

O/150/12

**IN THE MATTER OF REGISTRATION NO. 2535518
IN THE NAME OF BRIAN JOHN LOVEGROVE
OF THE TRADE MARK**

RENT A HUBBY

IN CLASS 37

AND

**AN APPLICATION FOR
A DECLARATION OF INVALIDITY THERETO
UNDER NO. 84020
BY HIGHDAWN PTY LIMITED**

Background

1. An application to register the above trade mark was made on 4 January 2010 by Brian John Lovegrove. The registration process was completed on 23 April 2010. Mr Lovegrove's trade mark registration stands as registered for the following services:

Class 37: Building construction; repair; installation services; installation, maintenance and repair of computer hardware; painting and decorating; cleaning services.

2. On 23 March 2011, Highdawn Pty Limited ("the applicant") filed an application for a declaration of invalidity of the registration under section 47(2) of the Trade Marks Act 1994 ("the Act") in respect of all the services. Section 47(2) states:

"47.—

.....

(2) The registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

The applicant claims the registration should be cancelled as it was registered in contravention of sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

3. At a case management conference held on 23 September 2011, I refused the applicant's application for an extension of time in which to file its evidence-in-chief. As a consequence of the non-filing of evidence, the applicant's grounds under section 5(3) and 5(4)(a) were struck out, together with an earlier right relied upon under section 5(2)(b) which was subject to proof of use¹. The sole remaining ground, 5(2)(b), relies upon two International Registrations designating the European Community, neither of which had been registered for five years or more at the date on which the application for a declaration of invalidity was filed. Consequently, there is no requirement for the applicant to prove use of its two earlier International Registrations, which may be considered across the breadth of their registered specifications on the basis of notional and fair use.

4. The two earlier International Registrations are as follows:

(i) 1022457

HIRE A HUBBY

¹ Sub-sections 2A to 2E of section 47.

Class 37: *Services for the construction and repair of buildings and homes, and parts thereof, including general home maintenance and repairs; clearing guttering, plumbing, and carpentry services; repair and restoration services for furniture and household equipment; handyman services; cleaning services for buildings and premises included in this class; services for the removal of rubbish and debris from buildings and properties included in this class.*

Class 44: *Gardening and lawn mowing services.*

Protection requested on 21 October 2009; protected on 11 November 2010.

(ii) 1020152



Class 37: *Services for the construction and repair of buildings and homes, and parts thereof, including general home maintenance and repairs; clearing guttering, plumbing, and carpentry services; repair and restoration services for furniture and household equipment; handyman services; cleaning services for buildings and premises included in this class; services for the removal of rubbish and debris from buildings and properties included in this class; electrical services.*

Class 44: *Gardening and lawn mowing services.*

Protection requested on 21 October 2009; protected on 14 October 2010.

5. Both of the International Registrations are earlier marks because the dates on which protection was requested pre-date Mr Lovegrove's application date (4 January 2010)².

6. Section 5(2)(b) states that:

“(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,

² See section 6(1)(a) of the Act.

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

7. The applicant claims that the registered mark contravenes section 5(2)(b) of the Act because it is highly similar to the applicant’s earlier trade marks and is registered for identical or similar services which would lead to a likelihood of confusion. In particular, the applicant claims:

“The words HIRE and RENT are visually similar in that they consist of four letters and, moreover, in that both words include the letter combination RE. The words HIRE and RENT are phonetically similar in that they both consist of a single syllable and they both include the R sound. The words HIRE and RENT are conceptually identical or, in the alternative, have similar and closely associated meanings.”

8. Mr Lovegrove filed a counterstatement³ in which he denied the applicant’s claim, attaching various documents, including a copy of a letter before action from the applicant. Mr Lovegrove states, in his defence, that he has been trading for many years in Sussex and South East London.

9. Following the case management conference referred to above, Mr Lovegrove was set a period of time in which to file evidence and/or submissions. He filed submissions, together with an extract from the trade mark register relating to the trade mark DIAL A HUBBY in class 37 and his filing receipt from the Intellectual Property Office relating to his earlier application to register RENT A HUBBY. The registry decided that these documents contained no evidential value since the extract from the register is a matter of public record, from the Registrar’s own record and, likewise, the trade mark application filing receipt merely relates to a filing which is on public record.

10. At this point in the proceedings, there being no evidence from Mr Lovegrove to reply to, the registry moved to make arrangements for either a hearing or a decision from the papers. It refused to admit a bundle of evidence subsequently filed by the applicant on 22 December 2011 which was purported to be evidence in reply, since there was no evidence to reply to.

11. Both parties appeared before me to make submissions on the substantive section 5(2)(b) ground on 28 March 2012. Mr Bernard Whyatt, of Brand Protect, represented the applicant. Mr Lovegrove represented himself. Mr Whyatt raised again the question of evidence in reply in his skeleton argument. I dealt with this at the hearing as a preliminary issue. Mr Whyatt was concerned that the documents submitted with the counterstatement were evidence in the proceedings and that the applicant was being treated unfairly in not being given an opportunity to reply to it. The documents supplied with the defence are not evidence (they are not in evidential format) but, even if they had been evidence, the applicant had had the opportunity to reply to the defence when it was set its initial period to file its evidence in chief. It did not do that in time, and its reasons for asking for further time were insufficient. I

³ The lack of signature on the statutory defence form (TM8) was regularised on 27 January 2012 under a direction from the Registrar under Rule 62(1)(e) of the Trade Mark Rules 2008.

refused Mr Whyatt's request to have the 'evidence in reply' admitted. There is therefore no evidence in these proceedings for me to consider.

Decision

Section 5(2)(b) of the Act

12. The leading authorities which guide me in relation to this section are from the CJEU ("Court of Justice of the European Union"): *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, *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 for 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) 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*,
- f) 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*,
- (g) 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*,

(h) 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*,

(i) 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*,

(j) 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*,

(k) 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*,

(l) 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*.

Average consumer and the purchasing process

13. The average consumer for the services of both parties, on a notional basis, is the general public, although the services may also be provided to businesses. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. Choosing tradesmen to work on one's house or business is likely to involve a reasonable, but not the very highest, degree of attention which will vary according to the specific service, the frequency with which it is used and the price of it. The purchasing process will be primarily visual, such as via brochures, websites and vehicle livery, although I do not ignore the possibility of an aural aspect to the process, such as word of mouth recommendation.

Comparison of goods and services

14. It is necessary for me to determine the level of similarity between the parties' services on account of the interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater degree of similarity between the trade marks, and vice versa, as a factor in the global appreciation of the likelihood of confusion⁴. For Mr Lovegrove's benefit, "global" in this context simply means "all things considered", not what is happening worldwide.

15. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*. where the CJEU stated at paragraph 23 of its judgment:

⁴ As per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

“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 intended purpose and their method of use and whether they are in competition with each other or are complementary.”

‘Complementary’ was defined by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”

16. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services included an assessment of the channels of trade of the respective goods or services.

17. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Jacob J also said, in *Treat*:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade”.

18. Neither should specifications be given an unnaturally narrow meaning, as per *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, although in the context of a non-use issue, the court considered interpretation of specifications:

“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. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the

court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”.

19. Finally, if goods or services fall within the ambit of terms within the competing specification, they are considered to be identical, as stated by the GC in *Gérard Meric v OHIM*, case T-133/05.

20. For ease of reference, I will refer, from here onwards, to the applicant’s International Registrations as its earlier marks. A comparison between the parties’ class 37 services will yield a stronger result than between the applicant’s class 44 services and Mr Lovegrove’s class 37 services, therefore I will confine my comparison to the parties’ respective class 37 specifications, which are:

The applicant’s services	Mr Lovegrove’s services
<p>Marks (i) and (ii): <i>Services for the construction and repair of buildings and homes, and parts thereof, including general home maintenance and repairs; clearing guttering, plumbing, and carpentry services; repair and restoration services for furniture and household equipment; handyman services; cleaning services for buildings and premises included in this class; services for the removal of rubbish and debris from buildings and properties included in this class;</i></p> <p>Mark (ii) only: <i>electrical services.</i></p>	<p><i>Building construction; repair; installation services; installation, maintenance and repair of computer hardware; painting and decorating; cleaning services.</i></p>

21. *Building construction*

This is identical to the applicant’s *services for the construction and repair of buildings and homes [...]*;

22. *Repair*

Mr Lovegrove’s term *repair* encompasses the applicant’s repair services: *services for the [...] repair of buildings and homes [...] including general home maintenance and repairs*; and so these respective services are identical.

23. *Painting and decorating*

These services are part and parcel of the wider term *general home maintenance and repairs* and so are identical.

24. *Cleaning services*

These are identical to the applicant's *cleaning services for buildings and premises*.

25. *Installation services*

This is unqualified and so covers, for example, the installation of central heating, double glazed windows and fitted kitchens. It is identical, or so nearly identical as to be highly similar, to the applicant's *plumbing and services for the construction and repair of buildings and homes*.

26. *Installation, maintenance and repair of computer hardware*

Mr Whyatt submitted that people expect that a handyman will be able to install, maintain and repair computer hardware; he referred to the trunking needed for a domestic computer's cabling. He also said that Mr Lovegrove's services were similar to the applicant's *services for the construction and repair of buildings and homes [...] including general home maintenance and repairs*. He submitted that Mr Lovegrove's services are also similar to the applicant's *electrical services* (mark (ii)).

27. I have referred above to the *Avnet* and *Treat* cases in relation to the construing of the meanings of terms within specifications. I should have in mind the core of possible meanings and the ways in which words would be regarded for the purposes of trade. *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* advised looking at this from the perspective of the average consumer. I think it very unlikely that one would call out a 'handyman' to install computer hardware and even more unlikely that a handyman would be called upon to maintain or repair it. These are expensive, technical items which require a level of specialist knowledge and which are provided by discrete computer technicians, not handymen. Similarly, the average consumer's perception of construction and repair services for buildings will not be services for installation, maintenance and repair of computer hardware: it will be bricklaying, carpentry, roofing, tiling, plumbing and electrical services. In relation to the latter, covered by the applicant's earlier mark (ii), this was Mr Whyatt's additional submission. The comments I have made already in this paragraph also apply to the comparison between the applicant's electrical services and Mr Lovegrove's installation, maintenance and repair of computer hardware. Electricians do not get called out in relation to computer hardware. Electricians are also not telecommunications engineers, so they will not be responsible for bringing telephone cabling or broadband cabling into a house. Sorting out trunking for cabling which may run to a personal computer was Mr Whyatt's main submission. This is too far outside of the core of possible meanings of installation, maintenance and repair of computer hardware as understood by the average consumer. There is no similarity between Mr Lovegrove's *Installation, maintenance and repair of computer hardware* and any of the applicant's services covered by either of its earlier marks.

Comparison of marks

28. The applicant relies upon near-identical class 37 specifications, the only difference being the addition of "electrical services" in mark (ii). As the only point of similarity between its earlier marks and Mr Lovegrove's mark is the word element,

and, as I found no similarity between electrical services and any of Mr Lovegrove's services, it follows that mark (i) presents the applicant's strongest chance of success. I will therefore confine my analysis to comparing the applicant's word mark (i) with Mr Lovegrove's mark.

29. The authorities cited above direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

30. The respective marks are:

Applicant's mark	Mr Lovegrove's mark
HIRE A HUBBY	RENT A HUBBY

31. Both the parties' marks 'hang together' as whole phrases; there is no single dominant and distinctive component in either mark. Visually and aurally, they follow a common pattern "— A HUBBY". Contrary to the applicant's pleadings and Mr Whyatt's submissions, HIRE and RENT look and sound nothing like each other. Balancing the similar "— A HUBBY" pattern against the clear differences between HIRE and RENT, a difference which is at the beginning of each mark, there is a reasonable degree of visual and aural similarity between the marks.

32. HIRE and RENT mean the same thing (the meanings are so well known, they need no definition from me). "A HUBBY" is a husband. No one would hire or rent a husband: the mark alludes to the hire/rent of services to help out with e.g. DIY or gardening, jobs traditionally performed by husbands in previous generations. The marks are conceptually identical.

33. Overall, there is a high degree of similarity between the applicant's mark and Mr Lovegrove's mark.

Likelihood of confusion

34. It is necessary to consider the distinctive character of the applicant's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁵. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁶.

35. I have no evidence of use to consider of the applicant's mark, only its inherent nature. I have discussed above the meaning of the mark, in the context of the

⁵ *Sabel BV v Puma AG* [1998] RPC 199.

⁶ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

services. It is an allusive concept rather than a description of the services. The applicant's earlier mark HIRE A HUBBY has a reasonable degree of distinctive character.

36. Mr Lovegrove referred to "hubby" being commonly used for the types of services he supplies. I understood this reference to relate to a number of entities co-existing, rather than a submission in relation to how distinctive, or otherwise, HUBBY may be in context. Mr Lovegrove did not file evidence to show co-existence, although he attached documentation to his counterstatement from an online directory. Even if this had been filed as evidence, it would not establish descriptiveness; a word may be used to indicate a brand by a number of other people, but that does not mean that the word describes the goods or services. If, as I suspect, Mr Lovegrove referred to the common use of "hubby" to refer to lack of confusion in the marketplace, there are a number of points to make. Firstly, as I have just said, there is no evidence of that in the proceedings. Even if I had been able to take into account the counterstatement attachments as evidence, they would not help Mr Lovegrove. That there are a number of entities co-existing using 'hubby' marks, including his own "for many years", may be explained by the very nature of the services they provide: they are local, provided in specific localities, not bumping up against each other in the marketplace. Secondly, Mr Lovegrove referred to the applicant not objecting to a third party's mark DIAL A HUBBY. That is a matter for the applicant and has no bearing on whether there is a likelihood of confusion in the minds of the average consumer in relation to HIRE A HUBBY and RENT A HUBBY.

