

O/144/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATIONS NOS. 3257637

AND 3257616 BY

BRAND EQUITY PARTNERS LIMITED

TO REGISTER:

BRAND IDEATION

Brand Ideation

AND

BRAND IDEATORS

Brand Ideators

AS TWO SERIES OF TRADE MARKS IN CLASSES 35, 36 & 42

AND

IN THE MATTER OF THE OPPOSITIONS THERETO

UNDER NOS. 411299 AND 411306 BY

BRAND IDEA DI PAOLO MACCAFERRI & C. S.N.C.

Background and pleadings

1. Brand Equity Partners Limited (“the applicant”) applied to register the following two series of trade marks in the United Kingdom on 19 September 2017:

BRAND IDEATION

Brand Ideation

BRAND IDEATORS

Brand Ideators

They were accepted and published in the Trade Marks Journal on 6 October 2017 in respect of the following services:

Class 35

Brand creation; Brand evaluation; Brand positioning; Brand strategy; Brand testing; Brand development; Brand concept and brand development services for corporate and individual clients; Branding services, namely consulting, development, managing and marketing of brands for businesses and/or individuals; Advertising, marketing and promotional services; Advertising services to create corporate and brand identity; Brand imagery consulting services; Marketing and consulting services in the field of promoting and tracking the goods, services, and brands of others through all public communication means; Advertising and publicity services, namely promoting the goods, services, brand identity and commercial information and news of third parties through print, audio, video, digital and on-line medium; Advertising services, namely, creating corporate and brand identity for others; Public relations, public relations services; publicity services; business consultancy; business networking services; production of marketing, promotional and advertising material; Business management; Business administration; Office functions; advisory, consultancy and information services relating to the above/aforesaid.

Class 36

Financial affairs; monetary affairs; real estate affairs; financial management; financial analysis; financial services; financing services; financial services in relation to brands and brand identity; financial consulting; real estate management; investment services; investment of funds; investments of funds loans [financing]; advisory, consultancy and information services relating to the aforesaid.

Class 42

Design services; brand design services; design of brand names; design and development of computer software; computer software design; technological services and design relating thereto; computer technology services; website design services; advisory, consultancy and information services relating to the aforesaid.

2. The applications were opposed by BRAND IDEA di Paolo Maccaferri & C. S.n.c. (“the opponent”). The oppositions are based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opposition concerns all services in the applications.
3. With regards to its claims based upon Sections 5(2)(b) and 5(3) of the Act, the opponent is relying upon EU (formerly Community) Trade Mark No 15090624 **BRAND IDEA WHATEVER MAKES THE DIFFERENCE** (“the 624 mark”) and EU (formerly Community) Trade Mark No. 5611967 (“the 967 mark”):

BRAND IDEA 
whatever makes the difference

4. The 624 mark was applied for on 9 February 2016 and registered on 10 June 2016 in respect of the following services, all of which the opponent states it is relying on under section 5(2)(b) of the Act:

Class 35

Business management consultancy; Public relations and market research; Business and commercial management assistance for companies in the food sector; Assistance and consultancy for advertising and promoting goods, retailing of foodstuffs; Retailing of culinary specialities; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Arranging of buying and selling contracts for third parties; Sales promotion for others; Shop window dressing; Product demonstrations and product display services.

Class 42

Research and development in the industrial food sector; Industrial research and analysis; Design and development of computers and computer programs.

Class 43

Serving food and drinks; Bar services; Cafeterias, canteens, food and drink catering, delicatessens; Fast-food restaurants and snack-bars; Self-service restaurant services; Serving food and drink in restaurants and bars.

5. The 967 mark was applied for on 12 January 2007 and registered on 10 June 2008 in respect of the following services, all of which the opponent states it is relying on under section 5(2)(b) of the Act:

Class 35

Services carried out for and/or on behalf of others in the advertising and business sectors; public relations and market research; business management assistance for companies in the food sector.

Class 42

Research and development in the industrial food sector; industrial research and analysis; design and development of computer hardware.

6. The opponent claims that the marks are similar and that the services covered by the applicant's specifications are the same as, or similar to, services covered by

the earlier marks, leading to a likelihood of confusion on the part of the public. The opponent therefore requests that registration of the contested marks should be refused under section 5(2)(b) of the Act.

7. Additionally, or alternatively, the opponent claims that it has acquired a substantial reputation in its earlier marks and that use of the applicant's marks would be detrimental to the distinctive character of the earlier marks in that the ability of those marks to identify the services for which they are registered would be weakened. The opponent also claims that use of the contested marks would be detrimental to the repute of the earlier marks and that this would come about by the use of similar marks in respect of services that have not been subject to the quality control of the opponent. Finally, the opponent claims that use of the contested marks would take unfair advantage of the distinctive character or repute of the earlier trade marks. The opponent submits that it is unaware of any due cause which requires the applicant to use the contested marks and that, as a result, the application should be refused under section 5(3) of the Act.
8. The applicant filed a defence and counterstatement, denying all the grounds. It also requested that the opponent provide evidence of proof of use of the 967 mark for all the services for which it is registered.
9. Both the opponent and the applicant filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. No hearing was requested. The opponent and applicant filed written submissions in lieu of a hearing, both on 21 November 2018. These will not be summarised but will be referred to as and where appropriate during this decision.
10. In these proceedings the opponent is represented by Stobbs and the applicant by Appleyard Lees LLP.

