

O/129/12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2527201 IN THE NAME OF  
GETFRIDAY (A DIVISION OF TTK SERVICES PVT LTD)

AND

OPPOSITION THERETO UNDER NO 100360  
BY CONVEYANCING LOCAL LTD

## Background

1. Application No 2527201 stands in the name of GetFriday (a division of TTK Services Pvt Ltd) ("GF") and has a filing date of 29 September 2009. Registration is sought for the following trade mark:



2. The application seeks registration in respect of services in classes 35, 42 and 45 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3. Following publication of the application in the *Trade Marks Journal* on 1 January 2010, notice of opposition was filed. The opposition was originally filed in the name of Simon Seaton. The opposition is based on grounds under section 5(2)(b) and section 3(6) of the Act and is directed against the application only insofar as it seeks registration for the following services:

Class 45  
Legal advice, Legal research

4. In support of the claim under section 5(2)(b) the following mark is relied upon:

No	Mark	Application/registration date	Specification
2361926	FRIDAYS	27 April 2004/ 22 October 2004	Class 42 Legal services; information and advisory services relating to the law; providing advice and assistance in respect of legal matters; legal research services; professional consultancy relating to law; all the aforementioned services including but not limited to those provided via telecommunications networks, by online delivery and by way of the Internet and the world wide web

5. In respect of the objection founded on section 3(6) of the Act it is claimed that GF does not have a bona fide intention to use the trade mark in respect of the services set out in paragraph 3 above.

6. Mr Seaton subsequently assigned his trade mark to Fridays Property Lawyers Ltd, who later assigned it to Gordons 173 Ltd. This latter company then underwent a change of name to Conveyancing Local Ltd ("CL"). CL has been substituted as opponent having confirmed that it has had sight of the relevant papers, stands by the original grounds of opposition and has accepted liability for any costs.

7. By way of its counter-statement, GF denies each of the grounds of opposition. It also puts CL to proof of use of its trade mark.

8. Both parties filed evidence and both filed written submissions in lieu of attendance at a hearing. I do not intend to summarise the entirety of the evidence as much of it contains submission but have considered it and will refer to it as necessary in this decision.

### **Decision**

9. I shall deal first with the ground of objection under section 5(2)(b). Section 5(2) of the Act 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. The meaning of "earlier trade mark" is set out in Section 6 of the Act which reads:

"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,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if

registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

11. CL’s trade mark is an earlier trade mark within the meaning of section 6(1) of the Act. GF’s application was published on 1 January 2010. As the earlier mark was registered more than five years prior to this date and GF has put CL to proof of use of its earlier trade mark in relation to all the services for which it is registered, the requirements of Section 6A of the Act are relevant. It reads:

“6A (1) This section applies where-

an application for registration of a trade mark has been published,

there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) .....

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7)....”

12. Also of relevance is section 100 of the Act which states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

13. The relevant period in which CL is required to prove use of its mark is 2 January 2005 to 1 January 2010. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);

- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

14. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification, namely:

“Pumfrey J in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use”.

15. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White’s brilliant and memorable example of a narrow specification) “three-holed razor blades imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. Thus the “fair description” is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods—are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

16. Also of relevance are the comments of the Court of First Instance in *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03 where it said:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it

to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

### **CL's evidence of use**

17. CL's evidence takes the form of witness statements from Simon Seaton, a solicitor and conveyancer who co-founded Fridays Property Lawyers Ltd ("FPL") and Natasha Bhatia who states she was co-founder and major shareholder of the original opponent (I presume she means FPL as the opposition was originally launched in Mr Seaton's name) and also co-founded and is the major shareholder of CL.

