

O-388-14

TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO 3018703
BY HERMES LAW LLP
TO REGISTER THE TRADE MARK



HERMES LAW LLP

IN CLASS 45

AND

OPPOSITION THERETO (UNDER NO. 600000081)
BY HERMES ADVISORY SERVICES LIMITED

BACKGROUND

1) On 19 August 2013, Hermes Law LLP ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of the following services:

Class 45: Legal services; conveyancing services; security services for the protection of property and individuals; social work services; consultancy services relating to health and safety; consultancy services relating to personal appearance; provision of personal tarot readings; dating services; funeral services and undertaking services; fire-fighting services; detective agency services.

2) The application was published on 06 December 2013 in the Trade Marks Journal and notice of opposition, under the fast track opposition procedure, was subsequently filed by Hermes Advisory Services Limited ('the opponent'). The opponent claims that the application offends under sections 5(1) and 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It directs its opposition against '*legal services; conveyancing services, consultancy services relating to health and safety*' in the application.

3) The applicant subsequently restricted the specification of its application to read '*Legal services; conveyancing services*'.

4) The opponent relies on the UK trade mark registration ('UKTM') shown in the table below:

UKTM details	Services relied upon
UKTM No: 2643264 HERMES Filing date: 23 November 2012 Date of entry in the register: 12 April 2013	<i>Class 45: Dispute resolution; legal services; litigation services; legal risk management services; legal compliance and regulatory services; legal dispute management services; alternative dispute resolution services; provision of consultancy, information and advisory services; all the aforementioned in relation to business refinancings and restructurings and interest rate management and other derivatives.</i>

5) The trade mark relied upon by the opponent has a filing date of 23 November 2012 and completed its registration procedure on 12 April 2013. The consequences of these dates in relation to the applicant's mark are that the opponent's mark is an earlier mark in accordance with section 6 of the Act and it is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

6) The applicant filed a counterstatement in which it states the following:

“The opponent has raised a Section 5(1) ground on the basis that the applicant’s mark is identical to the opponent’s mark. The applicant disagrees. The applicant’s mark comprises a word component, which comprises the word HERMES, and a logo component of a bird in flight. The bird is a dominant component of the applicant’s mark. Accordingly, the applicant submits that the marks are different to one another. In order for Section 5(1) to be successful, the marks must be identical, and so the applicant denies this ground of opposition.

The opponent has also raised a Section 5(2)(b) ground on the basis that the applicant’s mark is similar to that of the opponent’s mark. Again the applicant disagrees since the dominant logo component of a bird in flight in their own mark significantly distinguishes their mark from the opponent’s mark. Accordingly, the applicant submits that the marks are not sufficiently similar to one another such there exists a likelihood of confusion on the part of the public. The applicant denies the Section 5(2)(b) ground of opposition.

The opponent raises arguments of ‘detrimental to the reputation and distinctive character’. We respectfully submit that this is out of place under the grounds of opposition that have been raised since these are tests which are reserved for the Section 5(3) ground of opposition, which has not been brought. For a Section 5(3) grounds it must be shown that the earlier mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to the distinctive character or repute of the earlier mark. Accordingly, it is deemed unnecessary to address these statements.”

7) Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

8) The net effect of these changes is to require parties to seek leave from the registrar in order to file evidence in fast track oppositions. Mr Robert Simon Woolley, for the opponent, has filed evidence in the form of a witness statement dated 11 June 2014. The statement contains a mixture of fact and submissions. As leave has neither been sought nor granted to file evidence, the factual content will have no bearing on my decision. I will only take into account the submissions in Mr Woolley’s statement. In any event, even if leave had been properly sought and granted, the nature of the factual statements is such that they would have been of no assistance to me.

9) Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. I therefore make

the following decision based on the papers before me, giving full consideration to the written submissions of the parties.

