

BLO/0580/23

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL TRADE MARK NO. WO0000001491748 AND WO000000149254

DESIGNATING THE UNITED KINGDOM

BY ALLBRIGHT LAW OFFICES

TO REGISTER:

ALLBRIGHT

AND



AS TRADE MARKS IN CLASS 45

AND IN THE MATTER OF OPPOSITIONS THERETO UNDER NO. 419823 & 419824

BY ALBRIGHT IP LIMITED

AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON

BY THE APPLICANT

AGAINST A DECISION OF JUNE RALPH

DATED 14 NOVEMBER 2022

DECISION

Introduction

1. This is an appeal from a decision of June Ralph, acting for the Registrar, dated 14 November 2022, in which she found that the oppositions by Albright IP Limited (“the Opponent”) succeeded against the registration of international trade mark numbers WO0000001491748 (the stylised word mark shown above) and WO0000001491254 (the device mark shown above) (together “the Trade Marks”) in the UK. Allbright Law Offices (“the Holder” or “the Appellant”) requested protection in the UK from 13 August 2019 for the Trade Marks covering various mediation, arbitration and intellectual property-related services in class 45.
2. The oppositions were based on sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Opponent relied on the following earlier trade marks:

UK TM No. 3079492	UK TM No. 3179637
ALBRIGHT IP Albright IP (series of 2) Class 45 Filing date: 30 October 2014 Registration date: 20 March 2015	ALBRIGHT Albright (series of 2) Class 45 Filing date: 10 August 2016 Registration date: 11 November 2016

3. The Opponent relied on the ‘637 registration for all of the grounds, but only relied on the ‘492 registration for the s.5(2)(b) ground.
4. The cases were consolidated. Only the Opponent filed evidence and written submissions in lieu of a hearing, so the Hearing Officer reached her decision on the materials before her. The Opponent represented themselves and the Holder was represented by Bird & Bird LLP.

The Hearing Officer's Decision

5. The Hearing Officer made the following findings:

S.5(1) and s.5(2)(a)

The Hearing Officer found that the marks were not identical. While she found that the differences between the fonts used were not significant, the sizing of the letters A and B and the additional letter L in the '748 mark were significant, which denoted the mark as consisting of two conjoined words ALL and BRIGHT. These differences would be noticed by the average consumer, and so the opposition under s.5(1) and s.5(2)(a) failed.

S.5(2)(b)

The services

The services were identical as they all fell under the Opponent's "legal services".

The average consumer and the nature of the purchasing act

The average consumers would be businesses, which could encompass sole traders, SMEs or large multinational companies. Legal services are generally expensive so the purchaser would pay a high degree of attention. Services were likely to be accessed visually, although she did not discount any aural aspect such as word of mouth recommendations.

Similarity between the marks

Visual similarity

There was a high degree of visual similarity between the Opponent's marks and the '748 mark, and a medium degree of visual similarity between the Opponent's marks and the '254 mark.

Aural similarity

Where only the words ALBRIGHT and ALLBRIGHT would be pronounced, they were aurally identical. Where the words IP and LAW OFFICES would also be pronounced, there was a high degree of aural similarity.

Conceptual similarity

The marks were conceptually neutral as neither ALBRIGHT nor ALLBRIGHT has any meaningful concept, or in the alternative, whatever concept they do have will be the same in both cases.

Distinctive character of the earlier trade marks

The earlier trade marks were inherently distinctive to a high degree.

Likelihood of confusion

There was a likelihood of direct confusion between the earlier marks and the '748 mark. Consumers would not directly confuse the earlier marks and the '254 mark because there were sufficient differences in the device elements, but there was a likelihood of indirect confusion.

6. Accordingly, the Hearing Officer found that the oppositions succeeded under s.5(2)(b).

The Appeal

7. The Opponent filed a Notice of Appeal to the Appointed Person under s.76 of the Act. At the hearing before me, which was held remotely, Tom Hooper of Bird & Bird LLP appeared on behalf of the Appellant and Jamie Muir Wood of Hogarth Chambers appeared on behalf of the Respondent.

Standard of review

8. It is well established that in order to interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EQHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. In the absence of an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [80]). In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree

of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]). I have borne those principles firmly in mind.

Grounds of Appeal

9. The Appellant relied on three grounds of appeal (one having been dropped at the hearing), which I will deal with in turn.

