

O-073-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2590239  
BY  
PAUL OLDRIDGE  
TO REGISTER THE TRADE MARK**



**IN CLASS 45**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 102893  
BY  
VERITAS INTERNATIONAL CONSULTANCY LIMITED**

## Background and pleadings

1. Paul Oldridge applied for the following trade mark on 4 August 2011:



2. The application was published in the *Trade Marks Journal* on 21 October 2011, following which it was opposed by Veritas International Consultancy Limited (“the opponent”).

3. The following services are applied for, all of which are opposed:

*Class 45: Advisory services relating to security. Advisory services relating to the security of business premises. Advisory services relating to the security of households. Advisory services relating to the security of premises. Consultancy services relating to security. Provision of security alarm monitoring services. Public events security services. Security advisory services. Security services. Security services for buildings. Security assessment of risks relating to the guarding of persons. Security assessment of risks relating to the guarding of property. Security guard services.*

4. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)<sup>1</sup>, which states:

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

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<sup>1</sup> The opposition was originally also brought under sections 5(3) and 5(4)(a) but these were struck out because the opponent did not file evidence.

(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.”

5. The ground is based upon all the services of the opponent’s four earlier registered trade marks:

(i) 2538179

VERITAS

*Class 45: Close personal protection services; super yacht security services; supply of armed on-board counter-piracy teams for the vessels transits through known piracy/hostile waters.*

Date of application: 5 February 2010

Date of completion of registration procedure: 5 August 2011

(ii) Community Trade Mark (“CTM”) 8863301

VERITAS

*Class 45: Close personal protection services; super yacht security services; supply of armed on-board counter-piracy teams for the vessels transits through known piracy/hostile waters.*

Date of application: 5 February 2010

Date of completion of registration procedure: 13 July 2011

(iii) 2538176



*Class 41: Provision of training in relation to the security of property and individuals; arranging and conducting workshops, seminars, and conferences in*

*relation to the security of property and individuals; security awareness training; team building training; self defence training.*

*Class 45: Security services for the protection of property and individuals; security consultancy; security advisory services; personal body guarding; chaperoning; security guard services; missing person investigations; security surveillance services; aircraft security services; maritime security services; provision of on-site security facilities; provision of security information; assessment of risks for security purposes; crisis management services; public events security services; personal background investigations; employment screening services; baggage inspection for security purposes; passenger security screening.*

Date of application: 5 February 2010

Date of completion of registration procedure: 5 August 2011

(iv) CTM 8863441



*Class 41: Provision of training in relation to the security of property and individuals; arranging and conducting workshops, seminars, and conferences in relation to the security of property and individuals; security awareness training; team building training; self defence training.*

*Class 45: Security services for the protection of property and individuals; security consultancy; security advisory services; personal body guarding; chaperoning; security guard services; missing person investigations; security surveillance services; aircraft security services; maritime security services; provision of on-site security facilities; provision of security information; assessment of risks for security purposes; crisis management services; public events security services; personal background investigations; employment screening services; baggage inspection for security purposes; passenger security screening.*

Date of application: 5 February 2010

Date of completion of registration procedure: 22 June 2011

6. The opponent states that Mr Oldridge's mark contains its word-only VERITAS marks. It also claims VERITAS to be the dominant distinctive element in Mr Oldridge's mark and its composite marks. It claims that the services are the same or very similar and that there would be a likelihood of confusion.

7. Mr Oldridge filed a counterstatement in which he denies both that the marks are similar and that the services are similar. He claims that the only similarity is the word VERITAS which is "an ordinary noun in common usage. It is frequently in company and trading names." Mr Oldridge states that there has been no confusion in the marketplace since he started trading using his mark, in 2008, because his services are "a man in a van with a dog" security services, whilst the opponent's security services are armed protection for super yachts and "other high value individuals/items". He denies that there would be any confusion between his services and the services of the opponent.

8. Mr Oldridge filed evidence and the opponent filed written submissions. The matter then came to be heard before me on 22 January 2013 when Mr Oldridge was represented by Mr Jonathan Compton of AWB LLP. The opponent chose not to attend and to rely upon the written submissions which it had already filed which, of course, I bear in mind in making this decision.

