

O-056-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2447857
BY NHI SERVICES LTD TO REGISTER THE TRADE MARK**

letprotect

IN CLASS 36

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 95413
BY HOME 2 LET LTD**

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letprotect in Class 36**

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**IN THE MATTER OF Opposition thereto under No. 95413
by Home 2 Let Ltd**

BACKGROUND

1) On 27th February 2007 NHI Services Ltd, of Forge House, 66 High Street, Kingston Upon Thames, Surrey KT1 1HN (hereafter "NHI") applied to register the following trade mark:

letprotect

2) The application was in respect of "insurance only" in Class 36.

3) On 11th May 2007 the application was published for opposition purposes and on 13th August 2007, Home 2 Let Ltd, of 38 Main Street, Meriden CV7 7NF (hereafter "Home") filed notice of opposition to the application. The opposition is solely based on grounds under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act").

4) Home rely on their earlier UK registration 2447059. The details of this trade mark are:

Trade Mark	Filing and registration dates	Specification
Let Protect	17 February 2007 and 24 August 2007	Class 36 Accommodation letting agency, property letting services, rental of property, management of property, provision of information and consultancy in relation to the aforementioned services.

5) NHI subsequently filed a counterstatement denying the grounds for opposition.

6) Only NHI filed evidence in these proceedings. Both sides ask for an award of costs. Neither party requested to be heard and the matter has now come to me for a decision based on the papers filed.

Applicant's evidence.

7) David Jonathan Haddon Walker has provided a statutory declaration dated 23rd July 2008. He is the Managing Director of NHI. I will only deal with the evidence of facts, and will leave the area of legal submission, in particular the question of similarity of services, to the main body of my decision.

8) Exhibit 2 of Mr Walker's statutory declaration comprises a copy of the Financial Service Authority's (FSA) glossary of terms, the FSA being the Government's own Regulator for the Insurance Industry. This shows, says Mr Walker, that "insurance services" are not defined, and the nearest one gets is "insurance mediation", the entry against which makes no reference to consultancy. This is intended to show that consultancy and insurance services are completely different businesses.

9) He says that Home provide "an information service limited to personal contact in the Warwickshire area, despite their assertion [made in a letter dated 3rd October 2007 addressed to NHI and comprising Exhibit 3 to which I refer below] that they now manage property across the UK, not just in Warwickshire". Exhibits 4 and 5 show web material acquired by Mr Walker. Exhibit 4 shows the first page of results of a 'GOOGLE' search dated 28th May 2008 on the words "let protect warwickshire", which shows no reference to Home. Exhibit 5 shows the first page of the url, www.home2letgroup.co.uk, which I assume to be that of the opponent, which shows a statement "Coming soon. Please visit us again in early November or call us on 0845 202 6336 to discuss your immediate requirements".

10) He states further that there is no evidence that Home's "Let Protect" mark has been used previously or currently as a mark for an insurance product.

11) In contrast to Home's activities, Mr Walker says that "letprotect" by NHI is a national brand, promoted on the world wide web and via hard copy media. In support of the web activity there is exhibited (Exhibit 6) a search on 'GOOGLE' dated 28th May 2008 on the words "letprotect insurance" which shows the first page of results. These results show third parties urls such as www.webmoney.co.uk and www.moneysupermarket.com referring to NHI's insurance product "letprotect". Exhibit 7 shows the first page of NHI's own website www.letprotect.co.uk. There is also reference to a hard copy brochure in this Exhibit entitled "Summary of Cover". The brochure has the word "letprotect" at the top with the word "let" in green and "protect" in purple. The brochure makes clear that the insurance product involved is a "landlords' insurance" product, covering rental property buildings and contents with optional accidental damage cover, legal expenses, rent recovery cover and property emergency service.