Ground 1: Assessment of the similarity of the marks

10. The Appellant submitted that the Hearing Officer accurately summarised the law, namely that the average consumer perceives a mark as a whole, and that the visual, aural and conceptual similarities must be assessed by reference to the overall impression created by the mark, bearing in mind its distinctive and dominant elements. However, she erred in her application of those principles.

Visual similarity

11. With regard to the '748 mark, the Appellant argued that there was only a low degree of visual similarity between the marks because the Hearing Officer had found that the word ALLBRIGHT as it appears in the '748 mark consisted of two conjoined words ALL and BRIGHT, whereas the word ALBRIGHT as it appears in the earlier marks would be seen as one word. The Appellant also focused on the Hearing Officer's findings in paragraph 32 of her Decision that the '748 mark "*is a slightly stylised word in capitals but with the first and fourth letters namely A and B being larger in size than the remaining letters*".
12. I consider this a surprising submission. The Opponent's earlier mark for ALBRIGHT is a word mark, which would therefore cover its visual appearance in different fonts, and differs from the word ALLBRIGHT by the omission of a single letter L. The Opponent has not identified any error of principle or law made by the Hearing Officer. I agree with the Hearing Officer that the '748 mark is visually similar to the Opponent's earlier marks to a high degree and is a conclusion that a reasonable tribunal could reach.
13. With regard to the '254 mark, the Hearing Officer reduced the visual similarity to medium in light of the diamond device and the inclusion of the words LAW OFFICES and the Chinese characters. The non-Chinese speaking average consumer would pay little attention to the

Chinese characters, as their focus would be on the elements that they could understand. The Hearing Officer found that the word ALLBRIGHT was the dominant element of the '254 mark, and since it differed from the Opponent's ALBRIGHT word mark by the addition of the single letter L and the slight stylisation of the font, found a medium level of visual similarity. That approach was in accordance with the correct approach set out in paragraph 34 of the CJEU's judgment in *Bimbo SA v OHIM*, Case C-591/12P 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." (emphasis added).

14. The Hearing Officer's conclusion on visual similarity between the earlier marks and the '254 mark was one which a reasonable tribunal could have reached and disclosed no error of principle or law.

Aural similarity

15. I find the suggestion that the Hearing Officer erred in her conclusion that the '748 mark and the Opponent's ALBRIGHT word mark could be pronounced identically by the average consumer to be equally surprising. The Appellant argued that the word ALLBRIGHT would be pronounced as two separate words, with a "short pause" between the word ALL and BRIGHT, whereas the word ALBRIGHT in the Opponent's earlier marks would be pronounced as one word, with the "AL" element rhyming with the word "shall".
16. While I accept that there may be some people who would pronounce ALBRIGHT in the manner suggested by the Appellant, I consider it far more likely that it would be pronounced in the same way as ALLBRIGHT (i.e. with the "AL" element rhyming with the word "shawl"). When considering conceptual similarity, the Hearing Officer found that some people might see the ALLBRIGHT and ALBRIGHT elements as surnames. In agreeing with this suggestion, Mr Hooper submitted to me that the first person who came to mind with that surname was the former US Secretary of State, Madeleine Albright. He was careful not to pronounce her surname until I asked him to, at which point he said that the Appellant would pronounce it as AL-BRIGHT to rhyme with "shall". I have only ever heard her surname pronounced so that

the AL element rhymes with “shawl” rather than “shall”, so I do not consider that that example assisted the Appellant’s position on aural similarity.

17. With respect to whether or not ALLBRIGHT would be pronounced with or without a short pause between the words ALL and BRIGHT, the aural difference would be so slight that it would still mean that the marks were aurally similarly to a high degree. Whether the Hearing Officer found the aural similarity to be high as opposed to identical would have made no difference to her overall conclusions on the likelihood of confusion. This was therefore not a proper ground for appeal, for the reasons given by Iain Purvis KC sitting as the Appointed Person in *Greybox*, Case BL O/106/20 when he said at paragraph 23:

“This takes issue with the Hearing Officer’s view that the conceptual similarities between the marks were at a ‘fairly low level’. It is said that the conceptual similarity should have been found to be at least at a ‘medium’ level. I do not consider there is any great value in debating differences between ‘fairly low’ and ‘medium’ degrees of similarity in the context of the overall assessment of likelihood of confusion. Certainly, I do not consider that such fine distinctions can properly be characterized as errors of principle. They are at best simply disagreements about the precise ‘weight’ to be given to a factor in the overall assessment, something which the Courts have consistently rejected as a proper ground of Appeal.”.

