

**O-165-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3187372  
BY BRAIT LIMITED TO REGISTER THE TRADE MARK**

**brait**

**IN CLASSES 35, 36, 41 AND 45**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 408330  
BY BRAIT SOCIETAS EUROPAEA**

## **Background and pleadings**

1) Brait Limited (“the applicant”) applied to register, under no 3187372, the mark “brait” in the UK on 23 September 2016. It was accepted and published in the Trade Marks Journal on 28 October 2016. At the hearing, the applicant confirmed that he was removing Class 35 and Class 36 from the application (this was subsequently done) and, therefore, the remaining services covered by the application are as follows:

**Class 41:** *Business educational services.*

**Class 45:** *Legal advice; Legal consultancy services; Legal information research services; Legal investigation services; Legal mediation services; Legal services relating to wills; Legal support services; Legal research; Legal services relating to intellectual property rights; Legal document preparation services; Legal administration of licences; Legal consultation in the field of taxation; Legal services relating to the exploitation of patents; Legal services relating to the negotiation and drafting of contracts relating to intellectual property rights; Legal services relating to the protection and exploitation of copyright for film, television, theatre and music productions; Legal advice relating to franchising; Legal services relating to the exploitation of transmission rights; Legal services for procedures relating to industrial property rights; Legal services relating to copyright licensing; Legal services relating to company formation and registration; Legal consultancy relating to intellectual property rights; Legal services relating to the management, control and granting of licence rights; Legal services relating to the registration of trademarks; Legal services relating to the management and exploitation of copyright and ancillary copyright; Legal advice and representation; Legal services relating to the exploitation of copyright for printed matter; Legal services relating to the exploitation of film copyright; Legal and judicial research services in the field of intellectual property; Legal services relating to the exploitation of broadcasting rights; Legal assistance in the drawing up of contracts; Legal services relating to the exploitation of copyright and industrial property rights; Legal services relating to the exploitation of intellectual*

*property rights; Legal services relating to the exploitation of ancillary rights relating to film, television, video and music productions; Legal services.*

2) Brait Societas Europaea (“the opponent”) opposes the application on the basis of sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In respect of the grounds under section 5(1) and section 5(2)(a) it relies upon the earlier European Union Trade Mark (“EUTM”) 15471295, claiming that the applicant’s mark is in respect of an identical mark and identical or similar services. In respect of the grounds based upon section 5(2)(b), it relies upon the earlier EUTM 15471361, claiming that the applicant’s mark is similar and is in respect of identical or similar services. The relevant details of these two earlier EUTMs are shown below:

| <b>Mark and relevant dates</b>  | <b>Services (an identical list for each earlier mark)</b>   |
|---|---|
| <p>EUTM 15471295</p> <p>Mark: BRAIT</p> <p>Filing date: 24 May 2016</p> <p>Date of entry in register: 16 December 2016</p>                            | <p><b>Class 9:</b> <i>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; computer hardware and software; computer software relating to the handling of financial transactions; software; application software; pre-recorded software; computer interface software; computer software platforms; financial management software; network management software; interactive computer software; table representation software; process controlling software; computer software for encryption; computer e-commerce software; network management computer software; computer software development tools; computer programs [downloadable software]; computer software for document management; computer software for wireless content delivery; computer software relating to financial history; computer programmes relating to financial matters; computer software for producing financial models; computer software designed to estimate costs; computer software for analysing market information; computer software for processing market information; computer software programs for spreadsheet management; data processing software for word processing; software for processing images, graphics and text; computer software for creating searchable databases of information and data; computer software for communication between computers over a local network; computer software for communicating with users of hand-held computers; personal computer application software for managing document control systems; credit cards; plastic bank cards [encoded or magnetic]; cards for use in connection with sales, promotional incentive schemes, competitions including promotional competitions and related services; parts and fittings for the aforesaid goods.</i></p> |
| <p>EUTM 15471361</p> <p>Mark:</p>  <p>Filing date: 24 May 2016</p> | <p><b>Class 16:</b> <i>Paper and cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging; printers' type; printing blocks; printed matter, including brochures, annual reports, newsletters; publications; magazines; periodicals; promotional material; pamphlets; vouchers; manuals; document wallets; printed forms; parts and fittings for the aforesaid goods.</i></p> <p><b>Class 35:</b> <i>Advertising; business management; business administration; office functions; promotion services; business appraisal; business consultancy; business advice; business analysis; business acquisitions; business auditing; business research for new businesses; business management consultation; business administration consultancy; business research services; business merger consultation; business succession planning; strategic business consultancy; preparing business reports; arranging business introductions; business marketing services; business networking services; business project management;</i></p>  |

