

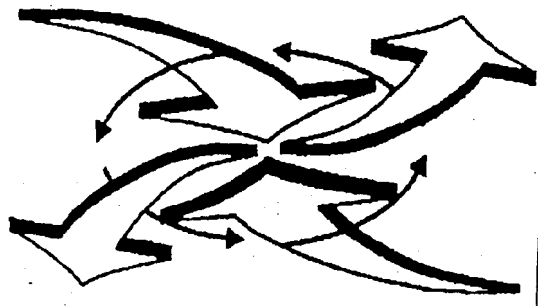
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2191962
BY CORPORATE ADVISORY SERVICES LTD
TO REGISTER A TRADE MARK IN CLASS 35

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 50128
BY ANTHONY WILLIAM JOHN DILNOT

BACKGROUND

1) On 16 March 1999, Corporate Advisory Services Ltd of Hampstead House, Basingstoke Shopping Centre, Basingstoke, Hants, RG21 1LG applied under the Trade Marks Act 1994 for registration of the following trade mark:



2) In respect of the following services in Class 35 “Personnel and recruitment services”.

3) On the 2 September 1999 Mr Anthony William John Dilnot of 27 Gabriels Hill, Maidstone, Kent, ME15 6 HX filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of UK trade mark registration number 2172439 ARROW device in respect of recruitment services; all included in Class 35.

b) The mark applied for is similar in appearance and is for similar services to the opponent’s mark. The application therefore offends against Section 5(2) and 5(4) of the Trade Mark Act 1994.

4) The applicant subsequently filed a counterstatement denying all of the grounds of opposition. Both sides ask for an award of costs.

5) Neither side filed evidence in these proceedings and the matter came to be heard on 17 May 2001 when the applicant was represented by Mr Cuddigan of Counsel instructed by Messrs

Alexander Ramage Associates, and the opponent represented himself.

DECISION

6) Prior to the hearing the opponent submitted a skeleton argument which included a number of allegations regarding the actions of the applicant and included a number of exhibits which the opponent sought to introduce as evidence into the case. I refused to allow the opponent to introduce evidence into the case at this stage as it appeared to me to be evidence which could have been filed at anytime during the normal evidence rounds.

7) Mr Dilnot then sought to have the hearing stayed pending the outcome of separate litigation. There was a dispute between the parties as to whether the separate action was in relation to the two marks in the instant case. From the responses elicited from Mr Dilnot and the papers filed with his skeleton argument it would appear that the dispute is over the use of the opponent's trade mark by the applicant and not the mark sought to be registered. I therefore refused the request to stay the proceedings.

8) As no evidence was filed the ground of opposition under Section 5(4) must fail. There is therefore only the ground of opposition under Section 5(2) to be determined. The relevant section reads:

“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 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 right is defined in Section 6, 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 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.

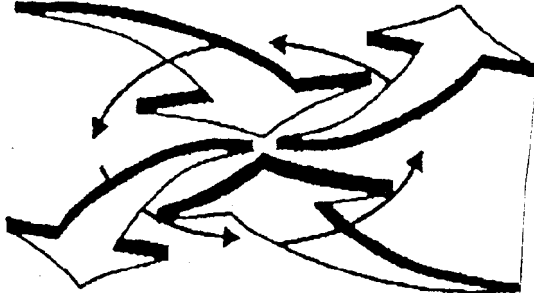
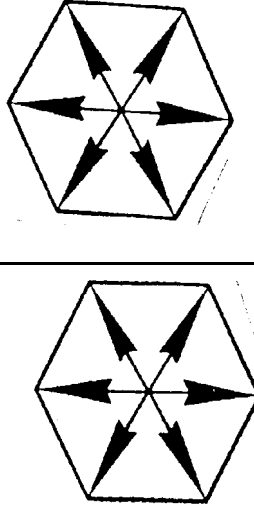
10) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that: -

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, 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; *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG* page 8, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;
- (h) further, 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; *Marca Mode CV v Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

11) It was common ground at the hearing that the services offered by both parties are identical.

12) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

13) For ease of comparison I reproduce the marks of both parties below:

Applicant's Mark	Opponent's Marks
	

14) The applicant's mark shows a pair of large 3-D arrows pointing to the centre of the mark and a similar pair pointing outwards. There are also four arrows creating an anti-clockwise circle. All of the arrows are curved and it is clear that the inward arrows go under those forming the circle, whilst the outwards arrows go over the circle. The opponent's marks each has the same device. This consists of six arrows emanating outwards from a single middle point enclosed within a hexagon. The second of the two marks has the words "Convenient - confidential - cost effective" printed underneath. However, I do not believe that such laudatory words affect the overall impression provided by the device. The opponent's device mark conveys a geometric image, looking somewhat like a compass. The swirling nature of the applicant's mark conveys an image of a flowchart.

15) I believe that this case is one where the words of Evershed J. in *Smith and Hayden Co.'s Application* (1946) 63 R.P.C. 97 at 102 are particularly relevant:

"When all is said, the question is in truth, as observed by Lord Justice Luxmoore and the House of Lords in the *ARISTOC* case, one of first impression, on which no doubt different minds may reach different conclusions. It is not profitable in such a case to indulge in a minute analysis of letters and syllables, a process indeed notoriously productive of confusion in regard to words."

16) Recruitment and personnel services are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. Even allowing for the notion of imperfect recollection, the average consumer is not likely to be confused.

17) Ordinarily I would also consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, no evidence has been filed. In such circumstances the opponent's marks cannot be regarded as enjoying an above average reputation at the relevant date.

18) With all of this in mind I come to the conclusion that while there are superficial

similarities, they are more than counterbalanced by the differences, and when all factors are considered, that there was no realistic likelihood of confusion at 16 March 1999. Consequently, the opposition under Section 5(2)(b) fails.

19) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £335. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31ST day of June 2001

George W Salthouse
For the Registrar
The Comptroller General