

O/700/18

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION UK 3245080 IN THE NAME OF

Anatomy Brands Ltd

FOR THE TRADE MARKS

Anatomy Brands
ANATOMY BRANDS
anatomy brands

IN CLASSES 35 AND 42

AND

THE APPLICATION FOR DECLARATION OF INVALIDITY THERETO UNDER
NUMBER 501976

BY

ZAMIRA DREW AND DANIEL HAYMAN

Background and Pleadings

1. Anatomy Brands Ltd (the Proprietor) is the registered proprietor of a series of three UK trade marks number UK 3245080 shown on the front cover page of this decision, filed on the 20 July 2017 and registered on the 13 October 2017 for the following services in classes 35 and 42:

CLASS 35

Brand creation services; Brand creation services (advertising and promotion); Brand evaluation services; Brand positioning; Brand positioning services; Brand strategy services; Brand testing; Advertising services to create corporate and brand identity; Web site traffic optimisation; Web site traffic optimization; Consulting services in business organization and management; Consulting services in the field of Internet marketing; Consulting services relating to marketing; Business consulting; Business consulting for enterprises; Business consulting services; Business research consulting; Direct marketing consulting; Marketing consulting; Providing marketing consulting in the field of social media.

CLASS 42

Brand design services; Brand design services; Design of brand names; Computer website design; Consultancy relating to the creation and design of websites; Consultancy with regard to webpage design; Creating and designing web pages for others; Creating and maintaining computer sites (web sites) for others; Creating and maintaining customized web pages; Creating and maintaining web sites; Creating and maintaining web sites for others; Creating and maintaining web-sites; Creating and maintaining websites; Creating and maintaining websites for cellular phones; Creating and maintaining websites for mobile phones; Creating or maintaining web sites for others; Creating web pages for others; Creating websites; Creating, designing and maintaining web sites; Creation of internet web sites; Design and construction of homepages

and websites; Design and creating web sites for others; Design and creation of homepages and web pages; Design and creation of web sites for others; Design and development of homepages and websites; Design and graphic arts design for the creation of web pages on the Internet; Design and graphic arts design for the creation of web sites; Web portal design; Web site design; Web site design and creation services; Web site design consultancy; Web site design services; Website design; Website design consultancy; Website design services; Website development for others; Website development services; Design and maintenance of web sites for others; Design and updating of home pages and web pages; Design of home pages and web sites; Design of homepages and websites; Design of web pages; Design of web sites; Design of websites; Design, creation and programming of web pages; Design, creation, hosting and maintenance of websites for others; Designing and creating web sites for others; Designing and developing web pages; Designing and developing webpages on the internet; Designing and implementing network web pages for others; Designing and implementing web sites for others; Designing websites for advertising purposes; Elaboration and maintenance of web sites for third parties; Graphic design for the compilation of web pages on the internet; Homepage and webpage design; Installing web pages on the internet for others; Internet web site design services

2. Zamira Drew and Daniel Hayman (the Applicants) filed an application for invalidation of the Proprietor's registration on 9 February 2018 under section 47 of the Trade Marks Act 1994 (the Act). The ground for the application for invalidation is based on section 5(2)(b) of the Act. The invalidity is directed against all the services in the contested trade mark's specification.

3. The Applicants rely on ownership of their UK trade mark number 3150022 for the trade mark "**Anatomy**" filed on the 16 February 2016 and registered on the 13 May 2016. It is registered for the following services:

Class 35: Advertising services; marketing services.

Class 42: Graphic design services.

4. The Applicants rely on all their services in classes 35 and 42 for which the earlier mark is registered claiming that there is a likelihood of confusion because the trade marks are similar and are registered for services identical with or similar to those for which the earlier mark is registered.

5. The Proprietor filed a defence and counterclaim denying the claims made. It denies there is any similarity between the services for the respective marks. Although originally requested by the Proprietor, the Applicants were not required to provide proof of use of their earlier mark because the earlier mark had been registered for less than five years at the date the application for invalidation was made, on 9 February 2018.¹

6. The Proprietor is unrepresented. The Applicants are represented by Stevens Hewlett & Perkins. Neither party filed evidence. Neither party requested a hearing, however the Proprietor filed brief submissions in lieu of hearing by email dated the 5 September 2018. The Applicants did not file further submissions, relying on their statement of grounds. This decision is taken therefore upon the careful perusal of the papers.

