawing is closer to that of an alligator or a crocodile; he or she is unlikely to know what the differences are and unlikely to care. If the word says its an alligator it’s an alligator. Equally the average consumer is not likely to know whether LCL’s reptile is an alligator or a crocodile from the representation. LCL describe it as a crocodile emblem but without other information there is no reason for the average consumer to know that it is not an alligator. There has been no evidence filed to show that the public would see the reptile as an alligator or crocodile. It might be that LCL have educated the public to see the emblem as a crocodile, however, I do not have any evidence of this before me.

39. This debate is a fruitless and sterile exercise.”

AND:

“78) ABL has made a lot of play of having used its trade mark without confusion having arisen. As I stated above this tells me nothing and shows me nothing. For this to have relevance it would be necessary to show that LCL has put its trade mark into the market place for the class 16 goods for which it is registered. No evidence of such use has been put forward. This case brings to mind *Origins Natural Resources Inc v Origin Clothing Limited* [1995] FSR 280 and the comments of Jacob J in that case:

“It sticks in one's gullet to think that a trade mark proprietor is better off *vis-à-vis* a competitor claiming honest concurrence because he has not used his mark than if he has.”

The absence of evidence of use by LCL means that LCL is in a potentially better position than if use of its trade mark for class 16 goods had been shown. Then an absence of confusion in the market place would have to be taken into account in the global appreciation.”

37) Green referred me to *Sabel BV v Puma AG (C251/95)* [1998] RPC 199 where Advocate-General Jacobs said:

“60. Secondly, the Bundesgerichtshof seeks to establish whether, as a matter of principle, it can base a finding of a risk of confusion upon the mere fact that 'the two signs coincide as to their signification (in this case, a bounding feline beast of prey)'.

61. It seems to me that if two pictorial marks convey the same idea, there might be circumstances in which, even if the registered mark is not well known and even if the two images are drawn as differently as possible, the public might nevertheless confuse the two marks. For example, a trade mark might consist of an unusual invented image, or an unusual combination of natural images, such as, respectively, a puma playing a violin or a puma grouped with a snake and a bird. I do not consider it unreasonable for such marks to be protected under trade-mark law against reproductions of the concept which they convey, however differently the competing marks might be drawn.

62. It is arguable that cases in which the similarity of two marks is purely conceptual should be left to Member States' unfair competition laws. I see no reason however for construing the Directive as excluding conceptual similarity from the scope of trademark protection. All the Directive requires is that there be a likelihood of confusion as a result of the similarity of the marks. The Directive does not purport to limit the ways in which that confusion might arise. Moreover, trade-mark protection in respect of conceptual similarity does not appear to be uncommon amongst Member States. However, it seems to me that it will be difficult to establish the likelihood of confusion on the basis of conceptual similarity alone in circumstances in which the earlier mark is not well known, particularly when, as here, the image in question is not particularly creative or unusual.

63. I accordingly conclude, in answer to the first part of the question referred, that a finding of a likelihood of confusion may be based on the fact that the ideas conveyed by the pictorial elements of two trade marks are similar, provided that it is established that there is a genuine and properly substantiated likelihood of confusion about the origin of the goods or services in question.”

38) It is clear from the evidence that Group has provided its services solely to insurance brokers and that all of its promotional material has been sent to brokers. There is no evidence that any members of the general public have come into contact with Group's mark 2502142. But it is the general public whom I must consider as they are the average consumer for the services of the two parties. Therefore, group's mark No. 2502142 cannot be regarded as being well known to the relevant public. At the hearing it was accepted that Group had not, prior to the relevant date, used its mark No. 2549311.

39) Green's mark 2558698 consists of the same two images, one being in colour the other being in black and white. The colour image shows a green insect dressed in a sleeveless fluorescent jacket which has a horizontal white stripe, with black work boots and holding an oversized adjustable spanner. The jacket has a badge with what appears to be writing upon it but in normal size it is not readable. The insect has two large, thin antennae which do not vary in thickness. It is standing upright on two legs whilst holding the spanner with four arms which emerge from the body and have distinct fingers. The eyes are quite small and there is an obvious mouth which is curved up depicting a smile.

