

O-179-17

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3151462
BY BEIJING 515J REALTY SERVICE CO. LIMITED
TO REGISTER THE TRADE MARK DEVICE**



IN CLASS 36

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 406732 BY
BE WISER INSURANCE SERVICES LIMITED**



BACKGROUND

1) On 24 February 2016, Beijing 5i5j Realty Service Co. Ltd (hereinafter the applicant) applied to register the trade mark shown above in respect of the following services:

- Class 36: Real estate agencies; Real estate brokers; Leasing of real estate; Real estate appraisal; Real estate management; Apartment house management; Renting of apartments; Accommodation bureaux [apartments]; Rental of offices [real estate]; Charitable fund raising; Factoring; Fiduciary; Financial evaluation [insurance, banking, real estate]; Financing services; Loans [financing]; Insurance underwriting; Insurance brokerage.

2) The application was examined and accepted, and subsequently published for opposition purposes on 11 March 2016 in Trade Marks Journal No.2016/011.

3) On 9 June 2016 Be Wiser Insurance Services Limited (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
	2545853	22.04.10 06.08.10	36	Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage, financial services; financial affairs; travel insurance brokerage; breakdown insurance and membership brokerage.
	3068430	13.08.14 12.12.14	36	Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage, financial services; financial affairs; travel insurance brokerage; breakdown insurance and membership brokerage.

a) The opponent contends that its marks and the mark applied for are very similar and that the services applied for are similar to the services for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is only in relation to the following services: Charitable fund raising; Factoring; Fiduciary; Financial evaluation [insurance, banking, real estate]; Financing services; Loans [financing]; Insurance underwriting; Insurance brokerage.

4) On 23 August 2016 the applicant filed a counterstatement, basically denying that the marks are similar, and put the opponent to strict proof of use in respect of mark UK 2545853. It points out that there are a number of owl devices registered for class 36 services, and states that its mark is a cartoon cutie style owl (full bodied, but without details such as legs, claws and feathers) and a house.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Both sides provided written submissions which I shall refer to as and when necessary in my decision.

OPPONENT’S EVIDENCE

6) The opponent filed a witness statement, dated 17 October 2016, by Andrew John Dunkerley a Director of the opponent company, a position he has held since July 2009. He states that his company has used the logo of an owl in conjunction with the words “Be Wiser Insurance” and/or “Be Wiser” and that the mark was registered under UK 2545853. He states that the company has assets of £1.7 million and is one of the fastest growing personal line brokers in the UK with over 700 staff in six offices in the UK. For the year ending 31 May 2016 the opponent’s gross written premium income was £123 million. The opponent acts for over 30 of the largest UK insurance companies including Aviva, Axa, Royal and Sun Alliance and Zurich Insurance. The opponent currently has over 210,000 clients and sell their policies via their website and over the telephone. He states that since its inception over £52 million has been spent on marketing and advertising. The advertising has included gaining entries in various directories, placing advertisements on hoardings at motorway services, petrol stations, cinemas and shopping centres around the UK. It also included advertisements on TV (ITV, Channel 4, Channel 5 and Sky TV) and in the national press (Daily Express, Daily Telegraph, Daily Mail, Daily Star, Sunday Times and Daily Mirror) as well as motoring magazines. In total they placed over 3000 advertisements in 58 publications with a cumulative circulation figure of approximately 469 million over the past eight years. The opponent has also sponsored sports events and teams. He states that in July 2016 the Insurance Post ranked the opponent as the 26th largest

broker in the UK. He states that customers provide their details by phone or via the internet and state what service they require i.e. Car, van, motorbike, home or travel insurance or breakdown cover. His company provides a list of quotations from different insurance providers to allow the customer to compare the costs etc. of each provider. He provides a single exhibit AD1. This contains a spreadsheet of marketing expenditure for each year from 2008-2016 inclusive. As might be expected this rises from the first year £ 513,402 (2008) to £10,598,093 in 2016. The expenditure in each year is considerable. The number of policyholders increases from 7,800 in 2008 to 210,000 in 2016; whilst the gross written premium income rises from £4.6 million in 2008 to £123 million in 2016.

