

O-225-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3192769
BY DIARMAID WALSH
TO REGISTER THE TRADE MARK**



**IN CLASS 42
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000629
BY THE SECRETARY OF STATE FOR DEFENCE**

BACKGROUND

1. On 23 October 2016 Diarmaid Walshe applied to register the trade mark shown on the cover page of this decision for the following services in Class 42:

Archaeology services; research services

2. The application was published for opposition purposes on 13 January 2017.

3. The application is opposed in full by The Secretary of State for Defence (“the opponent”) under the fast track procedure. The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the following two UK trade mark registrations:

i) 3192581



Filing date: 21 October 2016

Registration date: 13 January 2017

ii) 3192564

Operation Nightingale

Filing date: 21 October 2016

Registration date: 13 January 2017

4. The specifications for the above registrations are identical. The opponent indicates that it relies upon some of the services in its registrations, shown in paragraph 16 below.

5. Mr Walshe filed a counterstatement in which he denies the ground of opposition. He states:

“The logo of both applications are totally different in design and in no way could they be confused with each other.”

6. Rules 20(1)-(3) of the Trade Marks Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. In a letter to the Tribunal dated 19 June 2017, Mr Walshe sought leave to file evidence; the request was provisionally refused and, as Mr Walshe did not ask to be heard in relation to that decision, the refusal was automatically confirmed.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

9. In these proceedings the opponent is represented by Christopher Shea, an in-house legal representative; Mr Walshe is not professionally represented. A hearing was neither requested nor considered necessary. Neither side filed written submissions.

DECISION

Section 5(2)(b)

10. Section 5(2)(b) of the Act 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”.

11. 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) or 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.”

12. In these proceedings, the opponent relies on its registration nos. 3192581 and 3192564. In my view, the opponent’s strongest case lies in 3192564: if it cannot succeed in respect of this earlier registration, it will be in no better position as regards its other mark. I proceed on that basis. Registration no. 3192564 is an earlier trade mark within the meaning of Section 6(1) of the Act. As this earlier trade mark had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent is entitled to rely upon it without having to demonstrate genuine use.

Section 5(2)(b) case law

13. 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 great degree of similarity between the marks, and vice versa;

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

14. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (GC) stated:

“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. The competing services are as follows:

Mr Walshe’s services	The opponent’s services
Archaeology services; research services.	Archaeological research; advice and information on the aforementioned service.

17. The opponent’s *archaeological research* is encompassed by the broad term *archaeology services* in the application. The contested *research services* in the application encompass the opponent’s *archaeological research*. The parties’ services are identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

18. As the case law cited in paragraph 13 indicates, it is necessary for me to determine who the average consumer is for the services at issue; I must then determine the manner in which these services will be selected in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

19. I have no submissions from the parties on whom the average consumer for the services at issue might be. As the parties' services, which I found to be identical, are essentially services related to archaeological research, I would expect the average consumer to include professional users such as museums, universities and local authorities. Given the specific nature of the services, the degree of care and attention deployed during the selection will normally be higher than average. The services are likely to be selected predominantly by visual means following perusal of material such as advertisements, brochures and websites but oral dealings may also play a part.

Comparison of marks

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

Applied-for mark	Earlier mark
	<p data-bbox="938 416 1246 450">Operation Nightingale</p>

Overall impression

22. The overall impression of the earlier mark is of the combination of the words Operation Nightingale, both presented in title case. Neither of these two words dominates the other and together they form a complete phrase.

23. The contested mark consists of a circular device made up of a number of components. There is a figurative element composed of three stylised body silhouettes in the centre. The silhouettes, which are in blue, red and light blue are presented against a white background and create the impression of two adults and one child hugging. The words ARCHEOLOGY, ENJOYMENT, COMMUNITY and LEARNING appear vertically aligned (reading top to bottom) along the semi-circular shapes created by the stylised arms of the silhouettes; however, due to their very small size, they are hardly legible. This element is surrounded by a light blue circle with golden borders. The words MILITARY, VETERANS, COMMUNITY and FELLOWSHIP are included inside the light blue circle; these are written in black and in standard capital letters and separated by small dots. Around the whole is another, larger circle, also with golden borders, but in dark blue. It incorporates the words OPERATION NIGHTINGALE and HERITAGE presented in a golden colour and standard capital letters but in a larger size than the other verbal elements of the mark. The words OPERATION NIGHTINGALE and HERITAGE are placed in the top half and in the bottom half of the circle respectively, however, due to their length, the words OPERATION NIGHTINGALE occupy the largest portion of the circle.

