

O-274-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3148229
BY NOVAL PROPERTIES LTD**

IN CLASSES 36 AND 37

AND

**THE OPPOSITION THERETO UNDER NO. 600000426
BY GATEHOUSE BANK PLC**

BACKGROUND

1. On 5 February 2016 Noval Properties Ltd (“the applicant”) applied to register the trade marks shown below in respect of services in classes 36 and 37:



2. The application was published for opposition purposes on 19 February 2016 and a notice of opposition was subsequently filed by Gatehouse Bank plc (“the opponent”) under the fast track procedure on 19 May 2016. On 18 October 2016 the applicant filed a request on Form TM21 to amend its application by restricting the specified services in class 36. The amendment was accepted by the registrar and it was put forward for consideration to the opponent. The opponent confirmed that it wished to continue with the opposition. Following the amendment, registration is sought (and opposition proceeds) in respect of the following services:

Class 36

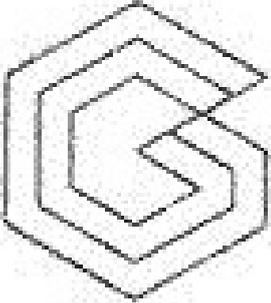
Real estate services; real estate management; property management; property portfolio management; property investment; real estate leasing; real estate valuations; real estate investment; real estate administration; real estate agency; rental of property; rental of offices; rental of buildings; rental of flats; rental of apartments; rental of real estate; rental of commercial premises; estate agency services for the sale and rental of buildings and land; rent collection agencies; building management; management of buildings; management of property; management of apartments; advice and consultancy in respect of all the aforesaid services.

Class 37

On site building project management; on site project management relating to the construction of buildings; property development services; development of land (construction); erecting of housing areas; construction of property;

maintenance of property; cleaning of property; renovation of property; plumbing installation, maintenance and repair; maintenance, repair and servicing of gas and electricity installations; maintenance and repair of utilities in buildings; installation, maintenance and repair of lifts; installation, maintenance, repair and servicing of security systems; installation, maintenance, repair and servicing of fire alarm systems and fire prevention equipment; consultancy and advice in respect of the aforesaid services; construction management services; advisory services relating to building construction; advisory services relating to the development of land.

3. The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the services in the application. The opponent relies on the earlier mark shown below:

<p>UK Trade Mark 3075315</p>  <p>Filing date: 3 October 2014</p> <p>Registration date: 20 March 2015</p>	<p>Class 36</p> <p>Banking services; Islamic banking services; financial services; commodity linked investment services; monetary services; real estate services, private equity and corporate finance services; asset management; arranging and structuring financial products relating to one or more of these services; consultancy and advice in relation to these services; all the aforesaid services including shariah-compliant services.</p>
---	---

4. The opponent argues that the respective marks are similar and that the respective services are identical or similar. It states:

“The opponent is the proprietor of the UK trade mark registration no. 3075315 for the mark G Logo in class 36 filed 3 October 2014. The trade mark applied

for is for highly similar G logo covering identical and highly similar services in class 36 and highly similar services in class 37.

Due to the similarity between the trade mark applied for and the opponent's earlier mark, and the identity/similarity of the services applied for, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the opponent's earlier mark. Due to the fact that the informed user may sometimes have an imperfect recollection of the sign –the likelihood of confusion and association between the respective signs is increased.”

5. The applicant filed a counterstatement in which it denies the ground of opposition. It denies that the contested mark is similar to the earlier mark such as to create a likelihood of confusion. It also denies that the services (as they stand after amendment) are identical or highly similar to the services covered by the earlier mark.

6. Rules 20(1)-(3) of the Trade Marks Rules (TMR) (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.

8. No leave was sought in respect of these proceedings.

9. 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.

10. A hearing was neither requested nor considered necessary. Both sides filed written submissions, which I will refer to as necessary, below.

DECISION

11. 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”.

12. 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.

13. Given its date of filing, the opponent’s mark is an earlier mark in accordance with Section 6 of the Act. As the opponent’s mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. Consequently, the earlier mark may be relied upon without having to prove use.

