

O-150-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3004665 BY
PANGEA ADVISORS LTD TO REGISTER THE TRADE MARK:**



IN CLASSES 35 & 45

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 401223 BY
THOMSON REUTERS GLOBAL RESOURCES**

BACKGROUND

1. On 3 May 2013, Pangea Advisors Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 16 August 2013 for the following services:

Class 35 - Advertising marketing, promotion and publicity services; business management; business consultancy services; business consultancy services relating to strategic development; business consultation and advice relating to mergers; tax advice [accountancy]; tax and taxation planning services; business administration; administration of the business affairs of franchises; advice in the running of establishments as franchises; business advisory services relating to the establishment of franchises; advisory services relating to publicity for franchisees; assistance in business management within the framework of a franchise contract; assistance in franchised commercial business management; assistance in product commercialization, within the framework of a franchise contract; office functions; demonstration services for goods and services; distribution of samples services; online advertising on computer networks; sales promotion services; information, consultancy and advisory services relating to all the aforementioned services.

Class 45 - Legal services; legal advice; legal advice relating to taxation; legal services relating to business; legal services relating to intellectual property rights; legal consultancy services; legal enquiry services; legal information research services; legal information services; legal investigation services; legal mediation services; legal research; provision of information relating to legal services; advisory services relating to consumers rights [legal advice]; alternative dispute resolution services [legal services]; arranging for the provision of legal services; attorney services [legal services]; bailiff services (legal services); certification of legal documents; compilation of legal information; computer software (Licensing of -) [legal services]; consultancy services relating to the legal aspects of franchising; conveyancing services [legal services]; domain names (Registration of -) [legal services]; information services relating to legal matters; security services for the protection of property and individuals.

2. The application is opposed in full by Thomson Reuters Global Resources (“the opponent”) under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opposition under both grounds is based upon all of the services (shown below) in the following Community Trade Mark (“CTM”) registration:

No. 9027161 for the trade mark:



which was applied for on 14 April 2010 and which completed its registration process on 19 October 2010:

Class 35 - Outsourcing services, including outsourcing of legal services; market research; business research; business information services; business intelligence services; business risk management services.

Class 36 - Financial research services; economic research services; financial information services; risk management services.

Class 45 - Legal services, including conveyancing services, litigation services and discovery services; legal research services; intellectual property services; intellectual property searching; research relating to intellectual property.

“Colours claimed/indication: Green, blue and white.”

3. In relation to its opposition based upon section 5(2)(b) of the Act, the opponent states:

“The marks are closely similar visually, aurally and conceptually. The services are identical and similar.”

4. In relation to its opposition based upon section 5(3) of the Act, the opponent states that it has a reputation in relation to all the services for which its trade mark is registered. It provides the following answers to the following questions which appear in the Notice of opposition:

Q3: Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?

Having answered “Yes” to this question, the opponent provides the following answers:

Q4: Is there any other basis for your claim of unfair advantage? If so, please explain what the advantage would be to the holder of the later mark, and why it is unfair.

“The applicant will benefit from the opponent’s investment in its advertising and promotion of its brand leading to advantage to the applicant without any investment by the applicant. The applicant will ride on the coat tails of the opponent’s mark benefitting from its power or attraction, reputation and prestige.”

Q5: Is there any other basis for your claim of detriment to the reputation of the earlier mark? If so, please explain what the detriment would be and how it would occur.

“The applicant’s use will be out of the control of the opponent, any poor quality goods and/or services provided under the mark by the applicant will reflect upon the opponent’s business and services leading to detriment to the opponent’s valuable reputation and business.”

Q6: Is there any other basis for your claim of detriment to the distinctive character of the earlier mark? If so, please explain what the detriment would be and how it would affect the economic behaviour of the relevant public.

“There will be detriment to the distinctive character of the opponent’s mark because the opponent’s mark will no longer signify origin. Furthermore, the economic behaviour of the relevant public will be affected as they will employ the applicant’s services in place of those of the opponent. If such services are unsatisfactory the public may cease utilising the opponent’s services also”.

The opponent also states:

“There is not due cause for adoption of the opposed mark.”

5. The applicant filed a counterstatement in which it denies the basis of the opposition and puts the opponent to proof of its various claims. The applicant states:

“3. The applicant asserts that the opponent cannot own a monopoly over the word PANGEA in relation to the services sought for registration by the applicant.”

6. Both parties filed evidence; the applicant also filed written submissions. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

EVIDENCE

The opponent’s evidence

7. This consists of a witness statement from Joanna Murphy, the opponent’s Director and Chief Counsel, a position she has held since August 2012. The main facts emerging from Ms Murphy’s statement are as follows:

- The opponent is an indirect subsidiary of Thomson Reuters Corporation (“TR”);
- TR employs over 55,000 people in over 100 countries and earned \$12.7 billion in revenue in 2013. Ms Murphy states: “The business trades under the name Pangea3”;
- Pangea3 is one of the world’s most experienced and fastest growing providers of high quality legal process outsourcing (“LPO”) services to the legal industry, including corporate in-house counsel and law firms;
- Pangea3 offers LPO solutions for litigation support, corporate transactional work, intellectual property, governance, risk management and compliance;
- Founded in the United States in 2004 and headquartered in New York and Mumbai, Pangea3 has developed industry-leading legal expertise, attracting and retaining the largest and most sophisticated global corporate clients and law firms in the world;
- Pangea3 has approximately 1000 employees including legal, engineering, management and scientific professionals;
- Pangea3 provides its services to almost one third of the Fortune 1000 listed companies, with clients in a wide range of industries including financial services, real estate, manufacturing, electronics, consumer goods, food and beverage, telecommunications, oil and gas, healthcare and biotechnology. Its global client base includes clients in the United States, the United Kingdom, the European Union, India, Japan, Australia and other Asia-Pacific countries;
- The PANGEA3 trade mark was launched in the UK in 2005 and is used in connection with its provision of LPO services such as litigation-related document review and “other customary LPO services”;
- The trade mark is used mainly in the United Kingdom’s financial centres e.g. London;
- Between 2005 and 2013, the “annual sales in relation to Pangea3 to UK clients” (all of which are expressed as “greater than” figures) was as follows: 2005 - £2,000, 2006 - £2,000, 2007 - £8,000, 2008 - £109,000, 2009 - £50,000, 2010 - £84,000, 2011 - £89,000, 2012 - £68,000 and 2013 - £56,000 (a total of £468,000);
- Pangea3’s marketing and advertising expenditure in the United Kingdom between 2009 and 2013 was as follows: 2009 - £69,000, 2010 - £175,000, 2011 £345,000, 2012 – £240,000 and 2013 - £135,000 (a total of £964,000);