#### **Mr Oldridge's evidence of fact**

9. Mr Oldridge states that he is a company director and company secretary of Veritas Security Southern Limited. For the most part, Mr Oldridge's statement is comprised of his opinion, rather than facts, as to the dissimilarities between the marks and the services each party offers to clients. Mr Oldridge exhibits (PO1) the results of searches he undertook on Google on 18 July 2012 which he states show that VERITAS is common in trade marks and trade names. He found VERITAS Symantec, Veritas Tools, Veritas Partnership Limited, Bureau Veritas, The Veritas Forum, Veritas Publication, The Official Website of the Veritas Political Party, and Veritas Asset Management. Mr Oldridge also did a search for VERITAS and SECURITY, whereupon he found that the opponent was listed as the second entry and Mr Oldridge's company was listed third, fourth, fifth, sixth, ninth and tenth.

10. Mr Oldridge states:

"My company business consists of bulk, low end commercial property guarding; what might be termed as 'a man, a van and a dog'. No one would hire my company to guard a Super Yacht. Neither my employees nor my company are trained or equipped to provide Super Yacht or anti-piracy services."

Mr Oldridge states that in 2011 his company signed 104 contracts and that 97% of his clients were won through a combination of his sales team cold calling on

construction sites and repeat business, turning over £1,661,615.77. His company's clients are housing developers, demolition companies and liquidators of companies being wound up. The company guards construction sites, empty buildings and commercial premises. About 1% of the business involves private individuals/residential premises. Mr Oldridge states that his company does not employ any ex-special forces and that 11% of his staff have had some basic previous military experience. Mr Oldridge states that his company does not provide any personal or close protection of individuals or super yachts and his staff do not transit piratical waters. The company advertises through Yell.com and its website. Mr Oldridge states that, in contrast, the opponent markets itself heavily on its military training and gives particular emphasis to its employment of ex-special forces personnel. Extracts from the parties' websites are exhibited to show this. Page 8 of the exhibit, from the opponent's website, says:

"Veritas are industry leaders, making us the best choice for Superyacht Security, Security Services and Executive Protection."

## Decision

11. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union ('CJEU'): *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, *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)*. 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 for the goods/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 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*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(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*,

(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*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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*.

### Comparison of services

12. The earlier marks are not subject to the proof of use of provisions because they had been registered for less than five years at the date on which the application was published<sup>2</sup>. This means that the services for which the opponent's marks are registered must be considered upon the basis of notional

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

and fair use of its marks for the full range of services for which it is registered. A substantial proportion of Mr Oldridge's evidence and Mr Compton's submissions at the hearing were devoted to demonstrating differences between the use Mr Oldridge has made of his mark compared to the opponent's use, emphasising that the different actual uses of the parties' marks will not lead to a likelihood of confusion. Mr Compton stressed that the opponent is a specialist company offering super yacht security in piratical waters and executive protection of individuals, whereas Mr Oldridge provides, as set out in his evidence, site security services for commercial premises and construction sites, using "a man and a van and a dog". In *Och-Ziff Management Europe Limited and another v Och Capital LLP and others* [2010] EWHC 2599 (Ch), Arnold J said:

"76. It is common ground that it is now clear that there is an important difference between the comparison of marks in the registration context and the comparison of mark and sign in the infringement context, namely that the former requires consideration of notional fair use of the mark applied for, while the latter requires consideration of the use that has actually been made of the sign in context."

As these proceedings are concerned with an opposition to an application to register a trade mark, rather than infringement proceedings, it is notional and fair use across both parties' specifications which must be the basis for the assessment, and not the use made by the parties of their marks. Section 5(2)(b) is concerned with whether there is a likelihood of confusion, not what has actually happened. I have to consider what is in the specification entered on the statutory application form, not what is on the parties' websites and in their company literature. Assessing levels of similarity between the parties' goods and services is ultimately a question of trade mark law, for the decision-taker to decide.

13. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

"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 intended purpose and their method of use and whether they are in competition with each other or are complementary."

14. 'Complementary' was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-325/06:



“82 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...”.

Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

15. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

“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.”

