

O/141/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK 3315911

BY

POSITIVE ORGANISATIONS & PEOPLE LTD

TO REGISTER THE FOLLOWING MARK IN CLASSES 35 AND 41



AND

THE OPPOSITION UNDER NO. 600000953 THERETO

BY

PSP COMPANY BVBA

Background and Pleadings

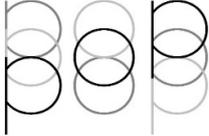
1. POSITIVE ORGANISATIONS & PEOPLE LTD (the Applicant) applied to register the mark as shown on the front cover page on the 6 June 2018 for services in classes 35 and 41 shown below. It was accepted and published on the 22 June 2018.

Class 35: Business management consultancy in the field of executive and leadership development.

Class 41: Coaching [training]; life coaching (training); training or education services in the field of life coaching; sales training services; sales training services for retailers; educational services relating to sales training; sales personnel training services; training relating to sales.

2. PSP COMPANY BVBA (the Opponent) opposes the application by way of the fast track opposition procedure, under section 5(2)(b) of the Trade Marks Act 1994 (the Act) relying on its two earlier EU registered trade marks numbered EU016150773 (Mark 1) and EU016150807 (Mark 2) which were filed on the 12 December 2016 and registered on the 12 May 2017 respectively. Both the earlier marks are registered for goods and services in classes 9,16, 35, 36 and 41.

3. For the purposes of this opposition the Opponent is only relying on its services in classes 35 and 41, listed below, for which the marks are registered claiming that there is a likelihood of confusion under section 5(2)(b) because the trade marks are similar and are to be registered for goods or services identical or similar to those for which the earlier marks are protected.

Earlier Mark 1 EU016150773	Earlier Mark 2 EU016150807
	
<p>Class 35: Business auditing; business management analysis; business research and surveys; business assistance and management; business and management advice, consultancy and information; human resources management; staff placement services; personnel management; recruitment services; organization of office functions; providing information in the fields of business and management;</p>	<p>Class 35: Business auditing; business management analysis; business research and surveys; business assistance and management; business and management advice, consultancy and information; human resources management; staff placement services; personnel management; recruitment services; organization of office functions; providing information in the fields of business and management;</p>
<p>Class 41: Educational, and training services; staff and management personnel training services; coaching services; arranging and conducting of seminars, symposia, meetings, exhibitions, classes and workshops; providing information in the fields of training; publishing and reporting services; publication of texts, other than advertising texts; publication of teaching materials; publication of instructional materials; multimedia publishing services; audio and video editing, production, recording and distribution; film editing, production, recording and distribution.</p>	<p>Class 41: Educational, and training services; staff and management personnel training services; coaching services; arranging and conducting of seminars, symposia, meetings, exhibitions, classes and workshops; providing information in the fields of training; publishing and reporting services; publication of texts, other than advertising texts; publication of teaching materials; publication of instructional materials; multimedia publishing services; audio and video editing, production, recording and distribution; film editing, production, recording and distribution.</p>

4. The Applicant filed a defence and counterclaim denying the claims made, refuting that the trade marks are “confusingly similar” and putting the Opponent “to strict proof that any or all of the services protected .. are identical or similar”. As the Opponent

has rightly pointed out in its submissions neither party has sought leave to file evidence and the matter has proceeded in accordance with the fast track procedure.

5. Both parties are professionally represented, the Applicant by Appleyard Lees IP LLP, the Opponent by Baron Warren Redfern. The Applicant did not file further submissions, relying on its statement of grounds. Only the Opponent filed submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

Decision

6. The opposition is based on section 5(2)(b) of the Act which states:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

7. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

(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.”

8. In these proceedings, the Opponent is relying upon its EU registrations shown above, which qualify as earlier trade marks under section 6 of the Act. As the earlier marks had been registered for less than five years at the date the application was published they are not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon all the goods and services of its registrations without having to establish genuine use.

9. The following principles 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.

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, 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.

