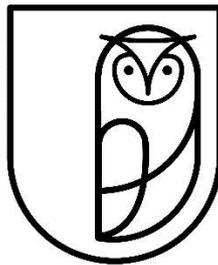


**O/547/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003259362 BY  
MICHAEL LESLIE-JOHNSON AND CAROL LESLIE-JOHNSON  
TO REGISTER:**



**AS A TRADE MARK IN CLASS 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 411233 BY  
KPS AG**

## BACKGROUND AND PLEADINGS

1. On 26 September 2017, Michael Leslie-Johnson and Carol Leslie-Johnson (“the applicants”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 6 October 2017.

2. The application was opposed by KPS AG (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is based on the earlier EU Trade Mark registration no. 17113168 for the following mark:



3. The opponent’s mark has an application date of 16 August 2017 and registration date of 11 January 2018. It claims the colours orange, blue and white.

4. The following services are relied upon in this opposition:

Class 41                      Education, providing of training.

5. The opponent argues that the respective services are identical and that the marks are similar.

6. The applicants have filed a Defence and Counterstatement denying the claims made. The applicants have also filed an email dated 26 June 2018 in which they make further submissions regarding the similarity of the services provided by the parties.

7. No hearing was requested and so this decision is taken following a careful perusal of the papers.

## DECISION

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

“5(2) A trade mark shall not be registered if because –

(a)...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

10. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in issue in

these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, as a consequence, rely upon all of the services it has identified.

### **Section 5(2)(b) – case law**

11. 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 greater 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 to mind the earlier mark, 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**

12. The competing services are as follows:

Opponent's services                      Class 41 – Education, providing of training

Applicant's services                      Class 41 – Training and education services

13. The opponent argues that the services are identical. The applicants accept, in their Defence and Counterstatement, that the “services specified are the same” but state that the “two organisations are very different”. The applicants go on to state that the opponent is a “multi-million Euro turnover retail consultant based in Germany. From their website, they offer many corporate services including a ‘boot camp’ in logistics which may well contain an element of training. *We do not offer any corporate services.*” In an email dated 26 June 2018, the applicants provide further information about the nature of their business.

14. The actual use by the parties is not relevant in a case such as this where proof of use does not apply, because the comparison must be made on the basis of notional use of the marks across the full width of the specifications. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) as follows:

“22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer’s use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

15. This approach was endorsed by the Court of Appeal in *Roger Maier v ASOS* ([2015] EWCA Civ 220 at paragraphs 78 and 84). It is clear from the case law that my assessment must take into account only the applied-for mark (and its specification) and any potential conflict with the earlier trade mark. Any differences between the

services provided by the parties, or differences in their trading styles are irrelevant unless those differences are apparent from the applied-for and registered marks.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 for 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.”

17. “Training and education services” in the applicant’s specification is plainly identical to both “education” and “providing of training” in the opponent’s specification. At the very least, these services are identical on the principle outlined in *Meric*.

### **The average consumer and the nature of the purchasing act**

18. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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.”

19. The parties have made no submissions on the average consumer or the purchasing process for the services at issue. These services could cover both education and training for the general public (such as schools, universities or specialised courses) and training for members of the business community (such as sector-specific and highly specialised courses). The average consumer for these services would therefore be a member of the general public or a business looking to purchase such services for the benefit of their employees. The average consumer will want to make enquiries about the services being purchased to ensure that they meet their specific requirements. The level of attention paid by the average consumer is likely to vary from average (such as a member of the general public choosing an evening course for their own enjoyment or a business user selecting a generic or standard training course) to high (such as a member of the general public selecting a university or a business selecting a highly specialised course for its specific sector). These purchases are likely to be infrequent and the cost will vary from average to high, depending on the nature of the services being purchased.

20. The purchasing process is likely to be primarily visual, following exposure to the mark on websites, in advertisements (whether online or in print) and on signage of premises. There is potential for the marks to be encountered aurally, through use over the telephone or in recommendations, so I do not rule out that there may be an aural component.

### **Comparison of trade marks**

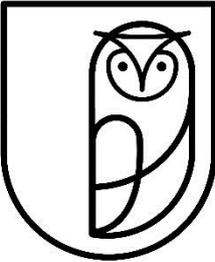
21. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

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 mark	Applicants' trade mark
	

24. The applicants have made the following submissions about the differences between the marks in their Defence and Counterclaim:

“Although they are both a two-dimensional depiction of a graphical Owl sideways on, as described by the opponent, *the Owls face different directions.*

Theirs has a bold outline in black, *ours is gold and is not bold.*

Theirs has a bold orange filled in mortar board, *ours does not have a mortar board.*

*Ours has a peaked nose, their does not.*

Theirs has an elongated coloured in orange tassel/nose appearance, *ours does not*.

Theirs is a heart shaped face, *ours is rounded*.

Theirs has feathers to the wing, *ours does not have feathers*.

*Ours is placed within a shield*, theirs is not.

An Owl will always have a similar look as it is a common object.”