18. Mr Seaton says that FPL's head office is based in London but that it has marketing offices (he does not explain what these are) in Bristol, Birmingham, Reading, Leeds, Manchester, Exeter, Liverpool, Cardiff, Newcastle and Nottingham although, as it is mainly promoted online, it can provide services to clients anywhere in the UK. The mark was first used on 1 June 2004 when it was applied to the front door of the company's premises. At SS3, he exhibits an undated picture showing a plaque on a wall next to a door. The plaque bears the word 'Fridays'. He states the mark has also been applied to business cards and letterheads. At SS4 he exhibits a photocopy of two business cards each of which show the word Fridays above the words PROPERTY LAWYERS. The exhibit also shows a sheet of letter-headed paper bearing the word Fridays on which the date Friday, 12 November 2010 has been typed (a date outside the relevant period).

19. Mr Seaton gives the following details of turnover and advertising spend under the mark:

Year beginning	Annual turnover	Advertising spend
2004	613,456	119,846
2005	1,589,853	161,551
2006	2,206,022	160,242
2007	2,068,093	132,867
2008	1,810,820	193,493
2009	5,350,530	472,374
2010 (to 12 Nov)		215,640

20. In addition to exhibiting, at SS6, printouts from the “current” website (the witness statement is dated 12 November 2011), Mr Seaton also exhibits, at SS7, printouts taken from the Internet archive ‘waybackmachine’ showing how it appeared in 2004, 2005, 2006 and 2007 as follows:

2004: (outside the relevant period). The word Fridays is shown at the top left of the page above the word Solicitors. The page shows the services on offer to be ‘no sale, no fee, Conveyancers’. The page indicates the company was regulated by the Law Society of England and Wales

2005: As per the 2004 extract above

2006: The word Fridays appears at the top left of the page and shows the services on offer as above. The page indicates the company was regulated by the Council for Licensed Conveyancers

2007: As per the 2006 extract above

2007: This extract does not show the earlier mark

21. At SS8, Mr Seaton exhibits 25 separate invoices (redacted in terms of customer names and addresses) which he says were issued between 2004 and 2010. Eight of these date from outside the relevant period. Of those from within the relevant period, four show dates in 2005, four in 2006, four in 2008 and five in 2009. All of them itemise various charges with all but four indicating, as the first item, that they are fees for work done in relation to either the purchase or sale of property. The invoices include other charges made for e.g. arranging the electronic transfer of funds or obtaining copies of documents from the Land Registry in respect of title deeds, obtaining copies of building regulations approval/planning permission or fees for identity or bankruptcy searches. The other four invoices refer to charges for conveyancing work, fees for a costs protection scheme, unspecified work carried out in relation to a certain property and, simply, for the balance of a previous invoice. All of the invoices include contact details for the company and show Mr Seaton to be a Director of it and a Licensed Conveyancer. With the exception of the two earliest, all

of the invoices indicate the company is regulated by the Council for Licensed Conveyancers to provide conveyancing services.

22. In her witness statement, Ms Bhatia gives evidence that in June 2005, FPL entered into an agreement with a company named SmartAnalyst whereby this latter company provided a number of analysts to carry out part of what she refers to as “the conveyancing process” on a remote basis. She states the activity expanded and led to the analysts carrying out other tasks but gives no details of when this might have occurred. The collaboration ended in the summer of 2010.

23. Ms Bhatia also states that FPL has offered other products and services in addition to what she calls basic conveyancing but again gives no details of when this occurred, under what mark these additional services were offered or whether any sales were made.

### **Findings on use of the earlier mark**

24. In its submissions filed in lieu of attendance at a hearing, GF submits that CL’s evidence of use of its mark should be discounted. It submits that the application was originally made in the name of Simon Seaton whereas the evidence is of use made by FPL. It submits there is no evidence that Mr Seaton gave consent to others to use the mark. No objection to the evidence was made by GF when the evidence was filed but, in any event, it is clear that the application has undergone a series of changes of ownership which can have been initiated only with Mr Seaton’s agreement. I take the evidence into account.

25. The earlier mark, as registered, is presented in plain block capitals whereas, for the most part, the evidence shows use of the mark with the initial letter capitalised and the remainder in lower case.

