

O-221-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 3038480
IN THE NAME OF RAFAQAT ALI
IN RESPECT OF THE TRADE MARK:**



AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 500485 BY NSURE GROUP PLC**

Background

1. Trade mark no. 3038480 shown on the cover page of this decision, stands registered in the name of Rafaqat Ali. It was applied for on 18 January 2014 and completed its registration procedure on 13 June 2014. It is registered for “Insurance services” in class 36.

2. On 14 July 2014, Nsure Group plc (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) & (b) and sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). However, in a letter to the Tribunal dated 27 October 2014, the applicant withdrew the objection based upon section 5(4)(a) of the Act. The relevant provisions which remain read as follows:

“47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered,

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

.....

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

And:

“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.”

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.”

3. The applicant directs its application against all of the services for which Mr Ali's trade mark stands registered. It relies upon all of the services (shown below) in registration no. 2611378 for the trade mark **nsure**, which was applied for on 22 February 2012, for which the registration process was completed on 19 April 2013 and which is registered for:

Class 36 – Commercial insurance, renewable energy insurance, wet leisure insurance and professional indemnity insurance; all the aforesaid excluding any insurance services offered to individuals for their personal needs.

The trade mark shown above qualifies as an earlier trade mark under the above provisions. As the applicant's earlier trade mark had not been registered for more than five years when the application for invalidation was filed, it is not subject to proof of use, as per section 47(2)(2A) of the Act. As a consequence, the applicant is entitled to rely upon all of the services for which its earlier trade mark is registered.

4. The applicant states:

"The respective marks are at least visually and aurally similar since the second to sixth letters of the later mark are identical to the earlier mark. The presence of these letters also gives the marks a conceptual similarity due to the allusion to insurance. The services of the registration include services identical to those protected by the earlier mark."

5. Mr Ali filed a counterstatement in which the basis of the invalidation is denied. He stated:

"Our trademark ensuretaxi.com is very different in visual presence and orally speaking.

Our logo "ensuretaxi" looks very different to "Nsure" there is no chance that our business is trying to "pass off" as "Nsure". The geographical presence between us and the third party is immensely stretched out.

The product we supply clearly state on the trademark name i.e. ensuretaxi.com (taxi insurance).

The word "sure" is very commonly used word and many brands use this i.e. "sure" deodorant, "esure" insurance, "ensure" drinks manufacturers. I would also point out that in no way these names give a similarity due to the allusion to insurance.

**I have attached the image for "Nsure" and the image for "ensuretaxi".
As one can see the trademarks look different to one another.**

I also recommend you check the websites online where you will also see the colour and the texture of these websites are very different. It would be virtually impossible for the general public to mistaken one company to another, in the concept of passing off."

Attached to the counterstatement are printouts obtained on 29 July 2014 from the websites of nsure.co.uk and ensuretaxis.co.uk. I will return to these printouts and the proprietor's invitation for me to "check the websites online" later in this decision.

6. Both parties filed evidence; the applicant also filed written submissions with its evidence-in-chief. Whilst neither party asked to be heard, the applicant filed written submissions in lieu of attendance at a hearing.

The evidence

7. The applicant's evidence consists of two witness statements from Joseph Letang, a trade mark attorney at Dehns, the applicant's professional representatives; Mr Ali also filed a witness statement. I will refer to the contents of these statements later in this decision.

Section 5(2)(b) – case law

8. 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 process

9. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services; 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.”

10. The average consumer of insurance is either a member of the general public or a business user. As to how such services are selected, the applicant's evidence, which consists of printouts obtained from the websites of a number of companies providing insurance services in the United Kingdom, confirms my own experience (as a member of the general public) that whether bought on-line or from premises on the high street, visual considerations are likely to have an important role to play in the selection process. That said, as insurance is, in my experience, also the subject of both radio advertisements and personal recommendations, aural considerations will also play a part, albeit, in my experience, to a lesser extent than visual considerations. As to the degree of care that will be taken by the average consumer

when selecting insurance, in its written submissions accompanying its evidence, the applicant states:

“Insurance can be relatively modest in cost and is very commonly purchased by members of the public.”