24. The opponent contends that the distinctive and dominant features of the contested mark are the words OPERATION NIGHTINGALE. The words OPERATION NIGHTINGALE have no meaning in relation to the services and create, in my view, a striking combination. However, the contested mark cannot be reduced to the words OPERATION NIGHTINGALE since it is made up of a number of elements that contribute, to various degree, to its overall impression. That said, I find that due to its nature, size and positioning it is the component OPERATION NIGHTINGALE that will have the greatest relative weight in the overall impression. The circular device is ornamental in nature and in the context of the services at issue, which are *archaeology services* and *research services*, the word HERITAGE is allusive. Consequently, these elements will have very little relative weight in the overall impression the mark conveys. Whilst the figurative element is also a distinctive component of the mark and makes a non-negligible contribution to its overall impression, given the presence of the words ARCHEOLOGY, ENJOYMENT, COMMUNITY and LEARNING and MILITARY, VETERANS, COMMUNITY and FELLOWSHIP, the consumer will take some form of laudatory significance from the combination of these elements, along the line of the mark being perceived as a reference to the services (somehow) involving “military, veterans, community and fellowship” and promoting “archaeology, enjoyment, community and learning” with the device being attributed some sort of symbolic association with the positive concepts conveyed by the words.

Visual similarity

25. Visually, the marks at issue coincide in the words OPERATION NIGHTINGALE. Overall, I find that taking into account the similarities created by the shared element OPERATION NIGHTINGALE and the visual differences which stem from the presence of additional elements in the contested mark, as a whole, the marks are visually similar to a low degree.

Aural similarity

26. The earlier mark will be pronounced as OPERATION NIGHTINGALE. This is also the element that the average consumer will easily refer to (and retain in his memory) when encountering the contested mark as a result of both its dominant and distinctive

nature and its position within the mark. Whilst the contested mark also includes the words HERITAGE, MILITARY, VETERANS, COMMUNITY, FELLOWSHIP, ARCHEOLOGY, ENJOYMENT, COMMUNITY and LEARNING, these words have descriptive/allusive connotations and are unlikely to be articulated. The marks are aurally identical. Were the word HERITAGE to be articulated, however, I conclude there would be, at least, a high degree of aural similarity.

Conceptual similarity

27. The words OPERATION NIGHTINGALE will be perceived in both marks in the context of the services at issue as referring to an operation, project or programme called NIGHTINGALE. The word NIGHTINGALE denotes a bird and is also a surname (although, in my experience, it is not very common). Consequently, the public could perceive OPERATION NIGHTINGALE in each mark as an operation named after a bird or a person whose surname is Nightingale. Though the contested mark includes additional concepts, due to their descriptive/allusive nature, the dominant concept in the mark remains that of OPERATION NIGHTINGALE. The marks are conceptually similar to a high degree.

Distinctive character of the earlier mark

28. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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).

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).”

29. As no evidence of use has been filed by the opponent, I have only the inherent distinctive character to consider. I have already found that the words OPERATION NIGHTINGALE forms a striking combination in relation to the services and is, in my view, possessed of an above average degree of distinctive character.

Likelihood of confusion

30. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective services and vice versa. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

31. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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 recognized 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 as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

32. Earlier in my decision I found that the respective services are identical. The marks are (potentially) aurally identical and conceptually similar to a high degree. The earlier mark is also distinctive to an above average degree. All of these factors points towards confusion. Nevertheless, the visual differences between the respective marks are

sufficient to rule out direct confusion, given that the purchase is primarily a visual one. The question, therefore, is whether taking all relevant factors into account there is a likelihood of indirect confusion. Having found that:

- i) the only point of similarity between the competing marks consists of the words OPERATION NIGHTINGALE;
- ii) the words OPERATION NIGHTINGALE is the only component of the earlier mark. It is also the component the average consumer will easily refer to (and retain in his memory) when encountering the contested mark;
- iii) the additional matter in the contested mark will be attributed some form of laudatory significance;

I conclude that, even taking into account the above average degree of attention paid to the selection of the services, the average consumer will regard the services provided under the marks to be the responsibility of the same or economically linked undertakings. **There is a likelihood of indirect confusion.**

CONCLUSION

33. The opposition succeeds.

COSTS

34. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in Fast Track opposition proceedings are governed by Tribunal Practice Notice (TPN) 2/2015. Using TPN 2/2015 as a guide, I award costs to the opponent on the following basis:

Official fees:	£100
Preparing a statement and considering the other side's statement:	£200
Total:	£300

35. I order Diarmaid Walshe to pay The Secretary of State for Defence the sum of £300 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.

Dated this 9th day of April 2018

**Teresa Perks
For the Registrar
The Comptroller – General**