

O-025-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3297617 BY
IMPACT NUMBERS LTD**

TO REGISTER THE TRADE MARK:



FOR SERVICES IN CLASS 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000908
BY IMPACT CREW LTD**

BACKGROUND AND PLEADINGS

1) On 17 March 2018 Impact Numbers Ltd (“the Applicant”) applied to register the following trade mark:



The application was published for opposition purposes on 13 April 2018. Registration is sought for the following services, which are opposed in these proceedings:

Class 35: *Bookkeeping.*

2) The application is opposed by Impact Crew Ltd (“the Opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon UK registration No. 3121835 which was filed on 11 August 2015 and completed its registration procedure on 6 November 2015 for the following sign:



The services relied on by the Opponent under registration 3121835 for the purposes of these proceedings are as follows:

Class 35: *Business management consultancy as well as development of processes for the analysis and the implementation of strategy plans and management projects; Business strategy and planning services; Business management consulting with relation to strategy, marketing, production, personnel and retail sale matters; Business strategy services; Business strategy development services; Consultancy and advisory services in the field of business strategy; Business recruitment consultancy.*

3) The significance of the dates given above is that (1) the mark relied on by the Opponent constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed less than five years before the publication of the Applicant's mark.

4) The Opponent claims that "the operative part of each trade is essentially identical", that "both trade marks are strikingly similar in style and create the same impression, and that the services of the opposed mark "could easily fall within the scope" of services for which the earlier mark is registered, which could cause confusion in the minds of the public. In its counterstatement the Applicant denies the grounds of opposition. The Applicant is represented in these proceedings by Azrights Solicitors. The Opponent is not professionally represented.

5) Rules 20(1)-(3) of the Trade Marks Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions such as the present proceedings, but Rule 20(4) does. It reads:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

The net effect of these provisions is that parties are required to seek leave in order to file evidence (other than the proof of use evidence, which is filed with the notice of opposition) in fast track oppositions. Neither side sought leave to file evidence in these proceedings.

6) Rule 62(5) (as amended) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) ("the Rules") provides that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. Neither side requested a hearing or filed written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the papers before me.

Section 5(2)(b)

7) Section 5(2)(b) of the Act reads 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 (“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:

(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) It is appropriate to deal at this point with the following statement made by the Applicant in its statement of opposition:

“In my attempt to better understand the nature of the applicant’s scope of business, I found that the applicant, who is also the owner and director of impact Numbers also operates business consultancy services, further increasing the likelihood of confusion. I suspect the scope of the services in this application have been deliberately narrowed in an attempt to increase the likelihood of

success, whilst the applicant still intends to use the trademark for a wider range of services in the future”

10) Apart from the fact that there is no evidence before the Tribunal to support this contention regarding the present or potential use of the opposed sign by the Applicant, the submission is in any case misconceived. Insofar as use of the sign by the Applicant in practice were to encroach on the protection afforded to the Opponent’s mark, the proper remedy would be an action for infringement or passing off. It is settled law that in assessing whether there is a likelihood of confusion for the purposes of these opposition proceedings I must make my comparison on the basis of *notional and fair* use of the whole range of services covered by the Applicant’s and (since the earlier mark is not subject to proof of use under section 6A of the Act) the Opponent’s respective specifications as relied on in these proceedings. It is the *inherent* nature of the services of the specifications which I have to consider. The range of services actually or potentially offered by the parties is irrelevant to this *notional* comparison. My task, therefore, is to conduct the comparison of the services, and my subsequent assessment of the likelihood of confusion, simply on the basis of the services *as they are set out in the respective specifications*.

11) In assessing whether there is a likelihood of confusion I must make my comparison of the goods on the basis of the principles laid down in the case law. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

12) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a) The respective users of the respective goods or services;

- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“Merik”), the General Court stated that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application. This principle is equally applicable to services.

14) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market*, Case T- 325/06 the General Court explained 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. This principle is equally applicable to services.