DECISION

10) As highlighted by the applicant in its counterstatement, the opponent claims in its notice of opposition, inter alia, “the “Hermes Law LLP” mark is detrimental to the reputation and distinctive character of the “Hermes” mark.” Such a claim is not appropriate under sections 5(1) and 5(2)(b) of the Act and will have no bearing on my decision.¹

Section 5(1)

11) This section of the Act provides:

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

12) In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (‘CJEU’) held:

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

As the opponent’s mark consists solely of the word HERMES and the applicant’s mark consists of the words HERMES LAW LLP (and device), they are clearly not identical. **The ground of opposition under Section 5(1) of the Act is dismissed.**

Section 5(2)(b)

13) This section of the Act provides:

“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.”

14) The leading authorities on assessing the likelihood of confusion from the CJEU are: *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*

¹ The official letter of 13 May 2014 refers.

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 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

15) The services to be compared are shown in the table below:

Opponent's services	Applicant's services
<p>Class 45: <i>Dispute resolution; legal services; litigation services; legal risk management services; legal compliance and regulatory services; legal dispute management services; alternative dispute resolution services; provision of consultancy, information and advisory services; all the aforementioned in relation to business refinancings and restructurings and interest rate management and other derivatives.</i></p>	<p>Class 45: <i>Legal services; conveyancing services.</i></p>

16) The leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* ('*Treat*') [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 ('*Canon*'). In the latter case, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular

whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive.

17) In *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* ('*Beautimatic*') [2000] FSR 267 Neuberger J held that the words must be given their natural meaning, subject to their being construed within their context; they must not be given "an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor".

18) However, I must also not interpret a service too broadly. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 ("*Avnet*") Jacob J stated:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

19) Lastly, in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) ('*Meric*'), I bear in mind that the General Court ('GC') held:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

20) The opponent's '*legal services; all the aforementioned in relation to business refinancings and restructurings and interest rate management and other derivatives*' are encompassed by the applicant's '*legal services*'. The respective services are identical in accordance with *Meric*.

21) Turning to the applicant's '*conveyancing services*', these are legal services concerned with the transfer of ownership of property. Such services and the opponent's '*legal services; all the aforementioned in relation to business refinancings and restructurings and interest rate management and other derivatives*' both involve the provision of legal advice, they may share trade channels and have the same users. The services are reasonably similar.

Average consumer and the purchasing process


22) It is necessary to consider these matters from the perspective of the average consumer of the services at issue (*Sabel BV v. Puma AG*). The average consumer is

deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods and services.

23) The opponent's services appear to be aimed primarily at businesses; the applicant's services will be used by businesses and the general public. The services at issue are likely to be infrequent purchases and not insignificant in terms of cost. As such, I would expect the average consumer to afford a reasonable to reasonably high degree of care when selecting the service provider. As to the manner in which the services are likely to be selected, the average consumer is likely, in my view, to peruse the internet or trade directories when seeking out a suitable provider and therefore the visual aspect is likely to dominate for the most part. That said, the aural aspect is certainly not disregarded and, indeed, on occasion, it may be of greater importance than the visual aspect, such as in circumstances where a specific conveyancer may be recommended by word of mouth to a prospective purchaser/seller of property.

Comparison of marks

24) The average consumer normally perceives a mark as a whole and does not proceed to analyse its details. The visual, aural and conceptual similarities 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*), but without engaging in an artificial dissection of the marks.

Opponent's mark	Applicant's mark
<p>HERMES</p>	 <p>HERMES LAW LLP</p>

25) The opponent's mark consists solely of the word HERMES in plain block capitals. There are no dominant elements; the distinctiveness lies in the mark as a whole. Turning to the applicant's mark, there are two elements; the first is the image of the bird, the second is the words "HERMES LAW LLP". Both elements are distinctive. As to dominance, the applicant states that the "bird is a dominant component" of the applicant's mark. The bird does have significant visual impact, given that it is prominently positioned above the words. However, this is not to such an extent so as to overshadow the words. In my view the "HERMES LAW LLP" element is of at least equal dominance to the image of the bird. Furthermore, within the "HERMES LAW LLP" element, it is the word "HERMES" which is likely to command the greatest degree of attention since the words "LAW LLP" are entirely descriptive of the applicant's services.

