

O-482-20

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3444255
BY
TO REGISTER**

**Driver Guardian
driver guardian**

(SERIES OF 2)

**AS A TRADE MARK
IN CLASS 36
AND OPPOSITION THERETO (UNDER NO. 600001333)
BY
GRYPHON GROUP HOLDINGS LTD**

Background & pleadings

1. Driver Guardian Limited (“the applicant”) applied for the trade mark set out on the title page as a series of two marks on 14 November 2019. The marks were published in the Trade Marks Journal on 22 November 2019 in class 36 for *insurance brokerage*.

2. Gryphon Group Holdings Ltd (“the opponent”) opposed the application using the Fast Track procedure on 24 February 2020. The opposition is pleaded under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on some of its services registered in class 36 for the following three UK trade marks:

UK TM No. 3292007	Services relied on:
 <p>(series of two)</p> <p>Filing date: 22 February 2018 Registration date: 1 June 2018</p>	Insurance services; brokerage services
UK TM No. 3281441	Services relied on:
<p>GUARDIAN 1821</p> <p>Filing date: 9 January 2018 Registration date: 13 April 2018</p>	Insurance services; brokerage services
UK TM No. 3312632	Services relied on:
<p>GUARDIAN QI</p> <p>Filing date: 22 May 2018 Registration date: 28 September 2018</p>	Insurance services; brokerage services

3. The opponent's trade marks are earlier marks, in accordance with section 6 of the Act, but as none of the marks have been registered for five years or more before the filing date of the applicant's mark, they are not subject to the proof of use requirements, as per section 6A of the Act.

4. The applicant filed a counterstatement denying the grounds of opposition.

5. 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".

6. The 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. No such leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) 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. A hearing was not requested nor considered necessary in this case. Both parties provided written submissions. This decision is taken following a consideration of the papers.

8. The applicant is unrepresented in these proceedings whilst the opponent is represented by Keltie LLP.

Preliminary issues

9. I note in the applicant's counterstatement it claims the parties "are totally different business models and supply totally different products/services".

10. Before going on, it is necessary to explain why, as a matter of law, this point has no bearing on the outcome of these opposition proceedings. A trade mark registration is essentially a claim to a piece of legal property, i.e. the trade mark. The services for which the mark is registered set some limits to the claim, although since marks can be protected against the use of the same or similar marks in relation to services which are only similar to those for which the earlier mark is registered, the limits of the claim are not precise. Every registered mark is therefore entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar services, if there is a likelihood of confusion.

11. Until a trade mark has been registered for five years (when the proof of use requirements set out in s.6A of the Act are applicable), it is entitled to protection in relation to all the services for which it is registered. Consequently, the opponent's earlier trade marks must be protected for the services they have relied on without the opponent needing to prove any use in relation to those services. The opponent's earlier marks are therefore entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for all the services listed. The concept of notional use is set out in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

"78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion."

12. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. In *Oakley v OHIM* (case T-116/06) it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between the two marks, ...cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective –of the trade mark proprietors...”

13. Essentially then the differences between the services currently provided by the parties are irrelevant, except to the extent that those differences are apparent from the services they have tendered for the purpose of the registration of their marks.

Approach

14. The opponent relies on the three earlier marks set out above. Two of these are word marks with identical specifications. I intend to compare these two marks to the application (a series of two word marks) in the first instance, returning to the figurative earlier mark if it proves necessary to do so.

Decision

15. Section 5(2)(b) of the Act is as follows:

“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.

16. 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 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

17. In the judgment of the CJEU 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”.

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

19. The following case law is also applicable to these proceedings. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20. The earlier marks share the same specification so the services to be compared are:

Opponent’s relied on services	Applicant’s services
Insurance services; brokerage services	Insurance brokerage

21. Clearly the applicant's services are contained within the broader coverage of the opponent's terms *insurance services* and *brokerage services*. On the basis of the *Meric* principle set out above, I find the services are identical.

Average consumer and the purchasing process

22. I next consider the role of the average consumer and how the services 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*.

23. 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.”

24. The average consumer for the contested services are the general public and business professionals. Purchasing insurance services is likely to be a visual process as consumers would likely browse print media such as literature, brochures and portfolios or their online equivalents before making a choice of service provider but I do not discount any aural component to choosing a service provider such as word of mouth recommendations or advice sought from an insurance professional. In my experience the cost of insurance services can be expensive and at any rate, a consumer will need to consider factors such as the features a policy offers, its

suitability for purpose and its terms and conditions. As such I find the consumer will be paying a medium to high degree of attention during the purchasing process.

Comparison of the marks

25. 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 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.”

26. 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.

27. The marks to be compared are:

Opponent's earlier marks	Applicant's marks
UK TM No. 3281441 GUARDIAN 1821	Driver Guardian driver guardian
UK TM No. 3312632 GUARDIAN QI	

28. The opponent's mark no. 3281441 comprises a word and numerals, **GUARDIAN 1821** in a standard typeface. No one element dominates the other and both contribute equally to the overall impression of the mark.

29. The opponent's mark no. 3312632 comprises a word and two letters, **GUARDIAN QI**, in a standard typeface. Like the previous earlier mark, the two elements make an equal contribution to the overall impression of the mark.

