

O-142-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATIONS BY BUBBLE JOBS LIMITED  
UNDER NO 2580377 FOR THE TRADE MARK**

**BUBBLE**

**AND**

**UNDER NO 2580378 FOR THE TRADE MARK**



**AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO  
UNDER NOS 102395 AND 102394  
BY O2 HOLDINGS LIMITED**

## The background and the pleadings

1) On 5 May 2011 Bubble Jobs Limited (“the Applicant”) filed applications to register the following marks:

Application no 2580377	Application no 2580378
<b>BUBBLE</b>	

For both marks registration was sought for the same services, namely:

**Class 35:** Employment services; recruitment services; advice and assistance in relation to personnel issues, employment, career choice, finding employment, employing others and finding others for employment; advertising services for the purposes of employing others or seeking employment.

Both applications were published in the Trade Marks Journal on 17 June 2011.

2) O2 Holdings Limited (“the Opponent”) opposes the registration of the Applicant’s mark under application 2580377 on grounds under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Opponent opposes registration of the Applicant’s mark under application 2580378 on a ground under section 5(2)(b) of the Act. In both oppositions the Opponent relies on its UK trade mark no. 2425211B, which was filed on 22 June 2006 and registered on 13 August 2010, and on its Community trade mark (“CTM”) 5583646, which was filed on 14 December 2006 and registered on 16 June 2011. The consequences of these dates are that: i) both the Opponent’s marks constitute earlier marks in accordance with section 6 of the Act, and ii) neither is subject to the proof of use conditions contained in section 6A of the Act, the registration process for both of them being completed less than five years before the publication of the Applicant’s marks.

3) The Applicant filed counterstatements, denying the grounds of opposition, and the oppositions were consolidated. The Applicant filed evidence. The matter then came to be heard before me on 14 February 2013. The Opponent was represented by Mr Julius Stobbs of Ipulse IP Ltd. The Applicant was represented by Ms Kate Széll of Venner Shipley LLP.

## The evidence

4) The evidence consists of a witness statement filed by Ms Sarah Kate Széll of Venner Shipley LLP. She attaches to her statement as **Exhibit SKS1** an extract,

downloaded by her from the OHIM website, from the official file relating to the Opponent's earlier CTM mark 5583646.

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

5) At the hearing the parties were agreed that in essence the case comes down to the 5(2)(b) claim. In its amended statement of grounds the Opponent relies on a wide range of goods and services in the specifications of its earlier marks in classes 16, 35, 36, 37, 38, 39, 41, 42, 43 and 44. However, at the hearing Mr Stobbs agreed that the Opponent's best case resides in establishing identity and/or similarity between its class 35 services and those of the Applicant. He did not, however, abandon reliance on the other goods and services pleaded, if the class 35 services were found not to be similar.

6) Argument focused on comparison of the terms *advertising*, *business management* and *business administration* in the Opponent's class 35 services, the Opponent contending that these are identical, or at least very similar, to the services of the Applicant's Class 35 services. Mr Stobbs stated that the Opponent does not claim identity and/or similarity for any technical reason relating to full class coverage, and the parties made their submissions on the basis of a conventional comparison of the respective services, construing them in accordance with their natural meaning in the usual way. The technical class coverage reason referred to relates to the recent decision of the Court of Justice of the European Union ("CJEU") in Case C-307/10 "*IP Translator*". Much of Ms Széll's evidence relates to this, so it is not necessary to consider it, given that Mr Stobbs did not pursue the point. I agree that the Opponent's best case lies in comparison, under section 5(2)(b) of the Act, of its Class 35 services *advertising*, *business management* and *business administration* with the Class 35 coverage of the Applicant. I shall make my analysis accordingly.

7) Section 5(2)(b) of the Act reads:

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.

8) In reaching my decision I have taken into account the guidance provided by the CJEU in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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 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 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."

### **Clarity and precision of specifications**

9) Ms Széll drew my attention to another aspect of the *IP TRANSLATOR* case (C-307/10), in which the CJEU stated that goods and services within a trade mark registration must be identified with sufficient clarity and precision to determine the

extent of the protection conferred by the mark. The CJEU had also stated that some of the general indications in the class headings of the Nice Classification do not meet this requirement, and that this was the case where such terms were “*too general and cover goods or services which are too variable to be compatible with the trade mark’s function as an indication of origin*”. Ms Széll cited a decision of the General Court (“GC”)<sup>1</sup> and three decisions of the OHIM Boards of Appeal<sup>2</sup> in which it was found that, where terms are too vague, it is not possible to make a comparison between them and terms in another application or registration, and they cannot, therefore, be considered similar.

