

O-414-20

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3311255
BY FUTURE FIRST ALUMNI LIMITED
TO REGISTER**



**AS A TRADE MARK
IN CLASSES 35 & 41
AND OPPOSITION THERETO (UNDER NO. 414182)
BY
FREIGHTFORCE DISTRIBUTION LTD**

Background & pleadings

1. Future First Alumni Limited (“the applicant”) applied to register the trade mark set out on the title page on 16 May 2018. The mark was published in the Trade Mark Journal on 27 July 2018 in classes 35 and 41 although the opposition proceedings only concern class 41. The applicant amended class 41 by means of a TM21B dated 13 June 2019. Class 41 currently stands as:

Class 41: Education services; provision of training courses for young people in preparation for careers; mentoring services; career advisory services, career counselling; consultancy, information and advisory services related to the aforesaid; excluding vehicle and trailer training services; driver education and training; arranging training; seminars and conferences relating to logistics, driver training, transportation and handling.

2. Freightforce Distribution Ltd (“the opponent”) opposed class 41 of the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) based on some services in class 41 of its earlier UK trade mark no. 3036027. The details of the earlier mark are set out below.

UK TM No. 3036027	Services relied on in Class 41:
 <p>(series of two)</p> <p>Filing date: 23 December 2013 Registration date: 11 April 2014</p>	Education; Providing of training; Entertainment; Sporting and cultural activities; vehicle and trailer training services; driver education and training; arranging training, seminars and conferences relating to logistics, driver training, transportation and handling; information, advisory and consultancy services relating to the aforesaid.

3. The applicant filed a counterstatement in which it denied the opposition claims.

4. The opponent's above mentioned trademark is an earlier mark, in accordance with Section 6 of the Act but is not subject to proof of use requirements as it has not been registered for five years or more before the publication date of the applicant's mark, as per section 6A of the Act.

5. The parties are both represented, the applicant by Taylor Wessing LLP and the opponent by ip21 Ltd.

6. Only the opponent provided evidence. Both parties provided written submission in lieu of a hearing. I make this decision based on the material before me.

Opponent's evidence

7. The opponent provided a witness statement and one annexed exhibit in the name of Jackie Tolson of ip21Ltd, the opponent's legal representative. The exhibit consisted of a document produced by the European Trade Mark and Design Network regarding use of simple geometric shapes.

Decision

8. Section 5(2)(b) of the Act which 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.

9. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Services

10. With regard to the comparison of services, in the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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”.

11. Jacob J (as he then was) identified the following factors as relevant for assessing similarity:

- 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.

12. The following case law is also relevant in these proceedings. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-133/05) (*‘Merici’*), the General Court (*‘GC’*) held:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

13. The services to be compared are:

Opponent’s services in class 41	Applicant’s services in class 41
<i>Education; Providing of training; Entertainment; Sporting and cultural activities; vehicle and trailer training services; driver education and training; arranging training, seminars and conferences relating to logistics, driver</i>	<i>Education services; provision of training courses for young people in preparation for careers; mentoring services; career advisory services, career counselling; consultancy, information and advisory services related to the aforesaid;</i>

<p><i>training, transportation and handling; information, advisory and consultancy services relating to the aforesaid.</i></p>	<p><i>excluding vehicle and trailer training services, driver education and training, arranging training, seminars and conferences relating to logistics, driver training, transportation and handling.</i></p>
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13. I note the applicant has included an exclusion to its specification which serves to exclude some specific services named in the opponent's specification, i.e. *vehicle and trailer training services, driver education and training, arranging training, seminars and conferences relating to logistics, driver training, transportation and handling*. However, the opponent's specification is not limited to those specific terms but contains broad terms as *Education; Providing of training; information, advisory and consultancy services relating to the aforesaid* at large so I find there is still an overlap between the respective parties' services which I highlight below.

14. The terms *Education; information, advisory and consultancy services relating to the aforesaid* in the opponent's specification are identical to *Education services; consultancy, information and advisory services related to the aforesaid* in the applicant's specification.

15. The term *Providing of training; information, advisory and consultancy services relating to the aforesaid* in the opponent's specification is broad enough to encompass *provision of training courses for young people in preparation for careers; consultancy, information and advisory services related to the aforesaid* in the applicant's specification and so is considered identical on the *Meric* principle.

16. I find the term *mentoring services* in the applicant's specification to be similar at least to a medium degree to *Providing of training* in the opponent's specification. Both mentoring and training involve guidance and development given to an individual with the aim of fulfilling their potential. The nature and purpose of the services are similar, namely working with individuals and developing their skill set and there will

be an overlap in the users of such services. There is also a degree of competition between the services.

