

O-475-15

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NO. 3071700
BY MATTHIAS MANGOLD
TO REGISTER THE TRADE MARK**

LIFEBONUS

IN CLASSES 9, 16, 28, 35, 36, 38 AND 41

AND

**THE OPPOSITION THERETO UNDER NO. 60000256
BY LIFE BOND HOLDING GMBH & CO. KG**

Background and pleadings

1. Matthias Mangold applied for the trade mark LIFEbonus on 8 September 2014 for a variety of goods and services in classes 9, 16, 28, 35, 36, 38 and 41. The application was published on 20 February 2015, following which it was partially opposed by Life Bond Holding GmbH & Co. KG (“the opponent”). The opposition is directed only at the services applied for in classes 35 and 36:

Class 35: Advertising; business management; business administration; office functions; marketing and promotional services; business analysis, research and information services; business assistance, management and administrative services; commercial trading and consumer information services; rental of advertising space.

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; financial and monetary services, and banking; fundraising and sponsorship; insurance underwriting; lending against securities; lending against security; pawnbroking; provision of prepaid cards and tokens; real estate services; secured loans; underwriting (Insurance -); valuation services.

2. The opposition has been brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), using the fast track procedure. The opponent relies on the following earlier Community trade mark:

10737971

Lifebond

Class 35: Advertising; Business management; Business administration; Office functions.

Class 36: Real estate affairs.

Filing date: 19 March 2012; date of completion of registration procedure: 26 August 2014.

3. The opponent claims that there is a likelihood of confusion owing to the similarities between the marks and identity or similarity between the services. Mr Mangold denies the claim:

“1. Save that it is admitted that the services “advertising”, “business management”, “Business administration”, “office functions” and “real estate affairs” are identical to those covered by the earlier trade mark, it is not admitted that the remaining services are either identical or similar and the Opponent is put to proof thereof.

2. It is denied that the trade marks at issue are similar.

3. To the extent that the Tribunal finds that there is a degree of similarity between the trade marks at issue, it is denied that the similarity is sufficient

that, taking account of the services covered by the respective application and registration, there is a likelihood of confusion.”

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

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

The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

5. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise written arguments will be taken. A hearing was neither requested nor considered necessary. Only the opponent filed written submissions which I will refer to, as necessary, along with the claims made in its notice of opposition.

Decision

6. Section 5(2)(b) of the Act states that:

“(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.”

7. 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.

Comparison of services

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

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”

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

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

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

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

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

13. The competing specifications are:

Earlier mark	Application
<p>Class 35: <i>Advertising; Business management; Business administration; Office functions.</i></p> <p>Class 36: <i>Real estate affairs.</i></p>	<p>Class 35: <i>Advertising; business management; business administration; office functions; marketing and promotional services; business analysis, research and information services; business assistance, management and administrative services; commercial trading and consumer information services; rental of advertising space.</i></p> <p>Class 36: <i>Insurance; financial affairs; monetary affairs; real estate affairs; financial and monetary services, and banking; fundraising and sponsorship; insurance underwriting; lending against securities; lending against security; pawnbroking; provision of prepaid cards and tokens; real estate services; secured loans; underwriting (Insurance -); valuation services.</i></p>

14. The first four terms in the class 35 specification of the application are identical to the entirety of the class 35 specification of the earlier mark: *advertising; business management; business administration; office functions.*

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-33/05, the General Court (“GC”) stated that:

“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 trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

The opponent’s term *advertising* covers *marketing and promotional services*, so these are identical. The opponent’s terms *business management* and *business administration* cover *business analysis, research and information services; business assistance, management and administrative services* in the application. *Rental of advertising space*, if not strictly covered by the opponent’s *advertising*, must be highly similar: the purpose of both is to provide advertisements, they are complementary services, aimed at the same users, and the channels of trade will coincide.

16. *Commercial trading and consumer information services*: I assume this means commercial trading information services and consumer information services. Although advertising provides information, I do not think the average consumer would consider the core meaning of consumer information to be advertising, or vice versa. *Consumer information services* are not similar to the opponent's services. Commercial trading (information) appears to be information about trading on the stock market or trading in investments. These are financial services. However, they have been applied for in class 35. To the extent that the information assists business activities, this term is encompassed by or is highly similar to the opponent's *business management services*.

17. Both parties' class 36 specifications include the identical term *real estate affairs*. The application also covers *real estate services*, which is identical to real estate affairs. *Valuation services* are highly similar to, if not covered by, real estate affairs. The purpose is to facilitate property sale at a given value and estate agents provide a valuation as part of the process of putting property on the market. In relation to the application's remaining services in class 36, the opponent submits:

"Real estate affairs include the financial services associated with real estate services, so insurance; financial affairs; monetary affairs; financial and monetary services, and banking; fundraising and sponsorship; insurance underwriting; lending against securities; lending against security; secured loans; underwriting (Insurance-); valuation services. Are [sic] all identical or similar to real estate affairs having the same nature and purpose and being complementary to those services.

