

O-445-19

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3353215
BY MARTIN MATTHEWS, ROB HILLS & JAMES DENNIS
TO REGISTER:**

Fathers Justice

AS A TRADE MARK IN CLASS 36

AND

**OPPOSITION THERETO (UNDER NO. 600001061) BY
FATHERS FOR JUSTICE LIMITED**

Background and pleadings

1. These proceedings relate to an opposition against the registration of the above trade mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on one earlier mark, UK registration no. 3114422. Consequently, the question to be determined is whether there is a likelihood of confusion between:

The application	The earlier mark
Fathers Justice	FATHERS4JUSTICE
Class 36: Fundraising for charitable purposes.	Class 36: Charitable fundraising services; arranging, organising and conducting fundraising and collection; monitoring charitable funds; information, advisory and consultancy services relating to all the aforesaid; information, advisory and consultancy services relating to financial and monetary matters, including matters relating to maintenance and child support. ¹
Filed on 13 November 2018	Filed on 22 June 2015 Registered on 11 December 2015
Applicants: Martin Matthews, Rob Hills & James Dennis	Opponent: Fathers for Justice Limited

2. The opponent used the fast track opposition procedure.

3. The applicants filed a counterstatement denying the ground of opposition in which they stated: ““FATHERS JUSTICE” is not the same as “FATHERS FOR JUSTICE LIMITED”. WE ARE ON A MISSION FROM GOD.”

¹ The opponent’s mark is also registered for services in class 45, however, it does not rely on them for the purposes of this opposition.

4. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013/2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

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

5. The net effect of these provisions is to require parties to seek leave in order to file evidence in fast track proceedings. No leave was sought.

6. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) 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 and neither side filed written submissions.

7. The applicants have represented themselves. The opponent has been represented by Maucher Jenkins.

Decision

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

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.

9. An “earlier trade mark” is defined in section 6 of the Act:

6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

10. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the earlier mark was registered within the five years before the date on which the applicants’ mark was filed (it having no priority date), it is not subject to proof of use (section 6A refers). The opponent is therefore entitled to rely upon its mark for all the services on which it relies (as above).

Section 5(2)(b) case law

11. The following principles are gleaned from the decisions of the courts of the European Union 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. The average consumer 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 services

12. The applicants seek registration in relation to “[f]undraising for charitable purposes”. Although it relies on other services, I note that the opponent’s specification includes “[c]haritable fundraising services”. Although worded slightly differently, they mean the same thing. The services are identical.

Average consumer and the nature of the purchasing act

13. I now move on to determine who the average consumer is for the services, and the nature of the selection process. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods in question².

14. The most obvious average consumer are donors, those who are giving to the charity, or those supporting it by raising funds themselves. They will largely be members of the general public, but could also be businesses who choose a charity to give to. The choice of which charity to give to is not a wholly casual process – even if small amounts are given in, for example, a charity box, the average consumer will still want to know who they are giving to and what cause they represent. Where larger sums of money are involved, or where a regular commitment is being given, greater care will be applied. Overall, at least an average level of care and consideration will be displayed. Marks in this field will be encountered visually, on collection boxes, promotional material and in advertising campaigns. This suggests the visual impression of the marks will take on more importance. However, I do not discount the aural significance of the marks because

² *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, C-342/97, para. 26

discussions will often take place with charity collectors and, also, donations often made over the telephone.

15. The other group of average consumers to keep in mind are, essentially, those that benefit in some way from the charitable fundraising. For example, those looking to approach a fundraising service for help and assistance with a particular issue (relative to the cause of the fundraising) or research groups who may be seeking funding. These types of average consumers are likely to pay more attention than members of the general public who are making contributions, again through largely visual means, but where the aural impact also has some importance.

Comparison of marks

16. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* that:

...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.³

17. It would be wrong, therefore, to artificially 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.

³ C-591/12P, para. 34

18. The respective marks are shown below:

Fathers Justice

v

FATHERS4JUSTICE

19. The overall impression of both marks resides in the totality of the components that make up each mark. None of the elements in either mark stand out and dominate the other element/s of which they comprise. In both cases, the components form a unit which the average consumer will read through as a phrase.

