O/489/20

TRADE MARKS ACT 1994
IN THE MATTER OF
OPPOSITION Nos. 412720, 412721 & 412722
IN THE NAME OF DOME CONSULTING LIMITED
TO TRADE MARK APPLICATION Nos. 3272414, 3272429 & 3272417
IN THE NAME OF DOME GROUP FINANCIAL ADVISERS LIMITED

DECISION

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1. This is an appeal against the decision of Hearing Officer Heather Harrison dated 11 December 2019 in which she allowed oppositions against four marks incorporating the word DOME in Class 36.

2. The Applicant and Appellant is Dome Group Financial Advisers Limited and the marks applied for are DOME ("the Word Mark"), DOME Group ("the Phrase Mark") and the following figurative marks shown below (a series of two) under numbers 3272414, 3272417 and 3272429 respectively ("the Logos"):

and


3. I shall refer to these together as the DOME Applications where there is no need to distinguish between them.

4. Before the Hearing Officer, registration was sought for the following services in Class 36:

> Financial services, excluding lending services; investment services; financial asset management services; investment management services; advisory services in relation to all of the aforesaid services.

5. The Opponent/Respondent is Dome Consulting Limited. It raised numerous grounds of opposition below and succeeded under s.5(2)(b). This is the only ground I have to address on this appeal, and, as I explain below, only on a limited basis.

6. The successful s.5(2)(b) opposition was based on EU trade mark registration 13299681 ("the EUTM") for

7. This is registered in the following classes:

> 35 Business advisory and consultancy services to those in the building and/or construction industries; business administration to those in the building and/or construction industries; office functions to those in the building and/or construction industries; business management assistance provided to those in the construction industry; business advisory and consultancy services relating to building and construction projects; business project management to those in the building and/or construction industries; compilation of information and analysis for input into computers and databases to those in the building and/or construction industries.
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> 37 Building project management; construction project management services; on site building project management; on site project management relating to the construction of buildings.

8. As the EUTM had not been registered for five years at the date of publication of the contested applications, it was not subject to any use conditions.

9. The Hearing Officer found as follows:

> (a) the Word Mark was visually similar to a high degree and aurally and conceptually identical to the EUTM (§89);
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> (b) the Phrase Mark was visually similar to a fairly high degree, aurally similar to a medium degree and conceptually similar to a fairly high degree to the EUTM (§91);

(c) the Logos were visually similar to a medium degree and aurally and conceptually identical to the EUTM (§93);

(d) the Device was inherently distinctive to a medium degree (§82);

(e) the average consumer will pay a high degree of attention (§79);

(f) the EUTM classes are similar to the class 36 application services to a low degree (§77);

(g) overall there was a likelihood of indirect confusion between each of the Dome Applications and the EUTM (§§95-97).

10. The appeal is confined to (f) and (g) above – and specifically the classification and comparison of services.

11. Further, on this appeal the Appellant seeks for the first time to restrict the scope of services within class 36 by addition of the following limitation '*none of the aforesaid services provided to those in the building and/or construction industries*' (the "Limitation").

12. On this appeal, as below, the Appellant/Applicant was represented by Guy Tritton of counsel, instructed by HGF Limited and the Respondent/Opponent by Jamie Muir Wood of counsel, instructed by JP Mitchell Solicitors. I am grateful to both of them for their submissions.

APPROACH TO THIS APPEAL

13. There was no dispute as to this and the principles are well known. See *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17. In order to allow the appeal I must be satisfied that there was an error of law or that the decision is outside the bounds within which reasonable disagreement is possible.

THE DECISION

14. I have summarised the relevant findings of the Hearing Officer above. In addition it is helpful to refer to the following paragraphs of the Decision.

15. At §§70-74 the Hearing Officer referred to the law relating to the comparison of goods and services. There was no dispute as to this. On this appeal Mr Tritton emphasised the passages quoted by the Hearing Officer at §§72-74 in particular:

72. In *Avnet Incorporated v Isoact Limited,* [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "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."

73. In *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Sanco SA v OHIM,* Case T-249/11, the General Court ("GC") indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, EU:T:2009:428, the GC stated that "complementary" means:

> "[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

74. I also bear in mind the comments of Daniel Alexander Q.C., sitting as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13, where he warned against applying too rigid a test when considering complementarity:

> "20. In my judgment, the reference to "legal definition" suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston".