Relevant dates

11. The opponent's 967 mark had been registered for more than five years on the date on which the contested application was published. It is, therefore, subject to the

proof of use provisions under section 6A of the Act, and the applicant has requested such proof for all services in Classes 35 and 42. The opponent has made a statement that it has made genuine use of the mark in the EU, including the UK, in the relevant period for all of the services upon which it is relying. The relevant period for these purposes is the five years prior to and ending on the date of publication of the contested application: 7 October 2012 to 6 October 2017.

12. The opponent's 624 mark had been registered for less than five years on the date on which the contested application was published. It is, therefore, not subject to the proof of use provisions under section 6A of the Act.
13. The relevant date for the purposes of sections 5(2)(b) and 5(3) is the date the application was filed: 19 September 2017.

Evidence

Opponent's Evidence

14. The opponent's evidence comes from Mina Refioglu, an administrator of BRAND IDEA di Paolo Maccaferri & C. S.n.c. since March 2006. It is dated 12 June 2018.
15. BRAND IDEA was established in Italy in 2006 and provides brand management services. Ms Refioglu explains that:

“My Company advises as to the best way our clients can develop a good relationship with the target market as this is essential for brand management. Advice also relates to tangible elements of brand management which can include the product itself, look of product, price of product, the packaging for the product and so on. Advice is also provided in relation to the intangible elements that relate to the experience that the consumer had with the brand, and also the relationship that they have with that brand.”

16. She states that the marks have been in continuous use throughout the EU, including the UK, since their adoption in 2006.

17. Two examples of the opponent's work are supplied in Exhibits XX3 and XX4, and the opponent states that both of these were in the UK. The first project, "Brand Idea Food Lounge", launched in 2016, brings together a group of Italian food companies in a single location with, as the brochure in Exhibit XX4 states,

"the aim of enhancing their products and brands, through dedicated counters that can reflect their own identities; concepts which communicate the origin and quality of the products, accompanying the customers throughout an emotional discovery."

A slightly stylised word mark is used, as shown below, in the brochure.



I have magnified the mark below:

BRAND IDEA

WHATEVER **MA** KES THE DIFFERENCE

The “K” in the middle of “MAKES” is presented in yellow and a different font. The brochure is printed in Italian and English and is copyright 2016.

18. The second project is “Parmesan is Fashion!”. The 967 mark is shown in the corner of one of the pages:



The brochure is in English, but there is no information about the geographical extent of this campaign or when it took place. Exhibit XX3 shows examples of the packaging and the labels used.



19. However, further information about this project can be found in Exhibit XX6, which includes an agreement between the opponent and Antica Formaggeria S.p.A., a company that packages cheese, to license “an innovative packaging design concept known as ‘Parmesan is Fashion’ consisting of 10 unique and distinct designs to be affixed to the portioned prepackaged Parmesan product”. The agreement is in Italian, but an English translation has been provided. Also included is an invoice dated 10 October 2011 showing an advance on royalties of €20,000 and data on sales between 10 November 2011 and 23 April 2012 (outside the relevant period for the purposes of showing proof of use).

20. The final item included in Exhibit XX6 is a contract between the opponent and Gallisrl for marketing and commercial assistance consulting dated 30 May 2012 and related to Italian dairy products. A translation has been provided. The territory covered by the agreement includes the UK, as well as several other EU Member States (France, Finland, Sweden, Netherlands, Belgium) and the US.

Applicant's Evidence

21. The applicant's evidence comes from Ms Rachel Louise Garrod, a Trade Mark Attorney at the applicant's representative, Appleyard Lees IP LLP. It is dated 13 August 2018. This evidence consists of definitions taken from the Oxford Dictionaries website, results of searches of trade mark databases and Google, printouts from the Internet Archive WayBack Machine for "www.brandidea.it", and examination and acceptance letters from the Registry. I shall not summarise this evidence here but shall refer to it where appropriate in my decision.

Proof of Use

22. Section 6A of the Act states that:

"(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

23. The case law on genuine use was summarised by Arnold J in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co*

KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the

purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].
- (7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis*

rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [132].”

24. The opponent has been requested to show proof of use of the 967 mark for all the services for which it is registered within the relevant territory. As this mark is an EUTM, this is the EU.