- The above expenditure relates to trade shows and exhibitions, media advertising, website activity, the production and distribution of brochures and leaflets and advertisements in legal magazines and publications. Exhibit JM2 consist of two documents, described by Ms Murphy as “a sales brochure” and an “e-mail marketing communication.” The first document, entitled “Multi-Shore Litigation Solutions” bears a copyright dated of 2011. Whilst the document contains references to Pangea3/PANGEA3 and

PANGEA³

there is no use shown of the trade mark in the form in which it is registered. The document advises the reader that they can obtain further information from “pangea3.com” or by calling the following telephone number “1-212-689-3819” (which I take to be a telephone number based in the United States). The second document appears to be a newsletter produced by the opponent entitled “The Weekly Pangean: The Latest Legal Outsourcing News”. The document, which contains the references mentioned above, was sent from “Pangea3...on behalf of Pangea3news” to “P3sales” on 19 December 2013 (i.e. after the date of the application for registration). The newsletter, which invites “FAQ’S” to be sent to p3faqs@thomsonreuters.com, appears to be directed at the market in the United States;

- Ms Murphy explains that the PANGEA3 trade mark has a presence on social media including profiles on Twitter and LinkedIn, which, she states, are directed at a global audience, including “professionals in the UK”. Ms Murphy states that “the strong social presence of the Pangea3 business serves to promote and advertise the PANGEA3 brand.” Exhibit JM3 consists of pages from Pangea3’s Twitter and Facebook profiles downloaded on 25 April 2014 i.e. after the date of the application for registration;
- Exhibit JM4 consists of articles from a range of websites i.e. www.legalweek.com, dated 19 November 2010, www.thelawyer.com, dated 19 November 2010, www.globallegalpost.com, dated 18 December 2013, www.outsourcemagazine.co.uk, dated 10 January 2011, www.building.co.uk, dated 26 October 2006, 25 June and 22 October 2010, www.lawgazette.co.uk, dated 26 October 2006, 25 March and 13 May 2010, www.legalfutures.co.uk, dated 14 May 2010 and www.legalsupportnetwork.co.uk dated 19 November 2010, all of which mention Pangea3 and all of which, states Ms Murphy, “have an extensive audience within the UK”;
- Exhibit 5 consists of what Ms Murphy explains is a “Pangea3 authored and sponsored white paper...”. The paper entitled “LIBOR’S Long And Winding Road” bears a copyright date of 2013 and contains references to Pangea3 and

PANGEA3 and directs the reader to obtain more information from the website and United States telephone number mentioned above;

- Ms Murphy states that “Pangea3 has also featured in BBC World News coverage.” Exhibit JM6 consists of a CD containing an undated BBC news report in which Pangea3’s Co-CEO, Sanjay Kamlani, is featured;
- Exhibit JM7 consists of an extract obtained from www.pangea3.com on 24 March 2014, with Ms Murphy noting “the numerous recognitions and accolades won by Pangea3 for its legal outsourcing services”. She points to Best Legal Process Outsourcer award in the 2011, 2012 and 2013 *New York Law Journal* Reader Rankings, the Market Leader Award for Legal Process Outsourcing by *Frost & Sullivan* in 2006 and Legal Process Outsourcer of the Year by *India Business Law Journal* for 2009, 2010 and 2011;
- Exhibit JM8 consists of an extract obtained from www.pangea3.com dated 13 May 2010. The article is entitled: “European Launch for legal outsourcing and legal process solutions leader” “Pangea3 opens London office for European LPO push”. The trade mark the subject of the registration (accompanied by the words “GLOBAL LEADERS IN LEGAL OUTSOURCING”) can be seen at the top left hand side of both pages;
- Exhibit JM9 consists of a range of news articles and press releases obtained from www.pangea3.com dating from 2004 to 2012 which, in Ms Murphy’s view, demonstrates, inter alia, “the global reach of the business.” The articles (all of which mention Pangea3) originate from and are dated as follows: *Business India*, 24 October 2004, *Chicago Daily Law Bulletin*, 8 May 2005, *Business Standard*, 28 December 2005, *Hindustan Times*, 28 July 2005, *The Economic Times*, 17 January 2006 and 11 August 2008, *American Lawyer*, 19 September 2006, *Crain’s New York Business*, 11 September 2006, *American Bar Journal*, 1 October 2007, *India Business Law Journal*, November 2009 and November 2011 *Times Ascent*, 16 September 2009, ACC Europe Event (held in London), 11 November 2009, *The Economist*, 21 January 2010, *Law Society Gazette*, 25 March 2010, an article dated 8 April 2010 in relation to an alliance between Pangea3 and Advent Lawyers of Australia, *Legallyindia.com*, 20 April 2010, www.lawgazette.co.uk, 13 May 2010, a press release relating to the acquisition of Pangea3 by Thomson Reuters, 19 November 2010, Global LPO Conference 2011 (held in London in March 2011), Fourth Annual Global Law Firm Leaders Conference (held in London in October 2011 and sponsored by Pangea3), InsideCounsel’s Super Conference (held in Chicago in May 2011 and sponsored by Pangea3), *DNA Daily News and Analysis* (an Indian newsletter), 19 April 2011, *Law Talk* (a New Zealand based magazine), 2 March 2012, NYSBA IP Law Section Fall Meeting (held in New York in October 2008) and General Counsel Roundtable Workshop (held in London on 14 May 2009);

- Exhibit JM10 consists of a list of conferences, seminars, tradeshows and other events attended by Pangea3 in Europe in the period May 2009 to October 2011. Of the eleven events mentioned, four were held in London, three were held online, one was held in the Netherlands, one in Belgium, one in Spain and one in Germany. Ms Murphy notes that “several of these events were held in London” and states that “others were attended by UK clients and professionals”;
- At paragraph 18 of her statement, Ms Murphy states: “My evidence shows our extensive use of the PANGEA3 mark in relation to LPO services across a wide range of sectors and industries. The PANGEA3 mark is the subject of considerable goodwill and reputation in the UK and worldwide...”.