40) Green's mark 2558700 consists of the same two images, one being in colour the other being in black and white. The colour image shows a green insect dressed in a sleeveless fluorescent jacket which has a horizontal white stripe, with black work boots. The jacket has a badge with what appears to be writing upon it but in normal size it is not readable. The insect has two large, thin antennae which do not vary in thickness. It is standing upright on two legs, with three of its arms on its waist whilst one arm is saluting. All the arms emerge from the body and have distinct fingers. The insect has an egg shaped segment attached to its waist sticking out at the back. The eyes are quite small and there is an obvious mouth which is curved up depicting a smile.

41) Group's mark 2502142 consists of six colour images. The insects depicted have a green and yellow body, a band of orange around their neck and two orange antennae which are initially thin but end in a ball. The insect has two legs which end in thick rounded feet and two arms which emerge from its neck and have distinct fingers. The head is very large and round, has an oversized eye and no mouth. In each mark the insect is in a different pose, running, sitting etc with the arms, legs and head in different positions.

42) Group's mark 2549311 consists of two grey images of an insect. Both have striped bodies with two legs ending in thick rounded feet, two arms which emerge from its neck and have distinct fingers, a shaped head with overly large eyes, an open mouth showing teeth and two antennae which are initially thin but end in a ball. Each insect is standing, in one instance with one arm on its waist and the other to its mouth, in the other both arms are raised to chest height.

43) Visually, the only similarity is the fact that the respective marks are all insects, all other elements are totally different. Overall, the differences far outweigh any similarity. Aurally, the images cannot be pronounced and so this element does not come into play. Conceptually, they are all insects. However, Group's marks are striving towards what might be considered cute insects as they have a babyish quality with the overly large eyes, and the playful poses. In contrast, the jacket and boots worn by Green's insects puts one in mind of a worker ant.

44) The similarities between the marks of both parties rest purely on the conceptual impression that they are all insects. I accept that conceptual similarities can outweigh visual and aural differences (*Picasso*), however in my opinion, taken overall there are a

large number of differences between the both parties' marks which far outweigh the similarities.

45) When determining whether there is a likelihood of confusion I have to take a number of factors into consideration. There 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. I must consider whether group's trade marks have a distinctive nature, the average consumer for the services, the nature of the purchasing process and the issue of imperfect recollection. I must also take into account that these services will not be chosen without a reasonable amount of care. In the instant case Group's marks have a high degree of inherent distinctiveness. It is accepted that the services in Class 36 are identical, however, even in respect of these services the differences between the trade marks are such there is no likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) fails.

46) I shall now turn to consider the ground of opposition under Section 5(3) of the Act which states:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in 3 the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

47) The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] RPC 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, C.A. *Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484 *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00 and, more recently *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7. Guidance in relation to reputation under Section 5(3) has been set out in *General Motors Corporation v Yplon SA* in paragraphs 23 to 27. Paragraphs 26 & 27 indicate the standard that must be reached:-

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

48) The onus is upon an opponent to prove that its earlier trade mark enjoys a significant reputation or recognition by a significant part of the public and it needs to furnish the evidence to support this claim. I have outlined the issues with the evidence which Group have filed (see paragraphs 23 above). Group have failed to provide any credible evidence of use of the marks relied upon or reputation in the UK at the relevant date. To my mind Group has failed to clear the first hurdle, and so the opposition under Section 5(3) fails.

49) I now turn to consider the ground of opposition under Section 5(4)(a) which reads:

“5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

50) In deciding whether the marks in question offend against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

51) Earlier in this decision I found that use of the marks in suit, actual or on a fair and notional basis would not result in confusion with Group's marks. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act must fail.

CONCLUSION

52) The opposition has failed under all grounds.

COSTS

53) Green has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement x2	£600
Preparing evidence and considering the other sides evidence	£1200
Preparing for and attending a hearing	£1000
TOTAL	£2800

54) I order Groupama Insurance Company Limited to pay Green Flag Limited the sum of £2800. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated the 7th of September 2012

**George W Salthouse
For the Registrar,
the Comptroller-General**