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

16. The parties’ specifications are:

<b>Opponent’s registered services</b>	<b>Mr Oldridge’s applied for services</b>
<p data-bbox="235 1516 646 1549"><u>2538179 and CTM 8863301:</u></p> <p data-bbox="235 1583 795 1766">Class 45: <i>Close personal protection services; super yacht security services; supply of armed on-board counter-piracy teams for the vessels transits through known piracy/hostile waters.</i></p>	<p data-bbox="824 1516 1380 1873">Class 45: <i>Advisory services relating to security. Advisory services relating to the security of business premises. Advisory services relating to the security of households. Advisory services relating to the security of premises. Consultancy services relating to security. Provision of security alarm monitoring services. Public events security services.</i></p>

<p><u>2538176 and CTM 8863441:</u></p> <p>Class 41: <i>Provision of training in relation to the security of property and individuals; arranging and conducting workshops, seminars, and conferences in relation to the security of property and individuals; security awareness training; team building training; self defence training.</i></p> <p>Class 45: <i>Security services for the protection of property and individuals; security consultancy; security advisory services; personal body guarding; chaperoning; security guard services; missing person investigations; security surveillance services; aircraft security services; maritime security services; provision of on-site security facilities; provision of security information; assessment of risks for security purposes; crisis management services; public events security services; personal background investigations; employment screening services; baggage inspection for security purposes; passenger security screening.</i></p>	<p><i>Security advisory services. Security services. Security services for buildings. Security assessment of risks relating to the guarding of persons. Security assessment of risks relating to the guarding of property. Security guard services.</i></p>
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17. Services can be considered as identical when the services of the earlier mark are included in a more general category, included in the trade mark application; as per the judgment of the GC in *Gérard Meric v OHIM* Case T-133/05. Also, if the services of the application are included in a general category of the services of the earlier mark, they must be identical. At the hearing, Mr Compton referred to Mr Oldridge’s witness statement which lists, at paragraph 20, the “proposed wording for the class 45 registration” (i.e. Mr Oldridge’s list of services in his application). The list in the witness statement does not include *security services* at large, which appears in the specification entered on the trade mark application form<sup>3</sup>. This is an ‘umbrella term’ which catches all of the opponent’s services, because they are all security services and so these services are identical to the services of the earlier registration. *Security services* also covers many of the terms in class 45 of the opponent’s composite mark

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<sup>3</sup> Form TM3.

registrations, which gives rise to identity. It is necessary to consider the specifically identified services of the application.

18. The opponent's specifications can be divided into pairs. The word-only marks VERITAS have been registered for the narrower specifications, and the composite marks are registered for the wider specifications. I will look at each of the terms in the application, individually or in categories.

19. *Security assessment of risks relating to the guarding of persons*

The nature of assessment differs to the actual security service, which is the provision of protection. *Security assessment of risks* is closely linked to the purpose of close personal protection services, i.e. to determine and provide the appropriate protection for the person. The channels of trade will be identical and the services are highly complementary, with the same users. They are **highly similar**.

20. *Security guard services*

The opponent's *close personal protection services* will include the provision of security guards to undertake the services; security guards may be included as an element of *super yacht security services*; and *supply of armed on-board counter-piracy teams for the vessels transits through known piracy/hostile waters* will, by definition, be the supply of security guards who are armed. The respective services must be considered to be **identical**.

21. *Advisory service relating to security. Consultancy services relating to security. Security advisory services.*

These services are the provision of advice or consultancy relating to security (without limitation to the type of security). The nature of advice differs to the actual security service, which is the provision of protection. The purpose of security advice and consultancy is closely linked to the purpose of the security service itself, i.e. to determine and provide the appropriate protection. The channels of trade will be identical and the services are highly complementary, with the same users. They are **highly similar** to the opponent's services *close personal protection services; super yacht security services; supply of armed on-board counter-piracy teams for the vessels transits through known piracy/hostile waters*.

22. *Security services for buildings.*

There is some similarity in nature and purpose with the opponent's services in that they are all security services, however the type of property which is the subject of security differs between the two parties. In Mr Oldridge's case, it is buildings as opposed to security for super yachts and close personal protection.