12) Exhibit 3 is a letter dated 3rd October 2007 from Home to NHI saying that their Let Protect mark has “been with our landlord and tenant base for the last four and a half years” and, as I have already said, it is in use across the UK and finally that they will be willing to consider granting NHI a non-exclusive licence on an annual basis for which an annual fee would be required.

DECISION

Section 5(2) (b)

13) The opposition is founded upon Section 5(2) (b) of the Act. This reads:

“(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.”

14) 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), 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,

Home’s mark was filed on 17th February 2007 and NHI’s on 27th February 2007. Thus Home’s mark is clearly an earlier trade mark in accordance with the Act.

15) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). 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*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*,

(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*,

(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*,

(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.*,

(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*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it

with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

The average consumer

16) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the services at issue, and whether there is anything about the nature of transactions under the respective marks that may lead me to conclude that the average consumer is other than someone “deemed to be reasonably well informed and reasonably circumspect and observant” (see authority (b) in para 15 above).

17) The average consumer for Home’s services will be both the general public, comprising prospective and actual tenants, looking for properties available for let and, on the other side of the coin, landlords, looking to let their properties. The average consumer for NHI’s services, as claimed in the specification, “insurance only”, will also, at a general level, be the general public and businesses. That said, the evidence from NHI has made me aware that what they offer, in fact, is “landlord’s insurance”. Both parties therefore share, at least, landlords as relevant consumers, and to that extent those relevant consumers can be said to be identical.

18) In relation to the nature of that consumer, my finding is that the average consumer for both sets of services is likely to be familiar with and attentive to the nature of services offered and by whom. Both services may well be accessed on the basis of personal recommendation and/or a careful analysis of features and benefits on offer. Consequently, I would regard the average consumer as more than “reasonably circumspect and observant”. Such consumers will not necessarily bring to the transaction the same precision of someone making a major purchase such as a car or prescribing medicine, but at the same time it will be a lot greater than a consumer making an everyday purchase from a supermarket.

Comparison of services

Applicant's services	Opponent's services
Class 36 Insurance only	Class 36 Accommodation letting agency, property letting services, rental of property, management of property, provision of information and consultancy in relation to the aforementioned services.

19) In assessing the similarity of services, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of the Judgment:

‘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 end users and their method of use and whether they are in competition with each other or are complementary.’

20) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance v OHIM – Johnson & Johnson (monBeBé)*).

21) The submission by Home is that insurance services is an area of information and consultancy in property lettings, which is covered by their registration. On the other hand, the submission by NHI is that Home’s specification does not contain insurance services per se, and that consultancy and insurance services are completely different.

22) I have to say I do not find the FSA glossary at Exhibit 2 to Mr Walker’s statutory declaration to be of assistance here. The question that needs addressing is not how the FSA may classify services for which it is responsible (which may not even include letting agencies), but whether, from a consumer perspective those services covered by Home’s specification are similar, and to what degree they are similar to those covered by NHI.

23) Further, the question has to be addressed, based upon notional and fair use across the range of services covered by Home’s registration and not upon Mr Walker’s research and assertions as to what Home actually do and how that may or may not be geographically restricted. This is a well established principle of law, see eg *Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280

at page 284, which although referring specifically to section 10 of the Act, nevertheless applies also to the likelihood of confusion test I am required to undertake in this case.

24) Nor do I agree with Mr Walker that the approach by Home to NHI regarding a non-exclusive licence amounts to proof that Home themselves do not see the marks as in any way operating in competitive fields. In effect, Mr Walker is saying that the offer of such a licence amounts to a 'concession' from Home that co-existence is possible. Use of this kind of 'without prejudice' material is to be discouraged; such material was never intended for my eyes in the first place and nor is its context clear. Even if I were to take this alleged 'concession' by Home into consideration, which I am not, I am not convinced it supports the conclusion Mr Walker argues I should draw. Rather the opposite in fact; if Home were convinced that the marks do not operate in competing fields, would they be bold enough to require a licence?