The applicant’s evidence

8. This consists of a witness statement from Oliver Oguz, a part qualified trade mark attorney at Trade Mark Consultants Co., the applicant’s professional representatives. The purpose of Mr Oguz’s evidence is to support the comment contained in the applicant’s counterstatement i.e.

“The applicant asserts that the opponent cannot own a monopoly over the word PANGEA in relation to the services sought for registration by the applicant.”

9. Mr Oguz states:

“3. There are presently no fewer than 36 live trade marks effective in the EU which cover services in classes 35 and 45 in the name of different owners...

4. The foregoing list of trade marks registered in respect of services in classes 35 and 45 and containing the term PANGEA have been found.”

10. Exhibit P1 consists of what Mr Oguz describes as a “Saegi.s printout.” It appears to consist of the results of a search conducted on 17 October 2014 of 29 European trade mark databases for trade marks in classes 35 and 45 which contain “pangea” as a part of the trade mark. The “Hit Overview” contains references to “Citation”, “Source”, “Status”, “Class” and “Owner Name.” I note that a number of the “hits” are in relation to trade marks whose status is described as “Rejected application abandoned”, “cancelled mark cancelled”, “terminated cancelled” and “unsuccessful application (abandoned)”. As full details of the 36 “hits” (three of which appear to relate to the parties to these proceedings) have not been provided, I am unable to tell exactly what the trade marks look like (the applicant’s trade mark is, for example, recorded as simply PANGEA), when they were filed or for what services in classes 35 and 45 they were applied for/are registered. In those circumstances, a detailed review of the exhibit is of little value. However, for the sake of completeness, I note whilst the exhibit reveals that there are a number of registered trade marks consisting of either PANGEA alone or PANGEA with what appears to be descriptive words, the search has also returned trade marks which contain the word pangea as part of a unified whole, for example: pangeatik, repangea,

pangeaprogettoitalia and pangeacard as well as trade marks where the word appears with other elements, for example, PANGEA LA VITA RIPARTE DA UNA DONNA and Pangea io mi muovo!

11. Exhibit P2 consists of a printout obtained from the Norwegian Industrial Property Office in relation to Norwegian trade mark no. 261208 for the trade mark PANGEA in the name of Pangea AS, which was applied for on 10 December 2010 (i.e. after the date of application of the opponent's registration) and which is registered in a range of classes including 35, 36 and 45. Also included are pages obtained from the website of Pangea AS (www.pangea.no) on 17 and 20 October 2014. It appears that Pangea AS uses its PANGEA trade mark in relation to a credit card the use of which has environmental benefits.

12. Exhibit P3 consists of a printout obtained from the website of the Office for Harmonisation in the Internal Market ("OHIM") in relation to CTM registration no. 9164583 for the trade mark PANGEA NET in the name of Browne Jacobson LLP, which was applied for on 9 June 2010 (again after the date of application of the opponent's registration) and which is registered in classes 35, 41 and 45. Also included are pages obtained from www.pangea-net.org/ on 17 and 20 October 2014. Pangea Net describes itself as:

"an international network of independent law firms founded in 2009...The member firms provide a broad range of commercial legal services which include corporate, foreign investment, international trade, M&A, banking, tax, anti-trust, intellectual property, IT and technology, labour and employment, construction, real estate, environmental and zoning, public procurement, litigation and arbitration."

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

DECISION

14. The opposition is based upon sections 5(2)(b) and 5(3) of the Act which read as follows:

"5 (2) A trade mark shall not be registered if because -

(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.

(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 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.

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. ”

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

16. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not been registered for more than five years when the application was published, it is not subject to the proof of use provisions as per section 6A of the Act. As a consequence, the opponent is entitled to rely upon all of the services for which it stands registered.

The opposition based upon section 5(2)(b) of the Act

Case law

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

- (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 or 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;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also 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 of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (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;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) 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;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

18. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

19. In its submissions, the applicant states:

“7...in the present case, the services covered by the applicant’s mark are aimed at a specialised section of the public, namely corporations, businesses and law firms, as well as well informed business men and women, it can be assumed that the relevant consumer’s level of attention will undoubtedly be very high. The relevant consumers will necessarily be conscious of the importance of selecting the correct advisors and consultants and will accordingly pay attention to the differences in the visual characteristics of the trade marks used by their preferred business advisers and consultants.”

20. Although some of the services at issue will also be provided to members of the general public (legal services for example), I agree that for the vast majority of the services at issue the average consumer is most likely to be a business user. As to how such services will be selected, the opponent’s evidence indicates that it makes its business and trade mark known by means of attendance at trade shows and exhibitions, via its website, by producing and distributing leaflets and by placing advertisements in publications, all of which is, in my view, likely to be fairly typical, and indicates that visual considerations are likely to play a significant part in the selection process. That said, as personal recommendations are also likely, aural considerations must not be lost sight of, although they are, in my view, likely to be a less important feature of the selection process. Given the obvious importance to a commercial undertaking of selecting, for example, the most appropriate business, financial or legal assistance, combined with what is likely to be the nature of the average consumer’s enquiries before a supplier is appointed (including, for example, presentations by suppliers/meetings and, on occasion, a tendering process), suggests that the average consumer will pay a relatively high degree of attention to the selection of the services at issue.

