

O-683-19

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 3289026
BY ONE PRO GROUP LIMITED
TO REGISTER**



**AS A TRADE MARK
AND
OPPOSITION NO. 412659 THERETO
BY
ONE HOLDING AG**

BACKGROUND

1) On 09 February 2018, One Pro Group Limited ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of goods in services in numerous classes including 'insurance services' in class 36.

2) The application was published in the Trade Marks Journal on 02 March 2018 and notice of opposition was later filed by One Holding AG ('the opponent'). The opponent claims that the trade mark application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It directs its opposition against class 36 of the application only. Relevant details of the mark relied upon are:

Registration No. EU016562654

Filing Date: 06 April 2017

Date of entry in the register: 29 July 2017

Class 36: Real estate services; Insurance underwriting; Valuation services; Finance services; Banking; Monetary affairs.¹

3) The opponent's registration is an earlier mark, in accordance with section 6 of the Act. As it did not complete its registration procedure more than five years prior to the publication date of the contested mark, it is not subject to the proof of use conditions, as per section 6A of the Act. The opponent claims that the respective services are identical and the parties' marks similar such that there exists a likelihood of confusion.

4) The applicant filed a counterstatement denying a likelihood of confusion. I note, particularly, the following points made therein:

¹ The registration also covers services in 35 and 42 but I have not set those out here as the services in class 36 clearly offer the opponent its best prospect of success.

- It is admitted that there is identity between the respective services.
- The similarity between the respective marks is 'extremely slight'.
- The services at issue are purchased with a high degree of attention.
- The word 'One' is extremely commonplace and, of itself, non-distinctive.

5) The opponent is represented by HGF Limited; the applicant by White & Case LLP. Only the opponent filed evidence. That evidence comes from Ms Clare Lang, a Trade Mark Attorney at HGF Limited. It suffices to record here that Ms Lang's evidence seeks to establish that the word 'PRO' is a known abbreviation of the word 'professional'. The applicant filed submissions. Neither party has requested to be heard before the decision is made nor filed written submissions in lieu. I now make this decision after considering the papers before me.

DECISION

6) Section 5(2)(b) of the Act states:

“5. - (2) A trade mark shall not be registered if because –

(a)....

(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.”

7) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-

120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Approach

8) As noted above, the applicant has conceded that there is identity between the respective services. This is a sensible concession given that the opponent's specification includes, amongst others, the broad term 'finance services' (which includes insurance services²). If the opponent does not succeed in respect of those identical services, it cannot be in any stronger position in respect of any of its other services. I will proceed accordingly.

Average consumer and the purchasing process

9) It is necessary to determine who the average consumer is for the respective services and the manner in which they are likely to be selected. 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:

² As per *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05).

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

10) The average consumer for insurance services is the general public and professional consumers. The marks are likely to be encountered primarily by visual means on websites, brochures and other promotional materials and on business signage. That is not to say though that the aural aspect should be ignored since the services may sometimes be the subject of word of mouth recommendations and discussions with sale representatives, for example. By and large, insurance services are not inexpensive and are unlikely to be purchased on a frequent basis. Factors such as the level of cover (comprehensive, for example), monthly premiums, ease of making a claim and policy conditions may all be borne in mind when selecting a provider. I would therefore expect both types of consumer to pay an above average degree of attention during the purchase.

Comparison of marks


11) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of

that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would therefore be wrong 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.

12) The marks to be compared are:

Opponent's mark	Applicant's mark
	

13) The opponent's mark consists of an abstract device element preceding the word 'ONE'. The latter is presented in a stylised font where part of each letter is missing. Whilst I would expect the stylisation of the word to have some impact on the consumer's perception, in a more than negligible way, it is the word itself, which makes a more substantial contribution to the overall impression of the mark. The abstract device is far from negligible but makes a lesser contribution to the mark's overall impression than the word 'ONE'. This is due to the latter occupying a greater proportion of the mark and that it is also the element by which the mark will be referred to.

14) The applicant's mark consists of a stylised letter 'p' above the words 'ONE PRO' with the latter being presented in a stylised, but not particularly unusual, font. The opponent argues that the word 'ONE' is more dominant than 'PRO' because the latter will merely be perceived as the descriptive word 'professional'. I accept that the consumer is likely to perceive 'PRO' as an abbreviation of 'professional'. However, both words are short in length (consisting of only three letters) and presented in the same font, inviting the eye to read through them both instantly as a unit. In my view,

neither word dominates the other. I find that the words 'ONE PRO' (in combination) contribute significantly to the overall impression of the mark. The stylised 'p' occupies a substantial proportion of the mark and is striking upon the eye. I find that it also contributes significantly to the overall impression of the mark, to a roughly equal extent, to the 'ONE PRO' element.

