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TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO 2 593 361
IN THE NAME OF ASCENSION MEDIA GROUP LLP
TO REGISTER IN CLASSES 09, 35, 37, 41 AND 42 THE TRADE MARK: ASCENSION**

AND

**PARTIAL OPPOSITION THERETO UNDER NO 103 061
BY ASCENTION INFORMATION MANAGEMENT GMBH**

TRADE MARKS ACT 1994

In the matter of trade mark application 2 593 361 in the name of Ascension Media Group LLP, to register in classes 09, 35, 37, 41 and 42 the trade mark: ASCENSION

and

Partial opposition thereto under No 103 061 by Ascention Information Management GMBH

THE BACKGROUND, PLEADINGS AND ARGUMENTS

1. Ascension Media Group LLP (the applicant) applied to register the word only trade mark ASCENSION on 02/09/2011. The application was published in the Trade Marks Journal on 25/11/2011 in respect of a variety of goods and services. The following services are attacked in these proceedings:

Class 35:

Advertising; electronic data storage; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services connected with the sale of computer software, computer software for processing digital music files, video recordings featuring music.

Class 41:

Education; providing of training; entertainment; sporting and cultural activities.

Class 42:

Technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; none of the aforesaid services in relation to naval, military, meteorological or oceanographic products or services.

2. Ascention Information Management GMBH partially oppose the registration of the mark, based on Section 5(2) (b) of the Trade Marks Act 1994. This ground of opposition is on the basis of its earlier Community trade mark No 9 059 891 ASCENSION, applied for on 23 June 2010 and registered on 12 November 2010 in respect of several services, the following of which are relied upon in this opposition:

Class 35:

Business administration, namely business consultancy in the field of information management and information technology

Class 41:

Education; providing of training; entertainment; sporting and cultural activities; coaching; arranging and conducting of seminars, workshops (providing of training), training courses; providing of further training courses

Class 42:

Scientific and technological services and research, namely technical consultancy in the field of information management and information technology; computer software design.

3. The opponent argues that the respective trade marks are almost identical and the services are similar as all are concerned with computer software and/or related consultancy in the field of information technology or information management.
4. In its counterstatement, the applicant denies the claim made. Specifically, it argues that the trade marks are not nearly identical and that there is no word ASCENSION in German nor ASCENTION in English and as such they are immediately distinguishable. Further, it argues that it is not providing consultancy services in the manner understood and provided by the opponent.
5. No evidence was filed by either side (although the opponent included a website extract as part of its submissions which will be considered further below). Written submissions were filed by both parties. In addition, I wrote to the applicant prior to issuing this decision, inviting it to submit a fallback position in respect of part of it's applied for specification. No response was forthcoming. Neither party requested a Hearing and so this decision is taken following a thorough review of the papers.

DECISION

Likelihood of confusion – Section 5(2) (b)

6. The relevant parts of section 5 of the Act read as follows:

“(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”.

7. The leading authorities which guide me in this ground are from the CJEU: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn- Mayer Inc* [1999] RPC 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, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C- 334/05 P (LIMONCELLO). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to *the overall impressions* created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*
- (f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.
- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

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(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

The opponent's arguments

8. The opponent accepts that ASCENTION is not an English word. However, it notes that the appearance of the respective trade marks is almost identical. One different letter not altering the overall view of the marks. The opponent submits that the respective trade marks will be pronounced identically. In respect of the similarity of services, the opponent includes an extract from the applicant's website, which, according to the opponent, demonstrates that the applicant is providing consultancy services.

The applicant's arguments

9. The applicant denies the marks are almost identical and feels that the marks are readily distinguishable as there is no word ASCENTION in English and no word ASCENSION in German. As regards the opponent's use of an extract from its website, the applicant responds that the wording will be reviewed and in any case its activities are related to investments and not consultancy.

Preliminary remarks

10. In response to the arguments of the parties as regards the nature of the respective businesses in the marketplace, the current, or past, marketing undertaken by the parties is not relevant to the issues to be determined, as the GC stated in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05*:

"71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant

public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors – whether carried out or not – which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).¹

This decision therefore, must consider the specifications as filed and registered.

Comparison of the services

11. When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. 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.”

12. 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.”

13. I also take into account the following guidance: Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 stated:

“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

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should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

14. I also bear in mind how complementary is defined, namely in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 GC explained when goods are complementary:

“82 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).”