Buildings are undefined; they could be private homes, mansions, exclusive banks, nightclubs, hotels, and so on. The users could be the same, and the channels of trade the same (i.e. a consumer needing high security would go to the same security service provider). There is a **good level of similarity** between the parties' services.

23. *Advisory services relating to the security of business premises. Advisory services relating to the security of households. Advisory services relating to the security of premises.*

The nature of advice differs to the actual security service, which is the provision of protection. The purpose of security advice is closely linked to the purpose of the security service itself, i.e. to determine and provide the appropriate protection, whether for super yachts or stately homes, or exclusive business premises. The provision of security for super yachts will entail the provision of advice as to the security itself. The users of the parties' services could be the same, and the channels of trade the same (i.e. a consumer needing high security would go to the same security service provider). There is a **good level of similarity** between the parties' services.

24. *Public events security services.*

There is less similarity here with the nature of the opponent's services. Security at public events will entail, e.g. crowd control and searching of bags. However, there will be an element of close personal protection involved at a public event (e.g. a rock concert or award ceremony) where celebrities are present so that the same security provider will provide public events security and close personal protection. In this respect, there are shared channels of trade and an element both of competition and complementarity. There is a **reasonable level of similarity** here.

25. *Provision of security alarm monitoring services.*

Security services for super yachts will entail, as a necessity, the monitoring of security alarms. These services are **identical** to the opponent's *super yacht security services*.

26. *Security assessment of risks relating to the guarding of property.*

Super yachts are property. As for the comparison of advice and consultancy services, above, the purpose of security advice and consultancy is closely linked to the purpose of the security service itself, i.e. to determine and provide the appropriate protection. The channels of trade will be identical and the services are highly complementary, with the same users. They are **highly similar** to the opponent's services.

27. In relation to the opponent's wider specifications (for the composite earlier marks), all of the parties' terms are **identical** in wording or scope (as said earlier, Mr Oldridge's *security services* are identical to many of the services in the class 45 specification of the earlier composite marks):

<b>Opponent's services</b>	<b>Mr Oldridge's services</b>
<i>Security consultancy; security advisory services</i>	<i>Advisory services relating to security. Advisory services relating to the security of business premises. Advisory services relating to the security of households. Advisory services relating to the security of premises. Consultancy services relating to security. Security advisory services.</i>
<i>Security services for the protection of property and individuals; security guard services;</i>	<i>Provision of security alarm monitoring services. Security services. Security services for buildings. Security guard services.</i>
<i>Public events security services.</i>	<i>Public events security services.</i>
<i>Assessment of risks for security purposes;</i>	<i>Security assessment of risks relating to the guarding of persons. Security assessment of risks relating to the guarding of property.</i>

Average consumer and the purchasing process

28. Mr Oldridge's witness statement includes the following submission:

"34. The Opponent submits at page 4 of its submissions of 13 July;

'When considering the range and complexity of the various security services offered under the Marks, it is inevitable that the average consumer's level of attention will vary depending on the cost and nature of the specific services being selected.'

35. I respectfully agree that this represents good and straight forward common sense so far as it goes. However, I submit that the Opponent's clients are anything but average. Average consumers do not own Super Yachts, engage pirates in hostile waters or indeed require armed personal protection with armed guards. The Opponent (perhaps in tacit recognition of this point), has not given a client base profile or any information of its client base. I submit that where, in the case of the Opponent, the physical wellbeing of the client or high value asset is placed in high risk

environments sometimes outside of the jurisdiction, consumers in the relevant market will take significant care prior to contact. On average, and by way of contrast, pre-contract negotiations for my company take 2-3 days. No evidence of periods of pre contractual negotiations is adduced by the Opponent.”

29. Professor Ruth Annand, sitting as the appointed person in *eBay Inc v. Prescription Marketing Limited*, case BL O/011/12<sup>4</sup>, referred to the average person in the following terms:

“39. The “average consumer” in trade marks law is a notional person who is deemed to be reasonably well-informed and reasonably observant and circumspect (Case C-210/96, *Gut Springenheide and Tusky* [1998] ECR I-4657, para. 31). He is fashioned according to the market sector for the goods or services concerned. His level of attention may vary according to the category of goods or services in question. Further, the average consumer rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind (Case C-342/97, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* [1999] ECR I-3819, para. 26).”



