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TRADE MARKS ACT 1994

IN THE MATTER OF OPPOSITION No. 407876

IN THE NAME OF BE WISER INSURANCE SERVICES LIMITED

TO TRADE MARK APPLICATION No. 3174629

IN THE NAME OF I GO 4 LIMITED

DECISION

INTRODUCTION

1. This is an appeal against the decision of Mr Salthouse dated 4 December 2017.
2. On 14 July 2016, i Go 4 Limited (the Applicant) applied to register the trade marks



in respect of the following services:

In Class 36: Insurance; Insurance brokerage; car insurance; insurance information; real estate insurance services; insurance consulting and advisory services.

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In Class 38: Telematics services.

3. On 14 November 2016 Be Wiser Insurance Services Limited (the Opponent) filed a notice of opposition based on a number of its own trade marks incorporating the word “Wiser” displayed in a number of forms.
4. This appeal is pursued in respect of the following marks and services only (the “Appellant’s Marks”):

UK Trade Mark No.	Mark	Services
3009812	BE WISER INSURANCE	Class 36: Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans
3068135	BE WISER	

5. The original hearing took place on 23 November 2017 when Ms Cookson of Messrs Filemot Technology Law Limited represented the Applicant; the Opponent chose not to attend but instead provided written submissions.
6. On this appeal the Opponent/Appellant was represented by Ms. Charlotte Blythe and the Applicant/Respondent by Mr Michael Edenborough QC.

The Approach to Appeals concerning likelihood of confusion

7. For the Opponent Ms. Blythe cited the decision of Ian Purvis QC, sitting as the Appointed Person in ROCHESTER Trade Mark (O-079-17), where he stated:
 33. I fear that far too much ink has been already spilled by Appellate Courts on these issues with diminishing returns, and I therefore do not propose to say a great deal more. So far as the particular context of this appeal is concerned, I would simply add that the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:
 - (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
 - (ii) The legal test ‘likely to cause confusion amongst the average consumer’ is inherently imprecise, not least because the average consumer is not a real person

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- (iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal
- (iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:

‘It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more “it depends on the evidence.”’

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

- 34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts.”

- 8. I agree that this is the correct approach.

The Decision Below

- 9. The only ground of opposition is under section 5(2)(b) which reads:

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

it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

- 10. When considering the issue under section 5(2)(b) the Hearing Officer cited the following principles derived 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:

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- (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;

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- (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.
11. It was not suggested that this summary was in any way inaccurate or incomplete, and I agree it represents a good précis of the legal approach.
12. When applying this to the facts of the case the Hearing Officer made findings as follows (original emphasis):
- (a) The average consumer and the nature of the purchasing decision - the nature of the services are such that the average consumer will pay a **medium to high degree of attention to the selection of such services** (§17). This finding is not challenged.
- (b) Comparison of services - **the class 36 services of both parties are identical, the applicant class 38 services are not similar to the opponent's class 36 services** (§25).
- (c) Comparison of trade marks – **overall the marks have a low degree of similarity** (§30). In his comparison the Hearing Officer focused on the Applicant's version of the mark without a coloured background as he believed that this was the Opponent's strongest case. He compared this with the Opponent's word-only mark 3068135 BE WISER mark as again he considered that this provided the Opponent with its strongest case:

Opponents' trade mark	Applicant's trade mark
BE WISER Be Wiser	

- (d) The Hearing Officer explained in §28 that the other word-only mark 3009812 relied on in this appeal has the word "insurance" included and whilst this would be seen as descriptive it also creates a visual and aural difference which is not present in the BE WISER mark.
- (e) Distinctive character of the earlier trade mark - the opponent's marks are **inherently distinctive to a medium degree**. (§36). This finding is not challenged.

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- (f) **The opponent has not shown use of its marks in the form that they are registered. As none of the marks relied upon has the owl logo and the words “be wiser” (apart from 3068422) the two marks I have chosen as providing the opponent’s strongest case cannot benefit from enhanced distinctiveness through use. (§36)**

13. Analysing all of these factors together to determine whether there was a likelihood of confusion, the Hearing Officer concluded in §38 that:

allowing for the concept of imperfect recollection, even when used on identical services in class 36, there is no likelihood of consumers being confused into believing that the services under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) therefore fails.**

14. He then went on to consider the likelihood of association, and concluded in §40 that the differences between the marks is such that the average consumer would not associate the marks of the applicant with those of the opponent so there is no likelihood of association. No separate point was pursued on appeal under this heading.