15. Further, taking into account issues as to the meaning of terms I bear in mind how terms are defined and considered eg: In “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” (*British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281). Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning (*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267). Consideration should be given as to how the average consumer would view the goods and services¹. In *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch) at paragraph 12 Floyd J stated:

“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.”

16. The earlier services are:

Class 35

Business administration, namely business consultancy in the field of information management and information technology.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; coaching; arranging and conducting of seminars, workshops (providing of training), training courses; providing of further training Courses

Class 42

Scientific and technological services and research, namely technical consultancy in the field of information management and information technology; computer software design.

The contested services are:

Class 35:

Advertising; electronic data storage; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services connected with the sale of computer software, computer software for processing digital music files, video recordings featuring music.

Class 41:

Education; providing of training; entertainment; sporting and cultural activities.

Class 42:

Technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; none of the aforesaid services in relation to naval, military, meteorological or oceanographic products or services.

Contested services in Class 35:

17. In comparing the respective services, I note that the earlier class 35 term is not business administration at large, which can encompass a very wide and diverse range of activities. Rather, it is limited to business consultancy and then further limited to such consultancy in the field of information management and information technology. These services are concerned with the provision of expert support and knowledge, the ultimate aim of which to ensure a business operates with maximum efficiency and effectiveness. This has a direct impact upon its profit margins etc. A consultancy service such as that described in the earlier service therefore may provide expertise with the aim of ensuring a business utilizes the best information management systems available and/or uses the most suitable information technology. The contested *advertising* (and advertising related services) are quite different in nature and purpose as they aim to communicate with an audience, for a particular effect, usually to encourage new custom. The respective services are not in competition with one another, nor are they complementary. I do not consider them to be similar. Further, I do not consider them to be similar to any of the other parts of the specification of the earlier registration, which seek to educate, entertain or otherwise provide consultancy and design services.
18. The contested *electronic data storage* is a service whereby companies maintain and manage electronic data on behalf of others. This is different in nature and purpose to the earlier business consultancy term or indeed any of the earlier terms. They are not similar.
19. The contested *accountancy* is a specialist service whereby the financial records of a company or an individual are kept, audited and otherwise managed. This is quite different in nature and purpose to any of the earlier services. They are not similar.

20. The contested *data processing* services seek to synchronize information from a number of sources and then to present that information. It is often carried out by professionals in the field and is an everyday task for many, if not all, businesses. This differs from any of the earlier terms in nature and purpose. It is not similar to the services of the earlier registration; closely related to these services is the *provision of business information*, which is not considered similar for similar reasons. The remaining contested class 35 services are retail services which bring together items for sale, auctioneering which enable bids to be placed thus leading to a sale and opinion polling which seeks to gather information and intelligence from a target group. These all differ in nature and purpose to those of the earlier services and as such are not similar.

Contested services in class 41

21. The same terms appear in each of the respective specifications; they are identical.

Contested services in class 42:

22. The term *technological services and research* appear in each specification. They are identical, despite the earlier limitation. Further, I consider that the earlier term can include aspects of technological design. This contested term is therefore also identical.

23. The earlier term is *computer software design*. The contested term is *design and development of computer hardware and software*. Part of the contested term is clearly identical. Further, the development of computer software is highly similar as it is simply the next stage of a process, the outcome or purpose of which is to produce functioning software. *Computer programming; installation, maintenance and repair of computer software* are highly similar. The *design and development of related hardware* is also similar to the earlier *computer software design*, as software can be designed in a manner which means it is permanently stored on hardware (this is known as firmware). In such a circumstance the contested service can be another part in the process of the earlier service.

24. The contested *computer consultancy* services aim to provide information, advice and expertise regarding computers and computer systems. This function can equally be covered by the earlier term technical consultancy in the field of information technology. I consider these terms to be highly similar.

25. As regards the contested *design, drawing and commissioned writing for the compilation of websites*, I note that such a service can require skills in, for example, coding. However, this normally involves utilizing pre-existing software in order to create a website. While this may be suggestive of a degree of complementarity, it is not the same as computer software design per se. The nature and purpose is therefore different and I do not consider the respective services to be similar. Likewise, I consider *creating, maintaining and hosting the web sites of others* are not similar.

