

O-015-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 2518561  
IN THE NAME OF QUINTESSENTIAL BRANDS LTD  
IN RESPECT OF THE TRADE MARK**



**AND**

**OPPOSITION THERETO (NO 99614) BY  
QUINTESSENTIALLY (UK) LTD**

## TRADE MARKS ACT 1994

**In the matter of trade mark application 2518561  
in the name of Quintessential Brands Ltd  
in respect of the following trade mark in classes 35, 37 & 39**



**and**

**opposition thereto (no 99614) by Quintessentially (UK) Ltd**

### **The background and the pleadings**

1) The above trade mark was filed by Quintessential Brands Ltd ("QB") on 13 June 2009. It was published in the Trade Marks Journal on 17 July 2009. QB wishes to register the trade mark in respect of the following services:

**Class 35:** Retail services connected with the sale of audio, audio-visual, sound or video apparatus and instruments, audio, audio-visual, sound or video playing, recording, transmission or reproduction apparatus and instruments, video recordings, sound recordings, televisions, radios, cabinets and stands for audio, audio-visual, sound or video apparatus and instruments, cables, leads and other ancillary accessories for audio, audio-visual, sound or video apparatus and instruments, parts and fittings, including products associated with the cleaning and maintenance for all the aforesaid goods.

**Class 37:** Undertake and provide repair of, and installation services to audio, audio-visual, sound or video apparatus and instruments, audio, audio-visual, sound or video playing, recording, transmission or reproduction apparatus and instruments, video recordings, sound recordings, televisions, radios, cabinets and stands for audio, audio-visual, sound or video apparatus and instruments, cables, leads.

**Class 39:** Transport, packaging and storage of audio, audio-visual, sound or video apparatus and instruments, audio, audio-visual, sound or video playing, recording, transmission or reproduction apparatus and instruments, video recordings, sound recordings, televisions, radios, cabinets and stands for audio, audio-visual, sound or video apparatus and instruments, cables, leads.

2) Quintessentially (UK) Ltd (“UK”) opposes the registration of the above trade mark. It filed its opposition on 9 October 2009. It opposes the trade mark in respect of all of the services sought to be registered. UK bases its opposition under sections 5(2)(b) & 5(3) of the Trade Marks Act 1994 (“the Act”). Under these grounds UK rely on two trade marks of which it is the proprietor, namely UK registration 2394841 and Community Trade Mark (“CTM”) registration 6167456. Both these registrations are for the word QUINTESSENTIALLY. Both registrations were filed before QB’s application (on 22 June 2005 & 3 August 2007 respectively) so making them earlier trade marks as defined by section 6 of the Act. A full list of the goods and services covered by the earlier marks can be seen in the annex to this decision. It is sufficient to record at this stage that the registrations cover a range of services in various classes including classes 35 & 39 which are the classes that UK considers to represent the greatest degree of overlap.

3) QB filed a counterstatement denying the grounds of opposition. QB required proof of use of UK’s registrations but as neither of the earlier marks had been registered for five years or more at the date of publication of the application there is no proof of use requirement. UK’s marks may, therefore, be considered for their specifications as registered. In terms of the defence itself, a number of points are raised by QB, the primary ones focus on:

- ❖ The differences between the marks themselves (including differences between the applied for mark and the mark UK actually uses in business).
- ❖ The differences between the types of businesses operated by QB and UK.
- ❖ The nature of the word “Quintessential” and that no one party should be able to monopolise such a term.

4) Both sides filed evidence which I will summarise shortly. The matter then came to be heard before me on 13 December 2010 where UK were represented by Steven Jennings of Lewis Silkin LLP and QB were represented by its managing director, Mr John Jolley.

### **The evidence**

*UK’s evidence – witness statement of Steven Jennings dated 15 April 2010*

5) Mr Jennings is a trade mark attorney employed by Lewis Silkin LLP, the firm with conduct of these proceedings on behalf of UK. Mr Jennings explains that UK’s business began in 2001, the business model being to provide the world’s best “concierge” services for its clients and members. He says that the concierge service has since then expanded to create a network of businesses operating under the QUINTESSENTIALLY brand and that it now supplies goods and services well beyond the original membership and concierge business.

