

O-180-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2567967
BY TAYLOR MADE (UK) LIMITED
TO REGISTER THE TRADE MARK**



**IN CLASS 36
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 102181 BY
TAYLOR WIMPEY HOLDINGS LIMITED**

BACKGROUND

1) On 24 December 2010, Taylor Made (UK) Limited (hereinafter the applicant) applied to register the trade mark shown on the front page in respect of the following services in Class 36: Estate agency services; accommodation letting agency services; rent and lease negotiation services; property management services; rent collection services; lease management services; property valuation services; financial services relating to property; information, advice and consultancy services relating to all the aforesaid goods.

2) The application was examined and accepted, and subsequently published for opposition purposes on 15 April 2011 in Trade Marks Journal No.6883.

3) On 14 July 2011 Taylor Wimpey Holdings Limited (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Date of application / date of registration	Class	Specification
TAYLOR WIMPEY	CTM 5787271	26 March 2007 / 31 January 2008	36	Rental of buildings and apartments; capital investments; real estate management services; marina, docks and harbour real estate management; financial management relating to marina, docks and harbours; fund investment; real estate agency services; real estate rental, letting and leasing services; mortgage banking; real estate appraisal; insurance services; insurance brokerage services.
			37	Building construction and repair services; construction and repair of roads, bridges, tunnels, dams, sewerage works, pipe lines and harbours; drilling of wells; maintenance and repair of buildings, parts and fittings for buildings and utilities of buildings; construction and repair of recreational and sports grounds; construction and repair of golf courses; installation of air conditioning equipment, burglar alarms, electric appliances, elevators, fire alarms, kitchens, kitchen equipment; real estate development services; land development services for housing and commercial use; cleaning services, building cleaning services, information and advisory services relating to all the aforesaid services.

b) The opponent contends that the mark in suit contains the term TAYLOR with the addition of the term MADE which it contends is of low distinctiveness. The dominant component of the mark in suit is identical to the first element of the opponent’s mark. The core services of the two parties are similar or identical, as when new homes are built the consumer frequently purchases direct from the developer. The mark in suit therefore offends against Section 5(2)(b) of the Act.

c) The opponent states that its business was formed from the merger of George Wimpey and Taylor Woodrow in 2007. Both companies had a history of 80 years or more. They state that today Taylor Wimpey is one of the UK’s largest house builders. In 2010 it built 9,963 UK homes with sales revenue of £1,736 million. It contends that it has a reputation in its mark and that use of the mark in suit is

without due cause and would take unfair advantage of the opponent's repute. The mark in suit therefore offends against Section 5(3) of the Act.

4) On 28 May 2012, the applicant filed a counterstatement denying all the grounds, pointing out that TAYLOR is a common surname in the UK. It accepts that the services in Class 36 are contained within the specification of the opponent's earlier mark. It denies that the opponent's services in Class 37 are similar to those it seeks to register. They point out that the mark in suit has been in use since 2007 and so there has been concurrent use without any instances of confusion. They did not request the opponent to prove use of its mark.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard, but both parties provided written submissions which I shall refer to as and when required in my decision.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 24 September 2012, by Jonathan Drake a Director of the opponent company, a position he has held since 2009 having worked for the group since 2003. He states that his company build homes from 1 bedroom apartments to five bedroom detached houses throughout the UK. He provides the following figures for Taylor Wimpey in the UK:

Year	Home completions	Sales outlets	Revenue from house building £million
2007	14862	337	3,054
2008	n/a	n/a	2,390
2009	n/a	n/a	1,700
2010	9962	289	1,737
2011	10180	305	1,780