Comparison of services

21. The competing services are as follows:

The opponent's services	The applicant's services
<p>Class 35 - Outsourcing services, including outsourcing of legal services; market research; business research; business information services; business intelligence services; business risk management services.</p> <p>Class 36 - Financial research services; economic research services; financial information services; risk management services.</p> <p>Class 45 - Legal services, including conveyancing services, litigation services and discovery services; legal research services; intellectual property services; intellectual property searching; research relating to intellectual property.</p>	<p>Class 35 - Advertising marketing, promotion and publicity services; business management; business consultancy services; business consultancy services relating to strategic development; business consultation and advice relating to mergers; tax advice [accountancy]; tax and taxation planning services; business administration; administration of the business affairs of franchises; advice in the running of establishments as franchises; business advisory services relating to the establishment of franchises; advisory services relating to publicity for franchisees; assistance in business management within the framework of a franchise contract; assistance in franchised commercial business management; assistance in product commercialization, within the framework of a franchise contract; office functions; demonstration services for goods and services; distribution of samples services; online advertising on computer networks; sales promotion services; information, consultancy and advisory services relating to all the aforementioned services.</p> <p>Class 45 - Legal services; legal advice; legal advice relating to taxation; legal services relating to business; legal services relating to intellectual property rights; legal consultancy services; legal enquiry services; legal information research services; legal information services; legal investigation services; legal mediation services; legal research; provision of information relating to legal services; advisory services relating to consumers rights [legal advice]; alternative dispute resolution services [legal services]; arranging for the provision of legal services; attorney services [legal services]; bailiff services (legal services); certification of legal documents; compilation of legal information; computer software (Licensing of -) [legal services]; consultancy services relating to the legal aspects of franchising; conveyancing services [legal services]; domain names (Registration of -) [legal services]; information services relating to legal matters; security services for the protection of property and individuals.</p>

22. The opponent asserts (without explanation) that the competing services are identical or similar, whilst in its counterstatement the applicant denies that claim but does not explain why.

The case law relating to similarity

23. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

24. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

25. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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.”

26. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. stated:

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

27. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...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”.

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

28. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the GC stated:

“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).”

Class 35

29. The opponent’s specification in class 35 includes: “outsourcing services...”, “business research”, “business information services”, “business intelligence services” and “business risk management services”, whereas its specification in class 36 includes a range of financial and economic research, financial information and risk management services. These are broad terms that will include within their ambit a wide range of services. In comparing the competing services, I will keep in mind the comments in *Avnet* mentioned above.

30. In my view many of the applicant’s services i.e. “business management; business consultancy services; business consultancy services relating to strategic development; business consultation and advice relating to mergers; business administration; administration of the business affairs of franchises; advice in the running of establishments as franchises; business advisory services relating to the establishment of franchises; assistance in business management within the framework of a franchise contract; assistance in franchised commercial business management; assistance in product commercialization, within the framework of a franchise contract” and “office functions”, would be included within one or more of the broad terms in class 35 I have identified above, and are identical on the principles outlined in *Meric*.

31. The opponent’s specification in class 35 also includes a reference to “market research”. There is, in my view, a well established and complementary relationship between these services and: “Advertising marketing, promotion and publicity services”, “advisory services relating to publicity for franchisees; demonstration services for goods and services; distribution of samples services; online advertising on computer networks; and sales promotion services”; which appear in the applicant’s specification in class 35 and, as a consequence, a low to medium degree of similarity between them.

32. Insofar as “tax advice [accountancy]; tax and taxation planning services” in the application are concerned, as these will also, in my view, be encompassed by one or more of the broad terms in the opponent’s specification in class 35, they too are identical on the *Meric* principle. However, even if I am wrong in that regard, if one considers the intended users, purpose, channels of trade and method of use of these services, they must, in my view, be considered at least reasonably similar to the opponent’s “financial information services” in class 36. The “information, consultancy and advisory services” which relate to the services I have found to be identical/similar would, in my view, be identical/similar on the same basis.

Class 45

33. The applicant’s services in this class fall into two categories. The first, relates to legal services of one sort or another. As the opponent’s specification in class 45

includes, inter alia, “legal services” at large, the competing services are clearly identical. The second relates to “security services for the protection of property and individuals”. In the absence of any explanation from the opponent as to why these services should be considered similar to any of its services, I find, having applied the relevant case law mentioned above, and in the absence of any evidence or submissions to assist me, that these services are not similar to any of the opponent’s services.



Comparison of trade marks

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

35. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

36. The trade marks to be compared are:

The opponent’s trade mark	The applicant’s trade mark
	

37. The opponent claims the colours green, blue and white as an element of its trade mark. In *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96] Kitchin LJ stated:

“A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours.”

38. As the applicant's trade mark has been applied for in black and white, if registered, it would be entitled to present its trade mark in the same colours as the opponent's trade mark; I will return to this point later in this decision. In its submissions, the applicant states:

"5. Visually, the respective marks are comprised of a number of different elements. Aside from featuring the word PANGEA followed by the number 3, the opponent's mark also features the characters P3 in a green circle. The contested mark, on the other hand, comprises a figurative element which is not present in the contested mark. Said device takes the form of a splodge with a spherical object, akin to a pearl, at its centre, and constitutes a dominant element in the mark. As a consequence of this, when the marks are perceived by the average consumer, the figurative element in the contested mark will, in all probability, be perceived as a dominant component of the mark - as a result of its relative size and position. On the other hand, the P3 element in the opponent's mark will likely be considered a dominant component in the opponent's mark - as a result of its position and brightness. In view of this, it is clear that the respective marks comprise different figurative elements that render them dissimilar from an aesthetic standpoint.

6. Aurally, the opponent's mark comprises the additional elements "P3" and "3" causing it sound dissimilar to the contested mark."

39. The opponent's trade mark consists of two components. The first component consists of what will, in my view, be understood by the average consumer as a letter P together with a superscript numeral 3. The letter P and superscript numeral 3 are presented in white and are contained within a green circle. The second component consists of the word PANGEA presented in upper case in blue to the right of which is a superscript numeral 3 presented in the same colour green as the circular device mentioned above. As will become apparent later in this decision, notwithstanding the applicant's argument to the contrary, the word PANGEA (alone) is, in my view, a distinctive element of the opponent's trade mark as is the combination PANGEA superscript 3 and the letter/superscript numeral and device combination which accompanies it. Although the device containing the letter P and superscript numeral 3 appears as the first element of the trade mark, given the size and positioning of the word PANGEA and the superscript numeral 3, both elements will, in my view, make a roughly equal contribution to the overall impression the opponent's trade mark conveys.