Reference is made to the website [www.quintessentially.com](http://www.quintessentially.com) where these wider forms of business can be found, but, each business is backed by a separate company and separate website address. Turnover figures are given as follows:

2005	£2,893,000
2006	£4,400,000
2007	£6,830,000
2008	£11,834,702
2009	£14,391,171

6) Details of the various QUINTESSENTIALLY businesses are then provided which include: Quintessentially Travel (offering tailor-made luxury experiences), Quintessentially One (a private members club onboard a 220m yacht), Quintessentially Gifts (providing luxury gifts with a bespoke service and a VIP personal shopping service), Quintessentially Gourmand (sources, selects and supplies the world's finest food), Quintessentially Estates (said to be a leading global property company with top end properties and developments across the world), Quintessentially Bespoke (a division of the gifts business but offering limited edition, bespoke and "made to order" products), Quintessentially Wine (dedicated to finding the most interesting, exquisite and sought after wines), Quintessentially Escape (creating new and innovative experiences, aiming to bring "once in a lifetime" dreams alluringly within reach), Quintessentially Driven (a luxury chauffeur or self-drive car service), Quintessentially Flowers (providing world renowned floral designs), Quintessentially Music (a bespoke music concierge service for the procurement of artists for private and corporate events, backstage access to desirable concerts and the chance to record your own album at the studios of EMI), Quintessentially Soho (a charitable pop-up members' lounge), Quintessentially TV (allowing individuals to create their own films/TV programmes and also to produce programmes for third parties), Quintessentially Publishing (who publish three titles and assist others in publishing complementary titles and for hotels looking to renew their literature), Quintessentially Design (a boutique design studio). Other activities include: events, Qube (online networking), a charitable foundation, wedding services, security provision, art, communications, property development, insurance, aviation, dating and villas.

7) Mr Jennings highlights that the name given by QB on its trade mark application form (Quintessential Brands Ltd) is not listed at Companies House but, another name, Quintessential Brands Online Limited, is. He considers that this should result in the application for the mark being treated as null and void.

8) Mr Jennings highlights that UK's business is offered not only to its members but also to non-members. He highlights that QB targets the same type of consumer as UK, with the following coming from QB's website:

“We seek to bring a new and higher level of professionalism and dynamism to specialist retailing. We offer new and pre-owned products from only the best manufacturers and, as a result, appeal to discerning customers”.

9) Further extracts are provided which Mr Jennings considers to show that QB offer bespoke services (the references include “ we help you to find solutions that meet your requirements...”) and that they offer high-end equipment. An extract from eBay is provided in Exhibit SJ2 showing that of 7 products listed by QB the cheapest was £899 and the most expensive £12,250.

10) The rest of the evidence is more submission than fact which I will bear in mind but not summarise here.

*QB's evidence – witness statement of John Robert Jolley dated 14 July 2010*

11) As noted earlier, Mr Jolley is QB's managing director. He is also a shareholder in the company. As with Mr Jennings's evidence, Mr Jolley provides a mixture of submission and fact. I will summarise the latter but not the former (the submissions will, of course, be borne in mind).

12) Mr Jolley says that the company called Quintessential Brands Online Limited was incorporated on 10 October 2005 and commenced trading in early 2006. It predominantly retails audio equipment. Mr Jolley says that it is a modest business but one building a very positive reputation amongst its target market. He says that the business is known as QUINTESSENTIAL BRANDS and that “online” and “limited” is sometimes left out. He says that Quintessential Brands Limited and Quintessential Brands Online Limited are one and the same company.

13) Mr Jolley says that none of his customers have heard of UK let alone being confused between the marks. He says that UK's business is entirely different and QB does not provide a concierge service or cater for lifestyle activities. He believes that UK, with the breadth of its claims (the various Quintessentially businesses), is trying to monopolise the word quintessential. He feels this to be unreasonable and anti-competitive.

14) In terms of the eBay prints, he highlights that they are second hand products and that whilst they may be expensive, they were even more expensive to begin with. This, he believes, demonstrates that whilst QB's clients like high quality audio, they are also price sensitive. He assumes, given the nature of UK's business, that its clients are not price sensitive.

15) Mr Jolley says that in relation to QB's business, its customers are normally looking for a particular product and that price sensitivity is the main issue rather

than who they are dealing with. He says that if a good deal is secured then this leads to subsequent loyalty.

16) Other evidence comes in the form of videos taken from UK's website where a representative of UK explains its business ethos and origins, but focusing on the luxury concierge type services. This was introduced late in the day but Mr Jennings, on behalf of UK, had no objection to its inclusion and did not seek leave to file reply evidence – he did, though, stress that the videos should not be taken out of context because they did not represent all of UK's activities.

*UK's reply evidence – witness statement of Steven Jennings dated 5 August 2010*

17) Mr Jennings notes Mr Jolley's explanation regarding the name of the applicant but repeats his view that the application was made in the name of a non-legal person which invalidates the application itself.

18) He makes further comments in relation to the breadth of UK's business and highlights that Quintessentially Gifts sell high-end hi-fi equipment. A print from quintessentiallygifts.com is provided showing a gramophone speaker (costing £54,000) and Katherine Pooley Crystal Speakers (costing £3,995). The dates of these prints are from after the material date (the material date in these proceedings being the date when QB applied for its mark) and there is nothing to suggest that they were available before then.