16. The Hearing Officer then turned to the comparison of services, and in particular what he identified as the opponent's best case under class 35, and held at §77 (footnotes omitted, emphasis added):

77. All of the applicant's services provide the consumer with advice regarding and/or the means of managing money. That would include, for example, advice about particular financial products, comparisons between different providers of such products and planning investments to maximise one's returns. The earlier "business advisory and

consultancy services to those in the building and/or construction industries; business management assistance provided to those in the construction industry" are both wide enough to include, for example, advice regarding the efficient allocation of financial or human resources, how to increase market share or cost price analysis. **The business advice may include certain financial aspects, such as tax advice, the level of investment that will be required to enter a new market or reports on the business's assets/financial health. That said, business consultancy services are unlikely to provide advice on specific financial products or investments, which would be provided by financial institutions. I do not consider that there is a competitive relationship: although there may be financial aspects to the class 35 services, they are not alternatives to one another. There may be a degree of complementarity, though I do not consider it particularly pronounced.** The applicant's evidence of separate fields is not relevant as it does not relate to the services under consideration. These services are similar but only to a low degree.

17. The conclusions of the Hearing Officer on the findings the subject of this appeal were expressed at §§95-97 as follows (emphasis added):

> 95. I will consider first the position for the contested word mark. The marks are visually similar to a high degree and both aurally and conceptually identical. Those are factors which point strongly towards confusion. Set against that, however, is that the services are similar only to a low degree. Further, these services will be selected with a high level of attention. I also bear in mind that, for the similar services, the earlier mark has a medium level of distinctiveness. **However, despite the low degree of similarity between the services, they are not so remote that the consumer will not think that the undertakings are economically connected. On the contrary, my view is that, when confronted with the later mark, the consumer is likely to think that these are variant marks used by the same or an economically connected undertaking. There is a likelihood of indirect confusion.**
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> 96. Turning to the "DOME Group" mark, my view is also that there would be a likelihood of indirect confusion. There is less visual and aural similarity between the marks overall and a degree of conceptual difference. **However, the indication in the later mark that there is a group of companies operating under the "Dome" mark does not offer a sufficient point of differentiation: it is itself suggestive of other entities potentially trading under the same dominant element. The limited similarity between the services and the medium distinctive character of the earlier mark are inadequate to compensate in the applicant's favour for the similarities between the marks**.

97. In respect of the contested figurative marks, there is plainly a lesser degree of visual similarity. However, the marks are aurally identical and any conceptual meaning in the device elements simply reinforces the same conceptual message. **Again, my view is that despite the limited similarity between the services there is a likelihood that the consumer, even one paying a high degree of attention, will think that the services are offered by related economic undertakings. There is a likelihood of indirect confusion.**

THE APPEAL

Comparison of Services

18. The first and main ground of appeal pursued related to the Hearing Officer's comparison of services. It was said that the Hearing Officer erred in three respects. First, she construed the services under the EUTM widely when she should have focussed only on the core. Second, she was wrong to find the EUTM services complementary to those sought to be registered in Class 36. And finally that she should have considered each of the services separately. I will take these points in turn.

19. As noted above, there was no criticism of the Hearing Officer's approach to the law. She cited Jacob J. in *Avnet*, and the Appellant submitted that this embodied the correct approach. However, it was said that, having identified the correct approach, she did not then go on to apply it. Had she done so, it was submitted that she would have focussed on the core services covered by the EUTM, and in particular the core of business advisory and consultancy services relating to building and construction projects, and found that they were not similar.

20. In addition to the passage from *Avnet*, which was repeated and approved by Jacob LJ (as he had by then become) in *Reed Executive Plc v Reed Business Information* [2004] EWCA Civ 159, [2004] RPC 40, I was also referred to the recent summary of the law provided by Arnold LJ (sitting as a first instance judge) in *Sky v Skykick*, [2020] EWHC 990 (Ch) where he explained (Appellant's emphasis):

> [54] This decision [T-279/18 *Alliance Pharmaceuticals v EUIPO* EU:T:2019:752] appears to me to be an application of the principle which I identified in the Second Judgment at [11], namely that **an unclear or imprecise term will be narrowly interpreted as extending only to such goods or services as it clearly covers**.
>
> ...
>
> [56] In summary, therefore, the applicable principles of interpretation are as follows:
>
> (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) **In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.**

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.

21. With this caselaw in mind, the Appellant submitted that there were four relevant principles to apply:

(a) The specification should be scrutinized carefully and confined to its core;

(b) If the term is potentially of wide scope, the tribunal should consider the core of the words' ordinary or natural meaning;

(c) A specification of services should not be interpreted liberally such that its meaning is unclear or imprecise;

(d) On the contrary, unclear or imprecise wording should be interpreted narrowly.

22. The Respondent did not dispute these principles, and nor do I. The relevant question for me is whether the Hearing Officer correctly applied this approach.

23. As to this, it was submitted that the Hearing Officer erred in construing the class 35 services for the EUTM too broadly – they were ambiguous and imprecise, and so it was said that she should have construed them more narrowly. Indeed, it was said that she was inconsistent and adopted the correct approach when assessing the use provisions of another of the Opponent's marks, but then failed to do so in the context of the EUTM.