11. In his statement, Mr Ali states:

“Consumers are more weary [sic] of who they are contacting for quotes due to the current economical situation, many people use the internet to shop around for a cheaper quote. The average consumers know exactly who they are being provided a quote from and to which company they are looking for.”

12. Whilst I agree with the applicant that insurance is “commonly purchased” by the average consumer, in my experience, the ever increasing cost of all types of insurance and the proliferation of, for example, price comparison websites, supports Mr Ali’s view of the matter. As a member of the public buying insurance is likely to undertake the type of investigations Mr Ali suggests, they will, as a consequence, pay a higher than normal degree of attention when doing so. As a business user is, in my view, likely to undertake many of the same investigations as a member of the public, and as the needs of a business user are likely to be more sophisticated with larger sums of money likely to be in play, I would expect them to pay an even higher level of attention.

Comparison of services

13. The competing services are as follows:

Applicant’s services	Mr Ali’s services
Class 36 – Commercial insurance, renewable energy insurance, wet leisure insurance and professional indemnity insurance; all the aforesaid excluding any insurance services offered to individuals for their personal needs.	Class 36 - Insurance services

14. In its submissions accompanying its evidence, the applicant states:

“The services of the challenged registration are identical and similar to those protected by the earlier mark. Commercial insurance is common to both marks. Non-commercial insurance services are similar to commercial insurance services because they are offered by the same organisations through the same trade channels. Consumers will expect companies that offer commercial insurance to also offer personal insurance, because this is typical of organisations operating in that sector...”

15. In his first statement, Mr Letang provides, as exhibit JML1, copies of pages obtained on 24 October 2014 from the websites of companies providing insurance services to the United Kingdom market i.e. aviva.co.uk axa.co.uk, allianz.co.uk and

hiscox.co.uk. By reference to this evidence, in its written submissions accompanying its evidence, the applicant states:

“Each of the examples listed offer commercial and personal insurance on the same website.

16. In his statement, Mr Ali states responded to the above in the following terms:

“The services we provide are not identical, we clearly state on our website and in our name that we are solely a taxi insurance provider. **Nsure** are not taxi insurance specialists and they do not mention taxi insurance on their website; hence there would be no confusion for a consumer.

As mentioned by Dehns “**Customers will expect companies that offer commercial insurance to also offer personal insurance**.”

This sentence is incorrect, consumer’s don’t expect commercial insurance brokers to provide personal insurance, and our name, website are clear in what type of product we specialise in.”

17. In his second statement, filed as evidence-in-reply, Mr Letang provided, as exhibit JML2, copies of a number of pages obtained on 10 February 2015 from the websites of other companies providing insurance services to the United Kingdom market i.e. finchgroup.net, bollington.com, cglloyds.co.uk, ltinsurance.co.uk and oneinsurancesolution.co.uk. Mr Letang states that this evidence:

“2...shows that taxi insurance is a form of commercial insurance.”

18. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“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).”

19. As Mr Ali’s “insurance services” would (irrespective of the exclusion at the end of the applicant’s specification) include all the applicant’s named insurance services, the competing services are identical on the principles outlined in *Merica*. However, in view of Mr Ali’s comments above, I thought it would be helpful if I also considered the position had the specification of his trade mark read “Insurance services for taxis” (or similar). However, even in those circumstances, as exhibit JML2 shows (which despite being obtained in February 2015 is, in my view, likely to have reflected the

position at the date when Mr Ali applied for his trade mark in January 2014), insurance for taxis is a sub-set of commercial insurance which appears in the applicant’s specification and would also be identical on the principles outlined in *Meric*.

Comparison of trade marks

20. As I mentioned above, in his counterstatement, Mr Ali provided examples of how the parties’ trade marks appear on their respective websites and suggested I review the websites for myself. Insofar as the latter is concerned, this Tribunal can only make determinations on the basis of evidence provided by the parties, it does not carry out its own investigations. As to the former, this approach was carried through to Mr Ali’s statement, where he based his comparison of the competing trade marks in the form in which they appear on the parties’ websites. As the applicant points out in its submissions filed in lieu of a hearing:

“The registered proprietor also incorrectly compares the marks in terms of how they appear on certain websites, as opposed to the marks as registered (which is the material point in these proceedings).”