7) The other pages in this exhibit are as follows:

- Pages 2-14 inclusive of exhibit AD1 appear to be advertisements from various sources such as hoardings, directories, newspapers etc. Whilst all of the advertisements have an image of an owl and most feature the words “Be Wiser” or “Be Wiser Insurance” there are clearly a number of different owl devices used by the opponent. Only page 4 is dated and it is not clear where the advertisements appeared, although page 5 appears to be from a Yellow pages directory, whilst page 10 appears to be a hoarding at a motorway service station, and page 11 is a hoarding alongside a road. Pages 13 & 14 have the names of newspapers and magazines included on the page implying these were the publications in which the advertisement appeared. None of the pages has the device element which appears in UK 2545853. Only one page has mark 3068430 upon it. All are advertising car, van, motorcycle and home insurance. A number also offer insurance in relation to breakdowns and personal accidents, homes, tradesmen, public liability, employee liability, shops and offices, residential and commercial, landlords, pubs and restaurants, boilers and heating.
- Pages 15 & 16 appear to be photographs of various sporting events which were sponsored by the opponent. Again no details are provided as to where or when these events took place. Whilst they show use of various owl devices and the words “Be Wiser” or “Be Wiser Insurance” none show use of either of the marks relied upon by the opponent.
- Pages 17 & 18 are the front and back of a sticker which when placed upon a piece of glass such as a windscreen shows the owl device from 2545853 on the front, *sans* words. On the back another owl device appears (but not the two relied upon) with the words “Be Wiser Insurance” and a phone number. It is not clear when, where or to whom this was distributed.

- Pages 20-23 inclusive are webpages from insurance commentators' websites and appear to support the claim by the opponent regarding its revenues and position in the top fifty brokers in the UK insurance industry, one of which has a date in 2014. Page 20 is identified as being from Finaccord, whilst page 21 is from www.insuranceage.co.uk. Quite who or what these sources are is unclear and none of the pages are dated.
- Pages 23 & 24 are from the opponent's own website but do not show use of either of the marks relied upon. They show the type of details required from potential customers and also the types of insurance offered, van, car, motorbike, home and travel. The marks used which are, in my opinion, closest to the registered mark are as follows:

Page 4: This has a date which is very difficult to read but would appear to be in August 2016.



Page 9



Page 10



Page 13





8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The only ground of opposition is under section 5(2)(b) which reads:

“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.”

10) An “earlier trade mark” is defined in section 6, the relevant part of 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 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.”

11) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. Given the interplay between the date that the opponent’s mark was registered (6 August 2010) and the date that the applicant’s mark was published (11 March 2016), the proof of use requirements bite. Section 6A of the Act states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application 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) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) 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, and

(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.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) 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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

12) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of the application was 11 March 2016, therefore the relevant period for the proof of use is 12 March 2011 – 11 March 2016. In *The*

London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes *Case C-442/07 Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and *Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

13) The applicant contends in its submissions that the use shown has been in a form differing in elements which alter the distinctive character of the mark in the form in which it is registered. The opponent accepts that its evidence does not show the mark as registered, but contends that the versions used do not alter the distinctive character of the mark. In deciding the issue I look to the comments of Mr Richard Arnold Q.C. (as he then was) as the Appointed Person in *Nirvana Trade Mark*, BL O/262/06, where he summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of