25. The opponent has made the following submissions about the similarity of the marks:

“...the signs of both the Applicant’s mark and the Opponent’s mark both comprise an almost identical distinctive two dimensional graphical owl device consisting of a sideways-on body outline, wing outline, and chest outline which passes through the wing outline in a distinctive way, as well an almost identical face-one face outline. The sign of the Applicant’s mark comprises a brow outline, and the sign of the Opponent’s mark comprises a mortarboard outline, but these are visually very similar to one another. Therefore, visually and conceptually the signs are very similar to one another.”

26. The applicants’ mark is a side-on graphical representation of an owl created using a black outline. The owl graphic is presented on an outlined background which the applicants submit is representative of a shield. The overall impression of the applicants’ trade mark is dominated by the owl. The shield background plays a lesser role in the overall impression of the mark. The opponent’s mark is a side-on graphical representation of an owl using a blue outline. The owl graphic is wearing an orange mortarboard, with the tassel falling in front of its face to form the owl’s beak. The overall impression of the opponent’s trade mark is dominated by the owl, with the presence of the mortarboard playing a lesser role in the overall impression of the mark.

27. The use of the outline to create the owl graphic creates a visual similarity between the marks. I also agree with the opponent that the distinctive brow outline on the applicants' mark does appear similar to the mortar board on the opponent's mark. They also share the same lines sweeping across the chest and wings of the owl. Although, as the applicants suggest, there are differences between the marks, for example, the opponent's mark has a heart-shaped face whereas the applicants' is rounded, the opponent's mark has a feathered wing whereas the applicants' does not and the opponent's mark has a peaked nose and the applicants' does not, these differences would only be revealed by a close examination of the trade marks. In my view, the only differences of any consequence are that the opponent's mark includes an orange mortar board and the applicants' mark includes the background of a shield. Despite these points of difference there remains, in my view, a high degree of visual similarity between the marks.

28. The applicants have stated in their submissions that their mark is "gold and is not bold". The applicants' mark as it appears on the Register is in black and white. Presumably then, the applicants' reference to the mark appearing in gold relates to their use of the mark in the course of trade.

29. The Court of Appeal has stated on two occasions following the CJEU's judgment in *Specsavers*<sup>1</sup> (see paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc* [2015] EWCA Civ 290 at paragraph 47) that registration of a trade mark in black and white covers use of the mark in colour. This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter). Consequently, a black and white version of a mark should normally be considered on the basis that it could be used in any colour. However, it is not appropriate to notionally apply complex colour arrangements to a mark registered in black and white. This is because it is necessary to evaluate the likelihood of confusion on the basis of normal and fair use of the marks, and applying complex colour arrangements to a mark registered, or proposed to be registered, without colour would not represent normal and fair use of

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<sup>1</sup> *Specsavers International Healthcare Limited & Others v Asda Stores Limited*, Case C-252/12

the mark. I cannot, therefore, consider the applicants' mark only in a specific colour and therefore its use in gold (about which there is no evidence) is not of assistance to my decision. However, even if I were able to take it into account it would not be enough to change my findings on the visual similarities between the marks.

30. With regard to conceptual similarities between the marks, they are both graphical representations of an owl (albeit the one is presented wearing a mortarboard and the other is presented on a shield). The fact that the opponent's mark is wearing a mortar board does conjure images of graduations and education which is, of course, indicative of the nature of the services provided by the opponent, although this does not detract from the dominance of the owl itself. The presentation of the applicant's mark on a shield also does not distinguish conceptually between the marks. Ultimately, the impression created by both marks is of an owl and I therefore find that there is a high degree of conceptual similarity between the marks.

31. In *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T-424/10 the General Court stated:

“45. ...contrary to what the applicant submits, a phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestle v OHIM – Master Beverage Industries (Golden Eagle and Gold Eagle Deluxe)* [2010] ECR II-1177, paragraph 67).

46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks”.

32. It would, therefore, be inappropriate in this case for me to consider the aural similarities or differences between the marks.

## **Distinctive character of the earlier trade mark**

33. 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-2779, 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).”

34. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

35. As the opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider. Neither

the opponent, nor the applicants have made any submissions about the distinctiveness of the earlier mark.

36. I must make an assessment of the inherent distinctiveness of the earlier mark as a whole. The use of the owl does carry an association with wisdom and there is therefore some allusion to the nature of the services provided. This is further enhanced by the presence of the mortarboard. I find that the earlier mark has a medium degree of inherent distinctiveness.

### **Likelihood of confusion**

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. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact 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.

38. I have found the parties' marks to be visually and conceptually similar to a high degree. I have found that the earlier mark has a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public or a business who will both select the services primarily by visual means. I have concluded that the degree of attention paid will be average. I have found the parties' services to be identical. Bearing in mind all of these factors, I am satisfied that the

similarities between the marks will lead to a likelihood of direct confusion between them i.e. the average consumer will mistake one mark for another.

## **CONCLUSION**

39. The opposition is successful.

## **COSTS**

40. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £300 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement	£200
Opposition fee	£100
<b>Total</b>	<b>£300</b>

41. I therefore order Michael Leslie-Johnson and Carol Leslie-Johnson to pay KPS AG the sum of £300. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 3<sup>rd</sup> of September 2018**

**S WILSON**

**For the Registrar**