21. The applicant is correct. What I am required to do is compare the competing trade marks in the form in which they stand registered, not in the form in which they may be used. As a consequence, the trade marks to be compared are as follows:

Applicant’s trade mark	Mr Ali’s trade mark
nsure	

22. 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.”

23. 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.

24. The applicant's trade mark consists of the word ensure presented in lower case. As no part of the trade mark is highlighted or emphasised in any way, there are no distinctive or dominant components; the distinctive lies in the totality. The overall impression will be of a single word, likely, in view, to be construed as a play on the word ensure.

25. Mr Ali's trade mark consists of a number of elements. The first is the word "ensure" presented in lower case in white. This word is followed by a capital letter "T" presented in yellow and enclosed within a circular device with a black background and yellow edging; this letter "T" is followed by the letters "AXI" presented in upper case also in yellow (the totality forming the word TAXI) which in turn is followed by a full stop and the letters "com" presented in lower case in white (indicating part of a web address); below the letters "co" of the word "com" there is a device element presented in yellow (which combine with the letters "co" to create a device reminiscent of a smiling face). All of these elements are presented against a blue rectangular background.

26. Although in the context of the insurance services at issue, the word TAXI, the punctuation mark/letters com and the rectangular background are likely to be considered descriptive and/or non-distinctive, they are clearly not negligible and contribute together with the colours in which the trade mark is presented to the overall impression it creates, which is, in my view, heavily dominated by the word ensure. The device element which contributes to create the impression of a smiling face, like the totality it creates, is, in my view, negligible and may well go unnoticed.

27. Although I accept that the applicant's trade mark is wholly contained within the first element of Mr Ali's trade mark, when considered from a visual perspective, the additional elements in Mr Ali's trade mark result in only a low degree of visual similarity between them. As to aural similarity, it is well established that when a trade mark consists of a combination of words and figurative elements, it is by the word element that the trade mark is most likely to be referred to. In this regard, I agree with the applicant that its trade mark will be articulated in the same way as the first element of Mr Ali's trade mark i.e. as the two syllable word en-sure; were Mr Ali's trade mark to be referred to by just the first element (which is not impossible given the descriptive/non-distinctive elements which accompany it), the competing trade marks would be aurally identical. However, in line with the current trend, I think it is equally likely that Mr Ali's trade mark will be articulated in full i.e. as the six syllable phrase en-sure tax-i-.com. However, even in those circumstances there remains, in my view, an above average degree of aural similarity between them. Finally, in relation to conceptual similarity, although the presence in Mr Ali's trade mark of the words Taxi and .com will create concrete conceptual impressions in the mind of the average consumer which are absent from the applicant's trade mark (albeit descriptive/non-distinctive ones), the fact that, in my view, both its trade mark and the first element of Mr Ali's trade mark will be understood as the word ensure still leads to a fairly high degree of conceptual similarity between them.

Distinctive character of the applicant's earlier trade mark

28. I must now assess the distinctive character of the applicant's trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the

services for which it is registered 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 the applicant has not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. In his statement, Mr Ali states:

“A point to remember is that the word “I-**NSUR**-ANCE” (Insurance, UK & globally used) actually includes the words, **NSUR**: if we compare this to **NSURE** group’s mark. The only difference is the word I-**NSUR**-ANCE does not have an **E** after the letter **R**. This clearly indicates that the words like **NSURE**, **ENSURE**, **ESURE**, **INSURE**, **INSURANCE** are very commonly used words in the insurance industry and are currently being used by hundreds of companies.”