### **Was the application a nullity from the outset?**

19) The registrar has previously considered the capacity for an application to be considered as a nullity on the basis of it being made in the name of a non-existent body. This can be seen in *Blarney Trade Mark* (BL O/175/02) where the name of an applicant was given, but that name did not exist because the application pre-dated the actual incorporation of the company bearing that name. The Hearing Officer in that case came to the view that such circumstances meant that the application was made in bad faith and, furthermore, even though he did not come to a settled view, he was clearly of the mind that "the true position may be that the application was deficient from the start and for practical purposes a nullity". This all stems from the fact that one of the pre-requisites of a validly filed application (as stipulated by section 32 of the Act) is the provision of the name and address of the applicant and, furthermore, that a trade mark is an item of personal property (as per section 26 of the Act) and, as such, can only be held by a real or legal person.

20) The circumstances here, though, are quite different from *Blarney Trade Mark*. QB states in its evidence that Quintessential Brands Limited and Quintessential Brands Online Limited are one and the same. It is explained that in commerce the words Online and/or Limited are sometimes left out. Whilst it

may have been somewhat naïve for the applicant to have used an abbreviated form of the company name on the Form TM3 rather than its full legal title, doing so strikes me as nothing more than a simple mistake. I do not consider it appropriate to deem the application a nullity on the basis of what constitutes a simple error when it is clear from the evidence that the two companies are one and the same. There is nothing implausible in what Mr Jolley explains in his evidence, evidence which QB have not challenged and, in any event, Mr Jennings conceded that he had made no request to amend the pleadings to reflect this aspect of the case and, so, he was not vigorously pursuing the issue.

21) After discussing this issue at the hearing, but not having decided the matter at this point, I instructed QB to file a Form TM21 to correct its recorded name from that filed to its correct legal title. QB duly did so. After this decision is issued the request for correction will be forwarded to the relevant team in the Intellectual Property Office so that it can be recorded in the register, with such an action being incapable of appeal by UK as this is a matter between QB and the registrar (see *Michaels Drinks Stop* BL O/168/05).

### **Section 5(2)(b) of the Act**

22) This section reads:

“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.”

23) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

24) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective services are similar, other factors are relevant including:

The nature of the average consumer of the goods/services in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods/services, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

#### The notional assessment

25) At the hearing both parties sought to argue their cases on the basis of business models and target consumers. QB argued that the type of service offered by UK is more a concierge service or personal shopping service offered to the rich and wealthy, who may be short on time but not on money whereas QB offer a specialist hi-fi retailing service to audiophiles who may not be particularly wealthy (and will be price sensitive) but who will have a keen interest in the subject matter. UK argued that the consumers would be similar because the goods sold by QB are expensive, as are its products, and highlighted that UK offers more traditional retailing to any member of the public and not just its members. Whilst I note all this, it is clear that the way in which either party markets its services has little part to play. Marketing strategies are by their very nature temporal. This applies despite Mr Jolley's comments (made in relation to the videos) that UK would be unable to re-position itself given the way it has marketed so far. In *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-47/03*, the General Court ("GC") explained the position thus:

"104 Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the



prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.

.....

107 It follows that by taking into consideration in the assessment of the likelihood of confusion between the marks the particular circumstances in which the goods covered by the earlier mark are marketed, the temporal effect of which is bound to be limited and necessarily dependent solely on the business strategy of the proprietor of the mark, the Board of Appeal erred in law.”

26) The parties should, therefore, bear in mind these observations when they consider the findings I come to make.

#### Comparison of services

27) In terms of the competing services, I will consider them class by class as per QB's application. When comparing the respective specifications I note the judgment in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* where the ECJ stated:

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

28) Guidance on this issue can also be seen in the comments of Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 (“*British Sugar*”) where the following factors were highlighted as being relevant in the assessment of similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (a) 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.”

29) In terms of understanding what a “complementary” relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 where it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

30) In construing a word used in a trade mark specification, one is concerned with how the service is, as a practical matter, regarded for the purposes of the trade<sup>1</sup>. I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>2</sup>. In relation to services, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

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

31) Finally, when comparing the respective specifications, if a term falls within the ambit of a term in the competing specification then identical services must be

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<sup>1</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>2</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 (“*Beautimatic*”).

held to in play<sup>3</sup> even if there may be other services within the broader term which are not identical.