20. Visually, the marks are of similar length (the applied for mark is only slightly shorter than the opponent's mark), both begin with the same 7 letters (Fathers/FATHERS) and end in the same 7 letters (Justice/JUSTICE). The difference in the casings of the marks (one being in upper case, the other being in upper and lower case) does not create a difference because, notionally speaking, either mark could be used in upper case or upper and lower case. Therefore, the only differences are the additional numeral 4 in the earlier mark and the fact that all its components are conjoined. Despite the differences, I consider there to be a reasonably high degree of visual similarity.

21. Aurally, the marks will be articulated as FAR-THERS-JUST-ISS and FAR-THERS-FOR-JUST-ISS. The articulations are the same, save for the additional syllable in the middle of the earlier mark. As above, I consider there to be a reasonably high degree of aural similarity.

22. Conceptually, FATHERS4JUSTICE could suggest the concept of a group of fathers who are in favour of attaining justice. Fathers Justice could suggest a concept of attaining justice for fathers. Whilst it is possible to argue that this creates something of a difference, it is in my view likely that FATHERS4JUSTICE, whilst having a perception of being in favour of justice, will also be perceived in that the

justice they are seeking is for fathers, or is in some way relating to them. I consider there to be at least a medium degree of conceptual similarity either way.

Distinctive character of the earlier trade mark

23. It is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

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).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).⁴

24. I have only the inherent characteristics of the mark to consider, based upon the distinctiveness of the mark FATHERS4JUSTICE. I have mentioned already the

⁴ C-342/97, paras. 22-23

concept the mark is likely to give. I consider that the evocative message it provides means that the earlier mark has only a low degree of inherent distinctiveness.

Conclusions on likelihood of confusion

25. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and now come to a global assessment. As the CJEU stated:

A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.⁵

26. There are two types of confusion that must be considered:

- direct confusion, where one mark is mistaken for another; and
- indirect confusion, where the similarities lead the consumer to believe that the goods or services come from the same, or a related, undertaking.

⁵ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97, para. 17

27. The services are identical. The marks have a reasonably high level of visual and aural similarity, and at least a medium degree of conceptual similarity. The earlier mark is, though, inherently distinctive to only a low degree.

28. In relation to confusion, I begin with the general public, who I have suggested will pay at least an average level of care and consideration. Taking into account the concept of imperfect recollection (the consumer rarely has the opportunity to compare marks side by side) I come to the view that there is a likelihood of direct confusion. An average consumer who has previously given to one fundraising service, may, upon encountering the other, miss-recall the mark and assume that the one now being encountered is the same. Put simply, this is caused by the marks being too close to one another. I accept that one must guard against giving too much protection to weak marks, however, having a weak or low level of distinctive character in the earlier trade mark does not preclude a likelihood of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the Court of Justice of the European Union found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.

29. For the reasons given above, there is a likelihood of confusion. In view of this, I do not consider it necessary to consider the other average consumer group in any

real detail (because confusion amongst one group is sufficient to uphold the opposition), however, I consider that there would also be confusion here even though the level of care and attention may be higher. I should also add that even if, from a semantic point of view, there is a conceptual difference between the marks then, whilst a conceptual difference can counteract visual and aural similarities⁶, this is not always the case⁷. Any conceptual differences would not have outweighed the close visual and aural similarities between the marks when imperfect recollection is borne in mind.

30. The opposition under section 5(2)(b) succeeds. Subject to appeal, the application is refused registration.

Costs

31. The opponent has been successful and is entitled to a contribution towards its costs. My assessment is as follows:

Fee for filing notice of opposition - £100

Filing a statement of case and considering the counterstatement - £200

Total - £300

32. I therefore order Martin Matthews, Rob Hills & James Dennis (being jointly and severally liable) to pay Fathers For Justice Limited, the sum of £300. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated 31 July 2019

Oliver Morris

For the Registrar,

The Comptroller-General

⁶ See, for example, Case C-361/04 P, *Ruiz-Picasso and Others v OHIM* [2006] ECR I-643

⁷ See, for example, *Nokia Oyj v OHIM*, Case T-460/07