17. I find the terms *Education; providing of training; information, advisory and consultancy services relating to the aforesaid* in the opponent's specification are similar to a medium degree to the applicant's services namely *career advisory services, career counselling; consultancy, information and advisory services related to the aforesaid*. In my view both services have an overlap in users and may reach the market in the same way, such as through colleges and universities. Provision of careers advice could form part of information and advisory services relating to education and training provision offered to individuals with regard to gaining necessary educational qualifications or training needed to enhance career opportunities.

Average consumer and the purchasing process

18. I next consider who the average consumer is for the contested services and how they are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

19. 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.”

20. The average consumer for these services are the general public and businesses. Services are likely to be a visual purchase as the average consumer would have browsed literature, brochures or other course descriptions either online or from physical media whilst researching educational establishment or training providers. The consumer would also be attending an educational establishment, training session or a career counselling session either online or in person. However, I do not discount an aural element such as word of mouth recommendations. In my view as the cost of educational courses and training courses can vary, the average consumer would be paying at least a medium degree of attention during the purchasing process.

Comparison of the marks

21. 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 the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

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

23. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
	

24. The opponent's mark consists of a series of two FF marks in a stylised typeface. The first mark in the series depicts the letters FF in green with blue shadowing effect, whilst the second mark is depicted in equivalent greyscale. I find that the colour (in the first mark) and the stylisation have little impact in comparison to the word element and the overall impression resides in the letters FF.

25. The applicant's mark consists of the letters FF in a standard typeface depicted in white and positioned inside a pink circle device. The use of a circle device as a background is commonplace and not especially striking. I note the pink colour. However in my view the colour is a secondary element in comparison to the letters. The colour provides a contrast for the letters FF to be seen more clearly. As such I find the letters FF will be seen as the dominant element.

26. Taking the visual comparison first, the element in common are the letters FF, which I found to be the dominant element in all marks. There are some visual differences in terms of the green/blue shadowing effect in the opponent's marks and the pink circle device in the applicant's mark but there are not particularly striking stylisation effects. Overall, I find there is visual similarity to a high degree.

27. Turning now to an aural comparison, all marks will be verbalised in the same way as a repetition of the individual letters, i.e. with an EFF-EFF sound. I find there is aural identity between the marks.

28. Regarding the conceptual comparison, all marks share the double letter combination, FF. As such the concept is identical in each case. The circle device

and typeface shadowing will be seen as mere stylisation and add nothing to the concept brought to mind by the dominant element, namely FF.

Distinctiveness of the earlier marks

29. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. 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).”

30. No claim has been made for enhanced distinctive character of the earlier marks through use, so I have only the inherent distinctiveness to consider. The earlier mark consists of a series of two stylised double letter FF elements. The letters FF do not describe or allude to the services for which they are registered but in my view

there is nothing especially striking or inventive about letters of the alphabet. I find the earlier marks to be inherently distinctive to an average degree.

Likelihood of confusion

31. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where 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 trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer and the nature of the purchasing process for the contested goods. In doing so, I must be aware that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

33. So far in this decision I have found that the parties' services to be identical and similar to a medium degree and that the average consumer will purchase these services through a primarily visual means although I did not rule out an aural component. The consumer will also be paying at least a medium degree of attention. I also found that the opponent's earlier mark is inherently distinctive to an average degree. Additionally, I found there was a high degree of visual similarity, whilst there was aural and conceptual identity.

34. Based on the marks and the services before me and taking into account the assessments set out above, the identical nature of the FF element is the most pertinent factor to consider. The stylised elements will not make a lasting impact on consumers, whereas the dominant FF element will. In my view the effect of imperfect

recollection will be such that a significant proportion of consumers will directly confuse the two marks where the services are identical or similar.

Conclusion

35. The opposition succeeds under section 5(2)(b) of the Act against class 41. The application can proceed to registration for class 35 which did not form part of these proceedings.

Costs

36. As the Opponent has been successful, it is entitled to a contribution of towards its costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs as follows although I decline to award costs for the evidence filed as it did not assist me in this decision.

£100 Notice of Opposition fee
£300 Considering the counterstatement
£300 Providing written submissions
£700 Total

37. I order Future First Alumni Limited to pay Freightforce Distribution Ltd the sum of £700. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of September 2020

June Ralph
For the Registrar,
The Comptroller General