32) QB's specification in class 35 reads:

“Retail services connected with the sale of audio, audio-visual, sound or video apparatus and instruments, audio, audio-visual, sound or video playing, recording, transmission or reproduction apparatus and instruments, video recordings, sound recordings, televisions, radios, cabinets and stands for audio, audio-visual, sound or video apparatus and instruments, cables, leads and other ancillary accessories for audio, audio-visual, sound or video apparatus and instruments, parts and fittings, including products associated with the cleaning and maintenance for all the aforesaid goods.”

33) UK's specification (in respect of earlier mark 2394841) in class 35 includes:

“.....;shopping retail services and electronic shopping retail services all connected with ..... CDs, DVDs ....., domestic electrical and electronic equipment including white goods, machines for handheld use, hand tools, optical goods, cameras and photographic goods, .....”

34) QB's specification clearly relates to the retailing of audio-visual apparatus and associated equipment such as cabinets, stands, cables, leads etc and to the retailing of sound and video recordings. UK's specification includes the retailing of various goods including domestic electronic equipment and CD's and DVD's. Whilst the electronic equipment it goes on to identify are not necessarily audio-video equipment, such a list is not exhaustive given the use of the word “including” – in other words it includes the sale of such goods but does not limit its retailing to only those goods. Audio-visual equipment is a typical type of domestic electronic equipment and the retailing of such goods therefore falls within the ambit of UK's specification as registered. To that extent, I find that the retail sale of audio-visual equipment (QB's service) is identical to services (retailing of domestic electrical and electronic equipment) within UK's specification. The retailing of sound and video recordings (QB's term) must also be considered identical to the retailing of CDs and DVDs (UK's term). In terms of the other items being retailed by QB (cabinets, stands, cables, leads etc), whilst such goods may not be electronic themselves, their clear relationship with certain electronic goods means that the retailing of these items must be a similar service, similar to a reasonably high degree.

**“Retail services connected with the sale of audio, audio-visual, sound or video apparatus and instruments, audio, audio-visual, sound or video**

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<sup>3</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) Case T-133/05 (“Gérard Meric”)*.

**playing, recording, transmission or reproduction apparatus and instruments, video recordings, sound recordings, televisions, radios” is therefore identical to services within UK’s class 35 specification.**

**“Retail services connected with the sale of cabinets and stands for audio, audio-visual, sound or video apparatus and instruments, cables, leads and other ancillary accessories for audio, audio-visual, sound or video apparatus and instruments, parts and fittings, including products associated with the cleaning and maintenance for all the aforesaid goods” is similar to a reasonably high degree to services within class 35 of UK’s specification.**

35) QB’s class 37 specification (again, in respect of earlier mark 2394841) reads:

“Undertake and provide repair of, and installation services to audio, audio-visual, sound or video apparatus and instruments, audio, audio-visual, sound or video playing, recording, transmission or reproduction apparatus and instruments, video recordings, sound recordings, televisions, radios, cabinets and stands for audio, audio-visual, sound or video apparatus and instruments, cables, leads.”

36) UK has no class 37 specification but relies instead on the ancillary relationship between retailing/delivery with installation/repair. I can clearly see the link. The retailer sells the product, delivers it if so required, and will install it if requested to do so. The repair of the products sold and delivered may also be facilitated if things go wrong. For some customers who require such ancillary services there will be a clear complementary significance, a relationship whereby customers would think that the ancillary services are the responsibility of the same undertaking. **I find QB’s services in class 37 to be similar, to a reasonable degree, to UK’s services in classes 35 & 39.**

37) QB’s specification in class 39 reads:

“Transport, packaging and storage of audio, audio-visual, sound or video apparatus and instruments, audio, audio-visual, sound or video playing, recording, transmission or reproduction apparatus and instruments, video recordings, sound recordings, televisions, radios, cabinets and stands for audio, audio-visual, sound or video apparatus and instruments, cables, leads.”

38) UK’s class 39 specification (again, in respect of earlier mark 2394841) includes:

“Transport and storage; transport of persons and goods, in particular by road, rail, water and air;.....; packaging and storage of goods; parcel delivery;.....”

39) All of the terms in QB’s specification have identical counterparts in UK’s specification. The fact that UK’s specification does not limit its services to relate to a particular product type does not alter this proposition. **QB’s specification is within the ambit of UK’s specification and is therefore identical.**

#### The average consumer

40) As matters must be judged through the eyes of the average consumer, I must assess who this is. I have already touched upon the notional assessment that needs to be borne in mind and, therefore, the claimed difference in average consumer (the audiophile v the luxury goods person) is somewhat artificial. This becomes even more apparent when one bears in mind that the services have been found, to a large extent, to be identical and the average consumer of such services must, therefore, also be the same.