30. The average consumer is therefore a legal construct. I must determine the identity and level of attention of the average consumer on the basis of the notional and fair use of the services listed in the specifications. The average consumer for some services notionally covered by both parties’ specifications, such as domestic security, personal property security and personal security, will be the general public; however, for other types of security services, it will be business professionals. Security is a serious matter and its purchase will necessitate a close level of attention, although this will vary depending on the value of the property or occasion and/or the level of risk attached to the situation. In some cases the level of attention will be very high; in others, it will be of a reasonable level. The purchasing process will be primarily visual as research will be undertaken before commitment is made, although I do not ignore the potential for an aural dimension to the purchasing process, such as through personal recommendation (I note that Mr Oldridge’s evidence refers to cold calling).

#### Comparison of trade marks

31. The marks to be compared are:

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<sup>4</sup> Published on the IPO website.

Opponent's marks	Mr Oldridge's mark
<p>(i) VERITAS</p> <p>(ii)</p> 	

32. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. There is only one component in the opponent's word only mark, VERITAS; this is the dominant and distinctive component of the word-only mark. The opponent's composite mark is comprised of two elements: the device which looks like a V, which is intersected by the large component VERITAS. Although the V device is distinctive and prominent in the mark, the eye is drawn immediately to the central word component. It is this which is the more dominant and distinctive of the two components.

33. Mr Oldridge's mark is comprised of the words VERITAS SECURITY SOUTHERN which appear at the top of a shield which is held by two heraldic lions, one either side of the shield. The lions are prominent. The shield is central to the mark and the words are superimposed upon the shield. The words are proportionately smaller in the mark compared to the lions and the shield. However, they are the central component and the eye is drawn to them. The words SECURITY and SOUTHERN will be perceived as descriptive references to the nature and geographical location of the services. VERITAS is more distinctive than the lions, which are in common heraldic form. The lions and the word VERITAS are the most dominant of the elements in the mark. Although it is smaller than the lions, VERITAS will be seen as an invented word, is at the centre and top of the mark and is the mark's most distinctive component. It is a dominant and distinctive component.

34. The claim to the colour orange, as recorded on the details for the opponent's mark on the Community trade mark register, makes no difference to the visual

similarity because Mr Oldridge does not claim that his mark has colour as a feature (the opponent's UK registered composite mark makes no claim to colour). This means that I should compare it as though it were also in the colour of the registered mark<sup>5</sup>. Colour is therefore not an issue which affects the comparison of the trade marks. There is a good level of visual similarity between the opponent's word-only VERITAS mark and Mr Oldridge's mark on account of the opponent's single element mark being the central distinctive element of Mr Oldridge's mark to which the eye is naturally drawn. There is also a good level of aural similarity; notwithstanding the fact that there are three words in the application, VERITAS is the only word in the opponent's mark and is the first word of Mr Oldridge's mark. In relation to the opponent's composite mark, there is also a good level of aural similarity on the same basis; the 'V' device is not likely to be enunciated. There is more distance between the opponent's composite mark and the application than is the case for the opponent's word-only mark because of the additional 'V' device. However, the word VERITAS is a prominent and central element and there is still a reasonable level of visual similarity. Mr Oldridge states in his counterstatement that the capital S makes a difference. Although the final S in VERITAS is a capital, rather than a lower case S, I do not consider that this would attract notice, partly because there is no space before the S, and so the word would still be seen as VERITAS, rather than Verita S.

35. Mr Oldridge claims that VERITAS is an ordinary noun in common usage. The opponent submits that it is known to be the Latin word for 'truth'. It is not an ordinary noun in the English language and is not an ordinary noun in common usage. It is also highly unlikely that, unless schooled in Latin, the average consumer would either know it means truth in Latin or see any evocation of the Latin word for truth. The opponent's marks therefore have no meaning and VERITAS will be seen by the average consumer in the UK as an invented word. It follows that it will also be seen as an invented word in Mr Oldridge's mark. The

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<sup>5</sup> In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J stated: "119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course."



words SECURITY and SOUTHERN will be seen as descriptors with obvious meanings. In comparison with one another, the marks are conceptually neutral as they are both centred upon the word VERITAS, which has no meaning. (Of course, if the meaning of veritas was known to the average consumer for the service, there would be a degree of conceptual similarity which would bring the respective trade marks closer together.)