30. The applicants mark is a word mark and a series of two. The marks differ only in that the first mark in the series is in title case and the second mark is in lower case. In relation to *insurance brokerage services*, the word **Driver** is meaningful as it describes a category of insurance, i.e. insurance for drivers. In those circumstances, the distinctive word **Guardian** would strongly dominate the mark. In relation to other non-motoring insurance brokerage services, **Driver** would take on a slightly more distinctive significance. In my view whilst the word **Guardian** is the most distinctive element of the mark, the overall impression is derived from the mark as a whole.

Visual, aural and conceptual comparisons

31. The respective marks share the word **GUARDIAN**, which is the first element in the opponent's marks and the second element in the applicant's mark. There are several points of difference. The applicant has the additional word **Driver** as the first word in its mark. Whereas in the opponent's marks, there are the additional second elements, namely **1821** and **QI**, which the opponent submits "do not detract from the dominance of Guardian within its marks"¹ as **1821** is the year the opponent was founded and **QI** is a short element at the end of the mark. I have already found that in both earlier marks, both elements have equal weight. Consequently, when considering the marks, I do not find it to be the case that the second element is less significant. There is nothing about the presentation of the marks that suggests one element dominates the other, beyond the word **GUARDIAN** being presented first,

¹ Written submissions dated 1 July 2020

Overall, I find there is a medium degree of visual similarity between the application and each of the earlier marks.

32. In an aural comparison, the marks share the word **Guardian** which will be pronounced identically in each case. In terms of differences, the applicant's mark has the additional word **Driver** which will be pronounced as it is the first word of the mark. The opponent's marks have the additional numerals **1821** and the letters **QI**, which are likely to be verbalised in the respective marks as the text is presented on a single line and may be easily read in full, from left to right. Overall, I find there to be a medium degree of aural similarity.

33. With regard to the conceptual similarity, I find the message brought to mind by the applicant's mark is that of someone or something acting as a guardian for drivers. The opponent's word **Guardian** will bring to mind the same concept of guardianship. With regard to the other element of the opponent's earlier mark ending '441, I find that the numerals **1821** will likely be seen as a year. The opponent states in its written submissions² that in fact 1821 was the year the opponent company or its predecessor was founded, but there is no evidence that the average consumer of the opponent's services would know this. For the earlier mark ending '632, there is no immediately graspable³ concept for the letter combination **QI**, other than they are simply two letters of the alphabet. The additional elements in the earlier marks do not alter or add to the concept of 'guardianship'. I find the application to be conceptually similar to the earlier marks to a medium degree.

Distinctiveness of the earlier mark

34. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of the use made of it, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

² Written submissions dated 1 July 2020

³ It has been highlighted in numerous judgments such as *The Picasso Estate v OHIM*, Case C-361/04 that it is only concepts capable of immediate grasp by the consumer that are relevant.

“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).”

35. As these are Fast Track proceedings with no requirement for evidence, I need only consider the inherent distinctiveness of the earlier marks. These consists of an ordinary dictionary word **Guardian** and a four-digit number **1821** and **Guardian** and the letters **QI**. I find that **Guardian**, being someone or something that guards, has a mild allusion to insurance services but is not descriptive of them. Turning to the additional elements, firstly 1821, I find that if the numerals are seen as a date, indeed maybe that of a founding year, then this is not uncommon in a trade mark. If that element is not seen as a date then they will simply be seen as a distinctive combination of numerals. With regard to the letters **QI**, although they have no relevant meaning as a combination and as such are distinctive, in my view an average consumer would merely see two random letters of the alphabet. Taking all these factors into account, I find that the earlier marks can be considered as inherently distinctive to a medium degree.

Likelihood of confusion

36. 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.

37. 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.

38. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

39. During this decision I have found that the services of the respective parties are identical, the average consumer can be a member of the general public or a business and that the services will be selected by a primarily visual means, although I did not discount an aural aspect. I also found that the consumer will be paying a medium to high degree of attention during the purchasing process. Regarding the similarity of the marks, I found there was a medium degree of visual, aural and conceptual similarity.

40. The existence of additional distinctive elements in the earlier marks and the word **Driver** in the application point away of a likelihood of direct confusion.

41. Turning to the question of indirect confusion and bearing in mind the identical nature of the services, I find that the average consumer on seeing the **Driver Guardian** mark may note the additional element but will assume that this is a plausible brand extension, e.g. for motoring insurance provision and is likely to be confused in to believing that respective goods come from the same or economically linked undertakings. As such I find there is a likelihood of indirect confusion.

Conclusion

42. The opposition brought under section 5(2)(b) of the Act has succeeded in full. Subject to any appeal against this decision, the application will be refused. Having succeeded in its opposition based on its two earlier word marks, I do not need to consider the opponent's earlier figurative trade mark no.3292007 as it does not put the opponent in any stronger a position.

Costs

43. The opponent has been successful, so it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs in Fast Track proceedings are governed by Tribunal Practice Notice (TPN) 2/2015. Bearing in mind the guidance given in TPN 2/2015, I award costs to the opponent as follows:

£100 Official fee

£200 Filing a notice of opposition

£100 Filing written submissions

£400 Total

44. I order Driver Guardian Limited to pay Gryphon Group Holdings Ltd the sum of £400. 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 30th day of September 2020

June Ralph

For the Registrar

The Comptroller-General