26) Comparing the marks visually, clearly they coincide in respect of the word HERMES. In view of this, and despite the presence in the applicant's mark of the words "LAW LLP" and the image of a bird, which are absent from the opponent's mark, there is a reasonable degree of visual similarity. From an aural perspective, the opponent's mark will likely be pronounced as HER-MEEZ and the applicant's mark as HER-MEEZ LAW L-L-P (the image of the bird is unlikely to be vocalised). The first two syllables in the applicant's mark, and the only two syllables in the opponent's mark, are clearly identical. Whilst the other syllables in the applicant's mark are absent from the opponent's mark I still consider there to be a reasonably high degree of aural similarity. Conceptually, insofar as the word HERMES evokes any concept at all, it will be the same for both marks. To that extent, and despite the additional concept of the bird in flight in the applicant's mark and the idea of a legal partnership conveyed by the words "LAW LLP" (which are entirely descriptive of the nature of the applicant's services), there is a reasonable degree of conceptual similarity.

Distinctive character of the earlier mark

27) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91).

28) As these are fast track opposition proceedings in which neither party has sought leave to file evidence (and, bearing in mind my earlier comments at paragraph 8), I have only the inherent characteristics of the opponent's mark to consider. Collins English Dictionary defines HERMES as "The messenger and herald of the gods; the divinity of commerce, cunning, theft, travellers, and rascals."² Even if the average consumer is aware that the word HERMES has that meaning, it is, in any event, a meaning which has no relevance to the opponent's services (it is neither descriptive nor allusive of those services). Accordingly, the opponent's mark is possessed of, at least, a good degree of distinctive character in relation to those services.

Likelihood of confusion

29) In deciding whether there is a likelihood of confusion I must take account of all of my earlier findings. I must also keep in mind the following:

- i) the interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and;

² "[Hermes 1](#)" 2000, in *Collins english dictionary*, Collins, London, United Kingdom. Accessed: 22 August 2014, from Credo Reference

- iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

30) Earlier in this decision I found that the respective services are identical and reasonably similar, as identified. I also found that the marks share a reasonable degree of visual similarity, a reasonably high degree of aural similarity and a reasonable degree of conceptual similarity (insofar as the word “HERMES” evokes any concept at all). The level of attention of the average consumer will likely be reasonable to reasonably high and the visual aspect is likely to dominate for the most part, although aural considerations must also be considered and, on occasion, may be of greater importance than visual considerations. I also bear in mind my finding that the earlier mark is possessed of, at least, a good degree of inherent distinctive character.

31) Having weighed all of the above factors against each other, I have come to the conclusion that the differences between the marks are sufficient to avoid direct confusion i.e. where one mark is mistaken for the other because the average consumer thinks they are the same. However, the similarities which do exist between the marks are nevertheless sufficient, in my view, to lead to a likelihood of indirect confusion i.e. where the average consumer is likely to believe that the services emanate from the same or economically linked undertaking(s). In reaching this view, I have borne in mind, in particular, that the respective services are identical and reasonably similar and that the opponent’s mark is possessed of at least a good degree of inherent distinctive character.

The opposition succeeds.

COSTS

32) The opponent has been successful and, as such, is entitled to a contribution towards its costs. In approaching the award, I take into account that the opponent has represented itself in these proceedings and, therefore, will not have incurred legal fees. I award costs to the opponent on the following basis:

Preparing notice of opposition and considering the counterstatement	£100
Opposition fee	£100
Written submissions:	£100
Total:	£300

33) I order Hermes Law LLP to pay Hermes Advisory Services Limited the sum of **£300**. 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 5th day of September 2014

**Beverley Hedley
For the Registrar,
the Comptroller-General**