15) The opponent contends that there is a high degree of visual and aural similarity between the marks. I disagree. Visually, the single point of coincidence between the marks lies in the common presence of the word 'ONE'. However, the stylisation of those words differs. In all other respects, the marks are also visually different due to the presence/absence of the respective abstract device element and the stylised letter 'p' and word 'PRO'. I find there to be a low degree of visual similarity. In terms of the aural aspect, the device in the opponent's mark will not be verbalised and I consider it unlikely that the letter 'p' in the applicant's mark will be spoken. Accordingly, the comparison is ONE v ONE PRO. I find there to be a medium degree of aural similarity.

16) Conceptually, the word 'ONE' will be perceived as meaning the number 1 or a single person/thing. The opponent's mark portrays only that concept (the device, being abstract, is unlikely to form any immediately graspable concept in the consumer's mind). The applicant's mark portrays the concept of the letter 'p' together with the concept of 'one professional'. I find there to be a medium degree of conceptual similarity between the marks overall.

Distinctive character of the earlier mark

17) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the

goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

18) As there is no evidence of use before me, I have only the inherent distinctiveness of the opponent’s mark to consider. I also remind myself that it is the distinctiveness of the common element which is key³. The common element between the marks at issue is the word ‘ONE’, of itself, and absent any stylisation, because that particular stylisation is not present in the contested mark. The applicant submits that that word, of itself, is extremely common in trade and is wholly devoid of distinctive character. I do not consider ‘ONE’ to be a word which is descriptive or otherwise non-distinctive in relation to the opponent’s services and there is no evidence before me to the contrary. I do, however, accept that it is an ordinary, and very commonplace, everyday word and one which may be perceived as alluding to the provider being *the* one or number one in its area of trade (i.e. the best). I consider it to have a below average degree of inherent distinctiveness.

³ In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

Likelihood of confusion

19) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

20) I have found that:

- The respective services are identical.
- The average consumer, being the general public and professional consumers is likely to pay an above average degree of attention during the purchase and encounter the marks primarily by visual means, although aural considerations are borne in mind.
- There is a low degree of visual similarity between the marks and a medium degree of both aural and conceptual similarity.
- The common element, being the word 'ONE', has a below average degree of inherent distinctiveness.

Weighing all these factors, I find that one mark is unlikely to be mistaken for the other, bearing in mind, in particular, that an above average degree of attention is likely to be paid and that the marks are likely to be encountered mainly by visual means and the visual similarity is only of a low degree. I reach this conclusion despite the identical services in play and the medium degree of aural and conceptual similarity between the marks. There is no likelihood of direct confusion.

21) Turning to whether there is nevertheless a likelihood of the consumer believing that the respective services emanate from the same (or linked) undertaking(s) (also known as 'indirect confusion'), I note that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 ('*L.A. Sugar*'), Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized 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."

22) Further, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

23) I remind myself that it is still a whole mark comparison that must be made when assessing indirect confusion and that there is only a low degree of visual similarity and a medium degree of aural and conceptual similarity between the marks overall. I also keep in mind that the common element, being the word 'ONE' (of itself), has a below average degree of inherent distinctiveness. Whilst I bear in mind the identical services in play, I find that an average consumer, paying an above average degree of attention, is unlikely to believe that the common inclusion of the word 'ONE' in the respective marks is down to the applicant's mark being another brand or sub-brand

of the opponent. To my mind, the common use of that word is likely to be put down to mere coincidence and nothing more. There is no likelihood of indirect confusion.

OUTCOME

24) The opposition fails.

COSTS

25) As the applicant has been successful, it is entitled to a contribution towards its costs. Using the guidance in Annex A of Tribunal Practice Notice 2/2016, I award the applicant costs on the following basis:

Reviewing the notice of opposition and preparing the counterstatement	£300
Written submissions	£300
Total:	£600

26) I order One Holding AG to pay One Pro Group Limited the sum of **£600**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of November 2019

**Beverley Hedley
For the Registrar,
the Comptroller-General**