Decision

7. The application for invalidation under Section 47(2) of the Act is based on the provisions of section 5(2)(b) namely:

¹ Sections 47(2A) – 2(E) of the Act

“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 Applicants' mark qualifies as an earlier mark in accordance with section 6 of the Act.

9. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG, Case C-251/95*, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97*, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97*, *Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98*, *Matratzen Concord GmbH v OHIM, Case C-3/03*, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04*, *Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P* and *Bimbo SA v OHIM, Case C-591/12P*.

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon

the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 to mind the earlier mark, 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 services

10. When conducting a services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer inc* Case C-39/97, where 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. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

(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. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) 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. The Applicants submit that *“the services protected by the registration in suit are identical or similar to the services covered by the Opponent’s earlier mark”* and *“the respective services are identical or alternatively similar, are directed to the same customers and are commonly provided by the same undertakings”*

14. In order to determine whether there is a likelihood of confusion, the parties’ competing specifications must be compared. I have displayed in the table below those services which I conclude are identical as they incorporate the other party’s description as per the decision in *Meric*.

Proprietor's mark	Applicants' Earlier Mark
<p>Class 35</p> <p>Advertising services to create corporate and brand identity;</p> <p>Brand creation services (advertising and promotion);</p> <p>Designing websites for advertising purposes;</p>	<p>Class 35</p> <p>Advertising services;</p>
<p>Class 35</p> <p>Brand creation services;</p> <p>Brand evaluation services;</p> <p>Brand positioning;</p> <p>Brand positioning services;</p> <p>Brand strategy services;</p> <p>Brand testing;</p> <p>Brand design services;</p> <p>Brand design services;</p> <p>Design of brand names;</p> <p>Consulting services in the field of Internet marketing;</p> <p>Consulting services relating to marketing;</p> <p>Direct marketing consulting;</p> <p>Marketing consulting;</p> <p>Providing marketing consulting in the field of social media.</p>	<p>Class 35</p> <p>Marketing services;</p>
<p>Class 42</p> <p>Design and graphic arts design for the creation of web pages on the Internet;</p> <p>Design and graphic arts design for the creation of web sites;</p> <p>Graphic design for the compilation of web pages on the internet;</p>	<p>Class 42</p> <p>Graphic design services.</p>

15. This leaves the following services:

i. *“Consulting services in business organization and management; Business consulting; Business consulting for enterprises; Business consulting services; Business research consulting”* which are usually provided by specialist companies who gather information and provide their clients with the necessary support to develop and expand their business. The services would include creating a corporate identity; advice and assistance on productivity, increasing market share, dealing with competitors, developing new products, marketing products, researching consumer trends and launching new products.

“Advertising and Marketing services” are offered by companies who provide clients with all the necessary advice and assistance in the sale and promotion of their goods or services by creating an individual strategy so that they acquire a competitive advantage through publicity via different forums - newspapers, websites, television, internet etc..

When comparing the aforementioned services, it is clear that advertising and marketing services are an essential tool for a business to make itself known in the market place. The purpose of advertising services is to reinforce a client’s position within the market and the purpose of business consulting services is to help a business acquire, develop and expand market share. A professional who offers advice on how to run a business efficiently, may reasonably include advice on advertising and marketing strategies. Furthermore, business consultants may offer advertising and marketing consultancy as part of their service. The relevant public may therefore believe that these two services share the same purpose namely to assist others in the selling or promotion of goods or services. They target the same public and come from the same commercial origin.

Therefore, the Proprietor’s *“Consulting services in business organization and management; Business consulting; Business consulting for enterprises; Business consulting services; Business research consulting”* are all highly similar to the Applicant’s *“Advertising services; Marketing services”* they share similar characteristics and purpose.