24. It is perhaps surprising to think that the Hearing Officer instructed herself correctly as to the law, and adopted the correct approach in one part of the decision, but then abandoned it in the part now under appeal. Nevertheless, the Appellant submitted that the Hearing Officer adopted too wide a definition of "business" in "business advisory services relating to building and construction projects" such that this encompassed any trading entity. Reliance was put upon her use of the word "may" when describing the sort of services she envisaged ("*The business advice may include certain financial aspects, such as tax advice*…"), but in my judgment that is not inconsistent with a narrow and precise definition which is directed at more than one service.

25. I was also taken to the class headings and explanation in the Nice Classification, which the Hearing Officer referred to in her §55. In relation to Class 35, the following was highlighted:

> Class 35
> Advertising; business management; business administration; office functions.
>
> Explanatory Note
> Class 35 includes mainly services rendered by persons or organizations principally with the object of:
> 1. help in the working or management of a commercial undertaking, or
> 2. help in the management of the business affairs or commercial functions of an industrial or commercial enterprise,
>
> as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services.

26. It was emphasised that very little of this was concerned with financial services. Consistent with this I was taken to the guidance for Class 36, the relevant part of which reads as follows:

> Class 36
> Financial, monetary and banking services; insurance services; real estate affairs.
> Explanatory Note
> Class 36 includes mainly services relating to banking and other financial transactions, financial valuation services, as well as insurance and real estate activities.

27. I accept all of this. But so it seems did the Hearing Officer. She held in §77 that *"business consultancy services are unlikely to provide advice on specific financial products or investments, which would be provided by financial institutions".* Nevertheless she held that business consultancy services could "*include certain financial aspects, such as tax advice, the level of investment that will be required to enter a new market or reports on the business's assets/financial health."* I consider that in focussing on these aspects the Hearing Officer had sufficiently confined the specification, as she was required to do, to an interpretation which was realistic and not unclear or imprecise.

28. In relation to this definition the Respondent pointed me to the following services found within Class 35:

> 350123 tax filing services
> 350073 tax preparation

350067 payroll preparation
350007 cost price analysis
350015 book-keeping / accounting
350017 business auditing

29. In other words, even adopting a narrow definition of business consultancy services, as she was required to do, the Hearing Officer was justified in holding that they could include services relating to tax, audit and accounting. There was therefore basis for the Hearing Officer to reach the conclusion that she did in §77. Moreover, she expressly pointed out that there was not a competitive relationship between the respective services, demonstrating that she had understood them correctly.

30. In short, I am not persuaded that the Hearing Officer fell into error in her approach to construction. Contrary to the submissions of the Appellant, she did not adopt an over-broad approach. Having cited the relevant authorities I consider she correctly applied them and her conclusion as to the meaning of the terms in Class 35 was justified.

31. I turn next to the question of whether the Hearing Officer was correct to find the services complementary. As noted above, she found complementarity only to a limited degree, stating "*There may be a degree of complementarity, though I do not consider it particularly pronounced"*.

32. On the basis of the analysis and comparison above, I think she was justified in holding that there is an element of complementarity between the relevant services in Classes 35 and 36, properly construed. She correctly recognised that such complementarity was limited, but I do not find that it was wrong of her to acknowledge it to the extent that she did.

33. The Appellant criticised the Hearing Officer's reference in a footnote following the finding of complementarity to Case T-301/09, EU:T:2012:473 *IG Communications v OHIM (Citygate)* where she referred to §56 of the General Court's judgment and its comparison between the services in that case, where there was a low degree. Instead, the Appellant submitted, guidance should be taken from a different case T-323/14 *Bankia SA v OHIM* ECLI:EU:T:2015:642, decided post-*IP Translator*, which it was said was closer on the facts but where there was no similarity. I did not find this attempt to compare facts in different cases to be particularly helpful and in any event I do not consider that the Hearing Officer's Decision depended upon the case she referred to. The question is whether the Hearing Officer in the present case

directed herself improperly as to the law or otherwise was wrong in finding the limited degree of complementarity that she did. I reject the appeal based on this limb.

34. Finally, under this ground I deal with the suggestion that the Hearing Officer failed to compare all the services sought to be registered separately. I do not consider there is anything in this point either. As she pointed out at the beginning of §77 "***All** of the applicant's services provide the consumer with advice regarding and/or the means of managing money.*" (emphasis added). Moreover, I consider that the conclusions she reached in the remainder of §77 would apply to all of the services sought to be registered by the Appellant, namely "*Financial services, excluding lending services; investment services; financial asset management services; investment management services; advisory services in relation to all of the aforesaid services*."

35. For these reasons I reject the Appellant's first ground of appeal.

Likelihood of Confusion

36. The Appellant's second ground of appeal focussed on §§95-97 of the decision and the Hearing Officer's conclusions as to the likelihood of confusion. The Appellant submitted that the Hearing Officer had erred in relation to her conclusion that there could be indirect confusion because the type of confusion she identified was not amongst the three categories identified by Iain Purvis QC in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he explained:

> 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"*.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even

where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example).

