

O-425-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3138684
BY ALL UK LIMITED**

TO REGISTER:

SOOTY AND SWEEP

AS A TRADE MARK IN CLASS 37

AND

**THE OPPOSITION THERETO UNDER NO. 600000406
BY REECE VERNON FORBES-SINCLAIR**

BACKGROUND

1. On 1 December 2015, ALL UK LIMITED (the applicant) applied to register the mark shown on the cover page of this decision for the following services:

Class 37: *Chimney sweeping*

2. The application was published for opposition purposes on 18 December 2015 and a notice of opposition, under the fast track procedure, was subsequently filed by Reece Vernon Forbes-Sinclair.

3. The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (the Act). Mr Forbes-Sinclair argues that the respective services are identical and that the marks are similar.

4. Mr Forbes-Sinclair relies on the UK Trade Mark registration no. 2605985 for the mark Sooty The Sweep, which has a filing date of 5 January 2012 and was registered on 27 April 2012 in respect of the following services:

Class 37: *Chimney sweeping*

5. The applicant filed a counterstatement in which it did not deny that there is similarity between the respective marks or the respective services, but made a number of comments as to why the opposition should fail. Rather than detailing them here, I will take them into account, referring to them when necessary.

6. Rules 20(1)-(3) of the Trade Marks Rules (TMR) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

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

7. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

8. No leave was sought in respect of these proceedings.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

10. Neither party was professionally represented. A hearing was neither requested nor considered necessary. Only the opponent filed written submissions, which I will refer to as necessary, below.

DECISION

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

“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”.

12. An earlier trade mark is defined in Section 6 of the Act, which states:

“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.

13. Given its date of filing, Mr Forbes-Sinclair's mark is an earlier mark in accordance with Section 6 of the Act. As Mr Forbes-Sinclair's mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. Consequently, the earlier mark may be relied upon without having to prove use.

Section 5(2)(b) case law

14. 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The correct approach to the comparison of services

15. Both the applicant, in its counterstatement and Mr Forbes-Sinclair, in his notice of opposition and in his written submissions, refer to the geographical extent of the respective marks' use. The applicant states:

“Whilst our core business name “ALL UK” suggests we are a National business, we operate within the Midlands and have no plans to extend our services beyond the Midlands and therefore do not feel that we are a threat of any kind to “Sooty The Sweep”, especially as there is over 200 miles between our addresses”.

16. Mr Forbes-Sinclair states that he intends to franchise his business on a national basis. He notes, in his written submissions, that whilst the applicant states that it does not intend to go nationwide, once the mark is registered there is nothing to prevent the applicant from selling it to a third party who may wish to extend the business nationally. I agree. In this connection I note that in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P the Court of Justice of the European Union (CJEU) stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

17. Accordingly, considerations relating to use are not pertinent when comparing the services and the fact that the parties trade in different locations is, therefore, irrelevant. The comparison that has to be made is a notional one, based on the services as registered and the services as applied for.

Comparison of services

18. The parties' services are:

Applicant's services	Mr Forbes-Sinclair's services
Class 37 <i>Chimney sweeping</i>	Class 37 <i>Chimney sweeping</i>

19. The respective services are self-evidently identical.

The average consumer and the nature of the purchasing act

20. 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 will be selected in the course of trade.

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 parties' services are used to clean chimneys and remove the build-up of soot and creosote from the chimneys of wood burning stoves and fireplaces. The average consumer is likely to be a homeowner and/or a landlord who have coal or wood burning fireplaces or stoves in their properties. The services are most likely to be selected having encountered the marks on a visual level, such as printed

advertisements and website use. However, I do not discount aural considerations, in the form, for example, of oral recommendations and use over the telephone. As to the level of attention paid during the selection of the services, from my experience the services are not cheap, but are not very expensive either. Nonetheless given the importance of preventing and/or correcting chimney related-hazards, which, can, in turn, result in fires and consequently, damage to properties and risk lives, the level of attention paid to the selection will be higher than average, to ensure a good deal and a good level of safety and reliability.

Comparison of marks

23. 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 them, bearing in mind their distinctive and dominant components. The 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.”

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

25. The marks to be compared are:

Applicant's mark	Mr Forbes-Sinclair's mark
SOOTY AND SWEEP	Sooty The Sweep

Overall impression

26. The only submissions I have on the comparison of the competing marks is Mr Forbes-Sinclair's bare assertion that the marks are "too easily confused".

27. The applicant's mark consists of the phrase 'SOOTY AND SWEEP', presented in capital letters. The mark contains no dominant components; rather, its distinctive character resides in the combination the words create. Mr Forbes-Sinclair's mark consists of the phrase 'Sooty The Sweep', all in lower case with initial capitals. No element of the mark stands out. Once again there are, in my view, no dominant elements, the distinctiveness of the mark lying in its totality.

Visual and aural similarity

28. Since both marks are word marks what is protected is the combination of words itself; consequently, I do not place any weight on the capacity of the casing to differentiate between the marks as notional and fair use of the applied for mark includes use in different scripts, such as, for example, a format comparable to that used by Mr Forbes-Sinclair's mark. The fact that the competing marks contain three elements, two of which, i.e. 'SOOTY/Sooty' and 'SWEEP/Sweep', are identical and appear in the same order and bearing in mind that the marks differ only to the extent that they contain a different second word, the short words 'AND' and 'The', results, in my view, in them being visually and aurally similar to a high degree.