25) Having set out the material that is unpersuasive to me it is necessary to return to the words of the respective specifications. Home's "information and consultancy services", which form part of the specification are, as a matter of language, restricted to the descriptions which precede those words, ie accommodation letting agency, property letting services, rental of property, management of property. It is not the case that "information and consultancy services" stand alone; they are part and parcel of the services which precede. Home's specific claim is that: "By virtue of the mark 'letprotect', insurance services is an area of information and consultancy in property lettings which is covered by mark 2447059 which was filed 10 days earlier". I confess to not being entirely sure what the opening words, "By virtue of the mark 'letprotect'..." are intended to convey, but what I would say is that, as a matter of onus and evidence, the assertion that 'insurance services is an area of information and consultancy' had to be proven by Home. It has not been. In the case of *Canon Kabushiki Kaisha v MGM Inc* Case C-39/97 [1999] RPC 117 at para. 22 the European Court of Justice states:

"It is however important to stress that....., even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods and services covered....."

26) The most I am prepared to accept is that, as part and parcel of the main service of a property or letting agency, Home (and other letting agencies) may offer customers information and consultancy which may include, eg referrals regarding matters such as, eg. insurance for landlords. What is not specifically, and crucially, established by Home is that letting agencies routinely offer these insurance services themselves and under their own brand and this is understood by the consumer. Whilst a landlord will doubtless be aware of the need for special landlords' insurance, the main use he or she will make of an agency is surely to find suitable tenants for his or her property. That is the agency's raison

d'etre. In the course of performing that primary function, there may be enquiry with the agency concerning insurance, but there will also be other, more usual, sources of such information, eg brokers, the internet and direct contact with the insurance providers.

27) On the face of it then, absent evidence from Home, I must conclude that insurance services are not the same in nature as property letting services. Insurance will be offered by companies responsible for the policies themselves, underwritten by others and offered through intermediaries, such as brokers. These are not services then which compete with each other. But, could it be said that they 'complement' each other, as asserted by Mr. Walker in his witness statement?

28) In answering this question it is important to understand what the law says about 'complementarity', which may be different to the way the word is interpreted by NHI and Mr. Walker. Relatively recently the European Courts have developed the concept of 'complementary goods', and in that regard have held that complementary goods are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both (see, eg, CFI Case T-169/03 *SISSI ROSSI*, [2005] ECR II-685, paras. 60-64).

29) Are the services of a property letting agency so closely connected (even if not indispensable), with those of insurance that the consumer may think that the same undertaking is responsible for both? Although Mr. Walker says there is "complementarity", what I assume he means is that the two services do not directly compete, but insurance is nevertheless an aspect (perhaps even a mandatory one) that a landlord will have to consider in fulfilling his role. This is far from conceding however that there is such a close connection between property letting services and insurance that the landlord will see the respective services as emanating from the same source. There is simply no evidence from Home which links the two services and would therefore give rise to complementarity within the sense meant by the European Courts.

30) I need to bring my conclusions forward into an overall view in relation to comparison of services. The respective services are aimed at the same consumer, namely landlords of rental property. Home's specification does not cover insurance services as such, but in practice it is nevertheless *plausible* that a letting agency will be aware of insurance requirements and, in consequence, provide referrals and a measure of advice even. Without this, and having regard to the total lack of evidence from Home, I would have had to find no similarity at all. With that plausibility, I find a low level of similarity, but no complementarity as meant by the European Courts.

Use and distinctive character of the earlier trade mark

31) I have to consider whether Home’s mark has a particularly distinctive character either arising from the inherent characteristics of the trade mark or because of the use made of it.

32) Home’s mark comprises the two words “Let” and “Protect”, separated by a space. Both are normal dictionary words. In the context of trade in relation to property letting services, the word “let” is apt to be viewed as descriptive, but in totality the mark has the required distinctiveness to be registrable. This is because the two words “Let” and “Protect” together are grammatically and linguistically unusual, and convey no clear descriptive or non-distinctive meaning. Inherently then, I regard the earlier mark as distinctive, but as both words have dictionary meaning and one is descriptive for the services, I would classify Home’s mark as being of below average inherent distinctiveness.