#### Distinctiveness of the earlier marks

36. It is necessary to consider the distinctive character of the opponent's marks because the more distinctive they are, either by inherent nature or by use (nurture) the greater the likelihood of confusion<sup>6</sup>. The opponent has not filed evidence of use, so there is only the inherent distinctive character position to consider. Mr Compton submitted that the prevalence of VERITAS in company and trading names means that there is nothing distinctive or extraordinary about the word. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public<sup>7</sup>. The earlier marks consist of or contain VERITAS which will be seen as an invented word. Unless VERITAS is commonly used to describe or allude to aspects of security services provided by other traders, it is not relevant to the assessment that other entities use the word in company and trading names<sup>8</sup>. The marks have no meaning and therefore do not describe or allude to any aspect of the services for which they are registered. The word-only mark is high in distinctive character and, in the case of the composite mark, even more so, owing to the presentation of the word VERITAS with the v device.

#### Likelihood of confusion

37. Mr Oldridge states that he is unaware of any instances of confusion between the parties' marks since his company began use of its mark in 2008. Absence of confusion has been the subject of judicial comment and a registry tribunal practice notice, TPN 4/2009. There must be evidence to suggest that the

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<sup>6</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>7</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

<sup>8</sup> See, by analogy, *Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch) Floyd J. "29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c)."

relevant public has shown that it distinguishes between the parties' services. Mr Oldridge's evidence is centred on what he calls "a man with a van and a dog" security services and that the opponent provides specialist security services for super yachts and high value property and individuals. A similar argument was run in *OAO "Alpha-Bank" v. Alpha Bank A.E.* [2011] EWHC 2021 (Ch). Briggs J said in that case:

"33: The final part of the Appellant's case on appeal was directed to a challenge to the Hearing Officer's rejection of the case advanced before him, namely that there was sufficient evidence of prolonged side by side trade without confusion to undermine his affirmative decision that there was a reasonable likelihood of confusion.

34. The parties had indeed traded side by side in London for at least six years. The Respondent adduced, in particular in the second affidavit of Mr Waghorn, evidence of a small number of instances of actual confusion, while the Appellant's witnesses advanced general assertions as to its absence, albeit from a standpoint in Russia which did not on its face appear to confer significant weight upon those assertions as evidence.

35. The Hearing Officer's analysis at paragraph 83 of the Decision was that concurrent use or coexistence of the marks within the UK would only give rise to evidence probative of the absence of confusion if he could be:

"satisfied that the effect of concurrent trading has been that the relevant public has shown itself able, in fact, to distinguish between services bearing the marks in question i.e. without confusing them as to trade origin. That implies that both parties are targeting an approximately similar, or at least overlapping, audience. This is not the case here. As Ms Maddox was at pains to point out, OAO is only actually trading as a broker of Russian and CIS countries' securities where its customers are institutional investors such as high street banks, investment banks and pension funds. On the other hand, I have found ABAE is providing retail banking, investment services and property loans. As ABAE makes clear, the majority of its customers are Greek nationals in the UK. Even in respect of ABAE's investment bank services, the evidence does not show any overlap with OAO's narrowly defined customer base. There is no evidence that ABAE has any institutional customers of the type that utilise OAO's services."

36. Mr Malynicz offered no persuasive challenge to that analysis. It was fully supported by the evidence, and I consider that the Hearing Officer was entitled to treat the absence of any overlapping audience as a sufficient reason to reject the concurrent use defence being advanced by the Appellant. The confusion issue which section 5(2) of the Act requires

to be answered depends upon a comparison between the competing marks, and a comparison between the specification for which registration is sought, and the specification established by way of genuine use by the proprietor of the earlier mark, under section 6A(6). It is in that respect no answer for the applicant for registration to say that its existing customer base is limited to a class which excludes the opponent's existing customers.”