the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

14) Although this case was decided before the judgment of the Court of Justice of the European Union ("CJEU") in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The opponent contends that the use shown includes cropping of the owl device's feet and use of colour which do not affect the distinctive character of the mark. They also contend that the positioning of the wording "Be Wiser" and/or "Be Wiser Insurance" does not affect the distinctive character of the mark. I accept that the cropping of the image and colour do not alter the mark's distinctive character and will, reluctantly, accept the contention regarding the positioning of the wording in the instant case. The opponent finally contends that the instances where the owl is sideways on also does not affect the distinctive character. I do not accept this view. To my mind, the sideways view of an owl fundamentally affects its shape, whilst still a relatively realistic depiction of an owl, and whilst the full face is towards the viewer as per the registered mark the overall impression is, to my mind, different. However, even if I agree with all of the above and accept that in all its different forms the use shown equates to use of the registered mark this does not get the opponent over the line in actually showing use of its mark. The evidence provided is, to put it mildly, sketchy. Apart from the assertion of Mr Dunkerley that various advertisements were placed in magazines, on television and on hoardings and the provision of impressive figures for such advertising, any corroboration is sadly lacking.

15) When considering the evidence filed I take into account the comments in *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the

material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

16) I also look to the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, where Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question,

and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

17) The opponent’s evidence was not challenged by the applicant, nor was cross examination sought. However, the opponent has failed to provide a single piece of dated corroborative evidence that it did indeed advertise its services within the period concerned. It has provided turnover figures and stated that these relate to various insurance services, and there is a single printout from www.insuranceage.co.uk relating to “personal lines brokers” which is dated 2014 (page 21). In the absence of dated copies of magazine advertisements, showing precisely which version of Owl and wording was actually used, if any, the opponent could have filed invoices showing payments for said advertisements. Similarly, hoardings and TV advertisements would have involved payments to various companies for providing the service even if copies of the advertisements or dated pictures were unavailable. Again details of what device element was used in these advertisements would have been helpful. The opponent could equally have obtained witness statements from the companies it states that it represents such as Axa, Royal and Sun Alliance or Zurich. **To my mind, the opponent has failed to support its contentions of use, and has not met the requirement to provide evidence of its use within the specified period. However, in case I am wrong on this I shall go on to consider the services which the opponent claims it has offered.**

18) The opponent’s mark is registered for:

“Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage, financial services; financial affairs; travel insurance brokerage; breakdown insurance and membership brokerage.”

19) As can be seen from my evidence summary at paragraphs 6 & 7 above the services offered on the various pages of exhibits cover virtually all aspects of insurance but do not mention financial services. To my mind the opponent, if their evidence were accepted as showing use, would be entitled to rely upon the following services: “Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage, travel insurance brokerage; breakdown insurance and membership brokerage”. This is the specification for 2545853 which I shall use in my comparison test.

20) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

(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

21) 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.”

22) I must consider the class 36 services of both parties, which (excluding those not opposed) broadly speaking are financial and insurance services. Such services are going to be purchased by the general public including businesses. Such consumers are likely, in my opinion, to select the services mainly by visual means, initially from an on-line search or advertisement. Once selected, even if the transaction is carried out on-line the average consumer is going to take considerable care in the selection as personal details will have to be provided and the service, whether insurance or financial, is going to be relied upon by the consumer to be robust and legitimate as the consequences of dealing with a less than scrupulous operator could be severe. Whilst the visual issues are likely to be the most important I also must take into account aural issues as it is possible that word of mouth recommendations may play a part in the selection. As I have stated, the nature of the services are such that the average consumer will pay **a medium to high degree of attention to the selection of such services.**

Comparison of services

23) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

24) 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.

25) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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”.

26) In *Sanco SA v OHIM*, Case T-249/11, the General Court 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.

27) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

28) The services of the two parties are:

Applicant's services	Opponent's services
Class 36: Charitable fund raising; Factoring; Fiduciary; Financial evaluation [insurance, banking, real estate]; Financing services; Loans [financing]; Insurance underwriting; Insurance brokerage.	2545853: "Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage, travel insurance brokerage; breakdown insurance and membership brokerage"
	3068430: Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage, financial services; financial affairs; travel insurance brokerage; breakdown insurance and membership brokerage.