Comparison of the services

10. The Opponent is relying on identical services in its opposition for each of its marks and therefore I will consider the services comparison globally for both. The competing services are as follows:

Applicant's Services	Opponent's Services
Class 35: Business management consultancy in the field of executive and leadership development.	Class 35: Business auditing; business management analysis; business research and surveys; business assistance and management; business and management advice, consultancy and information; human resources management; staff placement services; personnel management; recruitment services; organization of office functions; providing information in the fields of business and management;
Class 41: Coaching [training]; life coaching (training); training or education services in the field of life coaching; sales training services; sales training	Class 41: Educational, and training services; staff and management personnel training services; coaching services; arranging and conducting of

<p>services for retailers; educational services relating to sales training; sales personnel training services; training relating to sales.</p>	<p>seminars, symposia, meetings, exhibitions, classes and workshops; providing information in the fields of training; publishing and reporting services; publication of texts, other than advertising texts; publication of teaching materials; publication of instructional materials; multimedia publishing services; audio and video editing, production, recording and distribution; film editing, production, recording and distribution.</p>
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11. The Applicant argues that its services relate to “leadership development and life coaching services” and denies that the contested services are identical or similar. For the purposes of this opposition, the matter can only be determined on the basis of the specifications as registered and applied for. The Opponent sets out in detail an analysis as to why it considers the competing services are similar or identical and argues that it is at a loss to understand the distinctions claimed by the Applicant. Whilst I have considered both parties’ respective arguments I do not propose to reproduce them in any great length but I have taken them into consideration in so far as they are relevant in reaching my decision.

12. When conducting a goods and services comparison, I am mindful of the judgment of the Court of Justice of the European Union (CJEU) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where 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”.

13. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. In addition, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

15. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05, the General Court (GC) stated that even if goods or services are not identically worded they can still be considered identical if one term is encompassed within another broader term and vice versa:

29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

16. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating that:

“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”.

17. The purpose of business consulting services is to provide advice on how to develop and expand all aspects of a business including its management. A professional offering advice on how to run a business efficiently may reasonably include advice and assistance directed towards the skill set of the senior management team.

18. Applying the guidance in *Meric* the Applicant’s “*Business management consultancy in the field of executive and leadership development*” is identical to the Opponent’s “*business management analysis; business assistance and management; business and management advice, consultancy and information*” services.

19. All the Applicant's services in class 41 are encompassed by the Opponent's "coaching services; educational and training services." Coaching, educational and training services include the provision of life coaching and sales training.

Average Consumer

20. When considering the opposing marks, I must determine, first of all, who the average consumer is for the services and the purchasing process. The average consumer is deemed reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods and services in question.¹

21. 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."

22. Both parties are in agreement regarding the average consumer and the level of attention undertaken. The Applicant submits in its counterstatement that the average

¹ Lloyd Schuhfabrik Meyer, case c- 342/97.

consumer is “*well-informed and with a higher degree of attentiveness – a business consumer.*” It concurs with the Opponent’s submissions that the average consumer will be highly observant due to the nature of the services targeting business professionals.

23. In my view the average consumer for both sets of services will vary from members of the general public wishing to access information on or participate in a training course, to professional business users; a company or organisation wishing to instruct a coach/trainer or management consultant to train, advise and develop its staff and expand its business. Both circumstances give rise to a reasonable to high degree of attention in the purchasing process involving research into the cost and reputation of the service provider. Choosing the right provider to design a bespoke training plan or give advice on developing a business will be an important factor for any organisation. These are unlikely to be frequent purchasing decisions as they are likely to represent a not insignificant monetary investment from either the individual or the business user.

24. In relation to the purchasing process, the services are selected primarily through visual means with consumers purchasing the services online through websites and internet search engines to locate the providers of such services or equivalent advertising materials. However, as the services may also be subject to word of mouth recommendations from for example, one business user to another, aural considerations would also play a part.