25. The onus is on the opponent, as the proprietor of the earlier mark, to show use. Section 100 of the Act states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

The applicant submits that use has not been demonstrated. The opponent submits that it has done so in respect of the following services: *Services carried out for and/or on behalf of others in the advertising and business sectors; market research; business management assistance for companies in the food sector; research and development in the industrial food sector.* It admits that it has not shown proof of use with respect to *public relations, industrial research and analysis and design and development of computer hardware and software.*

26. In *Awareness Limited v Plymouth City Council*, BL O/236/13, Mr Daniel Alexander QC, sitting as the Appointed Person, stated that:

“The burden lies on the registered proprietor to prove use... however, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be

sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”¹

27. The opponent itself acknowledges that its evidence is “not ... particularly exhaustive”. In particular, there is no information on sales volumes or even general turnover figures, which presumably should have been easy for the opponent to provide. Nevertheless, I am required to assess the evidence as a whole, bearing in mind that genuine use does not always have to be quantitatively significant (see point 7 of Arnold J’s summary, quoted above).
28. Taking the evidence as a whole, the opponent has demonstrated use of the 967 mark in relation to three projects: Brand Idea Food Lounge, Parmesan is Fashion!, and a consultancy contract with Galli srl.
29. In the case of Brand Idea Food Lounge, the opponent does not make clear what services it delivered as part of this project, where it delivered them or what it earned from this work. All that is presented is the brochure, which contains some information on the participating companies. Consequently, I find that this evidence provides little insight into whether the opponent has made genuine use of the 967 mark.
30. There is more information in the case of Parmesan is Fashion!. I turn again to the licence agreement which states that the services provided included the design of packaging. It also sets out the payments that are to be made to the opponent: €0.30 per kilo of Parmesan cheese sold, with €20,000 each year as an advance on royalty payments. The first of these payments was made on 10 October 2011

¹ Paragraph 22.

(4 days into the relevant period) for the year 2012. As I have already shown, the 967 mark appears on the label of the product. The applicant questions the value of this evidence and submits that it is not clear where these products were sold. I agree that this information is absent. However, the opponent was not selling cheese to the general public, but services to Antica Formaggeria SpA, a company operating in the food and agriculture sector and based in Carpi, Italy. There is, though, insufficient evidence to lead me to find that work was done, and sales made, during the relevant period. In particular, the licence agreement states that the designs were registered on 1 July 2011 and that Antica Formaggeria was to begin marketing by and no later than 1 November 2011.

31. The third project is consultancy work for Galli srl, an Italian company selling dairy products. This was a two-year contract lasting from 1 June 2012 to 31 May 2014, with an option to terminate a year early. The majority of this time falls within the relevant period. Each year of the contract earned the opponent €25,000. Judging by the translation, the services to be delivered included identifying new overseas markets, developing existing overseas markets, and work on the company's packaging and product lines. The 967 mark appears prominently on the original language version of the contract.² This is the sole project that I have sufficient evidence to find falling within the relevant period and covering the relevant territory.
32. It is well-established case-law that there is no *de minimis* level of use that would qualify as genuine. Instead, the assessment must take account of all relevant factors, as the CJEU stated in *Ansul*:

“38. When assessing whether there has been genuine use of the trade mark regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market concerned for the goods or services protected by the mark.

² See Exhibit XX6, pages 108-110.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not therefore always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market.”

33. The services at issue are as follows:

Class 35

Services carried out for and/or on behalf of others in the advertising and business sectors; public relations and market research; business management assistance for companies in the food sector.

Class 42

Research and development in the industrial food sector; industrial research and analysis; design and development of computer hardware.

The Class 35 services are fairly broad. While I do not have any evidence on the size of the markets for these services, it seems to me that they are large. *Public relations* and *market research* are relevant to many businesses, and *services carried out for and/or on behalf of others in the advertising and business sectors* encompasses a wide range of services a business might require. The Class 42 services are, perhaps, more specialised and purchased infrequently. The work shown in the evidence would not be done quickly, but, as the contract with Galli suggests, could last for a few years.

34. I am required to come to a view on whether the evidence shows sufficient use of the 967 mark to create or maintain a share in the market for these services. There is one piece of evidence relating to the relevant period: the contract with Galli. I have not been shown whether, or how, the mark is used as part of the selection process. When it comes to the signing of a contract, selection has already been made. When the average consumer is choosing a provider of these services, they

are likely to consult websites and printed promotional material. In paragraph 26 above, I quoted the comments of Mr Daniel Alexander QC that there is no requirement for a particular type of documentation to be provided as evidence. Nevertheless, one contract with one company in one Member State is, to my mind, insufficient to support genuine use of an EUTM.

35. Consequently, I find that the opponent has not proved genuine use of the 967 mark for the services for which it is registered. However, the opponent still has the 624 mark, which, it will be recalled, was not subject to proof of use, and therefore the opponent may rely on all the services for which that mark is registered.

Decision

Section 5(2)(b) ground

36. Section 5(2)(b) of the Act states that:

“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.”

37. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the courts of the European Union in *SABEL BV v Puma AG* (C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (C-425/98), *Matratzen Concord GmbH v OHIM* (C-3/03), *Medion AG v Thomson Multimedia*

Sales Germany & Austria GmbH (C-120/04), *Shaker di L. Laudato & C. Sas v OHIM (C-334/05 P)* and *Bimbo SA v OHIM (C-519/12 P)*:

- (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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone 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 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 services

38. The opponent submits that the services in the applications are identical or similar to services covered by its marks, while the applicant submits that they are “quite different”.

39. When comparing the services, all relevant factors should be taken into account, per *Canon Kabushiki Kaisha*:

“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 complementary.”³

40. The General Court clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, T-325/06:

³ Paragraph 23

“...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.”⁴

41. Jacob J (as he was then) set out the relevant factors for assessing similarity in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281:

“(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.”

42. In my assessment of the applicant’s and opponent’s services, I bear in mind the comments of Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

⁴ Paragraph 82.