26. The contested *design services* is a very broad term which can include a wide range of diverse design related activities. This includes the earlier computer software design. In the absence of any fallback position from the applicant (I refer to a letter to the applicant inviting a revised specification above), I consider them to be identical.

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27. This leaves me to consider the contested term *industrial analysis and research* services. Bearing in mind the guidance in *Avnet*, referred to above, I consider this term to be referring to industrial processes and industrial research. This appears to be entirely different in nature and purpose to any of the earlier services. I consider that they are not similar.

28. In summary therefore, I consider the following contested services to be either identical or similar to those of the earlier trade mark:

Class 41:

Education; providing of training; entertainment; sporting and cultural activities.

Class 42:

Technological services and research and design relating thereto;; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design services; none of the aforesaid services in relation to naval, military, meteorological or oceanographic products or services.

The remaining services are not considered to be similar.

Comparison of the marks

29. 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. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

30. The respective trade marks have already been displayed above but for convenience are also shown below:

ASCENTION	ASCENSION
Earlier trade mark	Contested trade mark

31. The respective trade marks are both word only and, with the exception of one differing letter, coincide entirely. They are highly similar visually.
32. Aurally, the matter is even clearer. The final syllable “tion” and “sion” would be enunciated in an identical manner as would the remainder of each of the trade marks. They are aurally identical.
33. In comparing the trade marks conceptually, I am reminded that I must consider the matter from the position of the average UK consumer who will be an English language speaker. Conceptually, the contested trade mark will be understood as meaning “the act of ascending” (Collins English Dictionary), which is, rising, moving upwards. Though it is true, as argued by the applicant, that the earlier trade mark does not exist in the English language, it is in my view, highly likely to also be understood as the act of ascending. There is nothing in its appearance or enunciation that can avoid that. They are conceptually identical.

Distinctive and dominant components

34. The respective trade marks are each comprised of only one component and so the answer here is straightforward. Bearing in mind all of the foregoing, I consider the trade marks to be so highly similar as to be almost identical.

Distinctiveness of the earlier trade mark

35. The degree of distinctiveness of the earlier trade mark must also be assessed. This is important because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). No evidence has been filed in these proceedings and so I must consider the degree of distinctiveness on a prima facie basis. The distinctive character of a trade mark 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 (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00). In determining the distinctive character of a 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 Attenberger* Joined Cases C-108/97 and C-109/97). As already considered, ASCENTION has no meaning in respect of the services in question. It is assumed therefore to have at least an average degree of distinctiveness.

The average consumer

36. The case-law informs me that 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 GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).
37. The relevant public for the services in question here will be comprised of businesses in respect of, for example, services such as consultancy, software design etc but will

also include the public at large in respect of services such as retail and education. The level of attention displayed may also be diverse, in that the acquisition of business consultancy may represent a significant monetary investment for a business and so one would expect the degree of attention to be displayed to be high, whereas in the instance of purchasing a computer game, one would expect the level of attention to be displayed to be lower, though still probably reasonably considered.

Global Assessment – Conclusions on Section 5(2)(b)

38. It is clear that the factors assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that 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.
39. In respect of the remaining services, found to be identical or similar, I have already found the trade marks be to be highly similar overall. Indeed, aurally and conceptually, they are identical. It is true that there is likely to be a reasonably high degree of attention displayed during the purchasing process, at least in respect of some of the services. However, I must balance this against the fact that consumers rarely have the opportunity to view trade marks side by side and instead rely on an imperfect picture of them. Bearing in mind all of the aforesaid, I consider that there is clearly a likelihood of confusion between these marks.
40. The partial opposition therefore partially succeeds, in respect of the following services:

Class 41:

Education; providing of training; entertainment; sporting and cultural activities.

Class 42:

Technological services and research and design relating thereto; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design services; none of the aforesaid services in relation to naval, military, meteorological or oceanographic products or services.

It fails in respect of the remaining services opposed.

COSTS

41. Though each party has achieved a measure of success in these proceedings, it is clear that the opponent has been proportionally more successful than the applicant. As such, it is entitled to a contribution towards its costs. I award the opponent the

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sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Statutory fee for filing opposition - £200

Filing notice of opposition and considering counterstatement- £200

Filing submissions and considering the applicant's submissions - £200

Total - £600

42. The above sum should 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 15th day of May 2013

Louise White

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