

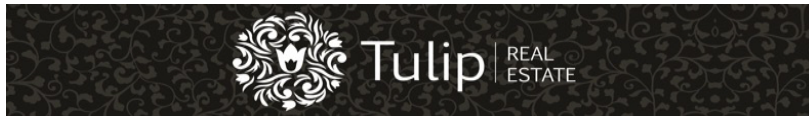
BL O-430-18

TRADE MARKS ACT 1994

IN THE MATTER OF:

**TRADE MARK APPLICATION 3229721
BY TULIP PROPERTIES & REAL ESTATE LTD**

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 36:



AND

**OPPOSITION THERETO (No. 410083)
BY TULIP IE B.V.**

Background and pleadings

1. **Tulip Properties & Real Estate LTD** (the applicant) applied to register the trade mark:



in the UK on 08 May 2017. It was accepted and published in the Trade Marks Journal on 19 May 2017, in respect of the following services:

Class 36: Real estate properties services; Real estate management services relating to commercial buildings; Real estate management services relating to residential buildings; Real estate agency services for the rental of buildings; Real estate agency services relating to the purchase and sale of land; Real estate agency services relating to the purchase and sale of buildings; Real estate investment; Real estate and property management services.

2. **Tulip IE B.V.** (the opponent) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier European Union (formerly Community) Trade Mark 012676516. The following services are relied upon in this opposition:

Class 35: Advertising; Business management; Business administration; Office functions; Business mediation in offering and purchasing insurance policies, financial products and services, and tax and legal services; Bringing service providers into contact with potential customers; Office functions in connection with concluding agreements between service providers and customers; Setting up and managing address databases for various service providers, and providing the aforesaid databases; Payroll preparation; Business auditing; Office functions relating to the notarisation of documents; Office functions relating to obtaining permits; Office functions relating to obtaining visas; Office functions relating to the further handling of visa applications; Providing administrative information relating

to questions about handling visas; Information and consultancy relating to the aforesaid services; Including the aforesaid services provided via electronic means, including the Internet.

Class 36: Insurance; Financial affairs; Monetary affairs; Real estate affairs; Financial planning services; Arranging of investments; Financial management; Financial analysis; Financial services relating to investment and Management of assets; Tax and duty services; Mortgage services; Information, consultancy and mediation relating to the aforesaid services; Including the aforesaid services provided via electronic means, including the Internet.

Class 45: Legal services; Security services for the protection of property and individuals; Legal services relating to the notarisation of documents; Legal services relating to obtaining permits; Legal services relating to obtaining visas; legal representation services; Information and consultancy in the field of employment law, tenancy law and contract law; Including the aforesaid services provided via electronic means, including the Internet.

3. The opponent argues that all of the applied for services are identical, highly similar or complementary to the services protected under its earlier mark, and that the marks are highly similar.
4. The applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use of its earlier trade mark relied upon. The earlier mark relied upon by the opponent, namely EU 012676516, was registered on 01 September 2014, less than five years prior to the publication of the application. The opponent does not therefore have to prove use of their earlier mark¹.
5. Neither side filed written submissions, over and above the comments presented in the TM7 [statement of grounds] and TM8 [defence and counterstatement].

¹ Relevant statutory provision: Section 6A(3)

6. No hearing was requested and so this decision is taken following a careful perusal of the papers. The applicant has represented itself throughout the proceedings whereas the opponent has been professionally represented by Stobbs.

Decision

Section 5(2)(b)

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 following principles are gleaned from the decisions of the Court of Justice of the European Union (“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, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well

informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of services

9. The parties' respective specifications are:

Earlier mark	Application
<p>Class 35: Advertising; Business management; Business administration; Office functions; Business mediation in offering and purchasing insurance policies, financial products and services, and tax and legal services; Bringing service providers into contact with potential customers; Office functions in connection with concluding agreements between service providers and customers; Setting up and managing address databases for various service providers, and providing the aforesaid databases; Payroll preparation; Business auditing; Office functions relating to the notarisation of documents; Office functions relating to obtaining permits; Office functions relating to obtaining visas; Office functions relating to the further handling of visa applications; Providing administrative information relating to questions about handling</p>	<p>Class 36: Real estate properties services; Real estate management services relating to commercial buildings; Real estate management services relating to residential buildings; Real estate agency services for the rental of buildings; Real estate agency services relating to the purchase and sale of land; Real estate agency services relating to the purchase and sale of buildings; Real estate investment; Real estate and property management services.</p>

visas; Information and consultancy relating to the aforesaid services; Including the aforesaid services provided via electronic means, including the Internet.

Class 36: Insurance; Financial affairs; Monetary affairs; Real estate affairs; Financial planning services; Arranging of investments; Financial management; Financial analysis; Financial services relating to investment and Management of assets; Tax and duty services; Mortgage services; Information, consultancy and mediation relating to the aforesaid services; Including the aforesaid services provided via electronic means, including the Internet.