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

43. Because this decision concerns services, I also take account of the comments of Jacob J (as he then was) in *Avnet Incorporated v Isoact Limited* [1998] FSR 16:

“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.”

44. The services to be compared are shown in the table below:

Opponent’s services	Applicant’s services
<u>Class 35</u> Business management consultancy; Public relations and market research; Business and commercial management assistance for companies in the food sector; Assistance and consultancy for advertising and promoting goods,	<u>Class 35</u> Brand creation; Brand evaluation; Brand positioning; Brand strategy; Brand testing; Brand development; Brand concept and brand development services for corporate and individual clients; Branding services, namely consulting, development, management

Opponent's services	Applicant's services
<p>retailing of foodstuffs; Retailing of culinary specialities; Electronic commerce activities, namely, providing information about products via telecommunication networks for advertising and sales purposes; Arranging of buying and selling contracts for third parties; Sales promotion for others; Shop window dressing; Product demonstrations and product display services.</p>	<p>and marketing of brands for businesses and/or individuals; Advertising, marketing and promotional services; Advertising services to create corporate and brand identity; Brand imagery consulting services; Marketing and consulting services in the field of promoting and tracking the goods, services, and brands of others through all public communication means; Advertising and publicity services, namely promoting the goods, services, brand identity and commercial information and news of third parties through print, audio, video, digital and on-line medium; Advertising services, namely, creating corporate and brand identity for others; Public relations, public relations services; publicity services; business consultancy; business networking services; production of marketing, promotional and advertising material; Business management; Business administration; Office functions; advisory, consultancy and information services relating to the above/aforesaid.</p> <p><u>Class 36</u> Financial affairs; monetary affairs; real estate affairs; financial management; financial analysis; financial services;</p>

Opponent's services	Applicant's services
<p data-bbox="264 692 392 725"><u>Class 42</u></p> <p data-bbox="264 748 807 1003">Research and development in the industrial food sector; Industrial research and analysis; Design and development of computers and computer programs.</p> <p data-bbox="264 1189 392 1223"><u>Class 43</u></p> <p data-bbox="264 1245 807 1554">Serving food and drinks; Bar services; Cafeterias, canteens, food and drink catering, delicatessens; Fast-food restaurants and snack bars; Self-service restaurant services; Serving food and drink in restaurants and bars.</p>	<p data-bbox="829 253 1388 618">financing services; financial services in relation to brands and brand identity; financial consulting; real estate management; investment services; investment of funds loans [financing]; advisory, consultancy and information services relating to the aforesaid.</p> <p data-bbox="829 692 957 725"><u>Class 42</u></p> <p data-bbox="829 748 1388 1223">Design services; brand design services; design of brand names; design and development of computer software; computer software design; technological services and design relating thereto; computer technology services; website design services; advisory, consultancy and information services relating to the aforesaid.</p>

45. Some of the applicant's services are self-evidently identical to services covered by the opponent's 624 mark: *Public relations, PR services; Design and development of computer software; Computer software design*. I shall consider the applicant's remaining services by Class.

The applicant's Class 35 services

46. The applicant's specification contains a relatively long list of brand-related services: *Brand creation; Brand evaluation; Brand positioning; Brand strategy; Brand testing; Brand development; Brand concept and brand development services for corporate and individual clients; Branding services, namely consulting, development, managing and marketing of brands for businesses and/or individuals; Brand imagery consulting services*. In my view, all these services are part and parcel of brand development and management and will frequently be provided by the same undertakings. Consequently, I shall group them together for the purposes of my assessment, in light of the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Separode Trade Mark*, BL O/399/10:

“...The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁵

47. The opponent submits that *Brand creation services* and *Brand development services* are highly similar to advertising:

“Advertising is the means by which brands are projected, in order to achieve sales and growth. It seems more probable than not that companies and agencies offering ‘advertising’ will also be concerned with a client’s brand and the image it wishes to project as the advertising aspect is integral to the brand services. The channels of trade are therefore likely to be the same and the end consumers also the same.”

⁵ Paragraph 5.

I agree that there is some similarity. Brands are all about the presentation of goods or services and how they are perceived by actual and potential customers. The users of these services are the same: businesses with a product or service to sell. The purpose of both is to influence perceptions of those products or services, and so is identical, or at least highly similar. The nature of the services will be similar: both will involve developing an understanding of the client's needs, research into the relevant market and the production of proposals. Channels of trade are similar: the same firms may provide both services, but this is not always the case. I find that there is a high degree of similarity between the brand services covered by the applicant's mark and the opponent's *Assistance and consultancy for advertising and promoting goods*.

48. I also consider that the following applied for services are sufficiently comparable for me to adopt the *Separode* approach: *Advertising, marketing and promotional services; Advertising services to create corporate and brand identity; Advertising and publicity services, namely promoting the goods, services, brand identity and commercial information and news of third parties through print, audio, video, digital and on-line medium; Advertising services, namely, creating corporate and brand identity for others; Publicity services; Production of marketing, promotional and advertising material*.

49. Goods and services may be considered identical in the following circumstances, as set out by the General Court in *Gérard Meric v OHIM*, Case T-133/05:

“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.”⁶

⁶ Paragraph 29.