37. Thirdly, Mr Lovegrove claims that the applicant has not traded in the UK, whereas he has. In relation to section 5(2)(b) of the Act, which concerns whether there is a likelihood of confusion between marks, if it was true that the applicant has not traded in the UK (and I do not take a view on that as I have no evidence one way or another), this very situation also does not help Mr Lovegrove. If the applicant has not traded in the UK, there has been no concurrent trade between the applicant and Mr Lovegrove. If there has been no concurrent trade, it is not possible to demonstrate an absence of actual confusion. Section 5(2)(b) is concerned with whether there is a likelihood of confusion, not what has actually happened. As explained earlier in this decision, because the applicant's earlier mark had not been registered for five years or more at the date on which it made its application to invalidate Mr Lovegrove's mark, it does not have to prove that it has used its mark: trade mark registration owners have five years in which to make genuine use of their marks before they become liable to revocation on the grounds of non use. This is the reason why, under section 5(2)(b) of the Act, it makes no difference that Mr Lovegrove has been using his mark "for a number of years". In registering his trade mark, he has a UK national right; the applicant also has a UK right because it has an International Registration designating the EC, which covers the UK. So it is a question of whether there would be a likelihood of confusion between the two registrations. The test in this case is whether there is a likelihood of confusion 'notionally', i.e. whether all the factors I have discussed throughout this decision combine to lead to a conclusion that there is, or is not, a likelihood of confusion, on the part of the average consumer, between the two marks.

38. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison and the principle of interdependency, referred to earlier. In this regard, I found that the marks are highly similar and that, with one exception, the services are identical or near identical. The exception is that Mr Lovegrove's *installation, maintenance and repair of computer hardware* is not similar to any of the applicant's services. A likelihood of confusion cannot be found where there is no similarity between services⁷. Consequently, there is no likelihood of confusion in relation to Mr Lovegrove's *installation, maintenance and repair of computer hardware*. This means that his registration remains intact for these services.

39. However, there is a likelihood of confusion in relation to Mr Lovegrove's other services. This is because the marks are highly similar for identical/near-identical services. The average consumer will remember the meaning created in his mind by the marks, a meaning which is identical. Even though one mark has HIRE and the other has RENT at the beginning, the memory recall by the average consumer will be likely to cause him to mistake one for the other because the idea of each mark is the same. The average consumer rarely has the chance to compare marks side by side; he has to rely upon his memory in circumstances where he is not applying the greatest level of attention, and so may imperfectly recall one mark instead of the other mark, the meanings being identical, the earlier mark being reasonably distinctive, and the services provided being identical/near identical.

Outcome

40. I found above that there is a likelihood of confusion in respect of all of Mr Lovegrove's services except for *installation, maintenance and repair of computer hardware*. The effect of this under section 47(6) of the Act⁸ is that:

- (i) The registration is deemed never to have been made in respect of *Building construction; repair; installation services; painting and decorating; cleaning services*. These services will be deleted from the specification of Mr Lovegrove's trade mark registration.
- (ii) Mr Lovegrove's trade mark registration is to remain registered in respect of *installation, maintenance and repair of computer hardware*.

Costs

41. The applicant has been largely successful and is entitled to an award from the Registrar's published scale of costs⁹. I will reduce the award to take account of the partial success/failure of its ground. I will also reduce the award as a result of Mr Lovegrove successfully challenging the registry's preliminary view which allowed the

⁷ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

⁸ "(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made."

⁹ Tribunal Practice Notice 4/2007.

applicant an extension of time to file evidence in chief. Mr Lovegrove's challenge resulted in the preliminary view being overturned at the case management conference, no evidence being filed and a considerable reduction in the amount of grounds running. I award costs to the applicant as follows:

Preparing a statement and considering Mr Lovegrove's statement	£200
Application fee	£200
Preparing for and attending a hearing	£400
Total	£800
Reduction of 15% in view of partial success/failure	- £120
Reduction for case management conference outcome	- £50
Total:	£630

42. I order Brian John Lovegrove to pay Highdawn Pty Ltd the sum of £630. This sum is 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 5th day of April 2012

**Judi Pike
For the Registrar,
the Comptroller-General**