The remaining services *pawnbroking; provision of prepaid cards and tokens* are also financial services which are complementary to the *real estate affairs* protected by the earlier right."

The opponent has not made any submissions as to whether it sees any similarity between the class 36 services of the application and its own class 35 services, so I will confine my analysis to its submissions, as reproduced above, regarding the class 36 services of the application and its own class 36 services (real estate affairs).

18. In *Bankia, SA v OHIM*, case T-323/14, the GC held that real estate services are not similar to financial services:

"34 As regards the comparison of the 'real estate services' covered by the mark applied for and the 'financial and banking services' in Class 36 covered by the earlier mark, the Board of Appeal found, contrary to the Opposition Division, that those services were similar on the ground, in essence, that they shared distribution channels, end-users and also providers (see paragraph 16 above).

35 In that respect, it should be noted, first, that, as regards the nature, intended purpose and method of use of the services at issue, financial and banking services do not have the same nature, the same intended purpose or the same method of use as real estate services. Whereas financial services are

provided by financial institutions for the purposes of managing their clients' funds and consist of, inter alia, the holding of deposited funds, the remittance of funds, the granting of loans or the performance of various financial operations, real estate services are services connected with a property, namely, in particular, the lease, the purchase, the sale or the management of such a property. Secondly, as regards the fact that the services in question might be found in the same distribution channels, it is clear that real estate services are not, in principle, provided on the same premises as financial services (see, to that effect, judgment of 11 July 2013 in *Metropolis Inmobiliarias y Restauraciones v OHIM — MIP Metro (METRO)*, T-197/12, EU:T:2013:375, paragraphs 42 and 43).

36 In any event, it cannot be validly argued that financial and banking services and real estate services are offered to customers without distinction in the same agency or branch of a bank. In principle, real estate services are provided by separate branches of financial institutions, so that financial activities are separate from any real estate activities (see, by analogy, judgment in *METRO*, cited in paragraph 35 above, EU:T:2013:375, paragraphs 44 and 45).

37 Thirdly, as regards whether the services in question are complementary, the Board of Appeal having found, in essence, in paragraph 26 of the contested decision that they were complementary, it should be noted that, while financial and banking services may play a significant role in the purchase of a property, it cannot be inferred from that fact alone that consumers would be led to believe that the same undertaking was responsible for real estate services and financial services. It cannot be claimed that consumers looking for a property turn to a financial institution in order to carry out that task. On the contrary, in such cases, consumers generally turn, first, to a real estate agency to search for a property and, secondly, to a financial institution in order to fund the property transaction. To conclude otherwise would imply that any non-financial procedure which, on the basis of its scale or other criteria, depends upon the provision of financing is complementary to a financial service, even where the only link lies precisely in the need to obtain financing and where consumers would in no way assume that the same undertaking was responsible for those services (see, to that effect, judgment in *METRO*, cited in paragraph 35 above, EU:T:2013:375, paragraphs 46 to 49).

38 The conclusion must therefore be drawn from the above, as the Opposition Division noted, that there is no similarity between the services in question, since, even though financial and banking services may be necessary in order to use real estate services, they are not so necessary that consumers will consider that the same undertaking was responsible for those financial services and real estate services.

39 It follows that, as the applicant claims, the Board of Appeal erred in finding that there was similarity between the 'real estate services' covered by the mark applied for and the 'financial and banking services' in Class 36 covered by the earlier mark."

19. Therefore, I find that none of the class 36 services of the application (except for real estate affairs, real estate services and valuation services, which are identical/highly similar) are similar to the opponent's services in class 36. Further, it is difficult to see how real estate affairs could ever be similar to pawnbroking and provision of prepaid cards and tokens.

Average consumer

20. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

21. 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.”

22. The average consumer for some of the parties' services will be the general public (e.g. real estate affairs, insurance and banking). For other services, it will be business professionals (e.g. the high finance, advertising, and business management). The purchasing process will be primarily visual as research will be undertaken before commitment is made. For banking, the telephone is a common medium through which to access banking services, but no more usual than internet banking and attendance in a physical branch.

23. At stake are potentially large sums of money. The services associated with large amounts of money or long-term business and financial decisions will be chosen with a high amount of care, whilst the level of attention will be lower for transactions with less financial or long-term impact. For real estate services, those selling the property will pay attention to choosing a provider to oversee the sale on their behalf. Those buying a property are likely to pay far more attention to the property than who is selling it. Overall, the average consumer's level of attention will be reasonably high.