7) Mr Drake states that his company offers a property search facility on its website allowing prospective customers to search on location, price and number of bedrooms which he states is similar to a typical estate agent's website. The company's sales staff guide customers through the purchasing process, and the opponent also financially assist purchasers through a variety of schemes including some which are Government backed. Further, Mr Drake states that his company, in certain instances, will purchase a buyers existing home to avoid a chain holding up the sale. He states that such part-exchange initiatives have been offered since 2007. He states that they also offer information and advice on buying a home, moving home and also buy to let. Over the period 2008-2011 inclusive the company incurred advertising costs averaging approximately £7000 per home sold. He states that his company is the subject of coverage in the media at both national and local levels. They have also won a number of awards which reflect the scale of the company's UK business and also its repute. He also provides the following exhibits:

- JD1: A copy of the search page of the opponent’s website, which shows the criteria set out above and the name TAYLOR WIMPEY.
- JD2: Details of the opponent’s financial assistance packages to aid would be purchasers. All feature the name of the opponent.
- JD4: A copy of the “buy to let” information page from the opponent’s website.
- JD5: Copies of press reports regarding the opponent. It includes one story from Nottingham dated November 2009, which is headed “HOMES NOW TAYLOR-MADE”. It refers to a housing estate previously sold under the name George Wimpey which was rebranded Taylor-Wimpey. Given that the merger took place in 2007 it is surprising that the rebranding took quite so long.

8) Mr Drake concludes:

“21. It will be seen from the foregoing information that my company offers under the Taylor Wimpey name, and has offered under the Taylor Woodrow name, extensive and large scale services including property searching, financial advice, homebuyer assistance and information schemes and a property part-exchange facility, all of which closely match the services of a conventional estate agent and would be considered as substitutable services by our house-buying customers.”

APPLICANT’S EVIDENCE

9) The applicant filed a witness statement, dated 6 December 2012, by John William Stein the Managing Director of the applicant company since its inception in 2007 (JWS1). He has worked in real estate since 1987. He states that his company has used the mark in suit continuously since its inception and also owns the domain name taylormadeuk.com which was registered on 27 June 2007 (JWS2). He provides the following figures for his company in the UK:

year	Turnover £	Advertising £
2007	130,000	2,591
2008	170,000	12,605
2009	210,000	18,822
2010	240,000	14,112
2011	285,000	19,314

10) He states that his company provides services of lettings, property management and estate agency. At exhibit JWS3 he provides copies of documents including letters and newspapers which show use of the mark in relation to these services. At exhibit JWS4 he provides copies of sample invoices which show use of the mark in relation to the above mentioned services. Mr Stein states that the advertising undertaken by his company includes newspapers, advertising and editorials, printed flyers and website activity. He also points out that the name TAYLOR is common and he provides a

number of instances, at exhibit JWS5, of such use in real estate and lettings where the name TAYLOR is used by other companies. He states that despite using the mark in suit since 2007 he has never been aware of any instances of confusion between the two parties in this case.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

12) I first turn to the ground of opposition based on section 5(2)(b) which reads:

5.-(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.”

13) An “earlier trade mark” is defined in section 6, the relevant part of 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.”

14) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The applicant did not request that the opponent provide proof of use, and because of the interplay of dates between the mark in suit being advertised and the opponent’s mark being registered the provisions of Section 6A of the Act do not apply.

15) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU 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). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10) Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Distinctive character of the opponent's earlier trade mark

16) The opponent has provided evidence of use of its mark in the UK. The opponent contends that as soon as the merger took place in 2007, the mark Taylor Wimpey was used throughout the new company. Clearly, exhibit JD5 (described above) contradicts this assertion, showing that parts of the company did not change the mark used until a year or so later. However, despite this I am willing to accept that the opponent has achieved a significant reputation prior to December 2010 under its mark Taylor Wimpey in respect of building and selling new homes. All of the other services that it offers are directly connected to its new houses and so whilst it may offer some services similar to the average estate agent these are always connected to its new houses unlike an estate agent which deals with houses of all ages and are not tied to a single builder. The opponent's mark will clearly be seen as an amalgamation of two surnames, and as such I consider it to have a reasonable degree of inherent distinctiveness for the services for which it is registered.