26. In the European Court of Justice (“ECJ” now CJEU) Case C-291/00 (*LJT Diffusion SA v Sadas Vertbaudet SA*) (“*Sadas*”), the Court made the following statement in relation to when marks can be considered identical:

“Article 5(1)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

27. In my view, the differences between the earlier mark as registered and that as used, which is merely a matter of whether individual letters are presented in lower or upper case, would go unnoticed by the average consumer. I am satisfied that the evidence shows genuine use of the earlier mark and go on to consider on what services that use has been made.

28. Ms Bhatia refers to FPL carrying out ‘basic conveyancing’ but CL claims that the mark has been used in relation to a wide range of legal services. It submits that the

invoices exhibited at SS8 show use in relation to such services as, e.g. the management of funds, carrying out identity checks and advising on planning matters. Whilst I accept the invoices include charges for e.g. the electronic transfer of funds, undertaking various checks and searches and obtaining copies of building regulations or planning permission, these appear to me to be no more than administrative tasks and searches undertaken as part of the standard conveyancing process rather than as a separate service whereby detailed legal advice is given on the particular subject matter. I gain support for my findings in the relatively low level of the fees charged for each of these other items as shown on the invoices. In addition, the first item listed on the vast majority of the invoices relate to the sale or purchase of a property with the remaining items being related to that sale or purchase, the invoices refer to FPL being regulated by the Council for Licensed Conveyancers and the evidence dates from a period when the earlier mark was in the ownership of a company called Fridays Property Lawyers Ltd.

29. GF submits the invoices at SS8 describe how the “work carried out related to residential conveyancing services” only. The invoices do not provide me with any details which allows me to identify the particular properties to which they refer but, regardless of this, no evidence has been filed to show that conveyancers deal only with residential *or* commercial properties or that the profession is otherwise separated. The average consumer would, I think, expect a conveyancer to be able to carry out his duties in relation to any type of property. Conveyancing is a discrete area of the wider legal profession and would be known as such by both the professional and lay user. Taking all matters into account, I consider a fair specification for the use made of the earlier mark is *conveyancing services*. It is this specification which I will take into account in my consideration of the ground of opposition founded on section 5(2)(b) of the Act.

### **The objection under section 5(2)(b)**

30. In determining the question under Section 5(2)(b), I take into account the guidance provided by the Court of Justice in the European Union (CJEU) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [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* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

- (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, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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 causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

31. In essence the test under section 5(2)(b) is whether there are similarities in marks and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion, I am guided by the judgments of the CJEU mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the services, the category of services in question and how they are marketed.

## Comparison of services

32. For ease of reference, the services to be compared are as follows:

CL's earlier mark	GF's application
Class 42	Class 45
Conveyancing services	Legal advice, Legal research

33. The fact that the respective services appear in different classes does not have any effect on whether the services themselves are similar or not. I take note of the comments made in *Proctor & Gamble Company v. Simon Grogan*, O-176-08, where Anna Carboni, sitting as the appointed person, said:

“32. The International Classification system also applies to Community trade marks. Rule 2(4) of Commission Regulation 2868/95/EC implementing the Regulation on the Community trade mark (40/94) states as follows:

(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

33. It is thus made plain under the Community trade mark system that class numbers are irrelevant to the question of similarity of goods and services.

34. There is no similarly plain provision in the Act or the Directive. The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd's Trade Mark Application (CAREMIX)* [2001] EWCA Civ 1928, [2002] RPC 639. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.”

34. In considering the similarity of the respective services, I take into account that services can be considered as identical when those designated by the earlier mark are included in a more general category within the application and vice versa (see *Gérard Meric v OHIM*, Case T-133/05). ‘Legal advice’ is a wide term that would include legal advice on any specific topic and includes legal advice on conveyancing matters. Similarly, ‘Conveyancing Services’ would include legal research carried out as part of the conveyancing process. In short, I find each of the respective services to be identical.