ii. *“Web site traffic optimisation; Web site traffic optimization;”* services is the process of giving advice on the changes that can be made to a business’ website so

that it will appear higher in a search engine results page. The purpose of marketing advice is to optimise the position of a client's products or services. These services would be part of a business strategy to promote the brand within the market place and clearly they overlap in their purpose, source and target audience. Therefore "Web site traffic optimisation; Web site traffic optimization;" are similar to a high degree to "Marketing services"

iii. "Computer website design; Consultancy relating to the creation and design of websites; Consultancy with regard to webpage design; Creating and designing web pages for others; Creating and maintaining computer sites (web sites) for others; Creating and maintaining customized web pages; Creating and maintaining web sites; Creating and maintaining web sites for others; Creating and maintaining web-sites; Creating and maintaining websites; Creating and maintaining websites for cellular phones; Creating and maintaining websites for mobile phones; Creating or maintaining web sites for others; Creating web pages for others; Creating websites; Creating, designing and maintaining web sites; Creation of internet web sites; Design and construction of homepages and websites; Design and creating web sites for others; Design and creation of homepages and web pages; Design and creation of web sites for others; Design and development of homepages and websites; Web portal design; Web site design; Web site design and creation services; Web site design consultancy; Web site design services; Website design; Website design consultancy; Website design services; Website development for others; Website development services; Design and maintenance of web sites for others; Design and updating of home pages and web pages; Design of home pages and web sites; Design of homepages and websites; Design of web pages; Design of web sites; Design of websites; Design, creation and programming of web pages; Design, Creation, hosting and maintenance of websites for others; Designing and creating web sites for others; Designing and developing web pages; Designing and developing webpages on the internet; Designing and implementing network web pages for others; Designing and implementing web sites for others; Elaboration and maintenance of web sites for third parties; Homepage and webpage design; Installing web pages on the internet for others; Internet web site design services" encompasses all the different disciplines relating to creating, designing and maintaining a company's website. This will include

how the webpage looks, its layout, internet production and graphic design. “*Graphic design*” is the process of creating visual communications. The role includes styling and designing the layout of web pages with content including text and images. The only difference between a web page designer and a graphic designer is the mediums they use. Both involve the creative process of assembling together images, text and pictures to reflect the company’s core philosophy be it through printed publishings or electronic mediums. Both web designers and graphic designers develop and produce something to promote the business either by hand or using computer software to attract customers by the visual representations they produce. The design tools used by both professionals are similar even though they may use different computer software.

The aforementioned services therefore are similar to a medium degree to “*Graphic design services*” as these services have the same purpose namely to produce a visual representation of the company, they target the same public and may be offered by the same providers.

Average Consumer

16. When considering the opposing trade marks, I must determine first who the average consumer is for the services and the purchasing process. For the purpose of assessing the likelihood of confusion, I must bear in mind that the average consumer’s level of attention is likely to vary according to the category of services in question.

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 for both sets of services is a business user. It will be a measured, careful, thought out purchase involving research into the cost and reputation of the service provider. Choosing the right provider to complement the consumers vision will be important and it is unlikely to be a frequent purchase. The most probable method by which the services are selected is likely to be visual via the internet or brochures but may also be aural as a result of recommendations. The degree of attention paid therefore will be reasonably high.

Comparison of the marks

19. 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 (“ 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.”

20. 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.

21. The respective trade marks are shown below:

Proprietor's Series of Marks	Applicant's Mark
Anatomy Brands ANATOMY BRANDS anatomy brands	Anatomy

21. For the purposes of this comparison I will proceed on the basis of the first mark in the series of the Proprietor's marks. There is no difference between the variation in the casing because a word trade mark registration protects the word itself irrespective of the font, capitalisation or otherwise. Therefore, a trade mark in capital letters covers notional use in lower case and vice versa².

22. The Proprietor's mark consists of two words "Anatomy Brands" presented in conventional font. Both words are well known to the average UK consumer. The word "Anatomy" is the dominant and distinctive element with the word "Brands" being non-distinctive and descriptive of the services. The word "Brands" does not contribute significantly to the overall impression of the mark, it does not add any unusual or essential feature or give any additional meaning when read in conjunction with

² Bentley Motors Limited v Bentley 1962 Limited O/159/17

“Anatomy”. The dominant element in the overall impression therefore is the word “Anatomy”.

23. The Applicant’s mark consists of a single word “Anatomy” presented in title case and is a well-known English word. It is the word “Anatomy” which dominates the overall impression conveyed and which gives the mark its distinctive character.