41) The services (at least where I have found identity/similarity) are ones utilised by the public at large. The average consumer is, therefore, such a person. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). However, this general presumption can change (or at least the degree of attention that the average consumer displays during the purchasing act) depending on the particular goods/services in question (see, for example, the decision of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). Where I have found identity and similarity, this stems from the retailing (and ancillary services) of audio-video equipment, related accessories and sound and video recordings. Such goods (with perhaps the exception of audio and video recordings) are not purchased frequently and although their cost can vary significantly, they are not low cost casually purchased items. Issues of sound quality, aesthetics, reliability and price may be important. It is reasonable to assume that the selection of a retailer to supply such goods (and its ancillary services) will be undertaken with some care. As Mr Jolley stated in his evidence, price considerations of the retailer may be important, but for the purchase of such equipment the reliability and expertise offered will also be important. There is, therefore, at the very least, a reasonable degree of care and attention, but I would say a degree of care and attention slightly higher than the norm when the retailing of these products is concerned. In respect of the retailing of audio and video recordings, the degree of care and attention will be no higher than reasonable.

42) In terms of how service providers are selected, this could range from simply looking on the high street, conducting Internet searches, or looking at subject specific magazines likely to contain advertisements for particular undertakings.

All of this suggests that the act is very much a visual one. However, whilst visual impressions may be slightly more important overall, aural impressions must not be ignored completely

Comparison of the marks

43) In terms of the marks themselves, they are, for ease of reference, replicated below. The marks are, of course, the marks as they appear on the register. The way in which UK may have actually used its mark in business is not relevant.

QB's mark	UK's mark
	<p data-bbox="817 730 1331 779">QUINTESSENTIALLY</p>

44) 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. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

45) In terms of distinctive and dominant components, UK's mark does not separate into distinctive and dominant components. It will be seen as the single word QUINTESSENTIALLY which is, therefore, its only constituent part. QB's mark is made up of the words QUINTESSENTIAL BRANDS and a device element made up of five overlapping, differently coloured circles. The QUINT element of QUINTESSENTIAL is coloured blue whereas the ESSENTIAL element is red as is the word BRANDS. Whilst this difference in colour is noted it does not, in my view, affect the capacity of the word to be read through as QUINTESSENTIAL. The word BRANDS is wholly non-distinctive in relation to retailing, the word would be taken merely as a reference to the brands that the retailer will be offering. The written elements have greater prominence and impact than the device element. For all these reasons, I consider that the word QUINTESSENTIAL to be the dominant and distinctive (it is distinctive because it is a somewhat unusual word to use in relation to these services) element of the mark. The device element clearly plays a role, it is distinctive and has only slightly less impact than QUINTESSENTIAL.

46) In terms of the comparison, given that there is very little difference between the words QUINTESSENTIAL and QUINTESSENTIALLY, and given the prominence of QUINTESSENTIAL in QB's mark, there is in my view a good deal

of visual similarity. The device element has not been ignored, neither has the additional LY nor the word BRAND, but the similarities outweigh, to a large extent, the differences. In terms of the aural comparison, there is even less difference on account that the device element will not form part of any pronunciation. From an aural perspective there is a high degree of similarity.

47) In terms of concept, whilst I note that I must not accept too readily the degree of knowledge that the average consumer may possess<sup>4</sup> and that for a conceptual meaning to be relevant it must be one capable of immediate grasp<sup>5</sup>, I believe that the average consumer will understand that the word QUINTESSENTIAL and the word QUINTESSENTIALLY are similar English dictionary words. Both come from the same root as the word “quintessence” which the Collins English Dictionary defines as: “the most typical representation of a quality, state etc”. Whilst the average consumer may not be able to define the word in as clear a level of detail as this, they are likely to have a vague understanding of what the words mean. However, quintessential is an adjective and quintessentially an adverb. Whilst Mr Jolley is correct in his submission that this creates a difference in terms of overall concept, such subtle difference does little to alleviate the similar concept. I consider there to be a high degree of conceptual similarity between the marks.

#### Distinctiveness of the earlier mark

48) The degree of distinctiveness of the earlier mark is another important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent starting point I consider the mark QUINTESSENTIALLY to be reasonably distinctive. It is a little unusual in construction given that the quality giving rise to the typical representation is not defined. It is not though high in distinctiveness such as an invented or completely fanciful word. Evidence has been filed which could, potentially, have enhanced the distinctive character of the mark. However, whilst there is evidence that UK’s services are offered to members of the general public, there is no explanation as to the proportion of its business that has been provided to the general public as opposed to its wealthy concierge clients. Neither is there any evidence which breaks down the turnover to the particular services claimed. Without such information it is not possible to find that the mark has an enhanced distinctive character with the average consumer in the UK.