Section 5(2)(b) case law

14. 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

15. In comparing the respective specifications, all the relevant factors should be taken into account. 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”.

16. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

17. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...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”.

18. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services

is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

19. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

20. It should also be noted that, as per the judgment of the GC in *Gérard Meric v OHIM*, case T-133/05, goods and services can be considered identical when the goods and services of the earlier mark are included in a more general category, included in the specification of the application and vice versa.

21. The services to be compared are:

Opponent's services	Applicant's services
<p>Class 36</p> <p>Banking services; Islamic banking services; financial services; commodity linked investment services; monetary services; real estate services, private equity and corporate finance services; asset management; arranging and structuring financial products relating to one or more of these services; consultancy and advice in relation to these services; all the aforesaid services including shariah-compliant services.</p>	<p>Class 36</p> <p>Real estate services; real estate management; property management; property portfolio management; property investment; real estate leasing; real estate valuations; real estate investment; real estate administration; real estate agency; rental of property; rental of offices; rental of buildings; rental of flats; rental of apartments; rental of real estate; rental of commercial premises; estate agency services for the sale and rental of buildings and land; rent collection agencies; building management; management of buildings; management of property; management of apartments; advice and consultancy in respect of all the aforesaid services.</p> <p>Class 37</p> <p>On site building project management; on site project management relating to the construction of buildings; property development services; development of land (construction); erecting of housing areas; construction of property; maintenance of property; cleaning of property; renovation of property; plumbing installation, maintenance and repair; maintenance, repair and servicing of gas and electricity installations; maintenance and repair of</p>

	utilities in buildings; installation, maintenance and repair of lifts; installation, maintenance, repair and servicing of security systems; installation, maintenance, repair and servicing of fire alarm systems and fire prevention equipment; consultancy and advice in respect of the aforesaid services; construction management services; advisory services relating to building construction; advisory services relating to the development of land.
--	---

Class 36 services

22. Taking the class 36 services first, the applicant accepts that there is some similarity between the respective services. It states:

“We agree that there are some services in class 36 of the application that are identical to the services protected by the opponent’s mark, some similar and some dissimilar (for example the services of building management are clearly dissimilar). However, in view of the similarity of the marks, the similarity or otherwise of any services is irrelevant.”

23. The opponent’s class 36 services are mainly financial and investment related services. All of the services in the specification are separated by semi-colons however, I note, the term *real estate services* is framed as follows: *real estate services, private equity and corporate finance services* with the semi-colons being positioned before the term *real estate* and after the term *corporate finance services*. Although due to the arrangement of semi-colons and commas, it is unclear whether the *real estate services* of the earlier mark are provided as a stand-alone service or are somehow qualified by (or provided in connection with) private equity and corporate finance services, the applicant has accepted in its written submission that some of the respective services in class 36 are identical. It follows that since the only

identical term contained in both (class 36) specifications is *real estate services*, the applicant impliedly accepts that the respective *real estate services* are identical. In the absence of any claim on the part of the applicant that the extent of the opponent's *real estate services* should be somehow limited (and how) in light of the adjacent terms, I consider that the *real estate services* of the earlier mark are identical to the *real estate services* of the contested mark.

24. Working on that basis, the term *real estate services* is very broad and covers a wide range of real estate-related services. Consequently, it appears to be the global term for all of the specific services listed in the applied for class 36 specification. It follows that the opponent's *real estate services* encompass the following services of the contested mark: *real estate management, real estate leasing, real estate valuations, real estate investment, real estate administration and real estate agency*. Since the opponent's *real estate services* encompass *real estate agency*, it also follows that it encompasses the following applied for services which fall within the ambit of *real estate agency services*, namely, *rental of property, rental of offices, rental of buildings, rental of flats, rental of apartments, rental of real estate, rental of commercial premises, estate agency services for the sale and rental of buildings and land and rent collection agencies*. In addition, as the term *real estate services* in the opponent's specification covers *real estate management and real estate investment*, it also encompasses the following applied for services: *property management, property portfolio management, property investment, building management, management of buildings, management of property, management of apartments*. Further, the applied for *real estate investment and property investment* are also encompassed by the opponent's *commodity linked investment services and financial services*. Consequently the *real estate services* of the earlier mark encompass all of the applied for services in class 36 including *advice and consultancy in respect of all the aforesaid services*. Applying the principle in *Meric* services are identical.