15) When it comes to understanding what terms used in specifications mean and cover, the guidance in the case-law is to the effect that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹. I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning².

¹*British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281

²*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

16) In *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, however, Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

17) Neither side applied to file evidence addressed to the issue of service similarity, so there is nothing to show whether there is any real overlap in trade between the respective services generally. In view of this, I can only really consider factors which are obvious. In the absence of evidence I must adopt the approach of Neuberger J in *Beautimatic* and give the words their natural meaning, subject to their being construed within their context. I must also bear in mind the comments of Jacob J in *Avnet*.

18) *Bookkeeping* is defined in the Oxford Dictionary of English (3rd edition) as “*the activity or occupation of keeping the financial records of a business*”. *Management consultancy* is defined as “*a professional practice that gives advice about how to run a company or organisation more effectively*”. Thus, *bookkeeping* would involve, for example, recording financial transactions, keeping track of debts and receivables, maintaining sales ledgers, payroll records, etc. *Business management consultancy*, on the other hand, consists of providing advice and assistance on conduct of the day-to-day management of a business and on its development in terms of organisation, goals, objectives, etc.

19) The purchasers of both *business management consultancy* services and *bookkeeping services* will normally be businesses and the self-employed (though they may also include organisations such as charities and associations of various kinds), so there can be user overlap. However, the mere fact that different services are supplied to the same users does not in itself indicate similarity. The nature and purpose of *bookkeeping* differ from those of *business management consultancy*; the former relates to the keeping of financial records and the latter to analysing how a business works and making suggestions in relation to its functioning. They involve different sets of professional skills. Nor are they in competition; one cannot be substituted for the other.

20) There may well be a sense in which some of the data used in the course of business management analysis may ultimately be derived from bookkeeping records, but I do not consider this means that the relevant consumers would regard the provision of bookkeeping services as important or indispensable to the services of business management consultancy in such a way as to lead them to think that responsibility for those services lies with the same undertaking. There is no material complementarity.

21) With regard to channels of trade there is no evidence before me that bookkeeping and business management consultancy are offered by the same providers (or, if they were, whether the relevant consumers would see this as indicative of a natural link rather than simply the diversification in trade of large practices). In the absence of such evidence the natural and obvious conclusion is that the services are provided by discrete operators. There is nothing to suggest that a business seeking *bookkeeping* services would look for a provider under the heading, or using the search term, *business management consultancy* – or vice versa.

22) Applying the principles laid down in the case law, and in particular taking into account *Avnet*, I find that *bookkeeping* and *business management consultancy* are not similar.

23) All the other services listed in the Class 35 services relied on by the opponent consist of various business management services qualified respectively by reference to the development of processes for the analysis and the implementation of strategy plans and management projects, business strategy and planning, marketing, production, personnel, retail sale matters, business strategy development, and business recruitment. None of these offers the Opponent a better case than its broad *business management consultancy* at large. They all fall within the ambit of *business management consultancy*. The same considerations apply to the comparison with these specific fields of business management consultancy as I have found above to apply to the Opponent's *business management consultancy* at large, and for the same reasons. There is no similarity between any of them and the Applicant's *bookkeeping*.

24) Some degree of similarity between the services at issue is required for there to be a likelihood of confusion³. Since I have found no similarity between the Applicant's and the Opponent's respective services, the opposition must fail.

Outcome

25) The opposition fails in its entirety.

Costs

26) Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. The Applicant has been successful and is entitled to a contribution towards its costs. I take into account that the pleadings were uncomplicated and that no submissions in lieu of attendance at a hearing were filed, though what amount to straightforward submissions were included in the counterstatement. I hereby order Impact Crew Ltd. to pay Impact Numbers Ltd. the sum of £200. This sum is calculated as follows:

Considering the opponent's statement of grounds and preparing a counterstatement	£200
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The above sum should 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 15th day of January 2019

Martin Boyle
For the Registrar,
The Comptroller-General

³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA