

O-040-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2413686  
BY PURE PROPERTY FINDERS LTD TO REGISTER, AS A SERIES OF TWO,  
THE TRADE MARKS**



**IN CLASSES 36, 37, AND 42**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 95234  
BY PURE INTERNATIONAL PROPERTY LTD**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2413686**

**By Pure Property Finders Ltd to register, as a series of two, the trade marks**



**in classes 36, 37 and 42**

**and**

**IN THE MATTER OF Opposition thereto under No. 95234**

**by Pure International Property Ltd**

**BACKGROUND**

1) On 13<sup>th</sup> February 2006, Pure Property Finders Ltd (formerly Pure Property Consultants Ltd), of Cedar House, 41 Thorpe Road, Norwich, NR1 1ES (hereafter "Pure Property") applied to register the following trade marks:



2) The application was in respect of the following services:

**Class 36**

Property acquisition services; services for the searching, locating, leasing, renting and purchasing of property; non-financial advice and information relating to the aforesaid services.

**Class 37:**

Property development services; property maintenance; renovation and repair services; installation services; property cleaning services; building and construction services; painting and decorating; advice, information and consultancy services relating to the aforementioned services.

**Class 42:**

Building and land inspection, surveying and conveyancing services; property management; provision of legal services relating to the acquisition, disposal and sale of property; advice, information and consultancy services relating to the aforementioned services.

3) On 23<sup>rd</sup> February 2007, the application was published for opposition purposes and on 23<sup>rd</sup> May 2007, Pure International Property Ltd, of 20 Garrick Steet, London WC2E 9BT (hereafter “Pure International”) filed notice of opposition to the application. The opposition, following amendment, is solely based on grounds under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

4) Pure International rely on their earlier UK registration 2388903. The details of this trade mark are:

Trade Mark	Filing and registration dates	Specification
	8 <sup>th</sup> April 2005 and 10 <sup>th</sup> March 2006	Class 36 Estate Agency Services  Class 37 Property development services

5) Pure International say their earlier mark was first used in the UK around June 2004 by a predecessor in title; they acquired the mark along with associated

goodwill and reputation in September 2005. They say that the distinctive and dominant feature of their mark is the word “Pure”, which is shared with Pure Property’s mark, as is the colour blue in the colour version of Pure Property’s mark. Given the visual, aural and conceptual similarities of the marks and the identical or closely similar nature of the services, Pure International say this application should be refused in its entirety under section 5(2)(b) of the Act as there would be a likelihood of confusion. Pure Property subsequently filed a counterstatement denying the grounds for opposition.

6) Neither party filed evidence (or submissions, beyond their respective statement and counterstatements) in these proceedings, and neither party requested to be heard. The matter has now come to me for a decision based on the papers filed. Both sides ask for an award of costs.

## **DECISION**

### **Section 5(2) (b)**

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

“(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.”

8) 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,

Pure International’s mark was filed on 8<sup>th</sup> April 2005 and Pure Property’s on 13<sup>th</sup> February 2006. Thus, Pure International’s mark is clearly an earlier trade mark in accordance with the Act. Moreover, Pure International’s mark is not subject to proof of use requirements as its date of registration (10<sup>th</sup> March 2006) is within the relevant

five year period, terminating on the date of publication of Pure Property's mark (23<sup>rd</sup> February 2007) (see section 6A of the Act).

9) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice ("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***

10) 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 9 above).

11) The average consumer for Pure International’s estate agency services will, at a general level, be both the general public and businesses, comprising those looking to sell their properties and those looking to buy. In relation to their property development services these could also be accessed by the general public and businesses, including, eg landlords. The average consumer for Pure Property’s services, as claimed in the specification, will also, at a general level, be the general public and businesses again including, eg landlords.

12) In relation to the nature of the purchasing act, my finding is that the average consumer for both sets of services is likely to be familiar with, and very 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” in this case. Major and substantial purchases are being made and the services related to those purchases will be duly accessed with considerable care and attention.

**Comparison of services**

<b>Pure Property’s services</b>	<b>Pure International’s services</b>
<p><b>Class 36</b></p> <p>Property acquisition services; services for the searching, locating, leasing, renting and purchasing of property; non-financial advice and information relating to the aforesaid services.</p> <p><b>Class 37:</b></p> <p>Property development services; property maintenance; renovation and repair services; installation services; property cleaning services; building and construction services; painting and decorating; advice, information and consultancy services relating to the aforementioned services.</p> <p><b>Class 42:</b></p> <p>Building and land inspection, surveying and conveyancing services; property management; provision of legal services relating to the acquisition, disposal and sale of property; advice, information and consultancy services relating to the aforementioned services.</p>	<p><b>Class 36</b></p> <p>Estate Agency Services</p> <p>Class 37</p> <p>Property development services</p>

13) 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.’

14) Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

15) Two further cases on the way that specifications ought to be interpreted should be borne in mind. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd (“Thomson”)* [2003] RPC 32, at para 31, Aldous LJ, says

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use.”

Although this was in the context of arriving at a fair specification consequent to an attack of revocation on the grounds of non-use, the principle that it is the public and circumstances of the relevant trade that should underpin consideration as to the terms used in a specification nonetheless holds good. Secondly, there is the case of *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd (“Beautimatic”)* [2000] FSR 267, in which the principle of giving words their ordinary (rather than an unnaturally narrow) meaning was enshrined. In summary, the *Beautimatic* case urges an approach that is not unnaturally narrow, whilst the *Thomson* case stresses that the exercise is not one of lexical analysis in a vacuum, but by reference to how the average consumer may perceive matters in the relevant trade.

16) It is important to recognise that even though the evidence on similarity is non-existent, I nevertheless have the statements of case and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the Appointed Person said in *Raleigh International trade mark* [2001] R.P.C. 11 at paragraph 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary. He also stated that the tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public.

17) I should also mention one final case in terms of the application of legal principles, and that is the European Court of First Instance (“CFI”) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (“Meric”)* Case T-133/05, where, at para 29, it is stated:



“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

I shall deal with each of Pure Property’s classes in turn.

#### Class 36

18) Estate agents in the UK routinely provide, eg valuation, search, sale, leasing, advertising, acquisition and rental services, all in relation to property. They may liaise with or be affiliated to specialist financial and legal services related to the same, and provide information in relation to, as well as providing, the actual service. In other words, the term ‘estate agency services’ would not merely entail the sale of property. Given the breadth of an estate agent’s role, the term ‘estate agency services’ is synonymous with or would at least be taken to include: “property acquisition services; services for the searching, locating, leasing, renting and purchasing of property; non-financial advice and information relating to the aforesaid services”, and accordingly therefore (applying the *Meric* case above) all the services in Pure Property’s Class 36 specification must be considered to be identical to those in Pure International’s Class 36 specification.

#### Class 37

19) In class 37 “property development services” are identical to the same services designated in the same way. This leaves: “property maintenance; renovation and repair services; installation services; property cleaning services; building and construction services; painting and decorating; advice, information and consultancy services relating to the aforementioned services”. I need to analyse each of these. The starting point for such an analysis is the definition of a ‘property developer’, which is as follows:

**property developer:** An individual or firm which buys property with a view to changing its use, making significant improvement, or constructing new property.....<sup>1</sup>

20) From this definition, the property developer buys property with a purpose in mind: to change its use, make improvement or construct new property. On that basis, and again applying Meric, “property renovation”, “installation”, “building and construction” services and “ advice, information and consultancy services relating to the same” would all be identical to “property development services”.

21) This leaves “property maintenance”, “repair”, “cleaning” “painting and decorating” services. The reason I have not grouped them with the identical services as above is that, either they relate to the ongoing maintenance of a property, or that they comprise discreet, specialist services in their own right. That is to say that a painter and decorator, whilst he or she may provide the property developer with the services of painting and decorating, will not necessarily be associated in the consumers’ mind with ‘property development’. That said, I think it implicit in the definition of property developer that these services are likely to be called upon by the developer, such that he or she may be reliant and dependant upon them. This in turn is likely to create an alignment, linkage or pattern in the consumer’s mind. It could well be that larger firms of developers have contractual relations with such providers or may even provide them ‘in house’. In all the circumstances, I consider that the remaining services in Class 36 can be classed as ‘similar’ to property development services.

#### Class 42

22) The services in Class 42 are: “building and land inspection, surveying and conveyancing services; property management; provision of legal services relating to the acquisition, disposal and sale of property; advice, information and consultancy services relating to the aforementioned services”. In the paragraph above I talked about ‘alignment’, ‘linkage’ and ‘pattern’ such that property development services may be seen to have an association with, or to even include, related specialist services. The same argument applies in relation to Class 42. The property developer may well, especially if it is a large firm, employ its own building and land inspectors, surveyors, and even specialist conveyancers or lawyers. If it is a smaller firm or individual, the developer will be reliant upon and closely aligned with the providers of the services in Class 42. Quite simply, he cannot go about his business without access to such services.