THE APPEAL

15. The Opponent raised five grounds of appeal before me.

Comparison of Services

16. The first ground was that the Hearing Officer erred in his comparison of the services. In particular it was suggested that the Hearing Officer made an error of principle at §25 of the Decision in finding that the Respondent’s Class 38 “telematics services” were not similar to the Appellant’s Class 36 “insurance” services. The Hearing Officer explained that finding in the following terms:

“25. ... Moving on to consider the applicant’s class 38 services, telematics is an interdisciplinary field that encompasses telecommunications, vehicular technologies, road transportation, road safety, electrical engineering (sensors, instrumentation, wireless communications, etc.), and computer science (multimedia, Internet, etc.). In the instant case it has been explained that “telematics services” relate to the provision of a black box which is fitted to a car and relays information regarding speed etc. thus enabling the insurance provider to have evidence of the drivers’ actual performance and hence adjust the insurance premium. For young drivers in particular it is a method which enables them to get affordable insurance albeit at the

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cost of some privacy. Whilst such services can be linked to the provision of car insurance they are not essential to its provision, whilst such technology plays no part in the provision of other forms of insurance, such as household insurance. In summary, ... the applicant class 38 services are not similar to the opponent's class 36 services."

17. Ms. Blythe accepted that this ground could only assist her if she first established that the Hearing Officer had erred in his conclusion based on the comparison of identical services in Class 36 under the other grounds of appeal. To this extent it is a subsidiary point. I deal with it nevertheless.
18. Ms. Blythe made two submissions. In her first she suggested that "telematics" services are identical to the Appellant's "insurance" services, on the grounds that "telematics" is a specific type of insurance and is therefore included within the more general "insurance" services designated by the Appellant's Marks pursuant to *Gerard Meric v OHIM*, Case T-133/05 at §29 (cited in the Decision at §20).
19. I reject that submission. Telematics is in a separate class from insurance services (class 38 v class 36) and I agree with the submission of Mr Edenborough QC for the Applicant that the two cannot be regarded as identical.
20. However I consider that Ms Blythe is on rather stronger ground in her alternative submission that telematics are complementary to insurance services so the two should be regarded as similar. As recognised by the Hearing Officer at §22, services are complementary where "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": *Boston Scientific Ltd v OHIM*, Case T-325/06.
21. Ms Blythe relied on the evidence submitted by the Applicant in these proceedings, namely the witness statement of Ms Jess Brown filed by the Respondent and the accompanying Exhibit JB1. Ms Brown explains that "telematics" in the context of motor insurance involves the fitting of a black box (or equivalent) into the customer's car to measure his or her driving behaviour and offers premium reductions in the event of safe driving scores. This is seen in particular in:
 - (a) Brown/§2, in which she describes the Respondent's product as "a telematics private motor insurance product".
 - (b) Brown/§5, in which she refers to the existence of the "telematics insurance sector" and the "telematics insurance market", and states that "telematics

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insurance is recognised by the relevant consumers as a distinct service from standard motor insurance”.

- (c) The article at JB1/p.1 by the British Insurance Brokers’ Association, which is entitled “40% increase in telematics motor policies in a year” and states that “Telematics is becoming the motor insurance solution of choice”.
 - (d) The article at JB1/p.3, which refers to insurance quotes from “telematics providers”.
22. This was recognised by the Hearing Officer at §6 where, in summarising Ms Brown’s evidence, he refers to the “telematics market” and “telematics based insurance”.
23. I consider that the evidence does establish that by the filing date a small but significant proportion of the car insurance market involved the offering of telematic services in combination with traditional motor insurance policies. Mr Edenborough submitted that there was no evidence that consumers would perceive that the supplier of the “black box” was the same as the supplier of the insurance services. However, I think that this is unrealistic given the evidence I have referred to.
24. It does not matter that there may be many examples of telematics which have nothing to do with insurance services. As in the *Boston Scientific* case, all that matters is that the two services would be seen as complimentary in certain circumstances. I consider that the evidence established that the two had become complimentary in the car insurance market (particular that targeting young drivers) by the filing date, and moreover the fact that the same consumers were targeted through the same distribution channels for telematics insurance is a further pointer towards similarity of services.
25. Accordingly I consider that the Hearing Officer was wrong to conclude that telematics are dissimilar to insurance services and I consider that there is a degree of similarity between them. However it is not the “high” degree of similarity which the Opponent urged upon me. In any event, for the reasons noted above this cannot assist the Opponent unless I decide the Hearing Officer was wrong for one of the additional reasons set out in the Grounds of Appeal, and it these to which I now turn.