50. I find the services listed in paragraph 48 to be identical to the opponent's *Assistance and consultancy for advertising and promoting goods*. The purpose, users and nature of the service are the same, as are the channels of trade. In my view, this analysis also applies to the applicant's *Marketing and consulting services in the field of promoting and tracking the goods, services, and brands of others through all public communication means*. These are activities that the average consumer of the services would expect to be provided as part of marketing and promotional services. If I am wrong on identity, the services are in any event highly similar.
51. I consider that the opponent's *Business management consultancy* would be encompassed by the applicant's broader *Business consultancy*. Following *Meric*, I find these services to be identical.
52. *Business networking services* are services which bring businesses together to build and maintain relationships. The users of these services will be the same as the users of *business management consultancy* and there may be some similarity in the purpose: to improve business performance. The services are not strictly speaking in competition with each other, nor are they complementary within the meaning of trade mark law (see paragraph 40). They may, however, be provided by the same companies. I find that there is a low degree of similarity between these services.
53. The applicant's *Business management* encompasses the opponent's *Business and commercial management assistance for companies in the food sector*. On the *Meric* principle, I find these services to be identical.
54. *Business administration* and *office functions* involve carrying out some or all of the functions of a business, rather than advising or consulting on them. The users are likely to be the same, and there may be overlapping purposes. In some instances, the services will be in competition. For example, a business could choose to outsource certain administrative functions to another company, or to receive consultancy on how to perform them better inhouse. I find there to be a low degree of similarity between these services and *Business management consultancy*.

55. The applicant's specification also includes *Advisory, consultancy and information services* relating to all the specified services in Class 35. In so far as, and to the extent that, the specified services are identical or similar, I find that these advisory, consultancy and information services are also identical or similar.

The applicant's Class 36 services

56. The opponent submits that, while the applicant's Class 36 services are different from those of the earlier mark(s) on account of their nature and intended use, there is a connection between them, and that this connection is sufficiently close that consumers may think that the services are provided by the same undertaking. The opponent continues:

"There is therefore a low degree of similarity between those services because there is, to some degree, a complementary relationship between some of the services in class 35 and the applicant's financial services in class 36 because they might be used in connection with the same business venture and consumers might believe that they were offered by the same (or economically connected) undertaking."

Simply being used in connection with the same business venture is not, however, enough to show complementarity in the sense that it is used in trade mark law. As Mr Daniel Alexander QC, sitting as the Appointed Person, said in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes"

and

"... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

57. The average consumer would expect financial services to be provided by a specialist, often regulated, firm or individual. They are unlikely to believe that the services are the responsibility of the same undertaking that supplies business management consultancy or services connected with promoting goods.
58. I find that the Class 36 services are different from the services covered by the opponent's 624 mark. In *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA, Arden LJ noted that "If there is no similarity at all, there is no likelihood of confusion to be considered".⁷ The section 5(2)(b) ground fails in the case of these services.

The applicant's Class 42 services

59. *Design services* is a broad term and it describes the process of developing the look and feel of products, software or services. Hence the services could be delivered to many different types of user for a variety of purposes: from the business looking for specialist product design or introducing a new customer service, to the sole trader wanting a website to be designed, to the member of the general public getting some posters and flyers for a community event. They are also likely to be supplied by different specialists. For these reasons, I will deal with the specified services separately in my comparison and return to *Design services* following my consideration of the other listed services.⁸
60. In my view, *Brand design services* and *Design of brand names* are services the average consumer would expect to receive during the creation or development of a brand. I have already discussed these services in paragraph 47 and found a high degree of similarity between these and the opponent's *Assistance and consultancy for advertising and promoting goods*. It follows that *Brand design services* and *Design of brand names* are also highly similar.

⁷ Paragraph 49.

⁸ In paragraph 45 of this decision I found *Design and development of computer software* and *Computer software design* to be identical to the opponent's *Design and development of computers and computer programs*.

61. I turn now to *Technological services and design thereto*. The average consumer would, to my mind, interpret this term as having a significant overlap with *Design and development of computers and computer programs*. While not all technology is related to computers, a large proportion of technological services delivered to consumers will be enabled by information technology. I find these services to be highly similar.
62. There is also an overlap between *Computer technology services* and *Design and development of computers and computer programs*. The core meaning of the former term may cover a wider range of services. The users of both services are likely to be businesses and the trade channels will overlap. I find these services to be highly similar.
63. *Website design services* may be used by members of the general public as well as businesses, both large and small. Designing a website requires a different set of skills from those needed by a designer or developer of computer programs. In particular, the website designer will not, in my view, be expected to possess the ability to program. While the design of websites depends on the design and development of computers and computer programs, the average consumer would expect the services to be provided by different undertakings. The nature of the services is similar and there will be some overlap in users, but the services are not in competition with each other. I find there to be a low degree of similarity between *Website design services* and *Design and development of computers and computer programs*.
64. I must now return to *Design services* which, as I have already noted, is a broad term. I remind myself of the General Court's judgment in *Meric*, to which I have already referred in paragraph 49. The opponent's *Design and development of computer programs* is included within the broader category and so I find these services to be identical.
65. As with the applicant's Class 35 services, the applicant's specification also includes *Advisory, consultancy and information services* relating to all the specified services in Class 42. In so far as, and to the extent that, the specified

services are identical or similar, I find that these advisory, consultancy and information services are also identical or similar.