## **The average consumer and the nature of the purchasing process**

35. Conveyancing services are services used by those members of the public buying or selling property. Legal advice is a service used by the general public at large. Legal research may be undertaken as part and parcel of a legal advice service and would therefore also be used by the general public though it may also be provided as a discrete service such that it may be used by businesses. Whilst all of the services are everyday ones and widely available, they are provided by specialists and the average consumer is likely to use them on a relatively infrequent basis. The average consumer may be directed to the service provider by a third party e.g. an estate agent may tell a prospective purchaser of a property the name of a recommended conveyancer, in which case aural considerations may be of prime importance though not to the extent that other considerations are negligible. As the invoices exhibited at SS8 show, conveyancing services involve a not insignificant expense and, whilst I have no evidence on the matter, legal advice and legal research services are also likely to come at a significant cost. Each of the respective services is such that the average consumer is likely to take some care over his purchase but not necessarily the highest care.

## **Comparison of the respective marks**

36. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). I have to consider the visual, aural and conceptual similarities of the respective marks with reference to the overall impressions created by the marks and bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). The average consumer, who rarely has the chance to make a direct comparison between marks but must instead rely upon the imperfect picture of them he has kept in his mind, is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH*).

37. CL's mark is for the word FRIDAYS, the plural of the name Friday. Whilst FRIDAY is a surname, it is a very uncommon one; so uncommon that many may be unaware of such use. As indicated within GF's submissions, FRIDAY may also be known by some to refer to a fictional character in a novel by Daniel Defoe (though I have no evidence on the point). The word is much more widely known and used in everyday language as the name of a day of the week. The word has no meaning in relation to the relevant services and is therefore distinctive of them. The distinctiveness of the mark lies in its whole.

38. GF's mark is made up of the words GET FRIDAY with a mirror reflection of part of the words positioned underneath them. To the left of the words is a distinctive, stylistic representation in a form reminiscent of a stick man who appears to be running either in front of or through a circle device. Whilst the mark is presented in colour, it is not limited to any colour and so colour plays no part in the consideration of similarity (see *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch)). Both words within the mark are identically presented so that neither stands alone and, given the meaning of the word GET, the two words will be read together. In *Société des produits Nestlé SA v Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles)* (OHIM)

Case T-74/04 it was held that words will normally be the dominant element of a composite mark. In my view, the size and position of the words GET FRIDAY make these words the dominant element of the mark under consideration. As these words neither allude to nor describe the services, they are also a distinctive element.

39. From a visual perspective, as both marks contain the word FRIDAY (albeit pluralised in the case of CL's earlier mark) there is a degree of similarity between them. Given the inclusion of the device elements in GF's application which is absent from CL's earlier mark, there are also some differences. I consider them to be similar to a reasonable degree. From an aural perspective, the degree of similarity is much higher due to the fact that the device elements will not be articulated. The word FRIDAYS is likely to be seen by the average consumer as the plural of the name of a day of the week. In his witness statement on behalf of GF, Sunder Prakasham states that the name GET FRIDAY was inspired by the character who acted as an assistant to the protagonist in the novel mentioned above. Whilst this may be true, I have no evidence that the average consumer will be aware of the novel or its characters and their respective roles and certainly there is no evidence that the average consumer will see any such meaning behind the mark. In my view, the mark is unlikely to have any particular meaning for the average consumer though he will be recognise the word Friday as being the name of a day of the week and on this basis I consider there is a reasonable degree of similarity between the respective marks from the conceptual perspective.

#### **Distinctive character of the earlier mark**

40. I also have to take into account the distinctive character of the earlier trade mark which can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (see: *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

41. In considering whether the earlier mark has increased its distinctiveness through use, I note that Mr Seaton has provided evidence that the earlier mark was first used in 2004 and also has provided details of promotional costs as shown above. He states that the mark has been used in a variety of ways. At SS5 he exhibits sample promotional material. The exhibit consists of 9 pages. They are:

Page 1: headed UPDATE the page refers to an Agent Referral Incentive Scheme (ARIS) and appears, from its content, to be intended for estate agents. There is no indication of whether and, if so, when or where this material was published.

Page 2: Another page referring to the ARIS scheme. Again, no information is given as to if, when or where this material was published.