10) Mr Stobbs submitted that precision and clarity were not to be confused with breadth. He contended that *IP Translator* says that the wording of a specification needs to be clear and precise, not that it cannot be broad; also, that *IP Translator* permits general terms, for example class headings from the Nice classification, to be used, as long as they are not vague.

In *IP TRANSLATOR* the CJEU stated:

“49 Accordingly, Directive 2008/95 requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought.

54 In that connection, it must be observed that some of the general indications in the class headings of the Nice Classification are, in themselves, sufficiently clear and precise to allow the competent authorities to determine the scope of the protection conferred by the trade mark, while others are not such as to meet that requirement where they are too general and cover goods or services which are too variable to be compatible with the trade mark’s function as an indication of origin”.

11) In relation to understanding what terms used in specifications mean/cover I bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281: “When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.” In *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 Neuberger J held that the words must be given their natural meaning, subject to their being construed within their context; they must not be given “an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor”. However, I must also bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* (“*Avnet*”)[1998] FSR 16:

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<sup>1</sup> Case T-162/08 *GREEN BY MISSAKO*, in which the GC held that “*retail services in shops*” was too vague to allow a proper comparison with services under the mark applied for, since it did not specify the goods, or types of goods, to which the retail services related.

<sup>2</sup> R1052/2010-1, R1303/2012-2 and R647/2011-2

“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.”

Subsequently, giving judgment in the Court of Appeal in *Reed Executive PLC v Reed Business Information Ltd.* [2004] RPC 40, Jacob LJ quoted his earlier comments in *Avnet*, adding:

“44 ..... The proposition follows from the inherent difficulty in specifying services with precision and from the fact that a service provider of one sort is apt to provide a range of particular services some of which will be common to those provided by a service provider of another sort. Here, for instance, both sides publish advertisements for jobs and have done so for years. No-one who has looked into a Reed Employment high street shop could have missed these. Nor could anyone have missed RBI’s advertisements in their various magazines.

45. Accordingly, I think that principle applies here. What one must do here is to identify the core activities which make a service provider an ‘employment agency’.”

12) I do not agree with Ms Széll’s first line of argument that, following the CJEU’s judgment in *IP Translator*, the terms *business management* and *business administration* in the specifications of the Opponent’s mark lack the necessary clarity and precision to enable a comparison to be made with the Applicant’s specifications. In the alternative, she argued that the terms should be given a narrow interpretation. I would say that business administration is provided by a third party to a business to assist with, or take on, administrative tasks, such as secretarial, accounting, etc. Business management consists of day-to-day management of, and provision of advice and assistance in the development of, a business, in terms of its organisation, goals, objectives, etc. On this basis I consider the terms *business management* and *business administration* to have sufficient precision and clarity to enable them to be compared properly with the services covered by the Applicant’s marks

13) The Oxford Dictionary of English (3<sup>rd</sup> Ed) defines “advertising” as “the activity or profession of producing advertisements for commercial products or services”. It must be borne in mind that services covered by a trade mark registration are services offered to third parties. Accordingly, advertising can be viewed as consisting of stimulating business for third parties by publicising their goods and services, so as to produce custom for them. On this basis, I find that the term advertising too has sufficient clarity and precision to enable it to be compared properly with the Applicant’s services.

### **Comparison of the goods and services**

14) In making an assessment of the similarity of the goods/services, all relevant factors relating to the goods and services in the respective specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro- Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

15) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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.”

16) Whether goods/services are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

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

17) When comparing the respective goods/services, if a term clearly falls within the ambit of a term in the competing specification then identical goods/services must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal*

*Market (Trade Marks and Designs) (OHIM) Case T-133/05* even if there may be other goods/services within the broader term that are not identical.

18) Neither side filed evidence addressed to the issue of service similarity, so there is nothing to show whether there is any real overlap in trade. In view of this, I can only really consider factors which are obvious. In the absence of evidence I must adopt the approach of Neuberger J in *Beautimatic* and give the words their natural meaning, subject to their being construed within their context. I must also bear in mind the comments of Jacob J in *Avnet*. I will make the comparison with reference to the Applicant's services. I will go through them term by term (but grouping them when it is useful and reasonable to do so – see the comments of the Appointed Person in *Separode* BL O-399-10).