Class 37 services

25. In relation to the applied for services in class 37 the opponent relies on EUIPO decision B2221631 S.C. *Arcada Company S. A. v Arcadia Investment GmbH* in which the Opposition Division found that the applied for *real estate affairs* serve a

related purpose and are complementary to the opponent's *building construction; repair; installation services*. The relevant part of that decision is reproduced below:

“The contested real estate affairs cover the range of operations which relate to real estate consisting of the building, sale, purchase, lease and management of real estate as well as intermediary services in any of these real estate activities. Although the nature and purpose of these services are different from the opponent's building construction; repair; installation services in Class 37, they are similar inasmuch as their objective is to effect operations of monetary value in relation to real estate (decision of 10/01/2012, R 518/2011-2 and R 795/2011-2, 'COMSA / COMSA, S.A.', paragraph 39 confirmed by judgment of 09/04/2014, T-144/12, paragraph 47).

Consequently, the services are complementary, since real estate affairs cannot be provided without the provision of services of property construction or repair. Moreover, said services can have the same origin inasmuch as construction companies can be (and, in fact, frequently are) owners of the buildings that they construct, in which case they would also promote the sale of the building. Consequently, these services are considered similar.”

26. As previously explained, the term *real estate services* in the opponent's class 36 specification contains no limits and it is broad enough to include real estate agencies, leasing and rental services as well as administration and management of real estates and real estate investment. The applied for services in class 37 include services relating to the management of building projects as well as services that involve the physical construction of buildings and their maintenance and cleaning. The respective services are not competitive and their purpose and nature are different. Further, I have no evidence regarding the trade channels, but, it seems to me that construction services (and maintenance and repair services) are not accessed via the same channels of trade as real estate services at large. Nevertheless, I agree there is a degree of complementarity not least because construction, repair and maintenance work goes hand in hand with the sale, purchase and rent of a property so that users can be the same. Further, those providing real estate management services may need to handle maintenance and repair issues; whilst the main company may sub-contract the work to third parties,

this does not prevent the public from attributing the responsibility to the main company itself. Finally property development is strictly connected to property investment. On that basis, I find that there is a low degree of similarity between the opponent's *real estate services* and all of the applied for services in class 37.

The average consumer and the nature of the purchasing act

27. As the case law above 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.

28. 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.”

29. The average consumer of the parties' real estate services in class 36 and of the applicant's services in class 37 are both the general public and commercial professionals although some of the applied for services, e.g. rental of commercial premises, property development services, are clearly limited to commercial consumers. I agree with the applicant that those looking for the services will pay close attention to selecting such services so, depending on the costs and level of investment at stake, the degree of care and attention will range from, at least, higher than average, i.e. rental of flats, to high, i.e. property development services. The selection process will be primarily visual with the services being selected from signage on the high street, i.e. estate agencies, and/or following perusal of brochures, directories and website information. Although I do not discount aural

considerations, as in some circumstances, the services might be the subject of word-of-mouth recommendations and/or discussions between the consumer and the provider, the visual perception of the mark will generally take place prior to the purchase. This is because, given the nature of the services, the mark will normally be used on premises, signage and vehicles and in advertising and promotional material, so that it will be perceived, for example, on premises where introductory meetings might be held, on forms and agreements which must be signed to access the services and/or tenders and quotations, which are normally received on headed papers.

Comparison of marks

30. 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 Court of Justice of the European Union (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.”

31. It would be wrong, therefore, artificially to dissect the marks, 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.