Summary

66. The table below sets out my findings:

<p>Identical services:</p> <p><u>Class 35</u> <i>Advertising, marketing and promotional services; Advertising services to create corporate and brand identity; Marketing and consulting services in the field of promoting and tracking the goods, services, and brands of others through all public communication means; Advertising and publicity services, namely promoting the goods, services, brand identity and commercial information and news of third parties through print, audio, video, digital and on-line medium; Advertising services, namely creating corporate and brand identity for others; Public relations, public relations services; Publicity services; Business consultancy; Production of marketing, promotional and advertising material; Business management; Advisory, consultancy and information services relating to the above/aforesaid.</i></p> <p><u>Class 42</u> <i>Design services; Design and development of computer software; Computer software design; Advisory, consultancy and information services relating to the aforesaid.</i></p>
<p>High degree of similarity:</p> <p><u>Class 35</u> <i>Brand creation; Brand evaluation; Brand positioning; Brand strategy; Brand testing; Brand development; Brand concept and brand development services for corporate and individual clients; Branding services, namely consulting,</i></p>

development, management and marketing of brands for businesses and/or individuals; Brand imagery consulting services; Advisory, consultancy and information services relating to the above/aforesaid.

Class 42

Brand design services; Design of brand names Technological services and design relating thereto; Computer technology services; Advisory, consultancy and information services relating to the aforesaid.

Low degree of similarity:

Class 35

Business networking services; Business administration; Office functions; Advisory, consultancy and information services relating to the above/aforesaid.

Class 42

Website design services; advisory, consultancy and information services relating to the aforesaid.

Different services

Class 36

Financial affairs; monetary affairs; real estate affairs; financial management; financial analysis; financial services; financing services; financial services in relation to brands and brand identity; financial consulting; real estate management; investment services; investment of funds loans [financing]; advisory, consultancy and information services relating to the aforesaid.

Average consumer and the purchasing act

67. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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 goods or services in question: see *Lloyd Schuhfabrik Meyer*.

68. 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:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”⁹

69. Both the opponent's and the applicant's specifications comprise services that will be commissioned by a business or professional person. Such services may involve a tendering process, or another formal selection process. This process is likely to be visual, the selection being made from websites, brochures, or submitted proposals, though I cannot ignore the aural element, as word-of-mouth recommendations may also be made. The services will be purchased fairly infrequently and in my view the average consumer would pay a higher than average level of attention to the selection.

70. Some of the services, such as website and other design services, may also be purchased by members of the general public. As with professional users, the process will, in my view, be likely to be predominantly visual, although word-of-

⁹ Paragraph 60.

mouth recommendations may also be made. Overall, however, I find that the average consumer of the similar or identical services is more likely to be a business or a professional.

Comparison of marks

71. 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 in *Bimbo SA v OHIM*, C-591/12 P, that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”¹⁰

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

73. The respective marks are shown below:

Earlier mark	Contested mark
BRAND IDEA WHATEVER MAKES THE DIFFERENCE	BRAND IDEATION/Brand Ideation BRAND IDEATORS/Brand Ideators

¹⁰ Paragraph 34.4

74. The opponent's 624 mark consists of the words "BRAND IDEA WHATEVER MAKES THE DIFFERENCE". These words are in capital letters in a standard font with no stylisation.¹¹ The opponent submits that the words "BRAND IDEA" will be perceived as the dominant and distinctive element of the mark. In my view, the sequence of words makes more sense seen as essentially two phrases, with the second commenting on, or describing, the first. When faced with a long string of words, it seems to me that the average consumer would break them up into units that hang together. While the beginnings of marks tend to have slightly more impact,¹² the second phrase still makes a reasonable contribution to the overall impression of the mark.

75. The applicant's marks consist of the words "BRAND IDEATION" and "BRAND IDEATORS". These words are in a standard font with no stylisation and are presented in one format as capital letters and in the other with just the first letter of each word capitalised. The overall impression of the contested marks rest in the phrase as a whole; neither word is more dominant than the other.

Visual comparison

76. All the marks under consideration are word marks in standard font. They share the same initial 9 letters: "BRAND IDEA....." The applicant's marks both consist of two words, the first with 5 and the second with 8 letters. The opponent's 624 mark consists of 6 words so appears much longer, although I note that the average consumer will rarely have the opportunity to see the marks side by side. Taken as a whole, I consider that the marks are visually similar to a low degree.

Aural comparison

77. The applicant's marks consist of 5 syllables and will be articulated thus: "BRAND EYE-DEE-AY-SHUN" and "BRAND EYE-DEE-AY-TORS". The opponent's mark

¹¹ Registration of a trade mark in capital letters covers use in lower case, as stated by Professor Ruth Annand, sitting as the Appointed Person, in *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.

¹² See *El Corte Inglés SA v OHIM*, Joined Cases T-183/02 and T-184/02.

is longer, at 11 or 12 syllables: “BRAND EYE-DEE-AH WOT-E-VER MAKES THE DIFF-ER-ENS” or “DIFF-RENS”. It is possible that the average consumer would only articulate the first two words. If the average consumer does this, then I consider the aural similarity to be high; if the average consumer does not, it would be no more than medium.