29. Although I follow Mr Ali’s logic and accept that **INSURE** and **INSURANCE** are words that will be widely used by others in the insurance industry, it does not, in my view, follow that simply because the letters in the applicant’s trade mark appear in, for example, the word **INSURE**, that its trade mark lacks any distinctive character. As I mentioned above, more likely, in my view, is that the applicant’s trade mark will be approximated to the well known English language word **ensure** which collinsdictionary.com defines as, inter alia, “to make safe or secure; protect”. While that definition suggests that when considered in relation to insurance services the word **ensure** itself may be allusive, the applicant’s trade mark is one further step removed i.e. it is not **ensure** but **nsure**. However, given the meaning of the word to which it will, in my view, be approximated, the applicant’s trade mark is possessed of a relatively low degree of inherent distinctive character.

Likelihood of confusion

30. 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 factor in the distinctive character of the applicant’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 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. Earlier in this decision I concluded, inter alia, that:

- The competing services are identical;
- The average consumer is either a member of the general public or a business user who will select the services by both visual and oral means (with the visual component dominating) and who will pay (at least) a higher than normal level of attention when doing so;
- The overall impression created by the applicant's trade mark will be of a single word and a play on the word ensure;
- While the overall impression created by Mr Ali's trade mark will be dominated by the word ensure, other elements within the trade mark will contribute to the overall impression it creates;
- There is a low degree of visual similarity, an above average degree of aural similarity (if not aural identity) and a fairly high degree of conceptual similarity;
- The applicant's trade mark is, absent use, possessed of a relatively low degree of inherent distinctive character.

31. In its submissions filed in lieu of a hearing, the applicant states:

"The invalidity applicant has a validly registered trade mark upon which it is entitled to rely in these proceedings; the fact that it is registered is evidence of its distinctive character."

32. The applicant is correct. This approach is confirmed by the CJEU in *Formula One Licensing BV v OHIM*, Case C-196/11P, where it found that:

"41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of

Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

33. In addition, the fact that the applicant’s trade mark has only a weak inherent distinctive character does not preclude a likelihood of confusion. In *L’Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

34. In view of all of the above, I now need to decide if there will be a likelihood of confusion. The differences (in particular the visual differences) between the competing trade marks are, in my view, sufficient to avoid direct confusion i.e. where one trade mark is mistaken for the other. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc* (BL-O/375/10), the Appointed Person, Mr Iain Purvis Q.C, commented on the difference between direct and indirect confusion in the following terms:

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

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even

where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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

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

35. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of words tend to have more visual and aural impact than their endings. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.”

36. Although the above is only a rule of thumb, it is clear from, for example, the comments of the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, that descriptive or non-distinctive matter (in this case the word TAXI and the partial web address .com) should be given less weight when comparing trade marks. Bearing that guidance in mind, the fact that the first word in Mr Ali’s trade mark is visually similar to the applicant’s trade mark to (at least) a reasonable degree and aurally and conceptually identical, is, in my view, notwithstanding the degree of care taken during the selection process, sufficient for the average consumer to assume that the identical services at issue come from undertakings which are economically linked i.e. there is a likely of indirect confusion. In reaching that conclusion I have not overlooked the following comment in Mr Ali’s counterstatement:

“The geographical presence between us and the third party is immensely stretched out.”

37. However, as the applicant correctly points out in its submissions filed in lieu of a hearing:

“That is irrelevant to the proceedings because trade mark registration confers UK-wide rights.”

38. Nor have I overlooked the fact that Mr Ali’s trade mark is presented in a range of colours. 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.”

39. Although the applicant’s trade mark consists of a single word presented in lower case, as it would be legitimate for the applicant to present this word in a range of colours (including one or more of the colours in Mr Ali’s trade mark), the fact that Mr Ali’s trade mark is presented in colour is not a point which assists him.

Conclusion

40. The application has been successful and, subject to any successful appeal, the registration will, under the provisions of section 47(6) of the Act, be deemed never to have been made.

Costs

41. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering Mr Ali’s statement:	£200
Preparing evidence and considering Mr Ali’s witness statement:	£300
Written submissions:	£300
Application fee	£200
Total:	£1000

42. I order Razaqat Ali to pay to Nsure Group plc the sum of **£1000**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19TH day of May 2015

**C J BOWEN
For the Registrar
The Comptroller-General**