O-060-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3097869
BY CUMULUS HEALTH LIMITED
TO REGISTER THE TRADE MARK**

**IN CLASS 42
AND**

**IN THE MATTER OF OPPOSITION
THERETO UNDER Nos. 404578 BY
FIRST CARE LIMITED**

BACKGROUND

1) On 6 March 2015, Cumulus Health Limited (hereinafter the applicant) applied to register the trade mark shown above in respect of the following services:

> Class 42: Design and development of computer hardware and software; Advisory services relating to computer software; Advisory services relating to the use of computer software; Cloud computing; Computer and computer software rental; Computer and software consultancy services; Computer hardware and software consultancy services; Computer programming and software design; Computer software design and development; Computer software design and updating; Computer software design for others; Computer software design services; Computer software (installation of-); Computer software (Maintenance of -); Computer software (rental of -); Computer software (updating of-); Creating and maintaining computer sites (web sites) for others; Creating and maintaining web sites; Creating and maintaining web sites for others; Design and writing of computer software; Design of computer software; Design of software; Development of computer software; Hire of computer software; Hosting computer sites [web sites]; Electronic data storage.

2) The application was examined and accepted, and subsequently published for opposition purposes on 27 March 2015 in Trade Marks Journal No.2015/013.

3) On 25 June 2015 First Care Limited (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates	Class	Specification
FIRSTDAY FIRSTDAY A series of two.	2576800	29.03.11 08.07.11	35	Business management; business administration; office functions; business consultancy; advisory services for improvement of business performance; human resources evaluation; human resources management; productivity management; business, administration and management services relating to managing employee/workplace absence; business services relating to co-ordination and management of medical, rehabilitation and health support services; provision and administration of schemes relating to managing employee sickness absence; absence tracking and absence management services; provision and administration of schemes for workplace accident reporting and recording; employee record and employee history verification services; information, advisory and consultancy services relating to all of the aforesaid.
			44	Medical services; medial screening services; arranging medical examinations; provision of medical information, advice and support; health care services; health management services; health screening and surveillance services; health assessment and advisory services; analysis of information relating to health; occupational health services; occupational health assessment services; occupational therapy services; employee health monitoring and assessment for others; information, advisory and consultancy services relating to all of the aforesaid

a) The opponent contends that its mark and the mark applied for are similar. It also contends that the services for which its mark is registered are identical and/or similar to the services applied for. The application therefore offends against Section 5(2)(b) of the Act.

4) On 24 August 2015 the applicant filed a counterstatement, basically denying that the marks are similar.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 1 February 2016 when the opponent was represented by Mr Rose of Messrs Wilson Gunn; the applicant was represented by Mr Le Piquet a director of the applicant company.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 11 November 2015, by David Hope the Chief Executive of the opponent company. He states that his company is an absence management company, handling all aspects of unplanned absence from employment. It covers 167,000 employees, and it provides medical assistance to prevent a repeat of the medical condition and get employees back to work as soon as possible. The employee absence is assessed by nurses and further care and advice provided to prevent reoccurrence. The mark shown in paragraph 3 above was first used in 2011 although the company has been operational in the UK since 2004. The mark relied upon by the opponent is one of three marks that it uses and relates to the day one absence management service, where an employee is professionally cared for from the start of the absence by nurses employed by the opponent.

7) Mr Hope provides evidence of a website www.firstdayhealth.co.uk at exhibit 8 which shows the copyright claimed by a company called Cumulus Health Pty Limited. This shows the mark in suit being used in respect of services identical and/or similar to those offered by the opponent. The contact details are UK based. The domain name firstdayhealth.co.uk is registered to the applicant (exhibit 9), at an address in Somerset identical to that shown for the applicant company on the Companies House register (exhibit 10). This exhibit also shows that Mr Gari Le Piquet was a director of the applicant company until 8 May 2015. At the hearing Mr Le Piquet confirmed that he is once again a director of the applicant company having been re-instated approximately 4 months ago. Mr Le Piquet was employed by the opponent from 5 October 2010 until 31 October 2011 as a Business Development Manager. He was therefore well acquainted with the new logo being used by the opponent and the services it offers. In exhibits 13 – 16 the opponent provides various documents which shows that Mr Le Piquet was an employee of the opponent and was aware of the use of the opponent's mark shown at paragraph 3 above.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The only ground of opposition is under section 5(2)(b) which 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."