*Employment services; recruitment services; advice and assistance in relation to employment, employing others and finding others for employment*

19) Essentially, employment and recruitment services are services which are provided to businesses wishing to locate people for the purposes of employment. They would include the services offered by employment agencies and "headhunters". The purpose and nature of a business administration service is the provision of administrative assistance to complete certain administrative tasks. The purpose of business management is to assist in the running of the business, including matters of strategy and organisation. There is nothing implicit in this that they perform any form of recruitment function. Thus, the nature and purpose of employment or recruitment services differ from those of business administration or business management. The methods of use also differ. There is no evidence to suggest that the respective services compete, and what I have said about their nature and purpose indicates that they do not. Nor are any of the services indispensable or important for the use of those of the other side, in such a way that the relevant consumers may think that responsibility for them lies with the same undertaking.

20) Ms Széll contended that the users of the respective services are not the same: persons running a business might or might not also be its owners, but it would be in their capacity as managers that they would require employment or recruitment services; persons looking for someone else to run a business would be not its managers as such, but the owners or shareholders of the business. Nevertheless, the fact remains that, especially with small and medium-sized companies, the owners and managers will, in fact, often be the same. However, the mere fact that different services are supplied to the same users does not in itself indicate similarity.

21) Regarding channels of trade, Mr Stobbs said he was sure there are specialist agencies that deal with recruitment and employment and there are specialist agencies that deal with business management, and to a certain extent they may be different, but they can also overlap; this was the point. Ms Széll argued that if a business were looking to recruit staff, it would go to a recruitment agent. Neither side filed evidence to support its contentions. In the absence of such evidence, the natural and obvious conclusion is that the services are provided by discrete operators.

22) The analysis I have made above with regard to employment and recruitment services is also applicable to *advice and assistance in relation to employment, employing others and finding others for employment*, which are services which would be performed in connection with the provision of employment and recruitment services.

23) Accordingly, I find no similarity between *employment services or recruitment services or advice and assistance in relation to employment, employing others and finding others for employment* and either *business administration or business management*.

#### *Advice and assistance in relation to personnel issues*

24) The provision of advice on personnel issues is a more general function and could form part of considering operational strategies for a business. In view of this there appears to be some similarity with business management services which could touch upon personnel issues. I consider there to be some (reasonable) degree of similarity.

#### *Advice and assistance in relation to career choice, finding employment*

25) These are services supplied to employees rather than the businesses that employ them. They are not in competition, or complementary, with *business management* or *business administration*, and their purpose, use and users are different. There is no similarity.

#### *Advertising services for the purposes of employing others or seeking employment*

26) These services are covered by the Opponent's *advertising*. They are identical.

#### *Office functions*

27) I have borne in mind the term *office functions* in the earlier marks, but consider that this term brings no more to the table than the terms already compared, and does not improve the Opponent's position – a point which Mr Stobbs seemed to accept given that he too made his submissions with reference to the terms above.

#### *Other goods and services of the earlier marks*

28) At the hearing Mr Stobbs told me that "If you are not with us on Class 35, you are almost certainly not with us on the remainder of the services". I agree. I have considered the other goods and services covered in the Opponent's statement of grounds, and can see no points of similarity which improve the Opponent's position.

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

29) According to the case-law, the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see,

for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

30) Consumers for the Applicant’s and Opponent’s respective services will consist of the owners and/or managers of businesses seeking to outsource business management or administration functions, or to recruit staff. In the case of the Applicant’s services, potential consumers or “end users” may also consist of those seeking employment. Because of the value and important consequences of the employment relationship for both parties, I think all these categories of persons can be expected to show a reasonably high degree of care and attention in purchasing or using these services. I think a reasonably high degree of care attention would also be shown by businesses purchasing advertising services. I would expect sources like trade directories and the internet to play the main role in locating providers of all these services, so I think the purchasing/selection process will be primarily visual. But “word of mouth” and oral communications may also play a part, and aural considerations will not be ignored in my analysis

**The distinctiveness of the earlier marks**

31) The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24).