18. In any event, while there may be some people who may give a short pause between ALL and BRIGHT when pronouncing ALLBRIGHT, I do not consider that that would be how most people would pronounce the word, since it is a single word. The Hearing Officer was therefore fully entitled to conclude that a significant proportion of consumers would pronounce the ALLBRIGHT element of the Trade Marks in the same way that they would pronounce ALBRIGHT as it appears in the earlier marks. Accordingly, I see no reason to interfere with her conclusion that the Trade Marks were aurally identical to the ALBRIGHT word mark if only the words ALBRIGHT and ALLBRIGHT would be pronounced.
19. The Hearing Officer accepted that some consumers would pronounce the IP element in the Respondent’s ALBRIGHT IP mark, and would pronounce the words LAW OFFICES which appear in the ‘254 mark, but they would not pronounce the Chinese characters, and the device element could not be pronounced. She concluded that, for those consumers, there was a high degree of aural similarity between the marks. Again, I see no reason to interfere with that conclusion, which is one that a reasonable tribunal could have reached.

Conceptual similarity

20. The Hearing Officer's findings on conceptual similarity were as follows:

"36. Finally turning to the conceptual comparison, I do not find that the element in common has any meaningful concept for a significant proportion of UK consumers although some might see it as a surname. Moreover the opponent contends in its written submissions that ALLBRIGHT is simply a variant spelling of ALBRIGHT and that the concepts are the same in both cases. I agree with this point about variant spelling. Although the holder's '748 mark has different sizing for the letters A and B making it appear as if two words have been conjoined the whole is still ALLBRIGHT as a concept. The remaining word elements namely IP and LAW OFFICES will bring to mind their usual meanings which in relation to the services, the opponent contends will overlap and "give rise to additional conceptual relevance". The device elements within the holder's '254 mark have no concept. The average consumer will likely recognise the characters in the mark as being Chinese from their appearance but will not attribute any meaning to them. Taking all these factors into account I consider the conceptual similarity to be neutral as neither ALBRIGHT nor ALLBRIGHT has any meaningful concept. Or in the alternative whatever concept they do have will be the same in both cases."

21. The Opponent submitted that the Hearing Officer was wrong to find that ALLBRIGHT was a variant spelling of ALBRIGHT. She was also wrong not to consider the meaning of the common English words ALL and BRIGHT, whereas ALBRIGHT had no meaning and may be seen as a surname. Had she considered the meaning of the ALLBRIGHT mark, and the lack of meaning of the ALBRIGHT mark, she would not have found ALLBRIGHT to be a variant spelling of ALBRIGHT, since variant spellings cannot apply to words with different meanings. She should therefore have found that the conceptual distinction between the marks was so significant that there was no conceptual similarity.

22. On the point about variant spellings, the Hearing Officer's comments were relevant when considering ALLBRIGHT and ALBRIGHT as possible surnames. In that situation, it was appropriate for her to consider the two spellings as alternative spellings of a possible surname. That was a submission that the Respondent had made in their written submissions before her, and the Appellant had not filed any submissions to counteract that suggestion (a point that applied to many of the submissions made for the first time before me). Further, just because a word is formed from two elements, each of which have meaning as an English

word on their own, does not prevent that word from being perceived as a surname. As Mr Muir Wood submitted at the hearing before me, the Hearing Officer's finding that the respective marks would be perceived as alternative spellings of the same surname could have resulted in her concluding that the conceptual similarity between the earlier marks and the '748 mark was higher than just neutral. However, she concluded that the marks would have either the same meaning, or no meaningful concept, and proceeded to apply conceptual neutrality. That is a decision I see no reason to interfere with.

23. With respect to the '254 mark, the Hearing Officer did consider the additional different elements between the marks. She found that the device element had no conceptual meaning, that the words IP and LAW OFFICES would be given their ordinary meaning (which the Respondent had pointed out did have an element of conceptual overlap), and that the average consumer would attribute no meaning to the Chinese characters. Those were all conclusions I see no reason to interfere with.
24. Finally, the Appellant submitted that the Hearing Officer erred in finding that the earlier marks had a high degree of inherent distinctiveness, saying that their distinctiveness was "low", but then later "no more than medium", in the Appellant's Skeleton Argument. Although this ground did not expressly appear in the Grounds of Appeal, since the Appellant argued that it fell within Ground 1 I will deal with it briefly. No reasons in support of this assertion that the Hearing Officer had erred were set out in the Appellant's Skeleton Argument, and at the hearing before me, the only reason given was that it should not be assumed that the word ALBRIGHT had a high level of distinctiveness just because it was a surname. The Hearing Officer's justification for her finding was that the word ALBRIGHT was an invented word that had no meaning in relation to the services for which the earlier marks were registered, whereas the IP element was purely descriptive (paragraph 40 of her Decision). I reject the Appellant's objection as a proper ground of appeal for the same reasons set out in the extract from *Greybox*, which appears in paragraph 17 above.
25. Accordingly, I have found no error of principle or law in the Hearing Officer's assessment of the similarity of the marks, and Ground 1 of the appeal fails.