Comparison of the marks

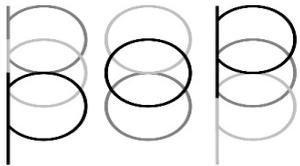
25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The

CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

26. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

27. The respective trade marks are shown below:

Applicant's mark	Opponent's Mark 1	Opponent's Mark 2
		

28. The Opponent asserts, when comparing its first mark with that of the Applicant's that both the phrases PEOPLE ON POINT and POSTIVE ORGANISATIONS & PEOPLE are generic and do not add any distinctive character to the word POP, such that the average consumer would disregard said word elements as being mere

marketing slogans. In relation to its second mark the Opponent asserts again that the mark will be seen as the stylised word mark POP and therefore argues that because of this both marks will be seen / perceived as POP marks and that they would share similarity to between a medium and a high degree with the later mark.

29. The Applicant on the other hand argues that consumers will recognise that the figurative "pop" element of its mark is an acronym of POSITIVE ORGANISATIONS & PEOPLE. It argues that due to the figurative presentation of the Opponent's word "pop" that the word would not be immediately obvious to the consumer. In relation to the Opponent's first mark consumers will recognise that POP is an acronym for PEOPLE on POINT and see it as a metaphor having no meaning in English. It argues that the additional figurative and word elements distinguish the marks from each other leading to no similarity.

30. Whilst I have taken note of all the parties' arguments in relation to the similarity or otherwise of the marks, I will undertake my own comparison which is as follows:

The Applicant's Mark

31. The Applicant's mark is a complex mark comprising a number of components:

- i. the word "pop" presented in emboldened lower case in black and pink;
- ii. the tick sign above the letter "o" also in pink;
- iii. the words "POSITIVE ORGANISATIONS & PEOPLE" which are centrally aligned immediately underneath the word pop in smaller lettering presented in a fainter shadowed text in capitals.
- iv. an underscore in the same shadowed text as the words presented above it.

32. The main components of the mark are the word pop, the tick symbol and the words POSITIVE ORGANISATIONS & PEOPLE. It is the word pop which attracts the most attention, due to its size, font, emboldened lettering and positioning. It is this word which is the more dominant element creating the greatest impact in the overall impression of the mark. The remaining words POSITIVE ORGANISATIONS & PEOPLE will be perceived as a strap line or mission statement and will play a lesser role in the overall impression of the mark. The colour combination and the underscore perform a limited role in the overall impression. The Applicant states that the tick above the “o” is a diacritic, however I would not describe it as such; unlike an accent or cedilla, its function in the mark is not to elongate the vowel nor to change the pronunciation of the word pop. To my mind the tick above the “o” will be seen as a tick, giving emphasis to the word pop and if the connection is made with the strap line at all, reinforcing the positive statement. Pop is a dictionary word and whilst pop may, on greater inspection, be understood as an acronym for the strap line underneath, average consumers are likely to focus on the word itself. They are unlikely to notice the connection without engaging in an abnormally high level of analysis. It is the word pop which dominates the mark and which will be retained in the mind of the average consumer.

Opponent’s Mark 1

33. The Opponent’s first mark consists of the word pop in triplicate, presented in an overlapping sequence. The letters are presented in gold, red and black in various combinations. The mark also contains the words “People On Point” in black title case, which will be seen as the organisation’s moto or mission statement. Both elements are presented over a cream background. Initially the words “People On Point” draw the eye, however, it is the stylised aspect of the word pop which has the greater impact in the overall impression of the mark and which will be retained as the dominant element. The colours make a limited contribution in the overall impression of the mark.

Opponent's Mark 2

34. The Opponent's second mark comprises of the single word pop presented in triplicate in an overlapping sequence. Each letter is presented in various combinations of grey and black in degrees of emboldened shading. The overall impression of the mark resides in the totality of the word pop in its stylised form.

