

O-360-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2414151
BY SFS LEGAL LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 16 AND 42**

BACKGROUND

1. On 17 February 2006, SFS Legal Limited of The Orchard, Naseby Road, Leicester LE4 9FH (“the applicant”) applied to register trade mark no. 2414151 under the provisions of the Trade Marks Act 1994. The mark consists of the word elements “E-COMM LEGAL” presented in a the figurative style shown below:



2. The mark was applied for in respect of the following goods and services:

- Class 16 Publications and printed matter relating to the provision of legal services, namely publications, newsletters, brochures, articles, manuals, and memoranda.

- Class 42 General legal and consultancy services, including but not limited to, e-commerce trading, company formation, online trading, maintenance and management of intellectual and property rights, litigation, and professional consultation and advisory services.

3. An examination report detailing the examiner’s view of SFS Legal Limited’s application was issued on 13 April 2006. In this report, the applicant’s attention was drawn to two conflicting earlier rights and an objection under Section 5(2) of the Trade Marks Act 1994 was raised.

4. The following two earlier rights were identified as citations against the applicant’s mark in Class 42:

- (i) UK trade mark registration no. 2145174 in the name of Kemp Little LLP, Cheapside House, 138 Cheapside, London, EC2V 6BJ, consisting of the following stylised-word mark:

COMLEGAL

- (ii) Community trade mark registration no. E843599 in the name of Kemp Little LLP, Saddlers House, Gutter Lane, London, EC2 6BR, consisting of the word-only mark “**COMLEGAL**”.

Both of these earlier marks have been registered *inter alia* in respect of the services shown below:

- Class 42 Legal services; technical and legal research; legal services and legal research relating to technology and information technology; company formation and registration services; conveyancing services; professional consultation and advisory services, all relating to the infringement, exploitation and

licensing of industrial and intellectual property rights; title searching; preparation of reports, provision of information and advisory services, all relating to the aforesaid services.

5. The examination report, issued on 13 April 2006, provided a six-month period for responses to be filed. The applicant therefore had until 13 October 2006 to present submissions in relation to the objection raised.

6. On 12 October, the applicant requested further time to allow for the collation of information in support of the trade mark application. In a letter dated 17 October 2006, the examiner confirmed that an extension had been granted until the date requested i.e. 03 November 2006. The applicant was also informed in writing that failure to reply by this date would result in refusal of the application under the provisions of Section 37(4) of the Trade Marks Act 1994.

7. On 25 April 2007, a review of the file showed that no response or written correspondence had been received from the applicant by the relevant date of 03 November 2006. As a consequence, the examiner issued a letter on that day, informing the applicant that the application had been partially refused in respect of the Class 42 specification. As is standard procedure, that letter also set a period of one month (i.e. until 25 May 2007) to enable the applicant to appeal against the refusal via submission of a completed Form TM5. This refusal, dated 25 April 2007 and based upon a relative grounds objection, was issued in accordance with the law at that time i.e. prior to The Trade Marks (Relative Grounds) Order 2007 which came into effect on 1st October 2007.

8. On 23 May 2007, the applicant filed written submissions contesting the validity of the Section 5(2) objection. The applicant argued that the earlier cited marks are phonetically and conceptually dissimilar to the mark applied for, and also questioned the breadth of the specifications listed in the earlier cited marks. A Form TM5 was not included with these submissions.

9. On 01 June 2007, the examiner issued a letter informing the applicant that its most recent written submissions could not be taken into consideration on account of the application having been formally refused with effect from 25 April 2007. It was emphasised that the period from 25 April 2007 until 25 May 2007 was granted only to allow for the filing of a Form TM5 requesting a statement of reasons for the Registrar's decision.

10. On 08 June 2007, the applicant filed further written submissions together with a Form TM5. In its letter, the applicant stated that an administrative error had resulted in failure to submit a Form TM5 within the relevant time period.

11. With regards to the alteration of time limits, Rule 68(1) of the Trade Marks Rules 2000 states the following:

68.- (1) *The time or periods-*

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or

(b) specified by the registrar for doing any act or taking any proceedings, subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as he thinks fit and upon such terms as he may direct.

In the context of Rule 68(1), the Registrar was satisfied with the reasons given relating to the applicant's failure to submit a Form TM5 within the relevant time period, and agreed to accept the form as filed on 08 June 2007.

12. As a result of accepting the Form TM5, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

DECISION

13. The grounds for objection to the application are under the terms of Section 5(2) of the Act. If none of the objections under this section of the Act were justified, then the final refusal of the mark under Section 37(4) of the Act should not have been issued.