Ground 2: The degree of attention of the relevant public

26. The Appellant submitted that, having found that the average consumer would pay a high level of attention in the purchasing act, she then made an error of law by failing to apply that high level of attention to the marks in dispute. However, with respect to the earlier

mark for the word ALBRIGHT and the Appellant's '748 mark, the error identified was merely that the Hearing Officer should have concluded that consumers paying a high level of attention would have noticed the difference between the distinctive font and larger letters A and B of the '748 mark and the additional letter L. I have already explained why the Hearing Officer was entitled to reach the conclusions she did when assessing the similarities of these marks. When she came to summarise her findings in paragraph 47 of her Decision, she expressly referred to her finding that *"the average consumer will pay a high level of attention during the primarily visual purchasing process"*. Further, her findings in paragraph 48 that *"these marks may be imperfectly recollected and therefore directly confusable"* were expressed to be *"taking account the assessments set out above"* (referring back to paragraph 47).

27. With respect to the comparison between the earlier marks and the Appellant's '254 mark, the Hearing Officer continued as follows:

"49. In terms of the opponent's marks and the holder's '254 mark, notwithstanding the ALBRIGHT/ALLBRIGHT element, there are sufficient other differences between the marks with the device elements, such that I do not find that consumers will directly confuse these respective marks.

50. As I did not find direct confusion, I will go on to assess the likelihood of indirect confusion for the holder's '254 mark. I remind myself of the guidance given in L.A. Sugar that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to the same or an economically connected undertaking, taking the later mark to be a possible brand extension or sub brand of the earlier mark. In this case consumers will note that the descriptive word element LEGAL SERVICES [sic] and the device elements and would likely draw the conclusion that the holder's '254 is simply a brand extension or sub-brand of the earlier marks, directed perhaps at legal services for the Chinese market. As such I find there is a likelihood of indirect confusion."

28. As these paragraphs immediately followed paragraphs 47 and 48 where, as explained above, the Hearing Officer expressly took into account the high level of attention of the average consumer, I see nothing to suggest that she did not also apply the same high level of attention to her conclusions in paragraph 49. For the reasons given below in relation to the third ground of appeal, I consider that this conclusion was one which a reasonable tribunal

could have reached, taking into account a high level of attention being paid by the average consumer.

29. Accordingly, Ground 2 of the appeal fails.

Ground 3: Assessment of the likelihood of confusion

30. The Grounds of Appeal set out this ground as follows:

“20. In view of the above, there would not be a likelihood of confusion between the respective marks, such that there would be no infringement of section 5(2)(b) Trade Marks Act 1994.”

31. Paragraph 21 of the Grounds of Appeal summarised the Appellant’s arguments covered by Ground 1 of the Appeal and paragraph 22 summarised the Appellant’s arguments covered by Ground 2 of the Appeal. Paragraph 23 referred to an argument regarding the Hearing Officer having placed undue emphasis on the visual similarity of the marks, which was not pursued at the hearing before me.

32. Paragraph 24 concluded:

“Due to these failings, the Hearing Officer incorrectly concluded that there was a likelihood of confusion in relation to the Opposed Word Mark.”

33. I therefore agree with Mr Muir Wood’s submission at the hearing before me that, if, as I have done, I find against the Appellant on Grounds 1 and 2 of the Appeal, then Ground 3 must automatically fail with respect to the ‘748 mark.

34. With respect to the ‘254 mark, the Grounds of Appeal continued as follows:

“25. The Hearing Officer was also wrong in her assessment of direct confusion [it seems that this was a typographical error, and that it was intended to state “indirect confusion”] in relation to the Opposed Device Mark. Her conclusion that the relevant public would think a law firm would spell a subsidiary brand differently to their main brand name does not make sense. If there was a sub-brand of the Respondent’s business it would follow the same naming convention of the house brand, ALBRIGHT, with an additional word or figurative element to distinguish it as a sub-brand.”