|  |  |
|--|--|
| <p>Date of entry in register: 16 December 2016</p> | <p><i>computerised business promotion; computerised business research; business data analysis; dissemination of business information; business efficiency advice; business risk management services; compilation of business information; business accounting advisory services; business management services relating to the development of businesses; business management services relating to the acquisition of businesses; professional business consultation relating to the operation of businesses; financial marketing; advertising services relating to financial investment; advertising services relating to financial services; auditing of financial statements; financial statement preparation and analysis for businesses; recruitment of consultants in the financial services field; business advice relating to growth financing; business advice relating to financial re-organisation; advertising services for promoting the brokerage of stocks and other securities; information, advisory and consultancy services in relation to the aforesaid services.</i></p> <p><b>Class 36:</b> <i>Insurance; financial affairs; monetary affairs; real estate affairs; investment services; investment banking; investment trusteeship; investment trust management; industrial investment; investment analysis; investment custody; investment research; financial investment; fund investment; investment (capital-); investment clubs; investment brokerage; stock investment management; equity investment; investment in securities; financial investment; investment business services; stock investment management; variable annuity investment services; variable insurance investment services; real estate investment; mortgage investment management; loan services for property investment; commercial property investment; property investment banking services; financial consultancy relating to real estate investment; school fees investment services; provision of investment capital; personal equity plan investment; fixed income investment services; maintaining escrow accounts for investments; venture capital and project capital investment services; private placement investment services; financial management of risk capital; investment capital and development capital; providing information and analysis in the field of financial investments; capital management; capital investment brokerage; capitalisation services; capital fund management; raising of capital; venture capital management; providing working capital; venture capital fund management; venture capital funding services; valuation services; financial appraisals; financial valuations; fiscal valuation; valuation of capital stock; appraisal services; financial assessments; financial information and evaluations; information, advisory and consultancy services in relation to the aforesaid services.</i></p> <p><b>Class 38:</b> <i>Telecommunications; telecommunications including the Internet and online communication services; telecommunication services provided via the Internet, intranet and extranet; provision of telecommunications access to databases; providing telecommunications connection to a global computer network; communication services; Electronic bulletin boards, chat rooms and message boards for entertainment, training and education purposes; provision of online forums; information, advisory and consultancy services in relation to the aforesaid services.</i></p> <p><b>Class 42:</b> <i>Scientific and technological services and research and design relating thereto, not in the fields of biotechnology, micro- and molecularbiology and biochemistry; industrial analysis and research services, not in the fields of biotechnology, micro- and molecularbiology and biochemistry; design and development of computer hardware and software; providing temporary use of online non-downloadable investment software; computer software and programming services; computer services; lease, hire and rental of computer equipment, hardware, software and programs; design of web sites; encryption services; creating and maintaining websites; hosting the websites of others; information, advisory and consultancy services in relation to the aforesaid services.</i></p> |
|--|--|

3) By virtue of having filing dates that predate the filing date of the contested mark, the opponent's EUTMs qualify, under section 6 of the Act, as earlier marks for the purposes of these proceedings. The earlier marks completed their registration procedures less than 5 years before the publication of the contested mark and, consequently, they are not subject to the proof of use provisions set out in section 6A of the Act. The consequence of this is that the opponent is entitled to rely upon the full list of services contained in its earlier EUTMs.

4) The applicant filed a counterstatement denying the claims made and points out its use of its mark in the UK since June 2014. It further claims that this use provides it with a common law right under passing off against the use of the opponent's EUTMs in respect of services in classes 35 and 36. This claim is noted, but even if an attempt was made to exercise this claimed right, it is outwith the scope of these proceedings because the sole purpose is to ascertain whether the application to register the mark "brait" would be contrary to sections 5(1), 5(2)(a) and/or 5(2)(b).

5) Both sides filed evidence and a hearing took place before me on 8 February 2018 where the opponent was represented by Julius Stobbs for Stobbs (IP) Limited and the applicant by its own Mr Brendan Roodt.

## **Evidence**

6) The opponent's evidence takes the form of two witness statements, the first by Richard Mark Beekhuizen, chief operating officer of Brait South Africa Pty Ltd, a corporate advisor to the opponent. Mr Beekhuizen provides a summary of the opponent's activity in the UK and asserts that it is well known and recognised in the business and financial world. Mr Beekhuizen states that it offers private equity fund management and has acquired a stake in UK retailer Iceland in 2012, Virgin Active in 2015 and the clothing retailer New Look in 2015. He states that the opponent's customers in the UK are financial professionals. The second witness statement is by Yana Zhou, a solicitor with Stobbs (IP) Limited, the opponent's representative in these proceedings. Ms Zhou produced evidence that the applicant company is dormant.

7) The applicant's evidence takes the form of a witness statement by Brendan Robert Roodt, director and shareholder of the applicant. He provides evidence regarding the applicant's activities in the UK in the fields of legal services and education.

8) For reasons of procedural economy, there is no need for me to summarise the parties' evidence further.

## DECISION

### Section 5(1)

9) In light of the applicant's confirmation at the hearing that he was removing classes 35 and 36 from the application, there can no longer be identical services and Mr Stobbs did not pursue the grounds based upon this section of the Act.

### Section 5(2)(a)

10) Section 5(2)(a) of the Act is as follows:

“(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or”

11) Firstly, I must consider if the respective marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“the CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

12) The respective marks differ only in that one is represented in lowercase letters i.e. “brait” and the other in uppercase letters, i.e. “BRAIT”. The applicant submits that, for this reason, the marks are not identical. In *Peek & Cloppenburg v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-386/07*.

“27. Furthermore, the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue. As the applicant is correct to note, since the earlier mark is a word mark, its proprietor has the right to use it in different scripts, such as, for example, a form comparable to that used by the mark applied for (see, to that effect, Case T-346/04 *Sadas v OHIM – LTJ Diffusion (ARTHUR ET FELICIE)* [2005] ECR II-4891, paragraph 47).”

13) Based on this guidance, I dismiss the applicant’s submission. A mark applied for in lowercase permits the proprietor to also use it in uppercase and vice versa. Therefore, I conclude that the respective marks are identical and in any case, that the difference is, in any event, immaterial.

### ***Comparison of goods and services***

14) In assessing the similarity of goods/services, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

‘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.’

15) Other factors may also be taken into account such as, for example, the distribution channels of the goods/services concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

16) In terms of understanding what a "complementary" relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the*

*Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06* where it was stated:

"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 (see, to that effect, Case T-169/03 *Segio Rossi v OHIM - Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseno original Juan Bolanos)* [2007] ECR I-0000, paragraph 48)."

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

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

18) Finally, I keep in mind that it is permissible to take into account the class number specified by the applicant when assessing the meaning of the descriptions of goods and services included in the application, see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA).

19) Whilst the opponent's case was not abandoned in respect of its other goods and services, at the hearing Mr Stobbs identified the opponent's best case as being as follows:

| <b>Applicant's services</b>   | <b>Opponent's goods and services</b>   |
|---|--|
| <p><b>Class 41:</b> <i>Business educational services.</i></p> <p><b>Class 45:</b> <i>Legal advice; Legal consultancy services; Legal information research services; Legal investigation services; Legal mediation services; Legal services relating to wills; Legal support services; Legal research; Legal services relating to intellectual property rights; Legal document preparation services; Legal administration of licences; Legal consultation in the field of taxation; Legal services relating to the exploitation of patents; Legal services relating to the negotiation and drafting of contracts relating to intellectual property rights; Legal services relating to the protection and exploitation of copyright for film, television, theatre and music productions; Legal advice relating to franchising; Legal services relating to the exploitation of transmission rights; Legal services for procedures relating to industrial property rights; Legal services relating to copyright licensing; Legal services relating to company formation and registration; Legal consultancy relating to intellectual property rights; Legal services relating to the management, control and granting of licence rights; Legal services relating to the registration of trademarks; Legal services relating to the management and exploitation of copyright and ancillary copyright; Legal advice and representation; Legal</i></p> | <p><b>Class 9:</b> <i>Computer software</i></p> <p><b>Class 16:</b> <i>Printed matter</i></p> <p><b>Class 35:</b> <i>Business administration; business advice.</i></p> |

|   |  |
|---|--|
| <p><i>services relating to the exploitation of copyright for printed matter; Legal services relating to the exploitation of film copyright; Legal and judicial research services in the field of intellectual property; Legal services relating to the exploitation of broadcasting rights; Legal assistance in the drawing up of contracts; Legal services relating to the exploitation of copyright and industrial property rights; Legal services relating to the exploitation of intellectual property rights; Legal services relating to the exploitation of ancillary rights relating to film, television, video and music productions; Legal services.</i></p> |  |
|---|--|