Comparison of marks (Section 5(2))

The Law

14. Section 5(2) of the Act reads as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.

15. An earlier trade mark is defined in Section 6(1) where it states that:

6.(1) In this Act an "earlier trade mark" means-

(a) a registered trade mark, international trade mark (UK), 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.

16. I take into account the guidance provided by the European Court of Justice (ECJ) in the following cases: *Sabel BV v Puma AG* [1998] R.P.C.199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer &*

Co GmnH v Klijsen Handel BV [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

17. It is clear from these cases that:

(a) The likelihood of confusion must be appreciated globally, taking into account 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*). The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant - but also one who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them kept in his mind (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel*).

(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 global assessment of the likelihood of confusion implies some interdependence between the relevant facts, and in particular a similarity between the trade marks and between their goods or services. Accordingly, a lesser degree of similarity between these goods and services may be offset by a greater degree of similarity between the marks 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*).

(g) 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*).

(h) 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 Section (5(2)) (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

18. The global comparison of marks therefore means that a number of elements must be analysed before effective judgement can be made.

Prima facie comparison

Comparison of the marks

19. Both earlier UK trade mark no. 2145174 and Community trade mark no. E843599 are registered, and are therefore deemed to be valid (Section 72 of the Trade Marks

Act 1994 refers). The first earlier mark consists of the word “COMLEGAL”. Although it has been filed and registered as a stylised word, the mark appears on the register in a familiar standard typeface, with no other additional elements present within it. The second earlier (Community) mark consists solely of the words “COMLEGAL”, and has been registered as “word-only”.

20. The trade mark applied for consists of the word element “E-COMM” presented in angular and bold upper case lettering. Underneath this element, in letters which are identically stylised but which are presented in a slightly smaller font size, appears the word “LEGAL”.

Comparison of the services

21. The refusal, issued on 25 April 2007, was partial by nature, and was based solely on an objection under Section 5(2) arising from the earlier marks’ specifications in Class 42. These specifications were, in turn, only directed at the Class 42 specification of the mark applied for. Therefore, for the purposes of this decision, it is only necessary to consider those potentially conflicting services found in Class 42.

22. In assessing the similarity of goods concerned, all the relevant factors relating to these services should be taken into account. Such factors include *inter alia* their nature, their end users and method of use, and also whether they are in competition with each other or are complementary (see *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer* [1999] E.T.M.R.1. paragraph 23). Further factors include the purpose of the goods, their origin, and their pertinent distribution channels and sales outlets.

23. In their class 42 specifications, the two earlier marks cover “legal services; technical and legal research; legal services and legal research relating to technology and information technology; company formation and registration services; conveyancing services; professional consultation and advisory services, all relating to the infringement, exploitation and licensing of industrial and intellectual property rights; title searching; preparation of reports, provision of information and advisory services, all relating to the aforesaid services”, whilst the applicant’s mark claims “General legal and consultancy services, including but not limited to, e-commerce trading, company formation, online trading, maintenance and management of intellectual property rights, litigation, and professional consultation and advisory services.”

24. Whilst the earlier proprietor’s Class 42 specifications contain a number of specialised legal services such as those relating to technical research, company formation, and intellectual property rights etc., I also note the claim to “legal services” at large. This must be interpreted as a claim to *all* activities of a legal nature which are proper to Class 42, and which are implicit within the term “legal services”.

25. In respect of the applicant’s mark, a claim has been made to “*general* legal services” (my emphasis), where use of the word “general” does little more than indicate that the legal services concerned are not specialised or limited in range or subject, and are the type of activities one might reasonably expect to be described by the term “legal service”. The applicant has then listed a number of specialised legal services including “company formation”, “management of intellectual property

rights” and “litigation”, all qualified by the preceding term “...including but not limited to...”. Due to the presence of this qualifier, I consider the applicant’s references to more specialist legal services to be little more than examples, used to show the range of activities intended for coverage under the broad term “general legal services”.

26. I also note that the applicant’s specification contains the terms “general legal *and* consultancy services...” which, from a linguistic perspective, constitutes not only a claim to general legal services, but also a claim to “consultancy services” *at large*. At the examination stage, the applicant’s specification was questioned pursuant to Rule 8 of the Trade Marks Rules 2000 on the grounds that it contained terms which are unclear. In subsequent correspondence, the applicant simply confirmed that its core activity relates to the support and maintenance of intellectual property rights. Therefore, I am assuming that the applicant’s claim to “consultancy services” *at large* was in fact intended to relate back to the legal services clearly listed elsewhere in the specification.

27. Having identified some of the broader terms claimed by both the applicant and the earlier proprietor, the comparison to be made is that between the term “legal services” as protected by the proprietor’s two earlier marks, and “general legal services” as claimed by the applicant. It is clear that these two terms effectively denote the same thing i.e. legal services. Therefore, I must conclude that the services claimed by the applicant are *identical* to those covered by the two earlier registrations.