Class 45: Legal services; Security services for the protection of property and individuals; Legal services relating to the notarisation of documents; Legal services relating to obtaining permits; Legal services relating to obtaining visas; legal representation services; Information and consultancy in the field of employment law, tenancy law and contract law; Including the aforesaid services provided via electronic means, including the Internet.

10. For the sake of procedural economy, I will focus my assessment on the class 36 element of the earlier mark which, with my emphasis, covers:

Class 36: Insurance; Financial affairs; Monetary affairs; Real estate affairs; Financial planning services; Arranging of investments; Financial management; Financial analysis; Financial services relating to investment and Management of assets; Tax and duty services; Mortgage services; Information, consultancy and mediation relating to the aforesaid services; Including the aforesaid services provided via electronic means, including the Internet.

11. 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”.

12. The term ‘Real estate affairs’ is a broad ranging term which encompasses any services provided by a company or individual specialising in the sale, rental or management of real estate property.

13. The applied for terms ‘Real estate properties services; Real estate management services relating to commercial buildings; Real estate management services relating to residential buildings; Real estate agency services for the rental of buildings; Real estate agency services relating to the purchase and sale of land; Real estate agency services relating to the purchase and sale of buildings; Real estate investment; Real estate management services’ are also services provided by a company or individual specialising in the sale, rental or care of real estate property.

14. I therefore consider that all of these applied for services (as above) in class 36, fall under the broad term 'Real estate affairs' in the opponent's class 36 specification. As such, they are considered identical.

15. The applied for term 'property management services' in class 36 is synonymous with 'real estate management services' and comprise the day to day management of real estate properties. As such I also find these services to be encompassed by the earlier broad term 'real estate affairs' and therefore identical.

Average consumer and the purchasing act

16. 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*.

17. 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.”

18. The average consumer of real estate services and property management services will be both the general public, using the provider of such services to assist in the sourcing, purchase or rental of residential properties, for the purpose of dwelling; and a professional consumer that will use the service provider in a

similar fashion to that of the general public, for example, to source property for commercial purposes, but also in the management and day to day running of such property, on their behalf.

19. The selection of these services could be made in a number of ways. The service provider may promote their business activities in traditional formats for example via flyers in local press and on billboards, as well as local media such as radio station advertising. They might also use internet websites and social media activity to engage in electronic and digital promotion and marketing activities. It is also the norm for real estate service providers to have an 'high street' presence, in the form of shop front establishments, displaying their name on traditional shop front signage. In the selection of these services, the mark will, primarily, be seen rather than heard which means the visual perception of the marks will be the most important. I do not, however, ignore the potential for the marks to be spoken, for example, by sales assistants in an office, or when conducting business over the telephone

20. The choice of a real estate service provider is not a casual selection, as these services are unlikely to be low cost. The general public, as the average consumer, will not regularly utilise real estate and property management services, as it is uncommon to buy or rent property frequently. The average professional consumer will utilise these services more frequently and may display a higher level of attentiveness, however the selection process for both types of consumer is likely to be similar and they will both pay a medium degree of attention to the selection of these services.

Comparison of marks



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 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.”

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 marks to be compared are:

Earlier trade mark	Contested trade mark
	

24. The opponent's trade mark consists of the large word element 'TULIP', underneath which are the words EXPATS SERVICES, and a white circle logo containing the silhouette of a tulip, all within a rectangular background. Whilst the rectangular background cannot be said to be negligible, its weight in the overall impression of the mark is low because it is likely to be viewed simply as a background to enable one to see the white letters in the word elements and the white circle within which the red tulip silhouette is placed. The words 'EXPATS SERVICES' are not only smaller in the mark, but will also be understood to indicate certain services offered by the opponent to an expatriate community and therefore carry little weight. Consequently, it is the larger word element TULIP

and the white circle with the red silhouette of a tulip that are the elements that carry greatest weight and to which the average consumer will attach most significance; relative to each other, they make a roughly equal contribution to the overall impression of the mark.

25. The applicant's mark consists of the word element 'Tulip' and a circular floral design, at the centre of which the head of a tulip can be discerned. This is presented within a patterned rectangular background and, although it cannot be said to be negligible, its weight in the overall impression of the mark is low because it is likely to be viewed simply as a background to enable one to see the white letters in the word elements and the circular floral design, which is also presented in white. The mark also contains the words 'REAL ESTATE' which will be understood to describe real estate services offered by the applicant to a consumer of such services and are therefore non-distinctive within the context of the services at issue; the words are also smaller than the word Tulip. The words REAL ESTATE therefore carry little weight in the overall impression. Consequently, it is the large word element 'Tulip' and the circular floral design in the applicant's mark which will be given most weight by the average consumer and which can be said to make roughly equal contributions to the overall impression of the mark.