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<sup>4</sup> In the *Chorkee case* (BL O-048-08), Anna Carboni, sitting as the Appointed Person, cautioned against accepting too readily the degree of knowledge that the average consumer may possess.

<sup>5</sup> This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

## Conclusions

49) It is clear that the factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

50) I have found the services to be identical or similar to a reasonable degree. I have found there to be a good deal of visual similarity and a high degree of aural and conceptual similarity. I have found the earlier mark to be reasonably distinctive from an inherent point of view. I must bear in mind the concept of imperfect recollection because consumers rarely see marks side by side. Whilst I also bear in mind the slightly higher than average degree of care and attention likely to be used by the average consumer, this does not completely mitigate against the relevance of imperfect recollection. Given that the most memorable aspect of QB's mark is the word QUINTESSENTIAL and that a very similar word forms the entirety of UK's mark, I believe that there is a likelihood of confusion. I should stress that I have not ignored the need to consider the marks in their totalities. The case-law relating to comparisons involving composite or complex marks clearly calls for such an approach (see, for example, *Medion v Thomson Multimedia* [2006] ETMR 13 and Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657) as does the case-law in general (*Sabel BV v. Puma AG*). However, considering the marks as totalities, but bearing in mind their dominant and distinctive elements as assessed, together with all the other relevant factors, confusion is still likely. Even if the average consumer notices and recalls the difference between the marks, it is my view that the similarities that I have assessed will be put down by the average consumer to there being an economic connection between the undertakings responsible for the services provided under the marks, i.e. that the marks and the service being provided come from the same or a linked company<sup>6</sup>. The opposition succeeds.

51) That deals with the opposition, but in case I am found to have given the average consumer too much credit and that such a person would not know of the words quintessential/quintessentially, this would mean that the words would be regarded as invented which, all other things considered, would increase the likelihood of confusion.

52) I should deal with one final point raised by Mr Jolley, that is what he described as UK's attempt to monopolise the word QUINTESSENTIAL. UK has an exclusive monopoly (to prevent use as opposed to make use) in relation to the word QUINTESSENTIALLY for the services it provides. However, the task of the

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<sup>6</sup> This is a relevant form of confusion – see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*.



tribunal in these opposition proceedings is to decide whether, as a result of both marks being used in the course of trade for their respective services, there would be a likelihood of confusion. This does not mean that UK has an exclusive right to succeed in an opposition against each and every mark that may contain the word QUINTESSENTIAL or a derivative of it. Each conflict must be assessed on its merits with a view to deciding the question of confusion. In this case I have decided that confusion is likely.

### **Section 5(3)**

53) In view of my finding under section 5(2) it is not necessary to consider the matter under section 5(3) in any great detail. However, in case of appeal, I will briefly say that UK would not have succeeded under this ground. This is because, in line with my finding in paragraph 48, UK has not shown that its mark(s) possess the required reputation in the UK<sup>7</sup>. A reputation is a pre-requisite for a finding under section 5(3) of the Act, without it UK would not have been able to succeed.

### **Costs**

54) UK has been successful and is entitled to a contribution towards its costs<sup>8</sup>. I hereby order Quintessential Brands Online Limited to pay Quintessentially (UK) Limited the sum of £1600. This sum is calculated as follows:

Preparing a statement and considering the other side's statement - £500

Expenses (opposition fee) - £200

Filing evidence and considering QB's evidence - £500

Attending the hearing - £400

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<sup>7</sup> In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 *Chevy*, the ECJ explained what needed to be considered when assessing the scope of any reputation thus:

"The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark."

<sup>8</sup> Costs are normally awarded on the basis of the registrar's published scale in Tribunal Practice Notice 4/2007.

55) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 24 day of January 2011**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**

## **ANNEX – UK’S FULL SPECIFICATIONS**

### **UK REGISTRATION 2394841**

**Class 16:** Writing implements; bookbinding materials; photographs; stationery; books, printed matter, leaflets, magazines, printed publications, printed plastic cards, cheques, cheque books, stationery; telephone, facsimile, e-mail and website directories, and material for packaging; travel guides and gazetteers.

**Class 18:** Goods made of leather or of imitations of leather not included in other classes; boxes of leather or of leatherboard, envelopes of leather for packaging; trunks, valises, travelling bags, travelling sets, garment bags for travel, vanity-cases, rucksacks, handbags, beach bags, shopping bags, shoulder bags, attaché-cases, briefcases, pouches, fine leather goods in particular pocket wallets, purses, key-holders, card holders; umbrellas, parasols, canes, walking-stick seats.