Conceptual comparison

78. The opponent submits that the marks are conceptually similar:

“‘BRAND IDEA’ can mean ‘a thought/idea captured in a simple but meaningful phrase that expresses the essence or embodiment of a brand – it defines the brand and acts as the central driving concept that the brand architecture is constructed from’.

The word BRAND on its own can mean ‘a mark made by burning with a hot iron to attest manufacture or quality or to designate ownership; a printed mark made for similar purposes; trade mark’.

The word ‘ideator’ means ‘a person/one who generates/forms an idea or a concept’. The words are clearly linked in meaning, one informing the other.

For the UK public the Applications and the Earlier Marks will be conceptually similar to the extent that they have the word element ‘BRAND’ and ‘IDEA-’ in common.”

79. The applicant, on the other hand, submits that there are conceptual differences, and refers to the dictionary definitions provided in the witness statement of Ms Garrod:

Idea¹³

A thought or suggestion as to a possible course of action; a mental impression; an opinion or belief; the aim or purpose; (in Platonic thought) an eternally existing pattern of which individual things in any class are imperfect copies.

Ideation¹⁴

The formation of ideas or concepts.

No definitions were found for the word “ideator”.¹⁵

80. I accept that the average consumer is likely to ascribe to “BRAND IDEA” the meaning submitted by the opponent. The remaining words are not negligible and will reinforce the notion that the idea of the brand is what differentiates the products from their competitors.

81. Neither “ideation” nor “ideator” are words in common English usage. On the basis of its absence from the comprehensive Oxford Dictionaries website, I accept that the average consumer will consider that “ideator” is an invented word. In my view, it is very possible that they will think that “ideation” has also been made up, as a derivative of “IDEA”. In *Usinor SA v OHIM*, Case T-189/05, the General Court found that

“... as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04

¹³ Exhibit RLG1.

¹⁴ Exhibit RLG2.

¹⁵ Exhibit RLG3.

Mundipharma v OHIM – Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57).¹⁶

The average consumer, when encountering the applicant's marks, will identify the recognisable words and is likely to assume that "BRAND IDEATION" and "BRAND IDEATORS" are something to do with "BRANDS" and "IDEAS". Possibly they may think that "BRAND IDEATORS" are the people who come up with ideas relating to brands. Consequently, I find that the marks are conceptually highly similar.

Distinctiveness of the earlier mark

82. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive, and conversely a lower likelihood of confusion if the earlier mark's distinctiveness is weak. The opponent has not claimed to have acquired enhanced distinctiveness in its marks, so I shall consider only inherent distinctiveness. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*:

"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

¹⁶ Paragraph 62.

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).”

83. The phrase “BRAND IDEA” is the common element of the earlier and contested marks, albeit it forms part of the word strings in the applied for marks. For the present assessment, it is the distinctiveness of the common element of the marks that is key here. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC, sitting as the Appointed Person, said:

“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.”¹⁷

84. “BRAND IDEA” alludes to some of the services provided under the mark. Where terms are allusive, the distinctiveness of the mark, or the common element of the mark, is relatively weak. In my view, this would apply to services connected with advertising, public relations or brands. It is less allusive to services such as office functions or the design and development of computers and computer programs, and so will be slightly more distinctive. As a phrase made up of dictionary words, the common element has a medium level of distinctiveness for these services.

Conclusions on likelihood of confusion

85. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 37. I must also have regard to the interdependency principle, that a lesser degree of similarity between the services may be offset by a greater degree of similarity between the marks,

¹⁷ Paragraph 39.

and vice versa.¹⁸ The distinctiveness of the earlier mark must also be taken into account.

86. Such a global assessment does not imply an arithmetical exercise, where the factors are given a score and the result of a calculation reveals whether or not there is a likelihood of confusion. I must keep in mind the average consumer of the services and the nature of the purchasing process. I note that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture he has kept in his mind.¹⁹
87. There are two types of confusion: direct and indirect. These were explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

“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 as a whole, I conclude that it is another brand of the owner of the earlier mark.’²⁰

88. In the case of the advertising, public relations and brand-related services, I found the distinctive and dominant element of the earlier mark to have only weak distinctiveness. Such a finding does not preclude a likelihood of confusion: see the judgment of the CJEU in *L’Oréal SA v OHIM*, C-235/05 P, particularly paragraph

¹⁸ *Canon Kabushiki Kaisha*, paragraph 17.

¹⁹ *Lloyd Schuhfabrik Meyer*, paragraph 27.

²⁰ Paragraph 16.

45. However, I must also take into account other relevant factors, such as the nature of the average consumer and the selection process. For these services, the average consumer would be a business paying a higher than average degree of attention, and selection would primarily be made using visual means. The average consumer will therefore see that the earlier mark contains words that are likely to be interpreted as a strapline, and these words do make a contribution to the overall impression of the mark. The average consumer is unlikely to be confused with respect to these services. “BRAND” and “IDEA” are both words that undertakings in these fields might wish to use, and there are, to my mind, enough differences between the visual elements of the marks for me to find no likelihood of direct or indirect confusion, even there the services are identical.

