

O-356-18

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3181097
BY TRUVAA LIMITED
TO REGISTER**

TRUVAA

**AS A TRADE MARK
IN CLASS 35
AND OPPOSITION THERETO (UNDER NO. 408507)
BY
STREETHUB LTD**

Background & pleadings

1. Truvaa Limited ('the applicant') applied for the mark **TRUVAA** on 18 August 2016. It was published on 11 November 2016 for the following services in class 35: *Price comparison services*.

2. StreetHub Ltd ('the opponent') opposes the application under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of some of its services in classes 35 and 42 in its earlier UK trade mark set out below.

UK TM No. 3116042	Services relied on:
<p>trouva</p> <p>Trouva</p> <p>(series of two)</p> <p>Filing date: 2 July 2015</p> <p>Registration date: 4 December 2015</p>	<p><i>Class 35 - Sales promotion services; providing online advertising marketplaces for sellers and buyers of goods and services; Provision of an on-line marketplace for buyers and sellers of goods and services; Business intermediary and advisory services in the field of selling products and rendering services; Presentation of goods on communication media for retail purposes; Mail order retail services connected with clothing accessories; Management of a retail enterprise for others; Communication media (Presentation of goods on -), for retail purposes; Providing information about commercial business and commercial information via the global computer network; Providing an on-line commercial information directory on the internet; Provision of on-line business and commercial information; Promotion, advertising and marketing of on-line websites; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Business information services provided on-line from a computer database or the internet; Computerised database management services; Commercial information services provided by access to a</i></p>

	<p><i>computer database; Provision of information and advice to consumers regarding the selection of products and items to be purchased.</i></p> <p><i>Class 42 - Constructing an internet platform for electronic commerce</i></p>
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3. The applicant filed a counterstatement in which it denied the ground of opposition.

4. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act and, as it had not been registered for five years or more before the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per section 6A of the Act.

5. The opponent filed evidence and submissions in lieu of a hearing whilst the applicant filed submissions only. I do not intend to summarise the evidence here but will refer to it in the decision as necessary. Neither party requested a hearing so I make this decision based on the papers before me.

6. The applicant represents itself in the proceedings whilst the opponent is represented by Buckworths.

Decision

7. Section 5(2)(b) of the Act is as follows:

"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.

8. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the services

9. The services to be compared are:

Opponent's services	Applicant's services
<i>Class 35: Sales promotion services; providing online advertising marketplaces for sellers and buyers of goods and services; Provision of an on-line marketplace for buyers and sellers of goods and services; Business intermediary and advisory services in the field of selling products and rendering services; Presentation</i>	<i>Class 35: Price comparison services.</i>

of goods on communication media for retail purposes; Mail order retail services connected with clothing accessories; Management of a retail enterprise for others; Communication media (Presentation of goods on -), for retail purposes; Providing information about commercial business and commercial information via the global computer network; Providing an on-line commercial information directory on the internet; Provision of on-line business and commercial information; Promotion, advertising and marketing of on-line websites; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Business information services provided on-line from a computer database or the internet; Computerised database management services; Commercial information services provided by access to a computer database; Provision of information and advice to consumers regarding the selection of products and items to be purchased.

Class 42 - Constructing an internet platform for electronic commerce

10. Regarding the comparison of services, in the judgment of the Court of Justice of the European Union (“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”.

11. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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.

12. Furthermore in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

13. In *esure Insurance Ltd v Direct Line Insurance Plc*, [2008] EWCA Civ 842, L.J. Arden stated that:

“56. In my judgment, Mr Hobbs is correct on this point. What the hearing officer had to determine was what the average consumer would have thought of the two marks and whether they would have confused him. The services sold by the parties were identical and were of a kind familiar to members of the public. In those circumstances, I see no reason why the hearing officer should not have decided the issue of similarity on his own in the absence of evidence apart from the marks themselves and evidence as to the goods or services to which they were, or, in the case of esure's mark, were to be applied. As Lord Diplock held in *Re GE Trade Mark* at 321:

“My Lords, where goods are of a kind which are not normally sold to the general public for consumption or domestic use but are sold in a specialised market consisting of persons engaged in a particular trade, evidence of persons accustomed to dealing in that market as to the likelihood of deception or confusion is essential. A judge, though he must use his common sense in assessing the credibility and probative value of that evidence is not entitled to supplement any deficiency in evidence of this kind by giving effect to his own subjective view as to whether or not he himself would be likely to be deceived or confused ... But where goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced, but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or

temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

57 An example of such a decision would, as Mr Hobbs submits, be *Spalding v Gamage (1915) 32 RPC 273*. The GE Trade Mark decision was under the provision in the Trade Marks Act 1938 for the rectification of the Register of Trade Marks. But the principle that it enunciates is one which is derived from the law of evidence and the decision is thus not limited to trade marks, or the 1938 Act.”

14. In its submissions date 10 August 2017, the opponent contends that,

“The applicant states in its counterstatement that its business is not similar to that of the Opponent’s because it provides price comparison services whereas the Opponent is a “design -led homeware and lifestyle products business selling items on behalf of individual boutiques. This is not entirely accurate as the Opponent runs an online marketplace platform for boutique retailers to sell to customers. The applicant’s price comparison business is also an online marketplace platform that enables sellers of luxury items to reach a larger customer base. Further, as expected with online marketplaces there are overlaps in the products offered on both the Applicant’s and Opponent’s platforms”.

15. I note the opponent's submissions but I will be comparing the parties' services on the basis of notional and fair use of what is listed in the respective specifications. As I see it *price comparison services* in the applicant’s specification would at the very least comprise the provision of information regarding the cost of a service or the cost of a product and the details of who is providing either the service or the product.