32. The marks to be compared are:

Applicant's mark	Opponent's mark
	

Overall impression

33. As a preliminary point I should say that since the earlier mark is not limited to colours, it is deemed registered in all colours, and the colours of the contested mark become irrelevant. For the purposes of comparison of the respective marks, therefore, the green version of the contested mark will be drained of colour, in accordance with the observations of Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch). Therefore, I will limit my consideration to the grey version of the same mark.

34. The opponent describes both marks as consisting of a capital letter G using three outer lines to form the letter. The applicant says that whilst the opponent's mark is most likely to be recognised as the shape of a hexagon, the contested mark looks like a maze. It provides the following eloquent description:

“The Opponent's mark is a slightly broken, six sided, regular, geometric shape, so much so that the design is most likely to be recognised as a simple hexagonal device (albeit one with a sharp “notch” taken out of it). It is entirely angular, using a multitude of straight lines presented in a sharp edged design that could be described as mechanical. The device is entirely closed, by which we say that there is no “entry” to the inside of the device from the outside of the device. It contains three enclosed areas bounded by thin straight lines.

In contrast, the Applicant's mark is a single line drawing, using only a very short straight line and otherwise consisting of entirely of curves. There are two points of entry in to the device, and the device might appear to represent a maze. The line used to draw the device is thick and rounded at each end, and

could be described as artistic rather than mechanical. It is beyond possibility that a consumer having seen one of the marks would then view the other as being similar, and there is no likelihood that a consumer would believe there to be an economic link between the users of the marks on the basis of their appearance.”

35. The applicant’s mark consists of the device of a curved line which emanates from a central point, bends into a horizontal stroke and revolves around itself three times. The device calls to mind a circular maze that looks like the capital letter G. Although the letter G is discernable, the fanciful stylisation of the mark is equally dominant and, arguably, more distinctive.

36. The opponent’s mark consists of a hexagon shaped device with two outer borders. The side length on the right hand side of the hexagon is split into two parts, the bottom half of which slides down diagonally into the hexagon itself. Contrary to the opponent’s claim, the device does not reproduce the typical elements of the letter G. The letter G is made up of a curved line, a vertical stroke and a small horizontal projection off the main stroke and I do not agree with the opponent that the hexagonal device will necessarily be associate with letter G. In this connection, I note that the name of the opponent is Gatehouse Bank plc. It might be that the intention of the opponent is to associate the device with the initial letter of its business name, i.e. G. However, the mark is registered as a device only and the assessment of the overall impression conveyed by it should be limited to the mark as registered, not carried out on the assumption that the mark will be used in conjunction with the business name and that, consequently, the average consumer will immediately perceive the device as the letter G because the name of the opponent begins with a G. In my view, without being aware of what the device is meant to represent, I do not think the argument that the consumer will associate the device with the letter G is tenable. In any event, even if I were to accept that the average consumer were to extract an abstract version of the letter G from the device, the stylisation is so striking that it will play the most distinctive role in the overall impression conveyed by the mark.

Visual similarity

37. The opponent states:

“Visually the marks are highly similar to the extent that they both consist of a capital letter G both using 3 outer lines to form a letter”

38. The devices at issue may be regarded as similar to the extent that they are made up of lines running in parallel. However, in the applied for mark there is only one curved line which rotate around itself calling to mind a maze that resembles the letter G whilst in the opponent’s mark there are three separate lines which form the shape of a hexagon with two outer borders and the vertical section on the left hand side split into two parts. Even accepting the opponent’s argument that both devices represent the letter G, the G in the opponent’s mark is much more abstract and the visual differences between the devices, due to their stylisation, prevail over the similarity. If there is any visual similarity between the marks it must be to a low degree.

Aural similarity

39. In relation to the assessment of aural similarity in case of device marks, in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T- 424/10 the General Court (GC) stated:

“45. The fact none the less remains that, contrary to what the applicant submits, a phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHMI — Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 67).

46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently,

it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.

47. In those circumstances, and given that the contested mark is a figurative mark lacking word elements, it cannot be concluded there is either a phonetic similarity or a phonetic dissimilarity between that mark and the earlier marks.”