The average consumer and the nature of the purchasing process

17) I must now determine the average consumer for the services of the parties. Clearly the specifications of both parties would be aimed at the home purchasing general public and businesses. When choosing an agent to assist in the purchase of a property, or indeed any of the other services related to property, the selection will be made very carefully. The sums of money involved even in services such as collecting rent can be considerable, and of one is looking to purchase a home then the average consumer is likely to pay a high degree of attention to the selection of an agent who will be entrusted to assist in the search. Overall the average consumer is likely to pay a high degree of attention to the selection of an estate agent.

Comparison of services

18) In the counterstatement the applicant accepted that the specification applied for was contained in the opponent's Class 36 services. **The services must therefore be regarded as identical.** The services in Class 36 are the opponent's strongest case, if it cannot succeed on identical services then its position with regard to its class 37 services must also fail.

Comparison of trade marks

19) The trade marks to be compared are as follows:

Applicant's mark	Opponent's mark
	TAYLOR WIMPEY

20) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

21) Whilst the name TAYLOR appears first in the opponent's mark, it shares equal prominence in the mark with the name WIMPEY. TAYLOR is a more common name compared to WIMPEY but, to my mind, neither of these two names dominates over the other and the distinctiveness lies within the mark as a whole. The mark in suit also has the common name TAYLOR as its initial word but then has the word MADE. This will immediately be seen as a play on words of, in the instant case, a service which is designed and altered to meet the individual needs of each customer i.e. tailor-made. Although the background on which these words appear could be deemed a device element to my mind it is negligible and it is not a distinctive element. Therefore, to my mind there is no dominant feature, the distinctiveness lies within the totality of the mark. I will approach the comparison of the trade marks with these conclusions in mind.

Visual similarity

22) Clearly both marks have as their initial word the common surname TAYLOR. The mark in suit then has the word MADE whereas the opponent's mark has another surname WIMPEY. I do not believe that the surround of the mark in suit will be taken into account by the average consumer as it is unremarkable and is not subject to any colour claim (*Specsavers*). To my mind, the respective marks share a moderately low level of visual similarity.

Aural similarity

23) Again there is a degree of similarity as they share the same first word but differ thereafter.

Conceptual similarity

24) The opponent's mark will be seen for what it is, two surnames, which will be assumed to be the names of the founders of the company, as this is common practice e.g SLATER WALKER; KLEINWORT BENSON. However, the mark in suit will conjure up the image of a service which is custom made or bespoke for each individual client. The phrase "tailor-made" is very well known to all in society, and is seen as something to aspire to as it suggests a higher quality product rather than a mass produced or standard item.

Likelihood of confusion

25) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services and vice versa. The opponent has a reputation in relation to building and selling new homes on sizeable estates. It does not have a reputation for dealing as an estate agent, even though some of its activities linked to selling its new homes would superficially appear similar. Anyone looking to move house would only seek out the opponent if there was a new build estate taking place where they were looking to buy, otherwise they would go to an estate agent who would have details of a vast array of different properties and not just the usual six or seven designs found on most mass built estates. The opponent is not assisted, in the class 36 instance, by its reputation. In the instant case it is clear that the services in Class 36 are identical, and there is a modest degree of similarity in the marks. However, the average consumer is well used to differentiating between people and families by reference to a surname. The average consumer will be aware that TAYLOR is a very common surname and will not immediately assume that there is a link. They will see both marks as wholes and will perceive that the opponent is a different company having been formed by two individuals/families whereas the mark in suit, whilst started by a person called TAYLOR, has decided to use word play to imply that its services are honed to each client. Even when taking into account imperfect recollection, the differences between the marks is such that there is no likelihood of consumers being confused into believing that the services provided by the applicant are those of the opponent or provided by some undertaking linked to them. In the case of the Class 37 services of the opponent these are not identical but only similar to the services applied for, the opponent has its reputation in the class 37 services but my comments regarding the marks still hold true and would outweigh the reputation. **The opposition under Section 5(2) (b) therefore fails in total.**