---



1

"property developer" *A Dictionary of Economics*. John Black, Nigar Hashimzade, and Gareth Myles. Oxford University Press, 2009. *Oxford Reference Online*. Oxford University Press. <http://www.oxfordreference.com>

On that basis I find that all the services in Class 42 are similar to property development services in Class 36.

**Comparison of marks**

23) The respective marks are as below:

Pure International's mark	Pure Property's mark
	

24) In accordance with the authorities, I need to undertake a comparison between the respective marks, taking account of their visual, aural and contextual components.

25) Visually, Pure International's mark takes the form of two words, "PURE" in upper case and the word "INTERNATIONAL", also in upper case beneath it, but in much smaller script. The words are in white against a light blue background that resembles a tear drop. Pure Property's application comprises two marks, one being a colour version in lightish, almost turquoise, blue, and the other a black and white version. The colour version shows, to the left of the words, a device element comprising two overlapping circles, one black and one lightish, turquoise blue. The colour of the circles is then replicated in the word "PROPERTY". The word "PURE" is in black, and the word "PROPERTY" in lightish, almost turquoise, blue. Both words are in lower case script. The second version of the series is not colour specific. I conclude that, visually, the marks are similar, sharing the word 'PURE' and also the lightish colour (even though Pure Property's mark has a turquoise tint, it is nonetheless a lightish blue colour) in the first version of the series.

26) Aurally, the PURE element will be pronounced in the same way in the respective marks. The words INTERNATIONAL and PROPERTY are clearly pronounced differently and so, assuming the consumer uses the full versions of the marks, the aural impact will be somewhat lessened by the impact of the second word in each mark. However, given the descriptive nature of the second words used in each mark, it is equally conceivable that in, especially informal,

aural use, the second words will not be pronounced at all. Overall, I conclude that the marks are aurally very similar.

27) Conceptually, I have already said that I consider that the other words used in the respective marks, “INTERNATIONAL” and “PROPERTY” will be seen as having descriptive connotations in the context of the services on offer. That is to say that ‘INTERNATIONAL’ denotes a geographical sphere of activity, whilst ‘PROPERTY’ denotes the object of the service on offer. Their non-negligible presence in the respective marks means however that they must be taken into account in deciding what concept may be conveyed by the respective marks, taking into account their totalities. Both marks share the same dictionary word, ‘PURE’, and it will, I believe, be that word which, to the average consumer will present as the primary, distinctive element. The other elements in the composites, such as colour, devices, fonts and descriptive words will, whilst they cannot be ignored, play a somewhat secondary role in terms of distinguishing the services. The respective devices, colours or fonts do not, in my view, impart or vary any meaning in relation to the verbal elements. However the descriptive words do, as I have said, have different meanings and for that reason alone, I cannot conclude that the respective marks are conceptually identical. I do however conclude that they are, conceptually, highly similar.

28) Making an assessment of the overall similarities and dissimilarities between the respective marks, I find that they are very similar.

### ***Likelihood of confusion***

#### ***Use and distinctive character of the earlier trade mark***

29) I have to consider whether Pure International’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.

30) In terms of its inherent characteristics, the mark comprises the words PURE and INTERNATIONAL. I have identified the word PURE as being the distinctive element. This word, though it is a known dictionary word with somewhat general laudatory connotation, would have no obvious ‘connection’ with the respective services on offer. That is to say that if the word PURE appeared in a mark connected with, say, juice, there would be a clear connection between it and the product, namely that the juice was ‘pure’, ie not from concentrate or 100% juice. There is no such clear connection here, and therefore I regard the mark as having an reasonably high (inherent) degree of distinctiveness. Although Pure International say their mark has been used since June 2004, resulting in goodwill throughout the UK, there is no evidence to support this, and accordingly I am not in a position to find that the mark’s inherent distinctiveness is enhanced through use.

31) 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.*

32) Bringing my conclusions together, in particular, the identical and similar nature of the services, the very similar nature of the marks and the reasonably high degree of inherent distinctiveness of the earlier mark, I conclude without hesitation that there is a likelihood of confusion in respect to all the goods and services of Pure Property's application. The opposition to the application under section 5(2)(b) succeeds in its entirety.

### **Costs**

33) Pure International is successful and is entitled to a contribution towards its costs. I take account of the fact that no evidence or submissions have been filed and that the decision has been reached without a hearing taking place. In the circumstances I award Pure International the sum of £700 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Filing Notice of Opposition and statement - £ 500
2. Considering counterstatement - £200

Total        £ 700

34) I order Pure Property Finders Ltd to pay Pure International Property Ltd the sum of £700. 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 04 day of February 2010**

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