29) The applicant contends that its insurance and financial services are targeted at its realty customers. It states “It is believed that the opponent’s target consumers are mainly life, saving, car or other type of insurance consumers, and the opponent seldom targets the people who are the house sellers, house buyers, landlord or tenant. Therefore it is believed that the applicant’s target consumers are different to those of the opponent”. However, I note that the opponent has “insurance services” registered without limitation. Therefore, I find that the term “insurance services” found in both the opponent’s marks encompasses “Financial evaluation [insurance]; Insurance underwriting; Insurance brokerage” which are within the applicant’s specification and must be regarded as identical.

30) However, the insurance services of the opponent's mark 2545853 are not similar or complementary to the remaining financial services applied for by the applicant.

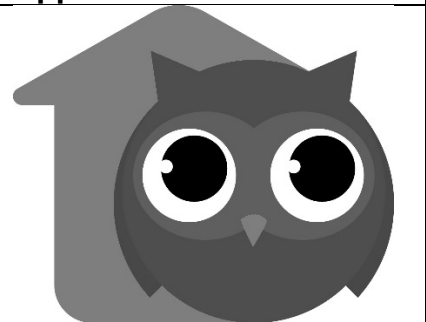

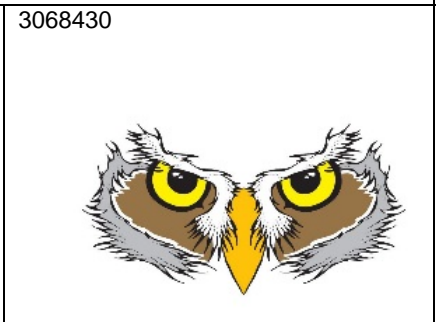
31) Turning to the opponent's specification in relation to trade mark 3068430 the terms "financial services; financial affairs" would clearly encompass "Factoring; Fiduciary; Financial evaluation [banking, real estate]; Financing services; Loans [financing]" and so must be regarded as identical. None of the opponent's services under this mark are similar or complementary in any way to the applicant specification of "Charitable fund raising", which is not a standard financial arrangement where a loan etc. is provided, it involves persuading individuals and companies to donate money for no return, apart possibly for some publicity showing them in a "good light".

Comparison of trade marks

32) 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."

33) It would be wrong, therefore, artificially to dissect the trade 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 them. The trade marks to be compared are:

Opponents' trade marks		Applicant's trade mark
2545853	3068430	
		

34) The applicant contends that its mark consists of a device of a house and a cartoon style owl which does not show its claws and contains no detailed feathers, and its eyes have a cute look. It describes the opponent's 2545853 mark as "a more realistically depicted grey scale owl with feathers detailed in a darker shade, is shown standing such that legs and claws are visible and is accompanied by the wording "Be Wiser Insurance"." Regarding the opponent's mark 3068430 the applicant states that it : "consists only of a pair of owl eyes and a beak without a body". It continues: "The owl's eye expression looks very serious and the mark is in realistic owl colours".

35) The opponent contends that both parties' marks consist of owls. It rejects the claim that the average consumer will identify the house behind the owl in the applicant's mark and associate this with real estate. The opponent also rejects that its owls are serious and that of the applicant cute.

36) I shall firstly compare the mark in suit with the opponent's mark 2545853. Visually the most obvious difference is the presence of the words "Be Wiser Insurance" in the opponent's mark in large print and which are the dominant element of the mark. Clearly the owl device in the opponent's mark will not be overlooked if only because of its size and its position to the left of the wording, meaning that it will be seen first by the average consumer. To my mind, the opponent's owl is reasonably realistic with legs, claws and feathers. Its features are proportionate to its overall scale. In contrast the mark in suit shows a cartoon-like baby owl with hugely exaggerated eyes. It is un-realistic and stands in front of a house. There are no words in the mark. The depictions of owls in the two marks could hardly be more different. In my opinion, visually the marks are not similar. As the mark in suit has no words then aurally the marks are not similar. Conceptually other than each having an owl the marks differ in that the owl device in the opponent's mark emphasises the words "Be Wiser" as owls are generally thought to be wise, whilst the mark in suit simply appeals to the emotional side of consumers as it will be considered to be "cute". **Overall the marks are similar to a very low degree.**