37. It was said by the Appellant that the type of confusion identified by the Hearing Officer was not indirect confusion at all, but direct confusion, and that she had erred.

38. I disagree. The type of confusion relied on by the Hearing Officer in e.g. §95 was as follows (emphasis added):

> However, despite the low degree of similarity between the services, they are not so remote that **the consumer will not think that the undertakings are economically connected**. On the contrary, my view is that, **when confronted with the later mark, the consumer is likely to think that these are variant marks used by the same or an economically connected undertaking**. There is a likelihood of indirect confusion.

39. This is indirect confusion. The consumer is not seeing the marks and mistaking them for each other without realising. Instead, the Hearing Officer was postulating that the consumer sees the mark, recalls that a similar mark has been used for different services, and wonders whether there is a connection between the relevant undertakings. This is precisely what Iain Purvis QC explained at §16 of *LA Sugar*.

40. It may be that this case is unusual because the confusion is "indirect" in the sense not that the marks are different, but that the services are. Thus the Hearing Officer was considering a situation in which the consumer would not mistake the mark/services of one undertaking for another, because the services were different enough. Nevertheless, she considered that there was sufficient similarity between the marks and the services for people to wonder whether the undertakings providing them were linked.

41. I do not consider that there was anything wrong with this assessment. As I pointed out in *Chanel's Gabrielle*, O/256/20 at §49, the categories of case to which the doctrine of indirect confusion might apply are not limited to the three examples identified in *L.A. Sugar*. The situation considered by the Hearing Officer is akin to *L.A. Sugar* type (b), except that in this case the difference arises at the level of the services offered and not the marks. Given that ultimately the test is a global one, I

do not consider there is any error of principle in attributing indirect confusion to the situations postulated by the Hearing Officer.

42. The Appellant suggested that brand extension exercises usually involved the addition of another word (such as LITE) to a well-known mark, not the removal of elements from such a mark. That may be, but the question of whether there is a likelihood of confusion under s.5(2)(b) includes the situation where the sign is seen before the mark and vice versa. It is therefore irrelevant which of the two is seen as the brand and which is seen as the extension.

43. For these reasons I dismiss this ground of appeal too.

44. I also stand back and assess the Appellant's arguments in the round. The Appellant drew my attention to the findings of the Opposition Division at EUIPO which rejected a parallel opposition. Both sides sought to draw support from this decision. The Appellant unsurprisingly pointed to the result, whilst the Respondent pointed to the reasoning in relation to the nature of the services within Class 35 and submitted that the mere fact that the Division had come to a different ultimate conclusion did not mean that the Hearing Officer had fallen into error, particularly where she had instructed herself in the same way as to the law. I agree with the Respondent as to this. All that can be said about the conclusion at EUIPO is that this appears to be one of those cases where reasonable people can differ. As is well settled, that does not justify intervention on appeal where the decision has not been demonstrated to be wrong.

45. Finally, I turn to the Limitation offered by the Appellant for the first time on this appeal. I heard submissions as to admissibility, and it was argued by the Respondent that the limitation should have been offered sooner. There is no need for me to go into this because I do not consider that the Limitation can assist in the circumstances of this case.

46. If there is a likelihood of confusion by the use of the respective marks for "*Financial services etc.*" in Class 36 compared to the EUTM's "*Business advisory and consultancy services to those in the building and/or construction industries*" on the grounds that the average consumer will think that the undertakings offering them are economically connected, then I cannot see how such confusion is removed by the fact that the financial services are not being provided to those in the building and/or construction industries.

47. As the Respondent pointed out, the types of services being offered in Class 36 are identical with or without the Limitation. It is therefore difficult to see how notional use with the Limitation compared to the services registered under Class 35 could be so different so as to avoid the confusion identified by the Hearing Officer. The mere fact that the Limitation prohibits them from being offered to a certain sector does not mean that the average consumer may not still think that there is a connection between the businesses, which could be divided by sector and not service. As I understand the decision of the Hearing Officer, the finding of complementarity and subsequent confusion would still follow.

48. Accordingly, I do not think that the Limitation can assist the Appellant in the present case.

Conclusion

49. The appeal is dismissed. In the usual way the Appellant should pay a contribution towards the costs of the Respondent. I assess this in an amount of £1400 to take account of the Respondent's costs of preparing for and attending the hearing.

50. Below, the Hearing Officer ordered that the Applicant pay to the Opponent the sum of £2700.

51. Accordingly I order that the Appellant pay to the Respondent the sum of £4100, to be paid within 21 days of the date of this decision.

Thomas Mitcheson QC
The Appointed Person
5 October 2020