40. Whilst a device mark will not always be articulated, the more a device mark resembles a letter, the more likely it is that consumers may perhaps attempt to articulate it. The graphic elements of the applicant’s mark look like a stylised letter G. On the other hand, the opponent’s mark is likely to be perceived as a device mark so that the average consumer is likely to describe rather than pronounce it. It follows that there is no aural similarity. But if the marks were pronounced as the opponent claims, i.e. as the letter G, they would be pronounced in an identical way.

Conceptual similarity

41. From a conceptual standpoint, no particular conceptual content will be attributed to either mark. Even if I were to accept the opponent’s argument that both marks will be perceived as a stylised letter ‘G’ there would be no specific semantic content (or concept) associated with that letter¹ and the common presence of the letter G would not give rise to a conceptual identity in the sense identified in the case-law.

Distinctive character of the earlier mark

42. 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

¹ See *Honda Motor Europe Ltd v OHIM* Case T 363/06 paragraph 42 and *Poloplast v OHIM — Polypipe (P)* Case T 189/09 paragraph 83

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).”

43. I have no evidence of use and no submissions from the parties on the distinctive character of the earlier mark. The opponent's mark has no meaning in relation to the services and it is essentially a geometrical shape although there is a degree of stylisation. As such, it has no more than an average degree of distinctive character.

Likelihood of confusion

44. 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 goods and services and vice versa. I must also keep in mind the average consumer for the goods and 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.

45. Earlier in this decision I found that the marks are visually similar to, at best, a low degree and that the marks do not appear to have any conceptual meaning. I also bear in mind that the earlier mark has no more than an average degree of distinctive character and that the services will be selected with a higher than average degree of care and attention which militates against imperfect recollection. However, this must be counterbalanced against the fact that some of the respective services are identical and that, given their nature, they will be selected relatively infrequently, so that the average consumer will not see the mark side by side but will have seen one mark and then, at a later date, will come across the other. Having given all these factors careful consideration, my conclusion is that the differences between the marks are such that, even when relying on memory, the average consumer is likely to retain them in his/her mind. There is no likelihood of confusion, either direct (where one mark is mistaken for the other) or indirect (where the respective similarities lead the consumer to believe that the respective services come from the same or a related trade source). Indeed, the position is even starker in relation to the class 37 services as the respective services are similar only to a low degree.

46. Insofar as the aural aspect is concerned, in *The Royal Academy Of Arts V Errea Sport S.P.A.* BL O-016-16, Mr Iain Purvis QC, sitting as the Appointed Person, rejected the appellant's submission that there was bound to be a likelihood of confusion where one mark consisted of letters and the other consisted of the same letters in (heavily) stylised form. He said:

“In essence [the appellant's attorney's] argument was that there was bound to be a likelihood of confusion in this case because of the aural 'identity' between the marks (if one tried to ask for goods using an aural version of the earlier mark, one would ask for 'RA' goods, just as one would ask for the applicant's goods). This argument seems to me to fly in the face of the necessary 'global' assessment, bearing in mind the visual, conceptual and aural similarities, which the tribunal must carry out. Particularly in the case of an earlier mark which is a heavily stylised device mark, taking the aural similarities alone tends to ignore the real substance and distinctive character of the mark and is likely to lead to an erroneous result.”

47. In the present case the respective marks are stylised devices used in relation to services which are likely to be selected primarily by visual means (and the opponent has not contended that the services are selected without a visual assessment of the marks). It follows that even if phonetic or conceptual similarities were found to exist between the signs, as the opponent claims, the relevant public would be capable of perceiving the visual differences and would not be led to believe that the services in question originate from the same undertaking or from economically-linked undertakings.

CONCLUSION

48. The opposition fails.

COSTS

49. As the applicant 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. I award costs to on the following basis:

Preparing a statement and considering the other side's statement:	£200
Written submissions:	£200
Total:	£400

50. I order Gatehouse Bank plc to pay Noval Properties Ltd the sum of £400 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 7TH day of June 2017

T Perks

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