Page 3: What appears to be a print out from the Internet as it bears the words 'click below to find out'. The page questions whether homes being marketed for sale in England and Wales need to have a Home Information Pack (HIP) prepared. No information is given as to whether and, if so, when this may have been available.

Page 4: The page contains contact details for FPL. No information is provided as to whether, and if so, when or where this appeared.

Page 5: What appears to be a printer's copy of an advertisement. It bears the date 11/4/08 but no information is given as to whether this advertisement was ever used and if so where and when it was published.

Page 6: Again, what appears to be a printer's copy of an advertisement, this time bearing the date 29/3/08. Again no information is given as to whether this advertisement was ever used and if so where and when it was published.

Page 7: What appears to be a printout showing an item of stationery in the form of an indexed document file. No further information is provided.

Page 8: What appears to be an advertisement for a HIP service. No details are provided of if, and if so, where and when this might have appeared.

Page 9: What appears to be an advertisement intended for mortgage brokers. Given the spelling mistakes it contains, it would seem to be a draft or another printer's proof but in any event, no information is given of whether and, if so, when and where it was published.

42. At SS6, Mr Seaton has exhibited a print-out of a webpage as it appeared at the date of the making of his witness statement. This is after the material date in these proceedings but in any event appears to be incomplete and no indication is given of e.g. when it first appeared or how many times it has been viewed.

43. Given the absence of any details as to whether, and if so where, any of this promotional material may have been published, I am unable to find that it assists CL.

44. Mr Seaton has also provided details of turnover under the mark, which I have set out above. Though not stated, I take it to be that the turnover is in pounds sterling. Whilst the figures provided are shown to have increased significantly in 2009, no information is provided to show how much of this figure relates to the period prior to the material date. For the previous complete years, the figures range from approximately £1.5m to £2.2m. I have no information about the size of the property market in general or the conveyancing market in particular, however, they are likely to be extremely large and, whilst the turnover figures provided are not insignificant, they are likely to be very small in relation the market as a whole.

45. Whilst Mr Seaton refers to 'marketing offices' in a number of towns across the country, he has given no explanation of when they were opened or their role or function and consequently I cannot establish what services they may have offered, if any or when. The invoices he has provided have been redacted such that I am

unable to establish e.g. the geographical spread of the customer base but, given that many of those invoices are for sums well in excess of £1000 they suggest, when taking the total turnover into account, that customer numbers are in the very low thousands. Again, this is likely to be very small in terms of the market as a whole.

46. On the basis of the evidence which has been filed, CL has failed to establish an increased distinctiveness of the mark through its use. That said, I consider the mark has a relatively high degree of inherent distinctiveness.

### **Likelihood of confusion**

47. In determining whether there is a likelihood of confusion, I must bear in mind a number of factors. There is the interdependency principle, whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the services and vice versa. I must take into account the distinctive character of CL's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparison between trade marks but must, instead, rely upon the imperfect picture of them he has retained in his mind.

48. I have found the respective marks to have a reasonable degree of similarity from both the visual and conceptual perspectives and a much higher degree of similarity from the aural perspective. I have found the respective services to be identical. Taking all matters into account, I find that there is a likelihood of confusion and the objection founded on section 5(2)(b) of the Act succeeds.

### **Offer of amendment**

49. In both its counter-statement and later submissions (made in the evidence of Sunder Prakasham), GF has stated that it is willing to make an amendment to the specification of its application, an offer it says it had made on previous occasions. The amendment it offers is as follows:

Outsourced virtual paralegal support services and legal research support services, specifically excluding conveyancing and property transactional legal services.

50. It is not clear to me (and no further explanation is given by GF) as to what the proposed specification is intended to mean. It clearly refers to support services of some kind but even if the proffered specification were to be re-worded so that its meaning becomes clear, it seems to me that support services for one area of trade could still be highly similar, if not identical, to support services for other areas of trade such as conveyancing so that my finding as to the likelihood of confusion between the two marks would not differ from that above.