37) I now turn to compare the mark in suit to the opponent's 3068430 mark. The applicant states that the mark: "consists of only a pair of owl eyes and a beak without a body". Also "Moreover, the opponent's owl's eye expression looks very serious and the mark is in realistic owl colours". The opponent merely states that both are representations of an owl. In my opinion, the opponent's mark is aggressive and brooding, which is a complete contrast with the "cute" image of the mark in suit. Visually the marks are very different, there is no aural comparison to be made, and conceptually whilst the opponent's mark will probably be identified as the main portion of an owl's face, the marks send very different messages; one child like, the other tough and aggressive. **Overall, I do not consider the mark to have anything other than a very superficial similarity.**

Distinctive character of the earlier trade mark

38) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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)."

39) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of

confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

40) The opponent’s mark 2545853 consists of a realistic image of an owl and the words “Be Wiser Insurance”. Clearly the word “insurance” for insurance services is descriptive. The words “Be Wiser” would be seen as allusive, informing the consumer that choosing the opponent’s services is the wise choice. **Overall the opponent’s mark is inherently distinctive to a medium degree. The opponent has not shown use of its mark and so it cannot benefit from enhanced distinctiveness. Even if were to accept that it had shown use of its mark the evidence was not sufficient to warrant enhanced distinctiveness.**

41) The opponent’s mark 3068430 consists of an image of an owl’s eyes and beak. **It is inherently distinctive to a medium degree for the services for which it is registered. The opponent has not shown use of its mark and so it cannot benefit from enhanced distinctiveness. Even if were to accept that it had shown use of its mark the evidence was not sufficient to warrant enhanced distinctiveness.**

Likelihood of confusion

42) 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 marks as the more distinctive the 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. Earlier in this decision, I concluded that:

- the average consumer for the services is a member of the general public including businesses who will select the services by predominantly visual means, although I do not discount aural considerations and that they are likely to pay a medium to high degree of attention to the selection of such services.
- The opponent's mark 2545853 is similar to a very low degree to the mark in suit.
- The opponent's mark 3068430 is similar to the mark in suit only in a very superficial way.
- Both of the opponent's marks have a medium level of inherent distinctiveness but neither can benefit from an enhanced distinctiveness through use.
- The following services of the applicant are identical to the opponent's services under its mark 2545853: "Financial evaluation [insurance]; Insurance underwriting; Insurance brokerage".
- The following services of the applicant are identical to the opponent's services under its mark 3068430: "Financial evaluation [insurance]; Insurance underwriting; Insurance brokerage; Factoring; Fiduciary; Financial evaluation [banking, real estate]; Financing services; Loans [financing]"

43) In view of all of the above, and allowing for the concept of imperfect recollection, in respect of either of the opponent's marks there is no likelihood of consumers being confused into believing that

the services applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it.

44) I must also consider the comments of Mr Iain Purvis Q.C. as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, where he 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).”

45) I do not believe that the instant case falls into the category described above and find that there will be no indirect confusion, as the marks are so dissimilar that I do not believe that simply because both use an owl device that the average consumer will assume that only one party will use such a device or that it is a sub-brand. **The opposition under Section 5(2) (b) therefore fails.**

CONCLUSION

46) The opposition in relation to all the opposed services has failed. The mark will be registered for all of the services applied for by the applicant.

COSTS

47) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Considering the other side's evidence	£200
Submissions	£200
TOTAL	£700

48) I order Be Wiser Insurance Services Limited to pay Beijing 5i5j Realty Service Co. Limited the sum of £700. This sum 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 11th day of April 2017

George W Salthouse
For the Registrar,
the Comptroller-General