Likelihood of confusion

28. According to guidance laid down by the European Court of Justice, the likelihood of confusion must be assessed using a global comparison, taking into consideration all the relevant factors mentioned above. The issue at stake can, for the sake of simplicity, be summarised by asking the following question: ‘is it reasonable to assume that an average consumer/user of legal services would believe that services provided by the applicant under the mark applied for originated from the same source as those protected by the earlier registration?’

29. The average consumer is considered to be reasonably circumspect. However, he must also be understood as having an imperfect recollection of any two marks. A potential user of legal services is less likely to see the marks presented ‘side by side’ and at the same time, and more likely to encounter one some time after encountering the other. Therefore, one must understand that an holistic analysis occurs in the mind of the average consumer. The consumer does not disassemble marks in his or her own mind, but rather the memory of one whole sign is compared with the next.

30. According to case law of the European Court of Justice, in determining the existence of likelihood of confusion, trade marks have to be compared by making an overall assessment of the visual, phonetic and conceptual similarities between the marks. The comparison “must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components” (*Sabel BV v Puma AG*).

31. Whilst the two earlier marks consist of the single word element “COMLEGAL”, the applicant’s mark consists of the prefix “E” hyphenated to the word “COMM” together with the separate word element “LEGAL”. It therefore appears that the applicant’s mark contains a number of elements not present in the earlier signs. That being the case, any comparison based solely upon identifying the amount of similar or dissimilar elements within two signs is still unlikely to produce a conclusion which accurately reflects the potential for confusion in the marketplace.

32. Although the earlier marks are presented as the single word “COMLEGAL”, when used in respect of legal services, the relevant consumer would immediately identify the sign as a composite of the two word elements “com” and “legal”. The secondary element “legal” would be perceived and understood as a descriptive reference to the services provided, whilst the first element “com” would be familiar as a common abbreviation denoting “commercial entity”, “company” and, in some cases, “communication”.

33. I do consider it likely that any potential user of the services would identify and recognise these two elements and make a cognitive distinction between them. However, I do not believe that the primary element “com” is so distinctive and so dominant that it would be used in isolation, or at the expense of recognition for the secondary element “legal”. The first part of the earlier cited marks consists of the three letters “c-o-m”, and is conjoined to the second part “legal”. The mark in its totality is relatively short (consisting of only eight letters), whilst its conjoined structure clearly invites one to view and perceive the sign in its *totality*, rather than on the basis of its individual elements.

34. In my opinion, the same logic largely applies to an assessment of the applicant’s mark. Again, the word “legal” undertakes a descriptive role in light of the services being offered, whilst the four-letter combination “COMM” serves as a familiar abbreviation for “communications” - particularly where, as is the case here, it is preceded by the single letter “E” denoting “electronic”. I recognise that the applicant’s mark possesses an element of figurative presentation not found in the earlier word-only marks. However, this presentation is not sufficiently striking or inventive to the extent that it would draw the consumer’s eye away from the clearly-presented word elements.

35. As with the earlier marks’ primary element “com”, the first part of the applicant’s mark, i.e. the word “E-COMM”, is relatively short in length. Furthermore, it is likely to be perceived as a reference to “electronic commerce” and/or “electronic communication”, and consequently to have some connection with the goods and services the mark is intended to be used upon (this is particularly relevant in light of the applicant’s claim to “general legal and consultancy services, including but not limited to, e-commerce trading...”).

36. Applying the guidance set out in *Sabel BV v Puma AG*, over the previous five paragraphs I have attempted to identify the marks’ dominant and distinctive elements in order to make an accurate assessment of the likelihood of confusion between “E-COMM LEGAL” and “COMLEGAL”. Having done so, I am not convinced that the relevant consumer is likely to identify and focus upon any one single element within these marks at the expense of perceiving them in their totalities. The brevity and

conjoined nature of the earlier marks suggests to me that they will be visually, phonetically and conceptually perceived as the single word “COMLEGAL”, whilst the descriptive and highly allusive nature of the individual elements contained with the applicant’s mark will also result in it being perceived in its totality.

37. Therefore, the visual, phonetic and conceptual comparisons that follow are made on the basis that the marks “COMLEGAL” and “E-COMM LEGAL” will be perceived in their totalities, rather than by the isolation of any individual elements.