40. As to the applicant's trade mark, this also consists of two components. The first is a device element which the applicant describes as "a splodge with a spherical object, akin to a pearl, at its centre"; a description I am happy to accept. The second component is the word PANGEA presented in upper case and in which the letters PAN are presented in a darker font than the letters GEA. Both components are distinctive. Although the device component is far larger than the word PANGEA which accompanies it, the word PANGEA is certainly not negligible and whilst it may have a slightly lower relative weight

than the device component, it will still, in my view, make a significant contribution to the overall impression the applicant's trade mark conveys.

41. When considered from a visual perspective, the presence in the opponent's trade mark of the device containing the letter P and superscript numeral 3 and the inclusion of the superscript numeral 3 after the word PANGEA, and the inclusion in the applicant's trade mark of a dominant device element results, in my view, in only a low degree of visual similarity between the competing trade marks.

42. Insofar as aural similarity is concerned, the opponent's trade mark is likely, in my view, to be pronounced as either "P3 PANGEA 3" or "PANGEA 3". As it is well established that when a trade mark consists of a combination of word and figurative elements, it is by the word element that the average consumer is most likely to refer to the trade mark, the applicant's trade mark will, in my view, be referred to as simply PANGEA (the difference in shading of the letters PAN and GEA will not, in my view, affect the position). The fact that either scenario results in the articulation of the three syllable word PAN-GE-A results, in my view, in a fairly high degree of aural similarity between the competing trade marks.

43. As none of the elements in the competing trade marks is likely to convey any concrete conceptual message to the average consumer (the word PANGEA being treated by them as an invented word), the conceptual position is neutral.

Distinctive character of the earlier trade mark

44. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As I alluded to earlier, in my view, the applicant's evidence falls a long way short of establishing that the word PANGEA has either no or low distinctive character, and the PANGEA3 element of the opponent's trade mark is, in my view, highly distinctive *per se*. Consequently, as the opponent's earlier trade mark as a whole is, in my view, absent use possessed of a high degree of inherent distinctiveness, any enhanced distinctive character it may have acquired as a result of the use made of it, is unlikely to significantly improve its position.

45. Although the opponent has filed evidence of its use, the only use of the trade mark (as registered) that has been provided appears, as far as I can tell, to be in exhibit JM8 which dates from May 2010. There is, however, use shown of Pangea3/PANGEA3 and:

PANGEA³

In approaching this issue, I note that in *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03 the CJEU concluded that a mark could acquire a distinctive character when it is used “as part of or in conjunction with a registered trade mark” and that in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the same court held that a registered trade mark may escape the consequences of revocation even if it were “used as part of a composite mark or in conjunction with another mark.” Applying the rationale in the above cases to the issue before me, it appears to me to be possible for the opponent’s earlier trade mark to acquire an enhanced distinctive character by virtue of the use of only one part of it (in this case the use of PANGEA super script 3). As I mentioned above, the opponent uses this element of its trade mark in a number of formats i.e. Pangea3, PANGEA3 and **PANGEA³** (hereafter “the PANGEA3 element”). Although the opponent’s registration contains these elements of its trade mark presented in blue and green (and claims these colours as elements of its trade mark), in my view, neither its presentation in the manner shown above or in the formats Pangea3/PANGEA3 affects the opponent’s ability to rely upon the use of the PANGEA3 element to establish that its earlier trade mark has acquired an enhanced distinctive character.

46. The opponent’s evidence is that by the date of the application for registration (i.e. May 2013), it had been using the PANGEA3 element in the United Kingdom for some eight years. In May 2010, it opened an office in London and in November 2010 the Pangea3 business was acquired by Thomson Reuters. Turnover in the United Kingdom between 2005 and 2013 totalled a little under half a million pounds with marketing and advertising spend in the period 2009 to 2013 amounting to nearly a million pounds. The Pangea3 business was promoted at trade shows and exhibitions and by way of media advertising, website activity and the distribution of brochures, leaflets and advertisements in legal magazines and publications; the business also has a presence on Twitter, Facebook and LinkedIn. The PANGEA3 element has appeared in a wide range of publications/websites. The vast majority of the extracts provided originate from before the date of the application for registration, a not insignificant number of them are from publications which originate in the United Kingdom, and in relation to all the extracts provided, Ms Murphy states they “have an extensive audience within the UK.” The business has a range of prestigious clients including, General Electric, Sony, American Express, UPS, Fujitsu and Yahoo. Although the business has won a number of awards, it appears that these relate to jurisdictions other than the United Kingdom. In the period May 2009 to October 2011, the Pangea3 business participated in four events held in the United Kingdom (one of which I note it sponsored) in which the PANGEA3 element appeared.

47. Although some of the evidence provided appears to be from after the date of the application for registration or relates to jurisdictions other than the United Kingdom, considering the evidence as a whole in light of the international nature of the opponent’s

business, I am satisfied that by the date of the application for registration, the use the opponent had made of the PANGEA3 element in the United Kingdom would have enhanced the inherent distinctiveness of its earlier trade mark. As to the services upon which the earlier trade mark has been used, Ms Murphy refers to the opponent's business as "litigation support, corporate transactional work, intellectual property, governance, risk management and compliance." It appears to me that the principle use of the opponent's trade mark has been in relation to "outsourcing of legal services" in class 35 and the services in class 45. I will, as a consequence, proceed on the basis that the opponent's enhanced reputation extends to the services I have identified.

48. In summary, the opponent's earlier trade mark is highly distinctive *per se*, and the use that has been made of the PANGEA3 element of it in the United Kingdom since 2005 has enhanced its distinctive character, although not, in my view, to the extent that it has significantly improved the opponent's position.