The Be Wiser Insurance Mark

26. Ms Blythe’s second complaint was that the Hearing Officer erred in failing to address the BE WISER INSURANCE Mark.

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27. However, she accepted that the addition of the word INSURANCE made the marks less similar to each other, albeit that she submitted that it doesn't add much because INSURANCE per se is non-distinctive. She sought to rely on it because it was said that the mark BE WISER INSURANCE had been used extensively by the Opponent and therefore benefited from an enhanced level of distinctiveness.
28. There was a tension in Ms Blythe's submissions under this ground – on the one hand accepting that the marks were less similar, but stressing that INSURANCE was non-distinctive, but at the same time suggesting that BE WISER INSURANCE had significant additional distinctiveness over BE WISER acquired through use.
29. I do not consider that the Hearing Officer erred under this ground. He was entitled to consider that the BE WISER mark gave the Opponent its strongest case and there was therefore no need to consider the BE WISER INSURANCE mark separately and in addition (particularly given the large number of marks relied on by the Opponent below). I do not consider that the Opponent can succeed using the BE WISER INSURANCE mark if it fails relying on BE WISER.

Comparison of Marks

30. This was the ground upon which Ms Blythe focussed most at the hearing. It was suggested that the Hearing Officer made three material errors in his assessment of the similarity of the respective marks at §§29-30 of the Decision and therefore ought to have found that the mark applied for was visually, aurally and conceptually similar to the Appellant's Marks to a moderate or high degree.
31. First, it was submitted that the Hearing Officer erred in finding that the WISE DRIVING mark "technically does not have the word "wise" in it". It was suggested that in spite of the stylised letter "i", the word WISE was clearly still present and the Hearing Officer gave too much weight to the stylisation of that letter.
32. Second, Ms Blythe suggested that the Hearing Officer failed to give due weight to the similarity between the marks caused by the coincidence of the element WISE which was the dominant and distinctive element of the mark. She suggested that the average consumer would not distinguish between WISE and WISER.
33. Finally it was submitted that the Hearing Officer gave too much weight to the non-distinctive and descriptive word DRIVING and the stylistic elements which were described as banal.

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34. For the Applicant Mr Edenborough emphasised the findings of the Hearing Officer and in particular the device element in the mark applied for, the difference between the words wise and wiser and the fact that the Hearing Officer compared the marks in question as a whole. The Hearing Officer had put it like this at §§29 and 30:

29. Clearly, the opponent's mark consists of a series of two marks one which is in all upper case the other which features upper and lower case. The average consumer will pay no attention to this difference. Visually there are obvious differences in that the opponent's mark has the word "Be" as its first element and a letter "r" at the end of the word "wise" changing it to "wiser". The applicant's mark technically does not have the word "wise" in it. It has the letters "W" and "se" with a device element of road markings between which leads the average consumer to "see" the letter "i" and hence form the word "wise". The road marking device element is reinforced by the word "driving". The mark in suit is likely to be pronounced as "wise driving" so there are aural similarities and differences. To my mind the words "Be Wiser" will be seen as an instruction, an exhortation or advice to the consumer that smarter consumers will chose the opponent's services. The two words effectively form a unit. Similarly the whole of the applicant's mark forms a unit with the device element helping the consumer to form the word "wise" and reinforcing the driving element. It is accepted practice that the beginnings of word tend to have more visual and aural impact than the ends (*El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02). I also note that in *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

30. Whilst I accept that conceptual differences do not always overcome (*Nokia Oyj v OHIM*, Case T-460/07) in the instant case there are very obvious visual, aural and conceptual differences and few similarities. **Overall the marks have a low degree of similarity.**

35. Bearing in mind the observations of Mr Purvis QC noted above, I do not think the Hearing Officer's reasoning can be criticised. He plainly addressed all the relevant issues, including the fact that the mark applied for would be seen as forming the word "wise". He did not give too much weight to the stylistic "i" which is why he described the absence of the word "wise" as "technical". He was entitled to draw a

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difference between WISE and WISER because of the different context in which the two words were used in the marks as a whole – including the instructive nature of the Opponent’s mark. Nor did he err by pointing out the differences caused by the use of the device or the word DRIVING in the marks applied for.

36. In short, I think he was correct to conclude that the conceptual differences outweighed any visual and phonetic similarities and therefore that the marks had a low degree of similarity.