**Class 35:** Conception, creation, design, development, implementation, operation, organisation and supervision of membership schemes; consultancy services and advice relating to all of the foregoing; consulting on and provision of customer relationship management; registration and notification services relating to cards used in financial transactions and to property and documents, including passports, luggage and keys; identification, replacement or return services, all relating to lost or stolen cards used in financial transactions and to property and documents including passports, luggage and keys; collection and systemisation of information into computer databases; all the foregoing being provided to financial institutions or other organisations or to individuals; promoting the goods and services of others by means of offering discounts on hotels, resort accommodations, restaurants, car rentals, cruises, air-fares, leisure facilities, exercise and recreational facilities, restaurants and clubs, tour packages, credit cards and brand name merchandise; ordering of goods and services for others; retail or online retail services relating to automobile goods and equipment, publications and stationery; shopping retail services and electronic shopping retail services all connected with automobile goods and equipment, publications, stationery, CDs, DVDs, magnetic data carriers, recording discs, video games, computer games, musical and audio visual works provided via the Internet and other computer and electronic communications networks or via wireless technology, computers and computer software, telephones, toys, games, playthings and sports equipment, building and home improvement goods for the 'do-it -yourself' sector, garden plants, gardening goods and equipment, domestic electrical and electronic equipment including white goods, machines for handheld use, hand tools, optical goods, cameras and photographic goods, jewellery, clocks, watches, bathroom and heating products, clothing, headgear, footwear, fashion accessories, leather and imitation leather goods, handbags, purses, and

luggage, travel goods and accessories, furniture, household containers and utensils, crockery and glassware, furnishings, textiles, haberdashery, napery, cosmetics, toiletries, health and beauty products, foods and beverages (alcoholic and non-alcoholic) pet foods, pet equipment and products, tobacco products and smokers' accessories; consumer consultancy services; information services relating to any of the services hereof; all the foregoing services optionally being provided through a membership scheme; organisation and operation of sales and promotional incentive schemes; provision to others of information relating to price, availability and specification of goods and services and to the dimension and the colour of goods; provision of access to sale of goods by auction whether on-line or not.

**Class 36:** Financial services; real estate brokerage services; rendering technical assistance to others in the establishment and/or operation of real estate brokerage services; credit card protection and registry services; travel insurance; insurance services relating to assistance for persons who get into difficulties while travelling, while away from home, while away from their permanent residence; insurance services relating to fraudulent or unauthorized use of cards used in financial transactions; provision of emergency money, including cash and travellers' cheques, and/or replacement travel tickets; insurance services relating to purchase protection, price protection and extended warranty for goods purchased using credit cards; extended warranty services; arranging discounts in relation to restaurant and hotel services, cinemas, theatres, sporting events and other leisure activities, as part of a membership scheme or programme; issuing of tokens of value in relation to or as part of a membership scheme or programme; insurance guarantees; provision of equipment guarantee insurance; provision of financial guarantees; issuing of guarantees; guaranteeing payment of medical expenses for travellers; guarantee insurance services; financing of guarantees; financial guarantee services for the reimbursement of expenses incurred as a result of vehicle accident or breakdown; financial guarantee assessment services; contract guarantee services; warranty insurance services; warranty programme services information services relating to any of the foregoing services; repair guarantee services, arranging of discounts for travel; arranging discounts for service and retail outlets; arranging discounts in connection with the provision of services and goods by others; introduction services to financial advisors and insurance brokers; insurance services; real estate affairs; information relating to services included in Class 36 as specified above, provided to members of a club via the Internet, databases or other electronic means.

**Class 39:** Transport and storage; transport of persons and goods, in particular by road, rail, water and air; portorage; guarded transport of money and valuables; arranging, booking and arrangement of travel, excursions and cruises; organising transport services; organising, booking and arrangement of tours, excursions and sightseeing; travel consultancy and personal chaperoning of travellers on guided tours; rental, booking and arrangement of aeroplanes, rental, booking and

arrangement of boats, in particular rowing boats and motor boats, yachts and canoes, rental, booking and arrangement of motor vehicles and bicycles and horses; packaging and storage of goods; parcel delivery; organisation of tours and sightseeing; travel agency services (included in Class 39), in particular consultancy and booking of travel, provision of travel information, arranging of transport and travel; transport reservation services (included in Class 39) for sporting, scientific, political and cultural events; online information, reservation and booking services in the field of tourism and business travel (online travel agencies); traffic information services; location of vehicles by computer.