26. Even without taking into account the additional differences in certain of the marks, for the reasons discussed above, the differences between the word

“ALBRIGHT” and “ALLBRIGHT” are sufficient to avoid direct or indirect likelihood of confusion.”

35. To understand the Hearing Officer’s findings on indirect confusion, it is necessary to review her findings on direct confusion, which were set out in paragraph 48 of her Decision as follows:

“48. Based on the marks and the services before me and taking into account the assessments set out above, I find the nature of the ALBRIGHT/ALLBRIGHT element is the most pertinent factor to consider as per Kurt Geiger. As set out above a consumer rarely has the chance to make direct comparisons between marks but instead relies on an imperfect recollection which could entail coming across the marks perhaps weeks or months apart. Whilst I did not find the opponent’s mark and the holder’s ‘748 mark to be identical under the test set out in the SADAS case, I nonetheless find these marks may be imperfectly recollected and therefore directly confusable.”

36. The Hearing Officer’s finding in paragraph 48 of her Decision was therefore that, due to imperfect recollection, consumers would not recognise the difference in the spellings of ALBRIGHT and ALLBRIGHT in circumstances where, for example, they would not have the opportunity to make a side-by-side comparison. She therefore did not find, as the Appellant suggested in paragraph 25 of its Grounds of Appeal, that consumers would notice the different spelling of ALLBRIGHT in the ‘254 mark and assume that it was a sub-brand of the Respondent, albeit with a different spelling. What the Hearing Officer decided was that, due to imperfect recollection, the average consumer would not notice the different spellings of ALBRIGHT/ALLBRIGHT. In those circumstances, they would assume that the word was a reference to the same brand, they would see the device element, the words LAW OFFICES (mistakenly referred to as LEGAL SERVICES in paragraph 50 of the Decision) and the Chinese script, and assume that it was a brand extension or sub-brand of the Respondent’s, for example, as the Hearing Officer described, *“directed perhaps at legal services of the Chinese market”*.

37. The Appellant argued that this is not a correct analysis of paragraph 49 of the Decision because nowhere in that paragraph is there any mention of imperfect recollection. While that is correct, it is clear from the previous paragraph (which I set out in paragraph 35 above) that the Hearing Officer had concluded that the words ALBRIGHT and ALLBRIGHT would be directly confused with each other as a result of imperfect recollection. She then

states in paragraph 49, “... **notwithstanding the ALBRIGHT/ALLBRIGHT element, there are sufficient other differences** between the marks with the device elements, such that I do not find that consumers will directly confuse these respective marks.” (emphasis added). That explains why there is no mention of ALBRIGHT/ALLBRIGHT in paragraph 50, where she discusses the “other differences”, because she did not consider ALBRIGHT/ALLBRIGHT to be one of the differences that the average consumer would notice in the ‘254 mark.

38. I therefore consider that the Hearing Officer was entitled to find in paragraph 49 of her Decision that there was no likelihood of direct confusion with the ‘254 mark because consumers would recognise the difference between the earlier word marks and the elements other than the word ALLBRIGHT which make up the ‘254 mark. This could not amount to direct confusion within the definition laid down in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, which requires the average consumer to mistake one mark for another. Having reached that finding, the Hearing Officer was then entitled to decide that the average consumer would not appreciate the differences between the word ALLBRIGHT as it appears in the ‘254 marks and the Respondent’s ALBRIGHT marks as a result of imperfect recollection of the earlier marks, and reach the conclusions set out in paragraph 50 of her Decision.

39. For these reasons, Ground 3 also fails.

40. As I have not interfered with the Hearing Officer’s findings of indirect confusion in respect of the ‘254 mark, there is no need for me to consider the Respondent’s cross-appeal that she should have reached a finding of direct confusion in respect of that mark.

Conclusion

41. The appeal fails and is dismissed.

Costs

42. Since the appeal has been dismissed, the Respondent is entitled to a contribution towards its costs of the appeal.

43. I will therefore make an order that the Appellant pay to the Respondent a contribution of £1,200 towards the costs of the appeal, to be added to the award of £1,000 made by the

Hearing Officer, making a total of £2,200 to be paid within 21 days of the date of this decision.

Simon Clark
The Appointed Person
20 June 2023

Representation:

Appellant: Tom Hooper (Bird & Bird LLP)

Respondent: Jamie Muir Wood (Hogarth Chambers)