10) An "earlier trade mark" is defined in section 6, the relevant part of which states:

> "6.-(1) In this Act an "earlier trade mark" means -

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

11) The opponent is relying upon its trade mark listed in paragraph 3 above. Given the interplay between the date that the opponent's mark was registered and the date that the applicant's mark was published, the opponent's mark is not subject to proof of use.

12) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*. Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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.

The average consumer and the nature of the purchasing decision

13) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. 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:

> "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."

14) The services of the two parties vary somewhat with the applicant, broadly speaking, offering consultancy services in respect of computer hardware and software, software design and maintenance services, rental of software, creating and maintaining websites and provision of computer storage. Whereas the opponent offers, broadly speaking, business management and administration services including human resources services, specialising in employee sickness absence and all aspects of tracking, managing and reducing sickness absence. Included in this are various medical services, although such medical screenings and examinations could be offered separate from human resources functions.

15) It is clear that both parties are targeting businesses, however there is nothing in their specification which prevent them offering many of their services to members of the public. Therefore, the average consumer for both sides' services would be the general public in the UK including businesses. The types of services on offer are likely to be initial chosen by reference to advertising either in print or on the internet. In either event the initial selection would be by eye although aural similarity must be considered as word of mouth recommendations may come into play. I regard it as unlikely that such services would be chosen without some discussion, either by telephone or face to face with the provider. Given the nature of the services outlined it is my view that they would not be chosen without careful consideration. **I therefore regard the average consumer would pay a medium to high degree of attention to the selection of the services offered.**

Comparison of services

16) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> "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".

17) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services;

c) The respective trade channels through which the goods or services reach the market;

d) 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;

e) 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.

18) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

"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."

19) The services of the two parties are:

Applicant's services	Opponent's services
Class 42: Design and development of computer hardware and software; Advisory services relating to computer software; Advisory services relating to the use of computer software; Cloud computing; Computer and computer software rental; Computer and software consultancy services; Computer hardware and software consultancy services; Computer programming and software design; Computer software design and development; Computer software design and updating; Computer software design for others; Computer software design services; Computer software (installation of-	35: Business management; business administration; office functions; business consultancy; advisory services for improvement of business performance; human resources evaluation; human resources management; productivity management; business, administration and management services relating to managing employee/workplace absence; business services relating to co-ordination and management of medical, rehabilitation and health support services; provision and administration of schemes relating to managing employee sickness absence; absence tracking and absence management services; provision and administration of schemes for workplace accident reporting and recording; employee record and employee history verification services; information, advisory and consultancy services relating to all

); Computer software (Maintenance of -); Computer software (rental of -); Computer software (updating of-); Creating and maintaining computer sites (web sites) for others; Creating and maintaining web sites; Creating and maintaining web sites for others; Design and writing of computer software; Design of computer software; Design of software; Development of computer software; Hire of computer software; Hosting computer sites [web sites]; Electronic data storage.	of the aforesaid. 44: Medical services; medial screening services; arranging medical examinations; provision of medical information, advice and support; health care services; health management services; health screening and surveillance services; health assessment and advisory services; analysis of information relating to health; occupational health services; occupational health assessment services; occupational therapy services; employee health monitoring and assessment for others; information, advisory and consultancy services relating to all of the aforesaid

20) The opponent contended:

1. The computer hardware and software services, the website related services, and the electronic data storage services of the Application are not specified to be in relation to any particular business or industry. Consequently, they could directly relate to and assist the provision of the business and human resources services and the health and medical services of the Registration. Therefore, all of the services of the Application are similar services to all those of the Registration.

2. Exhibit 8 of the Witness Statement of David Hope is evidence that the Applicant is providing, under the Mark of the Application, very similar, if not identical, services to those of the Opponent.

3. The evidence strongly suggests that the computer hardware and software services, the website related services, and the electronic data storage services of the Application are in fact used to provide the same services as those provided under the Mark of the Registration.