Assessment of Distinctive Character

37. The Opponent’s fourth ground of appeal alleged that the Hearing Officer had erred in his assessment of the distinctive character of the Appellant’s Marks. This involved criticism of the way the Hearing Officer had assessed the documentary evidence filed on behalf of the Opponent during the proceedings.

38. It is to be recalled that the Opponent elected not to make an appearance at the hearing below. Instead it put in written submissions only. Paragraph 6 of those submissions contained a brief summary of the evidence of Mr Dunkerley filed on behalf of the Opponent and paragraph 7 stated as follows:

7. It is therefore the Opponent’s position that its extensive use of the Opponent’s Marks, all of which included the WISER element, is such as to afford it enhanced distinctiveness in its “family of WISER marks” as a whole but also, importantly, in the WISER element of each of the Opponent’s Marks individually.

39. The Hearing Officer dealt with this submission by holding in §36 as follows:

36. The opponent’s marks, for the most part, have a large distinctive and independent owl logo coupled with an instruction such as “Buy wiser”, “insure wiser”, “quote wiser” and “be wiser”. All imply that the smarter consumer will use the services of the opponent. Unless educated otherwise, I consider it entirely possible that some consumers may assume that the company is called “owl insurance” and that they too can be as wise as an owl if they purchase the services of the opponent. The opponent’s marks are **inherently distinctive to a medium degree. The opponent has not shown use of its marks in the form that they are registered. As none of the marks relied upon has the owl logo and the words “be wiser” (apart from 3068422) the two marks I have chosen as providing the opponent’s strongest case cannot benefit from enhanced distinctiveness through use.**

40. Ms. Blythe criticised this finding and suggested that the Hearing Officer ought to have found extensive trade under and by reference to both the BE WISER Mark and

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BE WISER INSURANCE Mark. Although she accepted that in most cases the marks are used alongside an owl logo, she pointed out that the marks were generally separated from the owl by a border or otherwise distinguished by means of colouring, placement or intervening text. Further she suggested that the presentation of the owl logo (in terms of stance and relative positioning) varied from advertisement to advertisement.

41. She also pointed out that the owl logo does not always feature and relied on the use of the names BE WISER and/or BE WISER INSURANCE on the Appellant's website and in its domain name, bewiser.co.uk. She drew my attention specifically to Exhibit AD1/pp.34-35, 53, 67-100 and the Appellant's social media pages at Exhibit AD1/p.39. She criticised the Hearing Officer for not taking this evidence into account.
42. I do not accept this criticism for a number of reasons. First, it is clear that the allegation of enhanced distinctiveness was made in only very general terms before the Hearing Officer, as the extract from the written submissions quoted above demonstrates. At that stage the Opponent had not narrowed its case as it has sought to do on appeal and was relying on the family of WISER marks. This is a review, not a rehearing, and the Hearing Officer cannot be expected to trawl through pages of exhibits to identify a point which has not been adequately or specifically made in writing, nor in person at the hearing.
43. Even looking at the material afresh in the light of the submissions made on appeal I do not think the point is made out on the evidence. I have reviewed it all and I do not consider that there are grounds to interfere with the Hearing Officer's conclusions. The pages referred to above all still feature the owl logo and although there is occasional use elsewhere of BE WISER or BE WISER INSURANCE without an owl directly alongside, the overwhelming impact of the Opponent's marketing is to emphasise the owl device.
44. I therefore do not consider that there is basis to conclude that the specific marks relied on without an owl device possess enhanced distinctiveness sufficient to make any difference to the outcome of the present case. Such use is insufficiently established and/or widespread on the evidence to justify interfering with the conclusions of the Hearing Officer.

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The Conclusion that there was no likelihood of confusion was wrong

45. This wrap-up submission cannot succeed in the light of my findings above. It is plain that there is no basis for suggesting that the conclusion of the Hearing Officer was perverse, and none of the individual criticisms have attracted sufficient traction to justify a reassessment which would result in an alternative finding.

CONCLUSION

46. I therefore dismiss the appeal.
47. The parties agreed that costs should follow the event in the normal way.
48. I direct that the Opponent should pay the Applicant the sum of £1000 to represent the costs of the appeal in addition to the sum of £1900 ordered by the Hearing Officer, the total to be paid within 21 days of the date of this decision.

Thomas Mitcheson QC
The Appointed Person
24 April 2018

The Applicant was represented by Michael Edenborough QC instructed by Filemot Technology Law Ltd.

The Opponent was represented by Charlotte Blythe instructed by Blake Morgan.