Conceptual similarity

29. Whilst I have no submissions as to the meaning the words 'Sooty' and 'Sweep', the applicant submits in its counterstatement:

“Both names lend themselves naturally to the chimney sweeping business with Sooty The Sweep implying Mr Forbes- Sinclair operates as a 1 man band, whilst Sooty and Sweep implies that there are multiple individuals involved, of which there will be 2”.

30. Conceptually, when viewed as whole both marks bring to mind the concepts of ‘Sooty’ and ‘Sweep’. As to their meanings, Oxford English Dictionary provides the following definitions:

“**Sooty:** *Adjective (sootier, sootiest)*

Covered with or coloured like soot: *his olive skin and sooty eyes.*

■ used in names of birds and other animals that are mainly blackish or brownish black, e.g. **sooty tern.**”

“**Chimney Sweep:** *noun:* a person whose job is cleaning out the soot from chimneys.”

The word ‘Sooty’ is likely to bring to mind, in the context of the concerned services, the idea of someone covered in soot. Insofar as the word ‘Sweep’ is concerned, this is likely to be seen as shorthand for a ‘chimney sweep’. To this extent, the marks are conceptually identical. Whilst I accept that the preposition ‘AND’ in the applicant’s mark may bring to mind the concept of ‘SOOTY’ and ‘SWEEP’ as two separate ideas (or characters) and that in Mr Forbes-Sinclair’s mark, the article ‘The’ conveys the idea of ‘Sooty’ being a character qualified as ‘The Sweep’, I do not consider these constructions to introduce more than a negligible difference. This is because, I do not consider that these are points which will engage the average consumer’s attention – or which, even if they are noticed at the time, will be retained in the memory. In my view the marks are conceptually identical or, alternatively, similar to a high degree.

Distinctive character of the earlier mark

31. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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).

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).”

32. I note that Mr Forbes-Sinclair states in his written submissions:

“We have spent tens of thousands of pounds in advertising, paper and the internet, to promote and expand our business and brand.

[...] we have over 35 years of goodwill that we seek to protect by opposition this Application”.

33. However, these are fast track opposition proceedings in which it was not necessary for Mr Forbes-Sinclair to provide any evidence of the use it may have made of his earlier mark, thus, I have only the inherent characteristics to consider.

34. The applicant states:

“There are already multiple sole traders who use the name “Sooty The Sweep” and “Sooty and Sweep” with over 35 chimney sweeps within the Dorset Area alone. On a wider basis there are hundreds of chimney sweeps across the country and disagree with the claim that Mr Forbes-Sinclair makes that we will have a detrimental impact on his business plans”.

35. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court (GC) 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).”

36. There is no evidence that the marks referred by the applicant are used or even registered. Accordingly, the applicant’s submissions that the words “Sooty The Sweep” are commonly used in relation to the services of the earlier mark are not pertinent.

37. In assessing the distinctiveness of the phrase “Sooty The Sweep”, I bear in mind that a registered trade mark must be assumed to have ‘at least some distinctive character’¹. In the present case, the words “Sooty The Sweep” are allusive of the services covered by the mark, i.e. chimney sweeping services. As such, the mark is

¹ *Formula One Licensing BV v OHIM*, Case C-196/11P

possessed of a moderate degree of inherent distinctive character in relation to the services covered by the specification.

Likelihood of confusion

38. 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 marks may be offset by a greater degree of similarity between the respective services and vice versa. 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 marks and must instead rely upon the imperfect picture of them he has retained in his mind.

39. Earlier in this decision I have found that the respective services are identical and that the marks are visually, aurally and conceptually similar to a high degree. Even making allowances for the moderate degree of inherent distinctive character of the earlier mark and for the average consumer's higher than average level of attention, there is little difference between the marks and the key conceptual hook that will be recalled by the average consumer will be that of the two words 'SOOTY/Sooty' and 'SWEEP/Sweep'. Having carefully considered all these factors, I come to the conclusion that it is likely that the differences in the competing marks will go unnoticed by a significant portion of the relevant public, who will thus directly confuse them.

CONCLUSION

40. The opposition has succeeded.

COSTS

41. As Mr Forbes-Sinclair has been successful, he is entitled to a contribution towards his costs. Awards of costs in Fast Track opposition proceedings are governed by Tribunal Practice Notice (TPN) 2/2015. I note that Mr Forbes-Sinclair is

self-represented and as such, he has not incurred the costs of legal representation. I award costs to Mr Forbes-Sinclair on the following basis:

Official fees: £ 100

Preparing a statement and considering the other side's statement: £ 100

Written submissions: £ 50

Total: £ 250

42. I order ALL UK LIMITED to pay Mr Forbes-Sinclair the sum of £ 250 as a contribution towards his costs. 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 7th day of September 2016

Teresa Perks

For the Registrar

The Comptroller – General