38. In terms of a visual comparison, I note that the applicant’s mark presents the words “e-comm” and “legal” as two separate elements. The former is presented in a large typeface and in a more prominent position, whilst the latter is in a smaller (though identically stylised) typeface, and positioned underneath the primary element. This is in contrast to the earlier cited mark, where “com” and “legal” are conjoined to create the single mark “COMLEGAL”. In terms of their visual arrangement and presentation, there are some differences between the marks. However, I also note that the two word elements which combine to form the earlier cited marks are clearly contained within the applicant’s mark. The only additional elements in the later mark are the letters “E” used as a prefix (probably in order to denote or indicate an electronic aspect to the service provided), and the additional “M” used in the word “COMM”. Therefore, the majority of letters contained within the applicant’s mark are also found to occur (in a near-identical order) in the earlier cited marks. Balancing their different presentational elements against the clear similarities in word content, I find a moderate level of visual similarity between the two signs.

39. Aurally, the applicant’s mark would be referred to as “E / COM / LE / GAL”, whilst the earlier mark would be referred to as “COM / LE / GAL”. This comparison clearly shows that three of the four syllables contained within the applicant’s mark are identical to the three syllables which combine to form the earlier mark. The single letter “e”, although found at the beginning of the applicant’s mark, is unlikely to affect the clear potential for aural confusion. Use of this abbreviation to denote “electronic” is so common that its presence in the applicant’s mark may be overlooked, whilst its properties as a vowel make it unlikely to receive any oral emphasis particularly where, as is the case here, it is succeeded by the consonant “C” (occurring at the beginning of the word “COMM”). With three of its four syllables being identical to those contained within the earlier marks, and oral emphasis likely to be placed upon the common, rather than the uncommon, elements, I find there to be a high degree of aural similarity between “COMLEGAL” and “E-COMM LEGAL”.

40. From a conceptual point of view, I find it likely that the relevant consumer would perceive the applicant’s mark as a combination of references to (i) electronic commerce; and (ii) legal services. In totality, and in the context of the services intended for protection under the mark, it is reasonable to assume that the consumer would therefore expect the mark to be a clear allusion to legal services relating to the field of electronic commerce.

41. In relation to his perception of the earlier cited marks, that same relevant consumer is likely to differentiate between the two elements “com” and “legal”, recognise the frequent use of “com” as an abbreviation for “commerce” and/or

“company”, and conclude that the marks are an allusion to legal services for the commercial sector.

42. I accept that electronic commerce is a self-contained area of commercial activity, and that the applicant’s use of “E-COMM” as opposed to simply “COMM” or “COM” will directly inform the potential consumer that the legal services being offered are specifically related to electronic retailing/commerce. This is not the case with the earlier cited marks, where use of the term “COM” is likely to be taken as a broader reference to “commerce” in general. However, the fact remains that there are clear conceptual links between electronic commerce and more traditional non-electronic commerce, and I am conscious of the fact that the marks under comparison cover legal services which are identical in nature. Considering all of these factors, I am not convinced that the earlier marks create an idea sufficiently distinct from that created by the applicant’s mark so as to negate any possibility of confusion. Both marks clearly present similar abbreviations recognised as denoting the term “commerce” in combination with the term “legal”, and both will therefore convey similar meanings based upon the relevant consumer’s understanding of what those terms mean. As a consequence, conceptual similarity is found to exist.

43. In conclusion, I have sought to make visual, phonetic and conceptual comparisons in respect of the marks “COMLEGAL” and “E-COMM LEGAL”, having already determined that neither of the marks have any obviously dominant or distinctive *individual* elements. Comparing the marks in their totalities, I have noted the presentational differences between the two signs, finding only a moderate level of visual similarity. However, in relation to the phonetic and conceptual comparisons, I identified the individual letter “E” found in the applicant’s mark as the only disparate phonetic element not found in both of the signs. I also identified both marks as essentially consisting of terms which are commonly used as abbreviations for the words “commerce” and/or “company” (being “E-COMM” and “COM”), combined with the word “LEGAL” which serves to directly describe the nature of the services intended for use under the marks. On that basis, I identified much higher levels of phonetic and conceptual similarity. Having reached these conclusions, I must then incorporate them into a global comparison taking into consideration the degree of similarity or dissimilarity which has been identified between the relevant goods.

Decision regarding Section 5(2)

44. Overall, there appears to be sufficient similarity between the cited mark nos. 2145174 and E843599 and the applicant’s trade mark to justify objection under Section 5(2) of the Trade Marks Act 2000. The marks share a high degree of phonetic and conceptual similarity coupled with a lower degree of visual similarity, whilst the relevant services applied for by the applicant in Class 42 are considered identical to those of the two earlier marks in the corresponding class.

45. I therefore conclude that, in respect of the applicant’s services claimed in Class 42, there is a likelihood of confusion sufficient to warrant an objection under Section 5(2) of the Act.

Overall conclusion

46. The application in in Class 42 is not registrable because it is debarred from registration by Section 5(2).

Dated this 7th day of December 2007

**Nathan Abraham
For the Registrar
The Comptroller-General**