

O-304-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2444369  
BY MRS PEREZ OCHIENG TO REGISTER THE TRADE MARK**



**IN CLASSES 25, 26, 35 AND 41**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 95308  
BY SANOMA WSOY Oyj**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2444369  
By Mrs Perez Ochieng to register the Trade Mark  
Sacoma (plus device) in Classes 25, 26, 35 and 41**

**and**

**IN THE MATTER OF Opposition thereto under No. 95308  
by Sanoma WSOY Oyj**

### **BACKGROUND**

- 1) On 23<sup>rd</sup> January 2007, Mrs Perez Ochieng of Sahara Communities Abroad, 108 Cranbrook Road, Ilford, Essex, IG1 4LZ applied under the Trade Marks Act 1994 (“the Act”) for registration of the following trade mark:



The application was published on 30<sup>th</sup> March 2007 and the goods and services for which registration was sought are as follows:

**Class 25:**

Clothing, footwear, headwear, textile nappies for babies, leather belts, shoes.

**Class 26:**

Lace, embroidery, ribbons, braid, buttons, hooks and eyes, pins and needles, artificial flowers, dressmakers items, badges to wear.

**Class 35:**

Advertising, business management, business administration, office functions, organising, operating and supervising loyalty and incentive schemes, advertising services provided on the Internet, producing television and radio adverts, accountancy, auctioneering, trade fairs, opinion polling, data processing, providing business information.

**Class 41:**

Education, providing training, entertainment, sporting and cultural activities

- 2) On 28<sup>th</sup> June 2007, Sanoma WSOY Oyj of Ludviginkatu 6-8, Helsinki, Finland, FIN-00130 filed notice of opposition to the application. The grounds under Section 5(2)(b) of the Act are based upon the opponent's International Trade Mark No M801905, as below:

# SANOMA

The goods and services, insofar as they are relevant to the proceedings, are:

**Class 25:**

Clothing, footwear, headgear.

**Class 35:**

Advertising; business management; business administration; office functions.

**Class 41:**

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

- 3) This date of international registration of this mark is 18<sup>th</sup> March 2003 and it claims priority from a Benelux Registration 725020 having a priority date of 21<sup>st</sup> November 2002. The registration is protected in the UK with effect from 19<sup>th</sup> October 2003. This trade mark qualifies as an earlier trade mark within the meaning of Section 6A of the Act. Moreover, the opponent was not required to make a declaration in accordance with rule 13(2)(d) to the effect that their mark had been put to genuine use in respect of each of the goods and services of their specification. This is because the registration procedure (or rather the procedure leading to the protection of an international mark) had not been completed *before* the period of five years ending with the publication of the application in suit.
- 4) The opponent's statement of case relies upon the goods and services protected in classes 25, 35 and 41 as being identical or highly similar to the goods and services of the application in classes 25, 35 and 41. Thus, the goods in class 26 of the application remain unchallenged – it is in effect a partial opposition. The opponent claims that the marks are visually and phonetically very similar only differing by a single letter which appears in the middle of the marks. Given the identical or highly similar goods and services the opponent asks that the application in classes 25, 35 and 41 be refused.
- 5) The applicant duly filed a counterstatement denying that the respective marks are similar. The applicant said that her mark will be used with the logo device, and

not as a word only mark and thus there is a significant difference between the marks.

- 6) Neither side has requested to be heard. Only the opponent filed evidence and written submissions in lieu of a hearing although the applicant has made legal submission in her counterstatement which I shall come to in due course. Neither party asks for an award of costs. After careful consideration of the papers, I give this decision.