Likelihood of confusion

49. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

50. As per the comments of the CJEU in *Waterford Wedgwood plc v OHIM Case C-398/07*, there must be some similarity in the competing services to engage the test for the likelihood of confusion. Earlier in this decision, I concluded that there was no similarity between the opponent's services and the following services in the application:

Class 45 - Security services for the protection of property and individuals.

51. Where there is no similarity in the competing services there can be no likelihood of confusion and the opposition against the services shown above fails accordingly. In relation to the remaining services in the application, I have found these to be either identical or at least similar to a low degree to various services in the opponent's earlier trade mark. In addition, I have found that the average consumer will most likely be a business user who will select the services by primarily visual means and who will pay a relatively high degree of attention when doing so. As to the competing trade marks, I have found these to be visually similar to a low degree, aurally similar to a fairly high degree and conceptually neutral. I also concluded that the opponent's earlier trade mark was possessed of a high degree of inherent distinctive character and although this distinctive character had been enhanced by the use that it had made of the PANGEA3

element of it, this does not assist the opponent to any material extent. In its submissions, the applicant states:

“1. The Opponent’s opposition rests entirely on the fact that its mark comprises the term PANGEA. There are presently no fewer than 36 live trade marks effective in the EU which cover services in classes 35 and 45, in the name of different owners. As is clear from the Witness Statement attached hereto, a number of these marks are presently in use in respect of services that are identical with, or highly similar to, the services that the Opponent renders under and by reference to its P3 PANGEA3 mark. Accordingly, the Applicant contends that the Opponent does not own a monopoly in the word PANGEA and cannot therefore claim exclusive rights to use the word PANGEA in respect of the services in issue.”

52. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

53. I have reviewed and commented upon the applicant’s evidence at paragraphs 10-12 above. As the GC points out in *Zero*, the mere fact that a number of trade marks consist of or contain the word PANGEA is not, without “indications as to how many of such trade marks are effectively used in the market”.. “enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned.” Although the applicant has filed evidence of use by two undertakings, both of these undertakings applied for their trade mark after the opponent filed its trade mark. Whilst it appears that Browne Jacobson LLP’s uses its PANGEA NET trade mark in relation to legal services, the use by Pangea AS is, in my view, in relation to a different area of trade to that of the opponent. Regardless, as I mentioned above, use by two parties of trade marks consisting of or containing the word PANGEA falls a long way short of establishing that the word PANGEA has no or low distinctive character and does not affect my original finding in this regard. In its submissions, the applicant states:

“12. Furthermore, it is clear...that the marks are visually dissimilar as they comprise figurative or stylistic differences. Consumers will certainly detect these

differences and, in turn, will determine that the services issue from different undertakings and are by no means associated.

14. Given the numerous visual and phonetic and dissimilarities it is highly likely that the average consumer will assume the services originate from different undertakings...”

54. I agree with the applicant that the various differences (resulting in a low degree of visual similarity) between the competing trade marks will not go unnoticed by the average consumer and are, in my view, sufficient to avoid a likelihood of direct confusion i.e. where one trade mark is mistaken for another. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

“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).”

55. In my view, the scenario envisaged by Mr Purvis in paragraph 17(a) above applies to the circumstances of this case. Notwithstanding the relatively high degree of attention that will be paid during the selection process, the identity/degree of similarity in the

competing services, will still, in my view, lead to a likelihood of indirect confusion. I have reached this conclusion on the basis of the applicant's trade mark as filed i.e. in black and white. However, were the applicant to present its trade mark in the colours claimed by the opponent, the likelihood of indirect confusion would, in my view, be heightened.

Conclusion under section 5(2)(b)

56. The opposition succeeds in relation to all of the services in the application with the exception of "security services for the protection of property and individuals" in class 45.

The opposition based upon section 5(3) of the Act

57. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the

earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

58. Given my conclusions in relation to the opposition based upon section 5(2)(b), it is only necessary for me to consider this ground in relation to those services in relation to which the opposition based upon section 5(2)(b) has failed i.e.

Class 45 - Security services for the protection of property and individuals.

Although in its counterstatement the applicant denies that there "is no due cause for the adoption" of its trade mark, I remind myself that no evidence or submissions on this point have been provided by the applicant.

59. The opponent relies upon the same CTM mentioned above. In order to get an objection under section 5(3) off the ground, the opponent must establish that it has a reputation in the Community. What constitutes a reputation in the Community was considered by the CJEU in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07. The CJEU held that:

"20. By its first question, the national court in essence asks the Court, first, to clarify the meaning of the expression 'has a reputation in the Community', by means of which, in Article 9(1)(c) of the regulation, one of the conditions is laid down which a Community trade mark must fulfil in order to benefit from the

protection accorded by that provision and, second, to state whether that condition, from a geographical point of view, is satisfied in a case where the Community trade mark has a reputation in only one Member State.

21. The concept of 'reputation' assumes a certain degree of knowledge amongst the relevant public.

22. The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see, by way of analogy, General Motors, paragraph 24, with regard to Article 5(2) of the directive).

23. It cannot be required that the Community trade mark be known by a given percentage of the public so defined (General Motors, by way of analogy, paragraph 25).

24. The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (General Motors, by way of analogy, paragraph 26).

25. In examining this condition, 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 (General Motors, by way of analogy, paragraph 27).

26. In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers.

27. Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the Community (see, by way of analogy, General Motors, paragraph 28).

28. It should be noted that the Court has already ruled that, with regard to a Benelux trade mark, it is sufficient, for the purposes of Article 5(2) of the directive, that it has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries (General Motors, paragraph 29).

29. As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be

taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied.