Comparison of marks

24. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall

impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

25. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

26. The respective marks are:

Opponent	Applicant
Lifebond	LIFEBONUS

27. Both marks consist of two conjoined dictionary words, both of which contribute equally to the overall impression of the marks, the one word qualifying the other (a bond for life, a bonus for life). The first word in each mark is the same. The second word in each mark is different – bond and BONUS – but they both start with BON. This means that the first seven letters in each mark are identical, which is a high proportion of the marks and results in a high level of visual similarity.

28. There is less aural than visual similarity. The earlier mark consists of two syllables, whilst the application consists of three, with the second and third syllables (BONUS) pronounced differently to the second syllable of the earlier mark (BOND). As the first syllable is identical (LIFE), and it is the syllable which will be spoken first, there is an average degree of aural similarity.

29. The opponent submits:

“Conceptual comparison

The composite marks lifebond and LIFEBONUS have no meaning in the English language. Since the marks are without meaning there is no conceptual comparison to be made. It has long been established (*Sabel v Puma*) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

Overall comparison

The marks are visually and aurally highly similar. Conceptually, a comparison of the marks as a whole cannot be made but there is conceptual similarity between the separate elements of the respective marks. The marks each begin with the distinctive and dominant word LIFE. This element is the first element of the mark and the most memorable to consumers, the additional elements being simply words having financial connotations. Overall then there is a high degree of similarity between the marks.”

30. On the one hand the opponent submits that the marks cannot be compared conceptually, but on the other it submits that there is conceptual similarity between the words comprising the marks. This means that a conceptual comparison can be made. In relation to financial services, the opponent is correct that bond and BONUS have meanings. LIFE also has a meaning for financial services, specifically life assurance. A bond is a promise that borrowed money will be paid back at a specific date, whilst a bonus is an extra benefit or dividend. They have different meanings. Aside from the finance meaning, LIFE needs no explanation. There is an average degree of conceptual similarity as both marks share the LIFE meaning and both contain words which describe aspects of finance; but the words themselves have different financial meanings, which is a point of difference.

Distinctive character of the earlier mark

31. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹ the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

¹ Case C-342/97.

32. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark. As a consequence, I have only the inherent characteristics of its trade mark to consider. The mark consists of words which are descriptive of aspects of financial services, but the earlier mark is not registered for financial services. It does not describe or allude to any obvious characteristics of the opponent's services. The mark is comprised of two common dictionary words which will still be seen as separate words: the whole is not more than the sum of the parts. The inherent distinctive character of the mark is average for the registered services.

Likelihood of confusion

33. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the parties' services are either identical, highly similar or not similar at all. Where there is no similarity, there can be no likelihood of confusion. This means that the opposition fails in respect of:

Class 35: *Consumer information services.*

Class 36: *Insurance; financial affairs; monetary affairs; financial and monetary services, and banking; fundraising and sponsorship; insurance underwriting; lending against securities; lending against security; pawnbroking; provision of prepaid cards and tokens; secured loans; underwriting (Insurance -).*

34. This leaves the services for which I have found identity or high similarity:

Class 35: *Advertising; business management; business administration; office functions; marketing and promotional services; business analysis, research and information services; business assistance, management and administrative services; commercial trading information services; rental of advertising space.*

Class 36: *Real estate affairs; real estate services; valuation services.*

35. There is a high level of visual similarity between the marks. The services will, primarily, be purchased visually. Although there are conceptual differences, both share the ordinary LIFE meaning and both contain financial words as the second element, none of which describe or allude to characteristics of the services for which I have found identity or high similarity. The heightened level of attention of the average consumer during the purchasing process will not be enough to counteract

the similarities between the marks and the services and to militate against imperfect recollection. There is a likelihood of confusion.

Outcome

36. The application is refused for the following services:

Class 35: Advertising; business management; business administration; office functions; marketing and promotional services; business analysis, research and information services; business assistance, management and administrative services; commercial trading information services; rental of advertising space.

Class 36: Real estate affairs; real estate services; valuation services.

37. The application may proceed to registration for the following services:

Class 35: Consumer information services.

Class 36: Insurance; financial affairs; monetary affairs; financial and monetary services, and banking; fundraising and sponsorship; insurance underwriting; lending against securities; lending against security; pawnbroking; provision of prepaid cards and tokens; secured loans; underwriting (Insurance -).

Costs

38. Both parties have achieved an equal measure of success. Each side is to bear its own costs.

Dated this 12th day of October 2015

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