## The objection based on section 3(6) of the Act

51. Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith”

52. Bad faith includes dishonesty and “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular field being examined (see *Gromax Plastics Limited v Don and Low Nonwovens Ltd* [1999] RPC 367). It is necessary to apply what is known as the ‘combined test’ which would require a determination of what GF knew at the time of making its application and then, in the light of that knowledge, determining whether its behaviour fell short of acceptable commercial behaviour (see *Barlow Clowes International Ltd (in liquidation), Nigel James Hamilton and Michael Anthony Jordan v Eurotrust International Limited, Peter Stephen William Henwood and Andrew George Sebastian*, Privy Council Appeal No. 38 of 2004 and the decision in *Ajit Weekly Trade Mark* [2006] RPC 25). Bad faith impugns the character of an individual or the collective character of a business and, as such, is a serious allegation. The more serious the allegation, the more cogent must be the evidence to support it.

53. The objection under this ground can be dealt with very briefly. In its statement of grounds, CL claims that GF does not have a bona fide intention to use its mark in respect of each of the services for which registration is applied. It puts its claim in the following terms:

“The Applicant is not a Law Firm and is not qualified to give legal advice.”

54. In support of its claim, it enclosed, with its statement of grounds, a copy of a letter sent to its legal representatives from TTK Services Private Limited and dated 26 March 2010. The letter contains the following sentence:

“Your client’s request *may* have been legitimate if we were a property law firm or a law firm in any capacity. We are not and do not envisage ever becoming one.”

55. The copy letter has not been admitted into the proceedings by way of evidence and thus I do not take it into account. Even if I had taken it into account, the letter would not be sufficient basis for a finding that the application was made in bad faith. This is because such a claim would require there to be, at the very least, some explanation of how the comments made in the letter should be considered in relation to the specification claimed in the application. No further mention is made of the claim under section 3(6) of the Act in any of CL’s evidence. On that basis, it cannot hope to succeed and I decline to deal with the matter further. The opposition based on this ground is dismissed.

## Costs

56. The opposition against the application insofar as it relates to the services of class 45 has succeeded and CL is entitled to an award of costs in its favour.

57. CL submits that GF's request that it file evidence of use of the mark was "unnecessary" as GF was "fully aware that the mark relied upon was in use". It submits that it has been "put to considerable expense in proving a known fact to [GF]". CL also submits that GF filed "significant evidence which required detailed review and reply".

58. GF was fully entitled to request proof of use of CL's mark - not least in order to establish the extent of any use within the relevant period and with regard to the services on which any such use was made, particularly in view of the wide claims made by CL. The evidence of use filed was not extensive or particularly detailed and I cannot see that it would have been a particularly complex exercise to collate. In view of my findings as to the extent of the use shown, I do not consider the request to have been in any way "unnecessary". As to the amount of evidence filed by GF, it consisted of two, fairly brief, witness statements. The first, by Mr Prakasham, consists of some 27 paragraphs. After the usual introduction of the witness himself and brief details of his company, the vast majority of the remainder consists of submissions, though there are some references to how different legal firms sometimes have the same surname as part of their company names. The second witness statement consists of two paragraphs and introduces details of other legal firms who share part of their names with other firms. I have not found this material to be of any relevance to the issues to be determined. The evidence would have taken little time for CL to review. I do not consider it to be "significant" either by volume or content and whilst it would have had to have been "considered", I do not think it would have needed a particularly "detailed review and reply".

59. I take note that no hearing took place and that CL succeeded in respect of its objection under section 5(2)(b) only. I make the award on the following basis:

For preparation of a statement and reviewing the other side's statement:	£300
Official Fee:	£200
For filing and reviewing evidence/submissions:	£500
<b>TOTAL:</b>	<b>£1000</b>

60. I order GetFriday (a division of TTK Services Pvt Limited) to pay Conveyancing Local Limited the sum of £1,000. This sum is to 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 22<sup>nd</sup> day of March 2012**

**Ann Corbett  
For the Registrar  
The Comptroller-General**