### **Opponent's evidence**

- 7) The opponent's evidence is in the form of a witness statement from Hannu Syrjänen, the CEO of Sanoma WSOY Oyj. He says that the mark SANOMA was first used in 1904 as part of the registered Finnish trade name SANOMA-OSAKEYHTIO. Sanoma is a Finnish word meaning 'message' in English. He says that his company is one of the leading media groups in the Nordic countries. It has operations in at least twenty other countries including in the UK with an annual turnover in 2006 of 2.742 billion Euros and has 18,000 employees. The various divisions of the company number, broadly speaking, five. These cover (a) magazines, (b) newspapers, (c) education, books and business information, (d) TV broadband internet and radio, and finally (e) kiosk operations, press distribution, bookstores. However, the evidence does not reveal that all these strands operate in the UK or that their trade mark is exposed to UK customers, with the exception of the following.
- 8) Mr Syrjänen says that a fully owned subsidiary ESMERK is active in the UK primarily as a provider of business information. On pages 14 and 15 of the company's annual report from 2006 (exhibit HS 4) there is a map of Europe and a list of "Operating countries" which states that "business information services" only are provided in the UK, employing 54 people. This is in contrast, say, to the Netherlands where the activities include magazines, educational publishing and press distribution employing 2,296 people, or to Finland where the bulk of the activities are based, employing 9,409 people. It is not clear when this limited activity in the UK actually commenced. Exhibit HS 8 is a publication "IWR" (Information World Review) which is a business publication dated September 2007, aimed at providing strategic advice to businesses. This publication is dated some nine months after the relevant date for these proceedings, namely the filing date of the application, being 23/01/07, but when viewed with the other exhibits, I accept that it is indicative of the nature of the services provided by the opponent in the UK at the relevant date. In this publication there is an advertisement for ESMERK as a provider of business information. Beneath the word ESMERK are the words "SanomaWSOY Group". Other material in Exhibit HS 8 states that ESMERK has "over 25 years experience in delivering high quality current awareness services" but this does not establish that the opponent's trade mark 'SANOMA' has been established in the UK for that period. There is, for example, no reference to any activity in the UK in the company annual reports of

1999 and 2000. I conclude from the evidence that activity in the UK is limited to the area of provision of business information only, in connection with the ESMERK name and that this has only commenced relatively recently.

- 9) Mr Syrjänen says that “Sanoma” is effectively the “house-mark” being used as part of a number of other combinations eg SANOMA MAGAZINES, SANOMAWSOY EDUCATION AND BOOKS. His company opposed the mark SACOMA in Spain (application 2644814) and were successful in that opposition. The remaining statements in Mr Syrjanen’s evidence are, in effect, submission and not by way of factual evidence and therefore I do not need to recount them here.

## THE DECISION

### Section 5(2)(b)

- 10) The opposition is founded upon Section 5(2)(b) of the Act. This reads:

(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.

11) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice in *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 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723. 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 of 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) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) 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*,
- (g) 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*,
- (h) 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*,
- (i) 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*,
- (j) 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*,
- (k) in comparing marks, one of which is a composite mark, it is possible that the overall impression of the composite mark is dominated by one or more of its components (*Case C-3/03P, Matratzen Concord v OHIM, para 32 and Case C-120/04 Medion, para 29*), and
- (l) in order to establish likelihood of confusion it suffices that because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark ( *Case C-120/04, Medion para 36*).

### ***The average consumer***

12) Under 11(b) above, the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant. This is my starting point. In certain cases, such a starting point can be skewed if, from the nature of the goods or services or

purchasing transaction, it can be said that the consumer is especially attentive (or vice versa). This may be the case if the goods or services, for example are specialised or expensive, or on the other hand, the goods are cheap and purchased with an assumed lack of attention. The relevant goods and services in this case are in classes 25, 35 and 41. In class 25 the consumer will be the general public, whilst in classes 35 and 41, the consumer could well be businesses or the general public. But there is nothing obviously “specialist” about these goods and services, and neither are they purchased in a unique environment, such as would lead me to disturb the starting position as set out in 11(b) above.

***Comparison of goods***

13) The following table sets out the position.

Class	Applicant’s goods/services	Opponent’s goods/services
25	Clothing, footwear, headwear, textile nappies for babies, leather belts , shoes.	Clothing, footwear, headgear
35	Advertising, business management, business administration, office functions, organising, operating and supervising loyalty and incentive schemes, advertising services provided on the Internet, producing television and radio adverts: accountancy, auctioneering, trade fairs, opinion polling, data processing, providing business information.	Advertising; business management; business administration; office functions.
41	Education; providing training, entertainment, sporting and cultural activities.	Education; providing of training; entertainment; sporting and cultural activities.

14) In assessing the similarity of services, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v.Metro-Goldwyn-Mayer (Case C-39/97)* the ECJ 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 end users and their method of use and whether they are in competition with each other or are complementary.”

Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance v OHIM – Johnson & Johnson (monBeBé)*).