89. I now turn to the services for which the earlier mark has a medium level of distinctiveness. In the case of these services, it is less likely that two independent businesses would choose the combination of “BRAND” and “IDEA”. I found the following services to be identical to some of the opponent’s services: *Business consultancy; Business management; Design services; Design and development of computer software; computer software design; Advisory, consultancy and information services relating to the aforesaid*. Even when the average consumer is paying a higher than average degree of attention, there may still be imperfect recollection of the marks. In my view, the average consumer is likely to confuse the marks when used in connection with these identical services.

90. I found *Technological services and design relating thereto and Computer technology services* to be highly similar to *Design and development of computers and computer programs*. The earlier mark is not particularly allusive and so, taking account of imperfect recollection, I find that the average consumer is likely to confuse the two marks.

91. The remaining services (*Business networking services; Business administration; Office functions, and Website design services*) I found to be similar to a medium degree to the opponent’s services. The higher than average degree of attention paid during the selection process leads me to find no likelihood of direct confusion, given the differences between the services. Neither do I find a likelihood of indirect

confusion in the case of these services. A finding of indirect confusion should not be made merely because the two marks share a common element, as Mr James Mellor QC, sitting as the Appointed Person, noted in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. The average consumer must realise that the marks are different and assume that the services are from the same or economically connected undertakings. As the average consumer will be paying a higher than average degree of attention, they are less likely, in my view, to assume a connection. The earlier mark may be called to mind, but that is mere association, not indirect confusion.

Outcome of Section 5(2)(b) ground

92. The opposition succeeds under section 5(2)(b) with respect to the following services:

Class 35

Business consultancy; Business management

Class 42

Design services; Design and development of computer software; computer software design; technological services and design relating thereto; computer technology services.

93. The section 5(2)(b) ground fails with respect to all the services in Class 36 and the remaining services in Classes 35 and 42.

94. Even had I found that the opponent had demonstrated genuine use of the 967 mark, this would not have altered the outcome of this ground. The only additional service that the opponent would have been able to rely on would have been *Services carried out for and/or on behalf of others in the advertising and business sectors*. This is a broad term, but the meaning of it is encompassed by the services protected by the 624 mark that relate to advertising, business management, business administration and office services. In terms of the mark, the phrase “BRAND IDEA” is more prominent than the remaining words (“whatever makes

the difference”) on account of its size. However, there is also a figurative element, comprising four circles, which makes a contribution to the overall impression of the mark. Considering the mark as a whole, this would not have put the opponent in any better a position than the 624 mark.

Section 5(3) ground

95. Section 5(3) of the Act states that a trade mark which is identical with or similar to an earlier trade mark

“shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

96. The conditions of section 5(3) are cumulative:

- 1) The opponent must show that the earlier mark has a reputation.
- 2) The level of reputation and the similarities between the marks must be such as to cause the public to make a link between the marks.
- 3) One or more of three types of damage (unfair advantage, detriment to distinctive character or repute) will occur.

It is not necessary for the services to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

97. As the earlier mark is an EUTM, the relevant territory for an assessment of reputation is the EU. In its written submissions, the opponent has not made any submissions relating to the section 5(3) grounds, and the evidence they have provided does not show that the mark is known by a significant part of the public concerned by the services covered by the mark. Consequently, I am unable to find that the earlier mark has a reputation and the ground fails.

Conclusion

98. The opposition has been partially successful. The applications by Brand Equity Partners Limited may proceed to registration in respect of the following goods and services:

Class 35

Brand creation; Brand evaluation; Brand positioning; Brand strategy; Brand testing; Brand development; Brand concept and brand development services for corporate and individual clients; Branding services, namely consulting, development, managing and marketing of brands for businesses and/or individuals; Advertising, marketing and promotional services; Advertising services to create corporate and brand identity; Brand imagery consulting services; Marketing and consulting services in the field of promoting and tracking the goods, services and brands of others through all public communication means; Advertising and publicity services, namely promoting the goods, services, brand identity and commercial information and news of third parties through print, audio, video, digital and on-line medium; Advertising services, namely, creating corporate and brand identity for others; Public relations, public relations services; publicity services; business networking services; production of marketing, promotional and advertising material; Business administration; Office functions; advisory, consultancy and information services relating to the above/aforesaid.

Class 36

Financial affairs; monetary affairs; real estate affairs; financial management; financial analysis; financial services; financing services; financial services in relation to brands and brand identity; financial consulting; real estate management; investment services; investment of funds loans [financing]; advisory, consultancy and information services relating to the aforesaid.

Class 42

Brand design services; design of brand names; website design services; advisory, consultancy and information services relating to the aforesaid.

Costs

99. Both parties have had some success in these proceedings, with the greater proportion of success being won by the applicant. In the circumstances, I award the applicant the sum of £930 as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: £180

Preparing evidence: £475

Preparation of written submissions: £275

Total: £930

100. I therefore order BRAND IDEA di Paolo Maccaferri & C. S.n.c. to pay Brand Equity Partners Limited the sum of £930. 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.

20th March 2019

Clare Boucher
For the Registrar,
Comptroller-General