33) As far as use is concerned, in the letter dated 3rd October 2007 at Exhibit 3 from Home to NHI, four and a half years use prior to the date of the letter is claimed. I have however already (para 24 above) criticised use of that letter in evidence. There is nothing to corroborate that claim of use made by Home; crucially they themselves have given no direct evidence as to their usage. Therefore, even if I were minded to take the claim to use into account, without corroboration it is of little value. Accordingly, I find that I can only consider the inherent characteristics of Home’s mark, for which I have made a finding in para. 32 above.

Comparison of marks

34) The respective marks are as below:

Home’s mark	NHI’s mark
Let Protect	Letprotect

35) Visually, the marks are almost identical, the only difference being that the word elements ‘let’ and ‘protect’ are conjoined in NHI’s mark and clearly separate in Home’s mark. In my view the average consumer will seek to make sense of the conjoined word, and in doing so will naturally break it down into known and recognisable constituents. Therefore I conclude that, visually, the respective marks share a high level of similarity. Aurally the marks are identical and will be pronounced in the same way.

36) Conceptually, sometimes it can be argued that conjoining known words, and thus creating a neologism, can be said to create a new word (and concept) which is more than the sum of the known parts. In this case, my view is that there is still a natural divide between ‘let’ and ‘protect’ such that if there is any concept underlying the respective marks it will be the same for both. But is there a

concept here? I have already found that the word 'let' is likely to be viewed as descriptive for Home's mark on the basis that it will be used in relation to letting agencies. The word 'protect' in that mark will imbue a sense of security. Likewise, NHI's mark will be a combination of the descriptive 'let' and the word 'protect' which, in the context of insurance services, will have more obvious application (an insurance policy provides protection by its nature) than it does for letting agencies. In relation to the respective services, the marks will convey the same message; that they are connected with 'letting' and that the verb 'protect' will seek to convey safety and security. The respective marks are therefore conceptually identical.

Likelihood of confusion

37) The various findings I have arrived at above need now to be factored into an overall assessment of likelihood of confusion. I need to adopt a global approach, which takes into account 'imperfect recollection' on the part of the consumer as advocated by the ECJ in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* In making that assessment, I am acutely conscious that the opponent has filed no evidence, as required in the *Canon* case to which I have referred in para 25 above, and particularly no evidence that would persuade me that there is a recognisable pattern in trade, whereby those who offer property letting agency services are also engaged in the provision of insurance, or in some other way being closely connected to that provision. The absence of such evidence has been crucial and left me with no alternative but to assess the facts as best I can from the available evidence. In light of all this I concluded that the respective services show only a low level of similarity.

38) Bringing my conclusions together, in particular, the low level of similarity between the services, and not without some hesitation, given the similarity of the marks, I nevertheless conclude that, based on the evidence available to me, there is no likelihood of confusion. The opposition to the application under section 5(2)(b) fails in its entirety.

Costs

39) NHI is successful and is entitled to a contribution towards its costs. I take account of the fact that that the decision has been reached without a hearing taking place. In the circumstances I award NHI the sum of £600 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Considering Notice of Opposition - £ 100
2. Preparing and filing counterstatement - £100
3. Filing evidence and all other matters – £400

Total £600

40) It should be noted that in this breakdown of costs, the sums awarded represent no more than two thirds of what I may otherwise have awarded. This reflects the fact that the applicant has not had legal representation in these proceedings. The Civil Procedure Rules state at Part 48.6:

“48.6-(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

41) I order Home 2 Let Ltd to pay NHI Services Ltd the sum of £600. The sum should 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 25th day of February 2009

**Edward Smith
For the Registrar,
the Comptroller-General**