32) No evidence of enhanced distinctiveness through use has been adduced for the earlier marks, so I have only their inherent distinctiveness to consider. The word BUBBLE has an obvious meaning, but not one which has any descriptiveness or allusiveness in relation to the services of the earlier marks. The earlier marks have a reasonably high degree of inherent distinctiveness.

**Comparison of the marks**

**The Applicant’s marks:**

Application no 2580377	no	Application no 2580378
<b>BUBBLE</b>		

**The earlier marks:**

UK Trade Mark No. 2425211B		CTM No 5583646
<b>THE BUBBLE</b>		<b>THE BUBBLE</b>

33) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are shown above.

34) Whilst the use of the definite article adds something to the earlier marks, its contribution is not a significant one. BUBBLE is manifestly the dominant and distinctive element of the marks. As the sole element of the word mark in application no. 2580377, BUBBLE is its distinctive and dominant element. The prominent feature of application no. 2580378 consists of the word “bubble”, written in lower case. The font is in itself unremarkable, but very slightly distorted to create a suggestion of being written on a curved surface. The word is written in white on a purple background suggestive of bubbles, from which purple bubbles are seen rising. The device element is not insignificant, but it is the very distinctly presented word “bubble”, the simple message of which is supported and reinforced by the device, which clearly forms the dominant and distinctive element of the mark.

35) From a visual perspective, the Applicant’s word mark no. 2580377 consists of one word, the Opponent’s earlier marks of two; but the inclusion of the definite article in the earlier marks does not make a substantial difference to the overall visual impression, which is dominated in all cases by the word “bubble”. This remains true in the case of the Applicant’s device mark no. 2580378. Although its device element contributes some further visual differentiation to this mark, it is the clear and prominent word “bubble” which dominates it visually. There is a high degree of visual similarity between the Applicant’s mark no. 2580377 and the earlier marks, and a reasonably high degree of visual similarity in the case of no. 2580378. Aurally, the inclusion of the word bubble in all the marks will give them a high degree of aural similarity. Here too, the presence of the definite article in the earlier marks will not make a significant difference. Conceptually, though the specificity expressed by the definite article may make some difference, and fixes bubble as a noun rather than a verb, I do not consider the difference a conceptually substantial one. The word “bubble” creates a high degree of conceptual similarity between all the marks.

### **Likelihood of confusion**

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

37) I have found no similarity between the services of the earlier marks and the following services; accordingly, there can be no likelihood of confusion<sup>3</sup>:

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<sup>3</sup> See, for example, the CJEU’s judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07*.

*Employment services; recruitment services; advice and assistance in relation to employment, career choice, finding employment, employing others and finding others for employment.*

**The opposition fails in relation to the above.** Even if I had considered the Applicant's mark 2580377 to be identical with the earlier marks, the Opponent would have been in no better position under sections 5(1) or 5(2)(a) of the Act, the services not being identical or similar.

38) In relation to the services I found to be identical or similar, I have found the earlier marks to possess a reasonably high degree of distinctiveness, and that a reasonably high degree of attention will be employed in the selection/purchase of the services in question. I have found the word BUBBLE to be the dominant and distinctive feature of all the marks, and that there is a high or reasonably high degree of visual similarity between them, and a high degree of both aural and conceptual similarity. In view of this, I consider there is a likelihood of confusion in respect of the services of the application which I have found to be identical or similar with those of the Opponent. **The opposition therefore succeeds in respect of the following services:**

*Advice and assistance in relation to personnel issues; advertising services for the purposes of employing others or seeking employment.*

## **Outcome**

39) As a result of these consolidated oppositions the specifications of both applications will read:

**Class 35:** *Employment services; recruitment services; advice and assistance in relation to employment, career choice, finding employment, employing others and finding others for employment*

## **COSTS**

40) Both parties have achieved a measure of success in these consolidated proceedings. I therefore consider that each side should bear its own costs and I make no award of costs. In reaching this decision I have not overlooked Ms Széll's submission at the hearing that the Opponent's grounds of opposition had covered a very wide range of goods/services, and that the Opponent had been repeatedly asked to make clear which of their very wide range of goods/services they thought identical/similar to the Applicant's. Although the pleadings could have been made clearer at any earlier stage, the conduct is not one which I consider to justify altering my costs assessment. On balance, therefore, I see no reason to make an award of costs.

**Dated this 2nd day of April 2013**

**Martin Boyle  
For the Registrar,  
The Comptroller-General**