38. The evidence does not show concurrent use in a market where the public has become used to distinguishing between the undertakings. There is no automatic entitlement to a registration simply because a mark has been used. Further, Mr Oldridge cannot speculate, on the basis of historical use, as to what type of security services the opponent may choose to use its marks with the wider specifications upon in the future or, if it assigned the marks to another proprietor, what use that proprietor may make of them. Likewise, the opponent cannot be certain that, if registered, Mr Oldridge’s mark would always be used on “man with a van and a dog” security services. It is not possible to restrict the consideration of likelihood of confusion to the current marketing or trading patterns of the parties, as per *Oakley v OHIM* Case T-116/06:

“76 Consideration of the objective circumstances in which the goods and services covered by the marks in dispute are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is prospective. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors (*QUANTUM*, paragraph 75 above, paragraph 104, and *T.I.M.E. ART/Devinlec v OHIM*, paragraph 75 above, paragraph 59).”

39. I bear in mind that it is necessary to compare the trade marks in their entireties, taking into account the dominant and distinctive components. The average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. I found that the parties’ services range from identical to reasonably similar in the case of the opponent’s word only marks and that they are identical in the case of the composite marks. I think it unlikely that any of the marks would be directly confused with one another. However, according to the jurisprudence cited above, I must also have regard to a scenario where, although the marks are not mistaken directly, there is a belief or an expectation upon the part of the average consumer that the goods or services bearing the individual marks emanate from a single undertaking because there

are points of similarity which lead to association. If the association between the marks causes the public wrongly to believe that the respective services come from the same or economically linked undertakings<sup>9</sup>, there is a likelihood of confusion. This is often called ‘indirect confusion’, but it is, nevertheless, confusion within the meaning of section 5(2)(b) of the Act. Mr Iain Purvis QC, sitting as the appointed person in *L.A. Sugar Trade Mark* BL O/375/10<sup>10</sup> explained indirect confusion in the following terms:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: *“The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”*

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

40. Mr Oldridge’s mark is different to the opponent’s marks but it has the identical distinctive element in common with them: VERITAS. VERITAS is an

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<sup>9</sup> *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

<sup>10</sup> All BL-prefixed decisions are available for viewing on the Intellectual Property Office’s website.

independently distinctive element of Mr Oldridge's mark. There is distinct potential, bearing in mind that confusion works both ways, for VERITAS to be viewed as a house mark and for the marks to be seen as a subsidiary brands, or different types of security services provided by related undertakings. There is visual and aural similarity between the marks and they are neither similar nor dissimilar conceptually. Conceptual differences between marks (even where only one mark has a meaning) can offset visual and phonetic similarity<sup>11</sup>, but there is no concept here to operate upon the consumer's perception of the marks. The opponent's marks are high in distinctive character. Notwithstanding the high level of attention of the average consumer for some of the services, there is a likelihood of confusion in relation to all of Mr Oldridge's services.

## **Outcome**

**41. The opposition succeeds in relation to all the services of the application. The application is refused.**

## **Costs**

42. The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. Mr Compton mentioned, in connection with costs, that the opponent's attorneys did not copy to his firm their letter of 4 January 2013. This letter contained a single short paragraph whereby the opponent stated that it strongly believed that the opposition was straightforward, that it could be decided without a hearing, and that the opponent did not plan to attend or to be represented at the hearing which Mr Oldridge had requested. Mr Compton also said that he only knew from the opponent that it was not attending on 17 January 2013. I do not consider that the failure to copy this particular letter should result in a reduction of costs to the opponent. It was Mr Oldridge who had requested the hearing, so the opponent's view as to the merits of attending a hearing would seem not to have affected Mr Oldridge's wish to be heard, which had already been expressed.

Preparing a statement and considering the counterstatement	£200
Opposition fee	£200
Filing written submissions and considering Mr Oldridge's evidence	£300
<b>Total:</b>	<b>£700</b>

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<sup>11</sup> *Ruiz-Picasso v OHIM*, case 361/04 P [2006] E.T.M.R. 29

43. I order Paul Oldridge to pay Veritas International Consultancy Limited the sum of £700. 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 19th day of February 2013**

**Judi Pike  
For the Registrar,  
the Comptroller-General**