Visual comparison

35. Both the later mark and the Opponent's first mark are complex containing a combination of the word pop together with a phrase perceived as a strap line or mission statement. They differ in their colour combination, font and stylisation as well as the combination of words used within their respective strap lines/mission statements, although the word people appears in both. I find that the marks share a low level of visual similarity due to the number of different elements present in both marks.

36. In relation to the Opponent's second mark, visually the respective marks are similar in so far as they share the word POP, however they differ significantly in the stylisation and the additional elements present in the later mark. Weighing up the similarities and differences in stylisation and bearing in mind my assessment of the overall impression I find the marks to be visually similar to a medium degree.

Aural comparison

37. Aurally the Applicant's mark and the Opponent's first mark will be articulated in the conventional manner with the pronunciation of each verbal element in turn. For those that overlook the respective straplines, the marks will be articulated as 'pop' and

will therefore be aurally identical. For those that articulate all the verbal elements in each mark they are aurally similar to a low degree. I do not accept the Applicant's argument that the word "pop" in either of the earlier marks will be repeated and articulated as "Pop Pop Pop".

38. In relation to the Opponent's second mark and where only the word pop is articulated in the later mark, again they will be aurally identical; but where all the elements are articulated in the later mark I find that they are similar to a medium degree.

Conceptual Comparison

39. For a conceptual message to be relevant it must be immediately obvious to the average consumer ². Conceptually all three marks contain the common element pop which is a reference to popular culture, pop music or the sound pop. For those that recognise these meanings, they will apply in all three marks.

40. The Applicant's mark contains an additional verbal element which will be perceived as the organisation's strapline/mission statement; projecting a positive corporate message reinforced by the tick element above the letter "o". The Opponent's first mark also has an additional phrase perceived as a strapline/mission statement and which may be suggestive of their services hitting the mark or that their staff can deliver a bespoke service meeting the needs of the customer.

² Ruiz Picasso v OHIM [2006] e.c.r.I-643; [2006] E.T.M.R.29.

41. Whilst the meanings of the straplines cannot be ignored, overall, I believe more notice will be taken of the element POP and therefore on this basis the marks will share a good degree of conceptual similarity.

Distinctiveness of earlier marks

42. 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.”

43. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

44. Registered trade-marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer to those with high inherent characteristics such as invented words which have no allusive qualities.

45. The Opponent has not filed any evidence to show that its marks have enhanced their distinctiveness through use, and therefore I am only able to consider the position based on inherent characteristics.

46. The first earlier mark consists of the word “pop” and the strapline People On Point, considered to be common English words which do not have any obvious link or association with the services at issue. The POP element is quite stylised and of above average inherent distinctive character, as is the mark as a whole.

47. The Opponent’s second mark contains the stylised word pop in triplicate which has no apparent allusive or suggestive quality associating it to the services. It is clearly

an English word and ordinarily its level of distinctive character would be medium however I take into account the fact that the word pop will be seen as a novel, unusual name for consultancy/training services and, together with the stylisation, this elevates the mark to a higher than average degree of inherent distinctiveness.

Likelihood of confusion

48. When considering whether there is a likelihood of confusion between the marks I must consider whether there exists direct confusion, where one mark is mistaken for the other or whether there is any indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

49. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark, I conclude that it is another brand of the owner of the earlier mark.”

50. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

51. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

52. The Opponent submits in its conclusion that there is a *“likelihood of indirect confusion arising out of the average consumer believing the Applicant’s mark to be a new mark or a sub brand within a family of POP marks on the part of the Opponent’s business.”* Whereas the Applicant concludes that *“the general public are more likely to notice differences in short marks. It follows that the relevant business consumer is even more likely to notice the differences. Accordingly, the average consumer will be well able to differentiate and distinguish between the marks”*

53. I have identified the average consumer to be a member of the general public or business community paying a reasonable to high degree of attention and selecting the services primarily through visual means but with aural considerations also playing a role. I have found the services to be identical. With regards the first earlier mark, I have found the marks to be visually similar to a low degree and in relation to the second mark to a medium degree. Where only the word pop is articulated the marks are aurally identical, otherwise they are similar to between a low and medium degree. Conceptually the marks will share a good degree of similarity. I have found the first earlier mark to have an above average degree of inherent distinctiveness, with the word pop by itself in the second mark also having a higher than average degree of inherent distinctiveness.