Visual

24. The common element and the only point of visual similarity is the word “Anatomy” which is identical in both marks. What separates the marks is the word “Brands” which is absent from the Applicants’ mark. However, since the word “Brands” is non-distinctive the average consumer will pay a low level of attention to it. Consequently, there is a good degree of visual similarity between the marks.

Aural

25. As a rule of thumb the beginnings of trade marks tend to have the more visual and aural impact than their endings.³ UK average consumers read marks from left to right and therefore “anatomy” will be the first word that is read or articulated and is identical in both marks. “Brands” may or may not be articulated. I conclude therefore that there is a medium degree of aural similarity if the word “brand” is articulated and high if it is not.

Conceptual

26. The Proprietor submits that “*anatomy is a word often associated with and used in the branding, marketing and advertising community.*” And that it can “*demonstrate and*

³ El Corte Ingles, SA v OHIM, cases T-183/02 and T-184/02

substantiate that the word anatomy is widely used in these fields (eg in the context of 'brand anatomy' and the 'anatomy of a brand'."

27. No formal evidence has been filed from either party regarding the use of the word in the advertising industry, and even if there had been it is the perception of the average UK consumer which is key. In this particular case, the average consumer is a business user and I do not believe that the majority would associate the word "anatomy" with the advertising industry in the way described by the Proprietor. To the average UK consumer the word "anatomy" taking its ordinary, natural meaning would refer to the structure of the human body. This may be suggestive of a multi-faceted service but this requires a degree of analysis which is not undertaken by the average consumer, who is more likely to see it as a novel, unusual name for an advertising agency. The word "brands" has an obvious concept for advertising services. Taking this into account, the conceptual similarity between the marks is medium because the earlier mark does not include the word "Brands".

Distinctiveness

28. The matter must be considered based on inherent characteristics as the Applicants have not filed any evidence regarding their use of the mark. 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).”

29. The earlier mark consists of one word, “Anatomy”. There is no evidence filed associating the word with the services covered by the registration. It has no apparent allusive or suggestive quality to the services unless it is recognised as advertising jargon. It is clearly an ordinary English word and therefore the level of inherent distinctive character is average.

Likelihood of confusion

30. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

31. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark, I conclude that it is another brand of the owner of the earlier mark.”

32. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective services may be offset by a greater degree of similarity between the respective trade marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Applicants’ trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

34. When comparing the two marks I take into account the obvious visual similarities between them as a result of the shared presence of the distinctive word “Anatomy” which is identical in both marks; the non-distinctive use of the word “brands” and the services being either identical or similar to a medium or higher degree. I take into account that the inherent distinctiveness of the earlier mark is average with no further enhancement attributed to it through use. I note that the average consumer is reasonably well informed and circumspect and probably a business user who will pay

a reasonably high degree of attention in the selection process. Conceptually the marks share a medium level of similarity.

35. Taking into account the principle of imperfect recollection and the fact that the consumer rarely has a chance to compare marks side by side I conclude that there is a strong likelihood that the Proprietor's mark will be mistaken for the earlier mark despite the average consumer paying a high degree of attention. The difference with the inclusion of the word "brands" is not sufficient to allow the average consumer to distinguish between them leading to a likelihood of confusion. There is sufficient similarity between the respective services even to a medium degree in respect of graphic design and web page design for the average consumer to mistake one for the other.

36. In case I am wrong about direct confusion I will consider indirect confusion as explained in L.A. Sugar. Even if the average consumer does not directly mistake the marks there is sufficient similarity between them that the average consumer perhaps may recognise that the marks are different with the inclusion of the word "brands" but conclude that it is a sub brand of the earlier mark and that the respective services come from the same or economically linked undertaking. There is therefore a likelihood of indirect confusion.

37. The application for cancellation therefore succeeds for services in classes 35 and 42. Under section 47(6) of the Act the registration for the series of trade marks number 3245080 is deemed never to have been made and is to be removed from the register.

38. The Applicants have been successful and are entitled to a contribution towards their costs, based on the scale governed by Tribunal Practice Notice 2/2016 below:

considering the counterstatement

Official Fee	£200
--------------	------

Total	£400
--------------	-------------

39. I order Anatomy Brands Ltd to pay Zamira Drew and Daniel Hayman the sum of £400 as a contribution towards their costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 7th day of November 2018

Leisa Davies

For the Registrar