26) I now turn to the ground of opposition under Section 5(3) which reads:

"5-(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in 3 the United Kingdom (or, in the case of a Community trade mark or international trade mark

(EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

27) The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] RPC 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484 *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00 and, more recently *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7. Guidance in relation to reputation under Section 5(3) has been set out in *General Motors Corporation v Yplon SA* in paragraphs 23 to 27. Paragraphs 26 & 27 indicate the standard that must be reached:-

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

28) The onus is upon the opponent to prove that its earlier trade mark enjoys a reputation or public recognition and it needs to furnish the evidence to support this claim. Although its claims regarding reputation were slightly compromised by its own evidence which showed that the rebranding to Taylor Wimpey did not occur across the business as it claims in 2007, I accept that the opponent has provided the evidence that its mark does enjoy such a reputation in relation to building and selling new houses (but no further) and so it clears the first hurdle.

29) Once the matter of reputation is settled any opponent must then show how the earlier trade mark would be affected by the registration of the later trade mark. The opponent has offered no evidence to this point and its submissions simply refer to the distinctiveness of its mark. However, earlier in this decision I determined that the distinctiveness of the opponent's mark lay within the whole of the mark as it consists of two names neither of which is dominant and the first of which is somewhat commonplace. In *Inlima S.L's* application [2000] RPC 61 Mr Simon Thorley QC, sitting as the Appointed Person, said:

“The word ‘similar’ is a relative term. One has to ask the question ‘similar for what purpose’. The question of similarity accordingly can only be answered within the context of a particular set of facts, once one has identified both the facts and the purpose for which similarity is required. In the case of section 5(3), the purpose of requiring similarity is so that the possibility of detriment or unfair advantage might arise. In any particular case, a conclusion as to whether it does arise must depend not only upon the degree of similarity but on all the other factors of the case, not least, the

extent of the reputation. I therefore conclude that the same global appreciation as is required for confusion under section 5(2) is likewise to be applied to the changed circumstances of section 5(3).”

30) I also note the following comment from Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge) in *Electrocoin*:

“ 102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

60) It seems to me that the opponents have singularly failed to show that the use of the mark in suit on the goods which are dissimilar to its own would cause detriment. I believe that this is a case where use of the mark in suit on items such as “flooring” will call to mind the opponents’ mark and its reputation for tackers. However, I do not believe that it will affect the consumers economic behaviour or damage the opponents’ mark by tarnishing or blurring. I also take into account the fact that the applicant has been using the mark 2019269 “RAPID” on goods in Class 20 since 1985. The opposition under Section 5(3) of the Act fails.

31) I note that the opponent has reputation for building and selling new houses on large development estates. Typically the houses will be visually similar differing in terms of size, and usually restricted to six or seven designs all around a theme for the estate. The opponent contends that it offers similar services to that of an estate agent when it sells its new houses. Earlier I found that the opponent’s mark is inherently distinctive for “building houses” and has an enhanced reputation. I also found earlier in this decision that the differences between the marks was such that overall they are quite dissimilar. Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that there is no advantage for the applicant to derive, as no link will be established and the average consumers’ economic behaviour will not be affected. As far as detriment is concerned, the opponent suggested that this would subsist in a reduction in the distinctiveness of its mark. I do not consider that registration of the mark in suit could have an impact in this respect, be it to the distinctiveness of the earlier mark or the reputation it enjoys. **The opposition under Section 5(3) therefore fails.**

CONCLUSION

32) The opponent has failed under Sections 5(2)(b) and 5(3).

COSTS

33) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£200
Preparing evidence and considering the evidence of the other side	£1000
Written submissions	£200

TOTAL	£1,400
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34) I order Taylor Wimpey Holdings Ltd to pay Taylor Made (UK) Ltd the sum of £1,400. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of May 2013

**George W Salthouse
For the Registrar,
the Comptroller-General**