54. To my mind there are three different ways for the Opponent’s first mark to be perceived by the average consumer; firstly, there will be those that only retain the word pop and nothing else from the mark, secondly there will be a proportion that recognise that the word pop is an acronym but do not recall the strapline it relates to and thirdly

those that retain all the elements of the mark recognising that the word pop is an acronym and connecting it to the mission statement displayed.

55. In *Interflora v Marks and Spencer* [2014] EWCA 1403 (Civ) the Court of Appeal held that it was appropriate to give due weight to the likely reactions of different sections of the public, provided that these represent the range of likely reactions of persons with the attributes of an average consumer. Kitchen L.J. stated that:

“129.... In deciding a question of infringement of a trade mark, and determining whether a sign has affected or is liable to affect one of the functions of the mark in a claim under Article 5(1)(a) of the Directive (or Article 9(1)(a) of the Regulation), whether there is a likelihood of confusion or association under Article 5(1)(b) (or Article 9(1)(b)), or whether there is a link between the mark and the sign under Article 5(2) (or Article 9(1)(c)), the national court is required to make a qualitative assessment. It follows that it must make that assessment from the perspective of the average consumer and in accordance with the guidance given by the Court of Justice. Of course the court must ultimately give a binary answer to the question before it, that is to say, in the case of Article 5(1)(b) of the Directive, whether or not, as a result of the accused use, there exists a likelihood of confusion on the part of the public. But in light of the foregoing discussion we do not accept that a finding of infringement is precluded by a finding that many consumers, of whom the average consumer is representative, would not be confused. To the contrary, if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then we believe it may properly find infringement.

130. In the circumstances of this case we are, of course, concerned with a claim under Article 5(1)(a) (and Article 9(1)(a)) in the context of internet advertising and the question to be answered was whether the advertisements in issue did

not enable reasonably well-informed and observant internet users, or enable them only with difficulty, to ascertain whether the goods and services so advertised originated from Interflora or an undertaking economically linked to Interflora or, on the contrary, originated from M & S, a third party. In answering this question we consider the judge was entitled to have regard to the effect of the advertisements upon a significant section of the relevant class of consumers, and he was not barred from finding infringement by a determination that the majority of consumers were not confused.”

56. Taking into account the decision in *Interflora* I consider that a greater proportion of average consumers would primarily focus on the word pop and dismiss the additional elements entirely or remember that pop is an acronym but have limited recollection of the words that the acronym represents. In either of these scenarios I find that the use of the word POP is distinctive in the context of business management consultancy and coaching, educational and training services. This is the element which will be retained in the mind of the average consumer and by which the mark will be referred, whether it is seen as an acronym or not. The average consumer even with a reasonable to high level of attention who comes across the later mark will in my view recognise that the marks are different but nevertheless assume that no one else but the brand owner would use the word “pop” in a trade mark for such services and therefore conclude that the respective marks will be regarded as one and the same undertaking. There is therefore a likelihood of indirect confusion.

Outcome

57. On the basis of my conclusion, the opposition succeeds under section 5(2)(b); subject to any appeal, the application is refused.

Costs

58. As the Opponent has been successful it is entitled to a contribution toward its costs. For fast track opposition proceedings, costs are capped at £500 according to TPN 2/2015. Applying that guidance, I award costs to the Opponent on the following basis:

Preparing a notice of opposition and reviewing the counterstatement:	£200
Preparing submissions in lieu of a hearing	£200
Official fee:	£100
Total:	£500

59. I order POSITIVE ORGANISATIONS & PEOPLE LTD to pay PSP COMPANY BVBA the sum of £500 as a contribution towards its costs. This sum is 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.

15th March 2019

Leisa Davies
For the Registrar