Visual similarity

26. The marks are visually similar inasmuch as they both contain the word 'TULIP'/'Tulip', presented prominently in large standard typeface. Whilst it could be said that they are also visually similar in that both marks contain a depiction of a tulip flower, the specific representations look very different.

27. The marks are visually different in respect of the verbal elements 'EXPATS SERVICES' and 'REAL ESTATE' however as they carry little weight the difference they make in the marks is not significant. As I have said above, the figurative elements in each mark, despite each containing a tulip, look very different.

28. Weighing the similarities and differences, and bearing in mind my assessment of the overall impression, I find the marks to be visually similar to a medium degree.

Aural similarity

29. The opponent's mark contains the verbal elements 'TULIP' and 'EXPATS SERVICES'. The word 'TULIP' will be enunciated as *CHOO/LIP*. The applicant's mark contains the verbal elements 'Tulip' and 'REAL ESTATE'. The word 'Tulip' in the applicant's mark will be articulated identically to that element of the earlier mark.

30. The additional verbal elements 'EXPATS SERVICES' and 'REAL ESTATE' found in the marks will be articulated respectively as *EX/PATS/SUR/VIS/IS* and *REE/AL/ES/TAYT* and share no similarity at all.

31. In relation to the elements 'EXPATS SERVICES' and 'REAL ESTATE', it might be argued that those elements may not be articulated at all, which would suggest a finding of aural identity purely in respect of the common element 'TULIP'.

32. For those consumers who would articulate all of the verbal elements found in each mark, the marks can be said to be aurally similar to a medium degree.

Conceptual similarity

33. Conceptually, the primary focus in each mark will be of the word 'TULIP', which is re-enforced by the figurative depiction of a tulip flower.

34. The additional verbal elements will be seen as descriptive components in each mark and therefore do little to distinguish on a conceptual level. The figurative elements, over and above the depictions of a tulip flower, combined with the rectangular backgrounds, will be perceived as decorative matter and do not deliver any conceptual message.

35. Therefore, I find that the marks are at least highly similar if not identical conceptually.

Distinctive character of the earlier trade mark

36. 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.”

37. 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.

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. The opponent has not claimed that its earlier mark has an enhanced distinctive character through use. I therefore have only the inherent position to consider.

40. The opponent’s mark comprises a number of verbal and figurative elements, however, as set out above in *Kurt Geiger*, it is the common element residing in both marks that will factor upon the likelihood of confusion. The common element is the word TULIP. It has no allusive or suggestive connection to real estate services and can therefore be said to enjoy a normal degree of inherent distinctiveness.

41. The other verbal elements in the opponent’s mark can be said to be descriptive components, adding little if any distinctiveness to the whole. The figurative elements in the mark, namely, a white circle with a red image of a tulip inside it, placed upon a rectangular background, can be said to be distinctive to a medium degree and could add to the distinctiveness as a whole, but this does not increase the likelihood of confusion.

Likelihood of Confusion

42. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the legal principles established previously (see paragraph 8).
43. 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 services down to the undertakings being the same or related.
44. I have found the parties' services to be identical. They are primarily purchased visually by both the general public and a professional consumer; who will be paying at least a medium level of attention during the purchasing process.
45. I have found that the earlier mark (in particular the element of it which is in common with the applied for mark) has a medium level of inherent distinctiveness and that the marks at issue are visually similar to a medium degree, aurally identical or similar to a medium degree (depending on whether the non-distinctive elements are pronounced), and conceptually identical or similar to a high degree.
46. Whilst I would not rule out direct confusion for a small number of consumers, I accept that the average consumer is likely to appreciate the differences, particularly the logo elements, in the marks, so meaning that direct confusion is not likely. However, I believe that the visual and aural similarities created by the word TULIP, combined with a conceptual identity in the dominant element 'Tulip', which is reinforced by the figurative image of a tulip in each mark, will lead to indirect confusion on the part of the average consumer, who will believe the marks to be brand variants of each other and originating from the same or related undertaking. Whilst I accept that indirect confusion should not be reached merely because the marks share a common element, and that what is required by the average consumer is an instinctive reaction that leads them to the conclusion that

the identical services come from the same (or related) trade origin², that instinctive reaction is present in this case. The average consumer will simply assume that the accompanying logo has been changed for some reason or another and will understand the inclusion of the word TULIP to signify a same stable service.

Conclusion

47. There is a likelihood of confusion. The opposition succeeds in full. The application is, subject to appeal, refused.

Costs

48. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Opposition fee	£100
Preparing the statement of case and considering the counterstatement	£200
Total	£300

49. I therefore order Tulip Properties & Real Estate LTD to pay Tulip IE B.V. the sum of £300. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

² See, for example, the decision of Mr James Mellor QC sitting as the Appointed Person in *Duebros Ltd v Heirler Cenovis GmbH* (BL O/547/17; 27 October 2017).

Dated this 16th day of July 2018

Andrew Feldon

For the Registrar

The Comptroller-General