4. The intended consumers of the respective services also appear to be very similar, if not identical, being UK businesses seeking to record, manage and reduce workplace absences with a focus on health related absences.

21) The opponent has confused the test to be applied under this section of the Act. I can only compare the specifications applied for, not what the parties are actually doing in the real world. I fully accept that the evidence would appear to show that the applicant is trading offering similar services to those of the opponent. However, they have not applied to register the services that they appear to be actually offering but a different set of services. I accept that the computer software services offered could relate to the management of staff sickness and management. But offering the hardware and software to allow someone to carry out certain function is not the same as offering to carry out those functions on their behalf. It would be equivalent to excluding a pen or paper provider as these could be used to record sickness absence. **I do not regard any of the services of the two parties as being similar in any way whatsoever.**

22) In *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, Lady Justice Arden stated that:

> "49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

23) The above finding means that the opposition must fail, however, for the sake of completeness I will consider the other aspects of the case.

Comparison of trade marks

24) 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 them, 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."

25) It would be wrong, therefore, to artificially dissect the trade 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 them. The opponent has a series of two marks registered. I shall use the black and white mark in my comparison as neither side makes any colour claim. The trade marks to be compared are:

Opponents' trade mark	Applicant's trade mark
FIRSTDAY	FIRSTDAY HEALTH

26) Both marks have a large device element on the left hand side and this is the first thing the average consumer will notice. Both devices are crosses, although the applicant's device has a "trace" line running through it that most people will recognise from their own experiences or from television/film as being reminiscent of a heart monitor trace. Indeed the applicant describes this aspect of its mark as a "heartbeat". There are also differences in the orientation of the crosses which the applicant highlighted in its submissions. The applicant also points out that its mark consists of three words whereas the opponent's mark only has two words.

27) Visually the marks share the image of a cross and the same two words which are at the start of both marks. Whilst I accept that the crosses have a different orientation; that one has a heartbeat and

the applicant's mark also has the word "Health" there are, in my opinion far more visual similarities than differences such that **I believe that the marks have at least a medium degree of visual similarity.**

28) Aurally, the device elements do not play a part. What is left is the same two words "First Day" at the start of each mark with the only difference being that the applicant's mark also has the word "health" tagged on at the end. **To my mind, the marks are aurally similar to at least a medium to high degree.**

29) Conceptually the opponent's mark draws attention to its medical bias, in that the cross is a symbol often seen as designating medical services, and the words "first day" indicate early intervention. The applicant's mark is more ambiguous in that the services applied for are not specifically to do with the provision of medical services. The cross with integral heartbeat and the words "First Day Health" all conspire to lead the consumer to the conclusion that the services on offer are of a medical nature, even if the services sought to registered, do not conform to this expectation. **There is a medium degree of conceptual similarity between the marks.**

30) **Given the above findings I come to the conclusion that the similarities far outweigh any differences in the marks, such that there is, overall, at least a medium degree of similarity**.

Distinctive character of the earlier trade mark

31) 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 *WindsurfingChiemsee* 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)."

32) 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. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out".

33) As the opponent's mark has a meaning linked to the services it offers it must be regarded as a **having a medium degree of inherent distinctiveness but it cannot benefit from enhanced distinctiveness as the opponent has not shown that it has a significant reputation in the UK.**

Likelihood of confusion

34) It is clear from paragraphs 21 & 22 above that no finding of a likelihood of confusion can be found when there is, as this case, no similarity whatsoever between the services of the two parties.

CONCLUSION

35) As the applicant has succeeded in full it is entitled to a contribution towards its costs. Initially the applicant was not going to be represented at the hearing, and the only written submissions provided were those included with the counter-statement. The applicant took part via the telephone and so incurred no costs in terms of travel and the hearing was extremely brief. I also take into account that the applicant has represented itself throughout the proceedings.

Preparing a statement and considering the other side's statement	£200
Attendance at a hearing	£100
TOTAL	£300

36) I order First Care Ltd to pay Cumulus Health Ltd the sum of £300. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of February 2016

George W Salthouse
For the Registrar,
the Comptroller-General