30. The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.

60. Having reviewed the opponent's evidence above, I concluded that the use that it had made of the PANGEA3 element had slightly enhanced the distinctive character of its earlier trade mark. Of course, that assessment was based upon the use the opponent had made of its earlier trade mark in the United Kingdom. Whilst there are references in the opponent's evidence to, for example, a European launch, to clients in the EU and to attending events in the Netherlands, Belgium, Spain and Germany, it is, I think, fair to say that (not surprisingly) the opponent's evidence focused on its use in the United Kingdom. In *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), Geoffrey Hobbs QC, as a Deputy Judge of the High Court held that:

“76. Article 9(1)(c) provides protection for Community trade marks which have a reputation “in the Community”. Kenwood suggested that this means a reputation across the Community as a whole or at least a large area of it. I do not agree. In the case of a trade mark registered at the national level, protection of the kind provided by art.9(1)(c) can be claimed for trade marks which have a reputation in the sense that they are known by a significant part of the public concerned by the products or services covered by that trade mark in the territory of registration. Since the territory of registration is part of the Community, the trade mark has a reputation in the Community. The trade mark does not cease to have a reputation in the Community if the national registration is either subsumed within a Community trade mark registration under art.34(2) of the CTMR on the basis of a valid claim to seniority or duplicated by a Community trade mark registration. In principle, a Community trade mark should not receive less protection than a national trade mark with a reputation in the same territory. I think that the aim should generally be to prevent conflict occurring in any substantial part of the Community and that the United Kingdom can for that purpose be regarded as a substantial part of the Community, with or without the addition of France and Germany. It thus appears to me that Whirlpool's Community trade mark has a reputation in the Community.”

61. In view of the guidance in *Pago* and *Whirlpool*, I am satisfied that the use the opponent has made of the PANGEA3 element of its earlier trade mark in (at least) the United Kingdom since 2005 is sufficient, given the international nature of the business in which it operates, for that element of its trade mark to have acquired a reputation in the

Community. I am further satisfied that the inclusion of PANGEA3 as a dominant and distinctive element of the earlier trade mark, means that the reputation of PANGEA3 was likely to have benefitted the earlier trade mark, with the consequence that it too may be considered as having a reputation in the Community by virtue of the inclusion in it of the PANGEA3 element. The nature of this reputation is, in my view, best informed by consideration of the international nature of some of its clients i.e. General Electric, Sony, American Express, Fujitsu, UPS and Yahoo, and is characterised by comments such as: “a leader in the niche LPO industry”, “one of the most touted names in the emerging LPO market” as one of “two of the top three legal process outsourcing (LPO) providers...” and by references to the high quality, accuracy, timeliness and cost effective nature of the services the opponent provides. Having concluded that the opponent’s earlier trade mark has a reputation and the nature of that reputation, I must next decide if the necessary link exists. In *Intel*, the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

The degree of similarity in the competing trade marks

62. I considered the competing trade marks earlier in this decision and concluded that there was a low degree of visual similarity, a fairly high degree of aural similarity and that the conceptual position was neutral. Although when assessing whether there will be a link I must compare the competing trade marks as a whole, I must not lose sight of the fact that the reputation in the opponent’s trade mark stems from the inclusion in it of the PANGEA3 element.

Similarity in the opponent’s services and the applicant’s services which remain

63. The opponent’s services are legal processing outsourcing services, legal services, and related services provided as part of a “customary” LPO offering, whereas the

applicant's services which remain are "security services for the protection of property and individuals". Although both parties' services may be provided to both the general public and businesses, as before, the average consumer is, in my view, most likely to be a business user; regardless, that degree of generality tells one little. If one digs deeper and considers, for example, the nature and intended purpose of the competing services, their channels of trade and whether they are in competition with or complementary to one another, there is, in my view, not only no similarity in the competing services, the competing services are, in my view, remote from one another.

The distinctive character/reputation in the opponent's earlier trade mark

64. I have already concluded that the opponent's trade mark is, absent use, highly distinctive and that its distinctive character has been slightly enhanced by the use made of it. It is clear from the evidence provided, that the opponent's trade mark is recognised as the badge of origin of one of the market leaders in the LPO field; it has a range of high profile international clients and its work is commented upon in very favourable terms. Its trade mark has, as a consequence, a strong reputation in that regard.

Primary conclusion in relation to section 5(3)

65. Although I concluded earlier that the applicant's trade mark will be indirectly confused with the opponent's trade mark, that was in the context of services which were at least similar to a low degree (and many of which I regarded as identical). However, notwithstanding the degree of inherent/acquired distinctive character/reputation the opponent's earlier trade mark possesses, the significant distance in the competing services, makes it, in my view, most unlikely that in relation to the applicant's services which remain, the opponent's trade mark will even be brought to mind. However, even if it is, I am unable to see how it will lead to any of the injuries the opponent claims. Consequently, my primary conclusion in relation to the opposition based upon section 5(3), is that there will be no link created; without a link the objection fails and is dismissed accordingly.

What if a link is established?

66. However, if I am wrong and a link is created, I will now go on and determine whether one or more of the types of injury the opponent claims exists, or if there is a serious likelihood that one or more will occur in the future.

Unfair advantage

67. In relation to the above, the opponent states:

"The applicant will benefit from the opponent's investment in its advertising and promotion of its brand leading to advantage to the applicant without any investment by the applicant. The applicant will ride on the coat tails of the opponent's mark benefitting from its power of attraction, reputation and prestige."

68. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law in this regard and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

69. Although there is no evidence or submissions to suggest that the applicant intended to take advantage of the opponent's reputation, it is clear that a conclusion in the opponent's favour is still possible if the objective effect of any potential use by the applicant would amount to it gaining an unfair advantage. In relation to the standard of proof necessary to establish, inter alia, unfair advantage, in *Aktieselskabet af 21. november 2001 v OHIM*, Case C-197/07P, the CJEU stated that:

“22. With regard to the appellant's argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded prima facie that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 Intel Corporation [2008] ECR I-0000, paragraph 38).

23. In the present case, it is clear that the Court of First Instance, in paragraph 67 of the judgment under appeal, properly established the existence of an unfair advantage within the meaning of Article 8(5) of Regulation No 40/94 in correctly considering that it had available to it evidence enabling it to conclude prima facie that there was a risk, which was not hypothetical, of unfair advantage in the future.”