15) In class 25, “clothing, footwear, headwear”, “leather belts” and “shoes” are all identical to the goods in the opponent’s specification, eg “shoes” are covered by the broader term “footwear”, whilst “leather belts” are covered by the broader term “clothing”. However, special consideration needs to be paid to “*textile nappies for babies*”. Specifically, although ‘worn’ in a broad sense, textile nappies for babies have an overriding, functional purpose – to provide babies with a comfortable and absorbent item for doing what comes naturally, and therefore I conclude that although their nature is similar to clothing, their intended purpose is somewhat different. Furthermore, nappies are likely to be sold in specialist baby outlets or, in discreet baby and child areas in larger shops or supermarkets. Whilst they may be sold along with clothing, for example on adjacent shelves in a discreet baby and child area of a large supermarket, in general they are not sold *as* items of clothing, and therefore I conclude, also, that the distribution channels for the respective goods are going to be different. **For these reasons, I regard “textile nappies for babies” ,though not dissimilar, as having a low level of similarity, with the opponent’s specification of “clothing, headgear and footwear” at large.**

16) In relation to class 35, both the opponent’s registration and the application at issue cover a number identical services, namely [a]dvertising, business management, business administration and office functions. The application also contains the more specific terms “organising, operating and supervising loyalty and incentive schemes, advertising services provided on the Internet, producing television and radio adverts, accountancy, auctioneering, trade fairs, opinion polling, data processing, providing business information”. I must consider if these more specific terms are covered by the opponent’s broad terms. I incline to a narrow view as advocated by Mr Justice Jacob in *Avnet Incorporated v Isoact Ltd [1997] ETMR 562*, which states:

“In my view specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

On that basis, I take the broad terms listed above to mean services offered specifically by a business to another business to enable it, loosely speaking, to perform better, gain market share or, in some other way, improve. Such terms cannot be taken to encompass all manner of specialist services which may be outside the core of possible meanings.

17) It is a reasonable expectation that the broad terms “business management” and “business administration” will include “organising, operating and supervising” any business function and as such, I find that the applicant’s “organising, operating and supervising loyalty and incentive schemes” are **identical** services to “business management” and “business administration”. Similarly, I find that “advertising services provided on the Internet” and “producing television and radio adverts” are covered by the broad term “advertising” in the opponent’s registration and are thus **identical**. Also “data processing” is a core element of both “business administration” and “office functions” and as such, I find that this is also **identical** to the opponent’s services. “Providing business information” is not covered by any of the opponent’s broad terms, however, it is a service closely associated with the provision of “business management” and “business administration” to third parties. As such, I find this service to be **closely similar** to “business management” and “business administration”.

18) When the *Avnet* principle is applied, the remaining terms, namely “auctioneering, trade fairs, opinion polling”, would not be covered by the opponent’s broad terms. Such services are normally provided by businesses who operate as specialists in these specific fields. Therefore the trade channels are different. These services do not directly contribute to the running of a business, and I conclude that the nature of these services is also different. However, they may well have the same end users and may be complementary to the opponent’s services. **Taking all these factors into account, I find that there is no more than a low level of similarity between these respective services.** As with the opponent’s services, “accountancy” services contribute to the general running of a business and as such, at that level share the same intended purpose. The relevant consumer for accountancy services is the general business sector and therefore shares the same relevant consumer as the opponent. It differs from the opponent’s services in that accountancy is generally offered by specialist companies and so the trade channels may be different. Taking all these factors into account I conclude that accountancy is **closely similar** to the services of the opponent.

19) In relation to class 41 I regard the terms used in the respective specifications as identical in scope.

#### ***Distinctiveness of the earlier mark***

20) This must be factored into the assessment of likelihood of confusion in accordance with para 11(f). The opponent is right to assert that his mark would be seen as having no meaning in the English language. It must be treated as an invented word, thus having, in accordance with principles of para 11(f) and (g) above, inherently highly distinctive character in trade mark terms. I would mention that the distinctiveness of an earlier mark under section 5(2)(b) may be assessed by reference to its inherent characteristics or to its reputation in the market place. The opponent’s evidence shows use in the UK in relation *only* to the provision of business information and, because no information has been provided as to the scale of use in relation to this service (other than that 54 people are employed by the opponent in the UK), **I am unable to conclude that the high level of**

**inherent distinctiveness is not further enhanced by any use made of the mark in the UK.**

***Comparison of marks***

21) I will now go on to consider the similarities and differences between the marks themselves and the impact of any differences upon the global assessment of similarity. The marks to be compared are:

<b>Trade mark of the opponent</b>	<b>Trade mark of the applicant</b>
SANOMA	

***(a) Visual comparison***

22) In terms of visual comparison, the third letter of the respective word elements differ, but are similar in other respects. They share the same number of letters, both begin with “SA” and both end in “OMA”. The applicant’s mark also contains an additional device element that consists of an oval shape surrounding the word element and to the right of this five, possibly six, “i”-like devices radiating out from a small centre. The overall impact of this device is not such as to detract from the word element. Applying the principles set out in *Matratzen* and *Medion* (see paragraphs 11(k) and (l) respectively) to this case, I have no hesitation in finding that the dominant element in the applicant’s mark is the word SACOMA. Further, this word is ‘independently distinctive’ in relation to the mark as a whole, whereby the device does not impact on the word to, in some way, ‘swamp’ it, or otherwise impart or vary any meaning. I thus conclude that the device element, although not negligible does not detract from the word SACOMA functioning as the dominant distinctive element.

23) The applicant, in her counterstatement, submits that the marks are significantly different by virtue of the fact that a device is included in the composite mark and the word SACOMA alone would not be used, however, in light of my comments above, I do not find this point persuasive.

**24) Taking all of the above factors into account, and viewing the marks as a whole I regard the marks as visually similar.**

***(b) Aural comparison***

25) The first part of both marks will be pronounced as SAC or SACO and SAN or SANO respectively. Both marks share the same final part –OMA or –MA. The opponent’s mark will be pronounced SAN-OMA or SANO-MA, and the applicant’s mark as SAC-

OMA or SACO-MA. The only difference in the two marks being the letters “C” and “N” in the middle of the words. Plainly the words are of the same length, and whilst it may be true that such a letter will serve to differentiate the marks aurally, I would say that one would have to be listening quite closely to make that difference tell. The device element would have limited or no impact at all in terms of aural analysis. **Taking all these factors into account, I find that aurally, the marks are very similar.**

*(c) Conceptual comparison*

26) Neither word will have any meaning as far as the average consumer in the UK is concerned and this leads me to the conclusion that, in conceptual terms, the marks can be said to be neither similar nor dissimilar. I would just add that the device element in the applicant’s mark would not, in my opinion, serve to confer a clear conceptual meaning on the mark such that it would render that mark any more any less different from the opponent’s mark. **Conceptually I find the marks are neither similar nor dissimilar.**

27) **In summary, I consider that the respective marks are aurally very similar, visually similar and conceptually neither similar or dissimilar and my conclusion, based on the principles and factors set out above is that, when viewed as a whole, they are similar.**

*Likelihood of confusion*

28) The global assessment of para 11(a) now requires me to bring together my findings above, in a balanced and overall assessment of likelihood of confusion. I must also have regard to the interdependency principle of para 11(e) above, whereby a lesser degree of similarity between the marks can be offset by a greater degree of similarity of the goods and vice versa. It is also important to bear in mind the legal proposition in para 11(b) above, that the average consumer does not necessarily compare the marks side by side, and he or she will have an imperfect recollection of the marks. This is a major factor in my comparison of these marks. Such a recollection will play an especially important role where, as I have already concluded, both marks will be seen as invented words, having no clear meaning. Taking all these factors into account, my decision is that there is a likelihood of confusion, and thus the opposition under section 5(2)(b) succeeds, in respect of the following goods and services:

Class 25 Clothing, footwear, headwear, leather belts, shoes

Class 35 Advertising, business management, business administration, office functions, organising, operating and supervising loyalty and incentive schemes, advertising services provided on the Internet, producing television and radio adverts: accountancy, data processing, providing business information.

Class 41 Education; providing training, entertainment, sporting and cultural activities

I find that there is no likelihood of confusion, and thus the opposition under section 5(2)(b) fails, in respect of the remaining goods and services, namely:

Class 25 Textile nappies for babies.

Class 35 Auctioneering, trade fairs, opinion polling.

**Costs**

29) Neither party has asked for costs. In accordance with para 12.4 of the Work Manual (Law Section Chapter), I invite both parties to make submissions and a specific request within one month from the date of this decision.

**Dated this 10th day of November 2008**

**Edward Smith  
For the Registrar,  
the Comptroller-General**