

**TRADE MARKS ACT 1994
AND
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 758291
AND THE REQUEST BY EKKO EIENDOM AS
TO PROTECT A TRADE MARK IN CLASS 36**

BACKGROUND

1. On 5 June 2001 Ekko Eiendom AS of Postbox 6091, Sluppen, N-7434 Trondheim, Norway, on the basis of International Registration No 208231 requested protection in the United Kingdom, under the provisions of the Madrid Protocol of the trade mark **NOTAR** in respect of the following services:

Class 36 Real estate brokerage; real estate appraisal; real estate development;
real estate investment; real estate management.

2. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and Notice of Refusal under Article 9(3) was given because the mark is excluded from registration by Section 5(2) of the Trade Marks Act 1994. This is because of the registered Community trade mark No 809145 which is registered in respect of the following services:

Class 36 Insurance; financial affairs; monetary affairs; real estate affairs; banking,
trusteeship.

3. A representation of Community trade mark No 809145 may be found below:



4. A hearing was held on 7 May 2002 at which the applicants were represented by Ms Leno of Forrester Ketley & Co, their trade mark attorneys. At the hearing the objection under Section 5(2) of the Act was maintained and Notice of Final Refusal was issued on 27 September 2002.

I am now asked under Section 76 of the Act and Rule 62(20) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

5. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

DECISION

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

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or*
- (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.”

An earlier trade mark is defined in Section 6(1) which states:

“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,”*

7. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik 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 Schuhfabrik 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-Mayer 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-Mayer Inc* page 9 paragraph 29.

Distinctive character of the earlier trade mark

8. It is clear from the ECJ's judgment in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade mark has a highly distinctive character.

9. The earlier trade mark is a registered trade mark and is therefore deemed to possess distinctive character. Furthermore this trade mark consists of the words **NOTAR**, **TREUHAND** and **BANK** together with device elements. There is also the colour claim to be taken into account. In my view the average consumer of the services in question would place nothing but trade mark significance upon this trade mark. Apart from the word **BANK** the remainder of the trade mark will be seen as a combination of invented words in combination with the device elements. In my view the trade mark possesses high distinctive character per se.

Similarity of the services

10. The earlier Community trade mark No 809145 is registered in respect of:

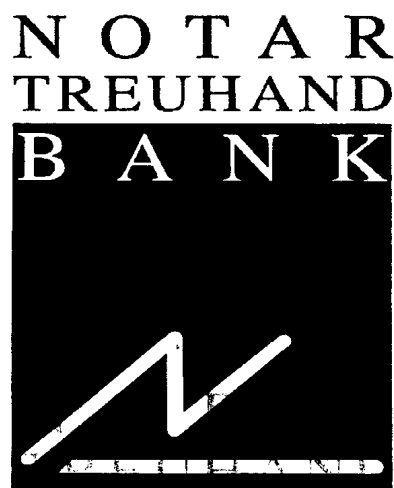
“Insurance; financial affairs; monetary affairs; real estate affairs; banking, trusteeship.”

11. It is clear from the applicants’ specification that at least some of the services are identical and that other services are similar to those of the earlier trade mark. The earlier trade mark’s specification includes “*real estate affairs*” which are identical to the services specified by the applicants. The earlier specification also includes services such as “*financial affairs; monetary affairs and banking*”, all of which are very broad terms that encompass a large number of services including the services specified by the applicants.

Similarity of the marks

12. Since the trade mark of this application is not identical to the earlier trade mark the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question, therefore, is whether the mark of this application is so similar to the earlier trade mark that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

13. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks bearing in mind their distinctive and dominant components. For the sake of convenience the earlier Community trade mark No 809145 is reproduced below:



14. The applicants have applied to register the word **NOTAR**. It is evident that the applicants’ trade mark is contained within the earlier trade mark. It is also evident that the earlier trade mark is a composite trade mark incorporating other words and devices.

Likelihood of confusion

15. In correspondence prior to the hearing, and at the hearing itself, Ms Leno stressed that the proprietors of the earlier trade mark are “**Notartreuhandbank (AG)**” and that their domain name is “**www.notartreuhand.at**”. It was suggested that the proprietors’ name and the domain name both serve to demonstrate that the proprietors of the earlier trade mark use their trade mark in this combined form and that this must result in there being no likelihood of confusion between the two trade marks. In my view this cannot be correct and must be considered to be irrelevant as far as this matter is concerned. The likelihood of confusion may only be assessed by reference to the applicants’ trade mark and the earlier registered trade mark. I do not accept that any weight can be placed on the manner in which the domain name and the name of the proprietors of the earlier trade mark are represented.

16. The earlier trade mark consists of the words **NOTAR**, **TREUHAND** and **BANK**. I have not been advised that the words **NOTAR** and **TREUHAND** will be identified by the average consumer of the services in question as anything but invented words. The word **BANK** has an obvious meaning in relation to the services in question and in my view the average consumer of these services would identify the word **BANK** as an indication that the mark in its totality is used in relation to banking and financial services. The word **BANK**, in white letters, is positioned at the top of a blue rectangle with further device elements, also in white, positioned at the bottom of the rectangle. The words **NOTAR** and **TREUHAND** appear in black lettering at the top of the trade mark, outside and above the blue square.

17. In the earlier trade mark the word **NOTAR** is in a very prominent position. It is placed at the top of the mark and is, in my view, likely to be the first element of the mark to be aurally or visually identified. Although there are other elements which combine with the word **NOTAR** to form the earlier trade mark it is the word **NOTAR** which is the prominent element and it is, in my view, the word by which the trade mark would be identified.

18. I must, of course, bear in mind that a mere possibility of confusion is not sufficient. (See eg *React Trade Mark* [2000] RPC 285 at page 290). The Act requires that there must be a likelihood of confusion. I have already found some of the respective services to be identical. It is clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the services (and vice versa) - see *Lloyd Schuhfabrik Meyer & CO GmbH v Klijsen Handel BV*.

19. Furthermore it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the services in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion. In this case I believe the identity of the services coupled with the high degree of distinctive character of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

20. In reaching this conclusion I bear in mind that it is sufficient if an average consumer encountering the respective marks would assume that the marks identify a single undertaking

or undertakings with an economic connection.

CONCLUSION

21. In this decision I have considered all of the documents filed by the applicants and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 07 day of February 2003

A J PIKE
For the Registrar
The Comptroller General