**Class 41:** Education; providing of training; entertainment; sporting and cultural activities; entertainment services; provision of entertainment services by means of television, the Internet and on-line databases; pay to play games services; organising of games, quizzes and competitions; production and presentation of television programmes, interactive television, interactive games, interactive entertainment and interactive competitions; production and presentation of competitions, contests, games, quizzes and audience participation events; interactive services for television viewers; interactive services for television viewers facilitating the playing of games; peer to peer interactive games and gaming services; interactive games and gaming services; electronic games services provided by means of the Internet, or via a global computer network, or on-line from a computer network database, or via telephony including mobile telephones, or via a television channel including a television channel distributed by satellite, terrestrial or cable television broadcast; provision of chat rooms; information and advisory services relating to all the aforesaid services; information and advisory services relating to entertainment; information relating to entertainment provided on-line from a computer database or the Internet; providing on-line publications (non-downloadable); on-line publication of electronic books and journals (non-downloadable); publication and distribution of printed media and recordings; publication of sheet music; organising, provision of, booking and reservation services for: entertainment and social events, club entertainment services, live entertainment; dancing facilities, nightclub, discotheque, music hall, concert, dance hall, ballroom, cabaret service, circuses, visual and musical entertainment, entertainment shows featuring dancers and singers, production of live entertainment, events, exhibitions and shows for entertainment purposes, music competitions, balls, theme parks, amusement parks, amusement arcades, cinema and theatres, sports facilities, recreation facilities and amenities, tenpin bowling alley and bowling greens, leisure centres, boating lakes, swimming facilities, golf facilities, tennis court facilities, health and fitness club, casino and gaming facilities, quizzes, games and competitions, beauty competitions; sporting competitions, conferences, seminars and exhibitions; rental and hire of sporting apparatus; education and training services relating to the establishment, operation, administration, management and conduct of amusement and theme parks; movie studios; recording studio services; television entertainment; cinema services; providing facilities; booking agency services for cinema tickets; rental and leasing of movie projectors and

accessories; rental of cinematographic and motion picture films; distribution of cinematographic and motion picture films; editing of cinematographic and motion picture films; showing of cinematographic and motion picture films; organisation and management of cinemas and theatres; education and training services relating to the establishment, operation, administration, management and conduct of cinemas and theatres; training services for cinema technicians; information, advice and consultancy relating to all the aforesaid services.

**Class 43:** Arrangement, booking, operation, management, provision, rental and reservation of, holiday homes, tourist homes and apartments, hotels, hotel rooms, motels, temporary accommodation, meals, nurseries and childcare facilities, restaurant, bar and catering services; tourism services being the provision of information about accommodation and places to eat and drink and including booking services relating thereto; information relating to all the aforementioned services included in Class 43 as specified above, provided to members of a club via the Internet, databases or other electronic means.

**Class 45:** Concierge services for others comprising of making requested personal arrangements and providing customer specific information to meet the needs of individuals; security services for the protection of property and individuals; all included in this class; information relating to services included in Class 45 as specified above, provided to members of a club via the Internet, databases or other electronic means.

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**Class 35:** Purchase and sale of artwork; business administrative processing of orders in connection with services featuring books and catalogues concerning artwork, fine furniture and decorative art, antique and collectible articles, and other valuable property; auctioneering services; auction advice and consultancy services; organisation and conducting of Internet auctions; advertising services provided for florists; model agency services; provision of models and staff for advertising and sales promotion; promotion [advertising] of concerts; shop, mail order, electronic and telephone retail services connected with the sale of plants, flowers, floral arrangements, gifts, motor vehicles, boats, marine vessels, private jets, aeroplanes, gliders, helicopters, motorbikes, bicycles; talent booking services; promotion services.

**Class 36:** Art appraisal and valuation services; financial services relating to the purchase and leasing of aircraft; provision of aircraft financing; insurance services, advice relating to insurance services, property rental and leasing, provision of insurance and financial services relating to property rental and leasing and vehicle leasing; advice relating to vehicle financing; vehicle financing brokerage; leasing and hire purchase; valuation services.

**Class 41:** Music production services; music concert services; concert promotion services; production of fashion shows; provision of models for artists; model teaching, tuition and training; provision of modelling studios; entertainment services; production and distribution services in the field of sound and/or visual recordings and entertainment; music publishing services; artist management; recording studio services; information services relating to music, entertainment, games and events provided on-line from a computer database, from the Internet or any other communications network including wireless, cable or satellite; provision of digital music (not downloadable) from the Internet; provision of digital music (not downloadable) from MP3 websites; production, preparation, presentation, distribution, and rental of television and radio programmes and films, animated films and sound and/or visual recordings; production of live entertainment features; organisation, production and presentation of quizzes, exhibitions, sporting events, shows, road shows, staged events, theatrical performances, concerts, live performances and audience participation events; provision of on-line electronic publications (not downloadable); electronic game services provided from a computer database, the Internet or any other communications network including wireless, cable, satellite; booking agencies ticket services; reservation services for concert tickets; advisory and consultancy services related to the aforementioned services.