20) Mr Roodt submitted that it would be wrong for the broad terms *printed matter* and *computer software* to be able to block an application based upon the broadest interpretation of these terms. I note this criticism of the opponent's case and note that the undesirability of such a situation has been commented upon by Laddie J in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850 at 864-865 when he said:

“The defendant argues that on its present wording, the plaintiff's registration creates a monopoly in the mark (and confusingly similar marks) when used on an enormous and enormously diffuse range of products, including products in which the plaintiff can have no legitimate interest. In the course of argument I put to [counsel for the plaintiff] that the registration of a mark for ‘computer software’ would cover any set of recorded digital instructions used to control any type of computer. It would cover not just the plaintiff's type of products but games software, accounting software, software for designing genealogical tables, software used in the medical diagnostic field, software used for controlling the computers in satellites and the software used in the computers running the London Underground system. I think that in the end he accepted that some of these were so far removed from what his client marketed and had an interest in that perhaps a restriction on the scope of the registration to exclude some of the more esoteric products might be desirable. In any event,

whether that was accepted or not, in my view there is a strong argument that a registration of a mark simply for 'computer software' will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest."

21) Recently, Arnold J has also expressed agreement with these views in *Sky v. SkyKick* [2018] EWHC 155 (Ch). However, the applicant has not challenged the earlier registration and, under section 72 of the Act, its existence, including its list of goods and services, is prima facie evidence of its validity. Therefore, even though disquiet has been expressed regarding the acceptance of broad terms such as *printed matter* and *computer software*, in the absence of a challenge to the broad scope of the terms by way of, for example, invalidation, there is no reason for me to not accept the broad scope of the terms. The terms *printed matter* and *computer software* are both clear and precise in meaning and therefore compliant with the guidance set out by the CJEU in *Chartered Institute of Patent Attorneys v Registrar of Trade Marks* ("IP TRANSLATOR"), Case C-307/10, and in an absence of a challenge to the earlier registration, I must accept their broad nature. I, therefore, reject Mr Roodt's submission.

22) Having established this, I turn to consider the similarity between the respective goods and services by reference to each of the applicant's classes in turn.

#### Class 41

23) Mr Stobbs submitted that the applicant's *Business educational services* are similar to the opponent's *printed matter* because the opponent's term includes goods

such as printed course material for business education courses. Mr Roodt submitted that because the classes are different, the respective terms are not identical. I concur with this, but for a finding of a likelihood of confusion, it is not necessary that the respective goods and services are identical. Therefore, Mr Roodt's submission does not assist his case.

24) As Mr Stobbs acknowledged, the nature of printed matter is different to the applicant's services but he also submitted that there is still similarity. I agree, the intended purpose of course material and also other types of printed matter, for example, self-help books for businessmen will have the same intended purpose as business education services in that they both impart information to further business knowledge and understanding. They may also be in competition in that the consumer may make a choice between a self-help book and a course or, indeed, the consumer may choose to rely on supporting printed matter for a course rather than attend the course itself. There is also complementarity in that educational printed matter in the field of business is important for the provision of business educational services. Consequently, there may also be an overlap of trade channels with course providers also providing printed matter related to the same.

25) Taking all of the above into account, I conclude that the respective goods and services share a medium level of similarity.

26) Mr Stobbs submitted that analogous arguments applied when considering the level of similarity between *computer software* and the applicant's services. I agree. Where such software has the specific function of supporting a business educational course, the level of similarity will be the same as for printed matter.

27) Mr Stobbs also relied upon a claimed similarity with the opponent's *business advice* and *business administration*. I do not believe that this case is any stronger than that already considered and, consequently, I will not comment further.

## Class 45

28) Mr Stobbs focussed his submissions on the similarity between the same three of the opponent's terms as above, i.e. *printed matter*, *computer software* and *business advice/business administration*. In addition, he also relied upon the opponent's *financial affairs* and *investment services* in Class 36.