70. Further, in *Mäurer + Wirtz GmbH & Co KG v OHIM*, Case T-63/07, the GC held that:

“40. It is possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non hypothetical risk of detriment to the earlier mark or of unfair advantage being taken of it by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end. However, it is also possible that the mark applied for does not, at first sight, appear capable of giving rise to one of the risks covered by Article 8(5) of Regulation No 40/94 with respect to the earlier mark with a reputation, even though it is identical with or similar to the earlier mark, in which case the non-hypothetical, future risk of detriment or unfair advantage must be established by other evidence, which it is for the opposing party to put forward and prove (Case T-215/03 *Sigla v OHIM –Elleni Holding (VIPS)* [2007] ECR II-711, paragraph 48).”

71. Notwithstanding the duration, nature and extent of the opponent’s reputation, bearing in mind the services in relation to which it has been established, the risk of unfair advantage by virtue of an image transfer is, in relation to the applicant’s services mentioned above, in my view, no more than hypothetical. In the absence of “other evidence” from the opponent in support of the risk it claims exists, its objection under this head is dismissed.

Detriment to reputation

72. In relation to the above, the opponent states:

“The applicant’s use will be out of the control of the opponent and poor quality goods and/or services provided under the mark by the applicant will reflect upon the opponent’s business and services leading to detriment to the opponent’s valuable reputation and business.”

73. In *Unite The Union v The Unite Group Plc*, Case BL O/219/13, Ms Anna Carboni as the Appointed Person considered whether a link between an earlier mark with a reputation and a later mark with the mere potential to create a negative association because of the identity of the applicant or the potential quality of its goods/services was sufficient to found an opposition based on detriment to reputation. She said:

“46. Indeed, having reviewed these and other opposition cases, I have not found any in which the identity or activities of the trade mark applicant have been considered in coming to a conclusion on the existence of detriment to reputation of an earlier trade mark. I can understand how these matters would form part of the relevant context in an infringement case, but I have difficulty with the notion that it should do so in an opposition. After all, many, if not most, trade mark applications are for trade marks which have not yet been used by the proprietor; some are applied for by a person or entity that intends to license them to a third party

rather than use them him/itself; and others are applied for by an entity that has only just come into existence.

47. I do not exclude the possibility that, where an established trading entity applies to register a mark that it has already been using for the goods or services to be covered by the mark, in such a way that the mark and thus the trader have already acquired some associated negative reputation, perhaps for poor quality goods or services, this fact might be taken into account as relevant “context” in assessing the risk of detriment to repute of an earlier trade mark. Another scenario might be if, for example, a trade mark applicant who was a known Fascist had advertised the fact prior to the application that he was launching a new line of Nazi memorabilia under his name: I can see how that might be relevant context on which the opponent could rely if the goods and services covered by the application appeared to match the advertised activities. But I would hesitate to decide an opposition on that basis without having had confirmation from a higher tribunal that it would be correct to take such matters into account.”

74. As there is no evidence that the applicant is trading and no “other evidence” from the opponent of the type mentioned in *Mäurer*, the risk, once again, appears to me to be no more than hypothetical and the objection under this head is dismissed accordingly.

Detriment to distinctive character

75. Finally, in relation to the above the opponent states:

“There will be detriment to the distinctive character of the opponent’s mark because the opponent’s mark will no longer signify origin. Furthermore, the economic behaviour of the relevant public will be affected as they will employ the applicant’s services in place of those of the opponent. If such services are unsatisfactory the public may cease utilising the opponent’s services also. There is not due cause for adoption of the opposed mark.”

76. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated that:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words ‘[i]t follows that’, immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could

thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of ‘change in the economic behaviour of the average consumer’ lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers’ perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38 The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that ‘the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark’s ability to identify the goods for which it is registered as coming from the proprietor of that mark’.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under

appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”

77. In *32Red Plc v WHG (International) Limited and others* [2011] EWHC 665 (Ch), Henderson J. held that a change in consumers’ economic behaviour could be inferred from the inherent probabilities of the situation. He stated:

“133. Is there evidence of a change in economic behaviour brought about by the use of the Vegas signs? In the nature of things, direct evidence of such a change is likely to be hard to find in cases of the present type, although Mrs F provides a suggestive example of a customer who was nearly persuaded to change her allegiance as a result of a perceived connection between 32Red and 32Vegas. However, I see no reason why I should not have regard to the inherent probabilities of the situation, and in particular to the contrast between the marketing models of the two casinos. The similarity of their names, and the fact that 32Vegas was always operated as one of a number of linked casinos on the carousel model, lead me to conclude that an average online gambler would have been far readier to switch his allegiance from 32Red to 32Vegas, or to play with 32Vegas in the first place, than he would have been in the absence of such similarity. These are changes in economic behaviour, and I am satisfied on the balance of probabilities that such changes are likely to have occurred to a significant extent.”

(See also para. 137 of - *Ziff Management Europe Ltd v Och Capital LLP* [2011] F.S.R. 11).

78. The decision in *32Red*, makes it clear that it is not always necessary for evidence of a change of economic behaviour to be adduced for a claim of detriment to distinctive character to succeed. However, in the absence of “other evidence” the opponent’s concerns are once again, in my view, no more than hypothetical and the ground is dismissed accordingly.

Secondary conclusion in relation to 5(3)

79. If, contrary to my primary conclusion a link is established, the significant distance between the competing services is, in my view, more than sufficient to avoid any of the adverse consequences the opponent suggests. The opposition is dismissed accordingly.

Overall conclusion in relation to 5(3)

80. The opposition based upon section 5(3) of the Act fails in its entirety.

Overall conclusion

81. Subject to any successful appeal, the application will be allowed to proceed to registration in respect of:

Class 45 - Security services for the protection of property and individuals,

and will be refused in respect of all other services in the application.

Costs

82. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. Although the applicant has retained one category of services within class 45 of its application, given the overwhelming nature of the opponent's success, I have made only a very small reduction to the costs I would have otherwise awarded to the opponent had it been completely successful. Using the TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£300
Preparing evidence and considering the applicant's evidence:	£500
Opposition fee:	£200
Total:	£1000

83. I order Pangea Advisors Ltd to pay to Thomson Reuters Global Resources the sum of **£1000**. 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 7th day of April 2015

C J BOWEN
For the Registrar
The Comptroller-General