In my view, *provision of on-line business and commercial information, Commercial information provided by access to a computer database and provision of information and advice to consumers regarding the selection of products and items to be purchased*, may all include or relate to price comparison services and I find these to be identical to the applicant's specification in accordance with the decision in *Meric*. Even if I am found to be wrong in this, these are at least highly similar services. The users are members of the general public seeking commercial information for the purpose of purchasing goods or services. The services, in most cases, are likely to be provided online, the trade channels overlap and the respective services may be in competition'

16. I do not intend to compare the remaining services in the opponent's specification as they do not put the opponent in any better position.

Average Consumer and the purchasing process

17. I must next consider who the average consumer is for the services I have found to be identical (or highly similar) and identify how those services are purchased. 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

18. 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.”

19. The average consumers for the contested services which I have found to be identical (or highly similar) are members of the general public. The level of attention paid to the purchase of the services will be at least reasonable as all of these services require consumers to input specific criteria in order to access the correct financial information, such as price comparison data. . As for the purchasing process for such services, I would consider this to be primarily a visual act as consumers are likely to search in printed matter or the internet to find suitable material outlining the price comparisons but I do not rule out an aural element whereby advice may be sought during the purchasing process.

Comparison of the marks

20. The marks to be compared are:

Opponent's mark	Applicant's mark
trouva Trouva (series of 2)	TRUVAA

21. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by

means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

23. The opponent's mark is a series of two word only marks, **trouva** and **Trouva**, the only difference being the lower and title case presentation. For ease of reference I shall refer to the applicant's mark as **trouva**, by which I mean to include both presentations of the mark. The overall impression of the marks is based solely on this word.

24. The applicant's mark is a single word **TRUVAA**, in plain black upper case, with no additional stylisation. The overall impression of the mark is based solely on that word.

25. In a visual comparison, there are similarities in that both marks are six letters long and begin and end with the same letters, namely TR and A. The letters 'U' and 'V' appear fairly centrally in both marks, being the third and fourth letters in the application and the fourth and fifth letters of the opponent's mark. In terms of visual differences, the applicant's mark omits the letter 'o' which is the third letter of the opponent's mark and the opponent's marks has only a single letter 'a' the end of their marks. Overall, I find that there is visual similarity to a high degree.

26. In an aural comparison, the sound made by the letter combination 'ou' is identical to the sound made by the letter 'u' alone, namely, 'oo', as in the word HOOT. Likewise, the pronunciation of the double 'aa' sound is identical to a single letter 'a', as the average consumer in the UK will not make a distinction between them. The respective marks are aurally identical.

27. In relation to the conceptual comparison, the opponent contends in its submissions dated 10 August 2017 that,

“The applicant contends that conceptually, its mark is a portmanteau of the words ‘true’ and ‘value’ which represents providing goods at their true value. The opponent submits that the concept of ‘true value’ is unlikely to be immediately realised by the applicant’s mark ‘TRUVAA’ without any further explanation. It is more likely that consumers will consider the mark ‘TRUVAA’ to be an invented word with no meaning. The opponent’s mark ‘trouva’ is derived from the French verb ‘trouver’, which means to ‘to find’, and ‘trouva’ is the third person singular past historic of the verb. However, the average consumer in the UK may not recognise this immediately, and would be more likely to assume the Opponent’s mark to be an invented word with no meaning. Therefore the Opponent argues that conceptually, the position of similarity between the Applicant’s mark and the Opponent’s mark is neutral.

28. I agree with the opponent’s submission. It is unlikely that the average consumer would be familiar with either of the claimed conceptual meanings of either mark. Neither mark has any ‘immediately graspable concept’¹ and both will be considered to be invented words. I find the parties’ marks to be conceptually neutral.

Distinctive character of the earlier mark

29. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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

¹ It has been highlighted in numerous judgments such as *The Picasso Estate v OHIM*, Case C-361/04 that it is only concepts capable of immediate grasp by the consumer that are relevant.

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).”

30. The opponent’s mark is an invented word which has no meaning in relation to the services so I consider it to be inherently distinctive to the highest degree. Although the opponent filed evidence showing use of the earlier marks, this does not put the opponent in any stronger position with regard to the distinctiveness of the earlier marks.

Likelihood of confusion

31. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 8:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).

- c) Imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

32. Confusion can be direct, when the average consumer mistakes one mark for the other or indirect, where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related.

33. So far, I have found the parties' services to be identical (or at least highly similar). They are primarily purchased visually by the general public who will be paying a reasonable level of attention during the purchasing process. In addition, I have found that the earlier mark has the highest level of inherent distinctiveness and that the contested marks are visually similar to a high degree, aurally identical and conceptually neutral.

34. Taking all of these factors into account, I find that the differences between the marks will not be sufficient to offset the similarities in the mind of the average consumer purchasing these services. Taking into account that the average consumer rarely has the chance to make a direct comparison of the marks, instead relying on the imperfect picture of them that they have kept in their mind, and bearing in mind the fact that both parties' marks are invented words where there is no conceptual hook provided by either mark, I find there is a likelihood of direct confusion.

Conclusion

35. The opposition succeeds under section 5(2)(b) and, subject to any successful appeal against my decision, the application is refused in its entirety.

Costs

36. As the opponent has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of

Tribunal Practice Notice (TPN) 2/2016. Using the guidance in TPN2/2016 I make the following award:

£100 Official fee for filing the Notice of Opposition

£200 Preparing the Notice of Opposition

£300 Preparing written submissions

£600 Total

37. I decline to award costs for the filing of evidence in these proceedings as it did not assist me in reaching a decision in this case.

38. I order Truvaa Limited to pay Streethub Ltd the sum of £600. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of June 2018

June Ralph

For the Registrar,

The Comptroller General