29) The applicant's lengthy list of services can be summarised as containing various legal services. Mr Stobbs submitted at the hearing that the consideration of the level of similarity between the respective goods and services is analogous to the considerations already discussed in respect of the applicant's Class 41 services. I agree. The opponent's *printed matter* includes printed information on legal issues such as printed information or advice on writing a will, preparing legal documents, or guidance regarding intellectual property law. Such printed matter may be provided as part of the legal services and are, therefore, complementary to the service, or they may provide information about legal issues that could be obtained alternatively by seeking out the applicant's legal services. Therefore, the respective goods and services may also be in competition. Such goods and services will share the same intended purpose, but will be different in nature. Taking all of this into account, I find that these goods and services share a medium level of similarity.

30) As with my comments in respect of the applicant's Class 41 services, the opponent's *computer software* present it with goods that share the same level of similarity as its *printed matter* does.

31) Mr Stobbs' case based upon the opponent's *business advice* and *business administration* and financial affairs/investment services does not materially improve its case and consequently, I will not comment further.

## **Average consumer and the purchasing act**

32) 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.

33) 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.”

34) The consumers of the relevant goods and services may be the individuals looking to access business education or legal services or, equally, businesses who wish to procure business education services for its employees or wish to procure legal services. The purchasing process is likely to be reasonably well considered, but they are unlikely to involve the highest level of care. The purchasing process is likely to be by visual means with consumers being attracted to such goods and services through print or online advertising, but I do not ignore that aural considerations may also play a part.

### **Distinctive character of the earlier trade mark**

35) 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).”

36) The earlier mark consists of the word BRAIT. The parties were in agreement that this means an uncut or rough diamond, however there is nothing before me to suggest that the average consumer will be aware of this meaning and neither side suggested otherwise. Consequently, the mark is likely to be perceived as an invented word and be endowed with a high level of inherent distinctive character.

37) The opponent’s evidence relates to use in the UK that Mr Beekhuizen concluded, in his witness statement, resulted in the opponent being well known. In light of the high level of inherent distinctive character of its mark, any enhancement of this through use is not likely to materially affect the outcome of these proceedings and, for procedural economy, I will not comment further on this claim.

#### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

37) The following principles, insofar as they are relevant to a pleading based upon section 5(2)(a) are gleaned from the decisions of the CJEU 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:*

(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) 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;

(d) 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;

(e) 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;

(f) 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.

38) I have found that:

- the respective marks are identical
- the respective goods and services share a medium level of similarity;
- the purchasing process is mainly visual in nature, but I keep in mind that aural considerations may play a role;

- the average consumer of the respective goods and services may be individuals or businesses seeking business educational opportunities or legal services/information;
- the purchasing process will be reasonably well considered;
- the opponent's mark is endowed with a high level of inherent distinctive character.

39) I keep all of the above in mind. The fact that the purchasing process is reasonably well considered is a factor that points towards no likelihood of confusion, however, all of my other findings point the other way, and overall, they outweigh the level of consideration paid during the purchasing process. This leads me to conclude that there is a likelihood of confusion against all of the applicant's services.

40) At the hearing, there was a suggestion from Mr Roodt that he may wish for further time to consider amending the applicant's defence to include as claim to concurrent use. I declined to allow further time because of the lateness of raising the issue and it would have required a suspension of the hearing to allow Mr Roodt to consider the point, then to amend his counterstatement. Further, there is nothing in the applicant's evidence that suggests to me that such defence had any prospect of success. I declined to allow Mr Roodt time to consider this point.

41) In summary, the ground based upon section 5(2)(a) is successful in its entirety.

### **Section 5(2)(b)**

42) The opponent's case under this ground is based upon its earlier EUTM 15471361, but this is no stronger than its case under section 5(2)(a). Consequently, in light of my findings above, it is not necessary for me to consider this ground.

### **Conclusion**

43) The opposition is successful against all of the applicant's remaining classes, namely, Class 41 and Class 45, and the application is refused.

## **COSTS**

44) The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. Both sides filed evidence, but it was not necessary to refer to this in making my decision. Consequently, I decline to make an award of costs in respect of this. I also take account that a hearing took place. With this in mind, I award costs as follows:

|  |              |
|--|--------------|
| Preparing statement and considering other side's counterstatement (including official fee) | £400         |
| Preparing for & attending hearing  | £650         |
| <b>Total:</b>  | <b>£1050</b> |

45) I order Brait Limited to pay Brait Societas Europaea the sum of £1050 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 15<sup>th</sup> day of March 2018**

**Mark Bryant**  
**For the Registrar**  
**The Comptroller-General**