

O-218-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2614072
BY I-SMART CONSUMER SERVICES LIMITED TO REGISTER THE
FOLLOWING TRADE MARK IN CLASSES 36, 39 & 45:**



AND

OPPOSITION THERETO (NO 103710) BY ISS A/S

The background and the pleadings

1) I-Smart Consumer Services Limited (“I-Smart”) applied for the above trade mark on 14 March 2012. It was published in the Trade Marks Journal on 18 May 2012. ISS A/S (“ISS”) opposes the registration of the mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) relying on two earlier trade marks that it owns. There is no dispute that ISS’ marks constitute earlier marks, neither is it in dispute that the earlier marks are not subject to the requirement to prove that they have been genuinely used. The following table sets out the competing marks:

I-Smart’s trade mark	ISS’ trade marks
 <p>Class 36: Insurance; financial services; claims handling services; debt management services.</p> <p>Class 45: Legal advisory services</p>	 <p>Class 35: Personnel recruitment, provision of personnel for events, provision of personnel for operation of switch boards, receptions, call centres and helpdesks, secretarial services, office space management (administration of and advice on office space for others), administration of furniture for companies; rental of vending machines; data and data base management; business management, namely advice on and providing subcontractors relating to employment, office logistics services, management of real estate, building management services, outer and inner building maintenance and cleaning, cleaning of facilities, industrial premises, public areas, roads and gardens, architectural services, building construction, clearing, cleaning and repair after fire and water damage, waste disposal services, transportation services, office messenger services, hygiene inspection and control services, engineering services, IT services and solutions, interior design services, services for providing of food and drink, gardener and gardening services for outdoor and indoor green areas, security services, pest control services and vermin exterminating; management of business processes for companies concerning outsourcing relating to employment services, office logistics services, management of real estate, building management services, outer and inner building maintenance and cleaning, cleaning of facilities, industrial premises, public areas, roads and gardens, building projects, clearing, cleaning and repair after fire and water damage, waste disposal services, transportation services, office messenger services, hygiene inspection and control services, engineering services, IT services and solutions, interior design services, services for providing of food and drink, gardener and gardening services for outdoor and indoor green areas, security services, pest control services and vermin exterminating; business consultancy services all relating to property and estate management, projects management, cleaning, catering, security, logistics, personnel, mechanical and electrical maintenance services, communications and IT consultancy and management; office functions, administration of day nursery and kindergarten; business consultancy in connection with the operation of kiosks, kiosks for selling products, namely</p>

newspapers, magazines, confectionery, ice-cream, flowers, greeting cards, tooth brushes, sanitary towels, snacks, fruits, non-alcoholic beverages, personal cleaning products; administration of rest homes, hospices, hospitals and clinics, including medical clinics; employment agency services; internal mail sorting for others; document reproduction.

Class 36: Administration and management of real estate.

Class 37: Maintenance of heating and air conditioning systems, of elevators and of escalators; cleaning of buildings, yards, facilities, property, gardens and rooms; cleaning within the food industry and disinfecting cleaning; cleaning of industrial premises; cleaning and rinsing of telephones and computers; cleaning and re-filling of various sanitary products in connection with wet rooms, washrooms and toilets; installation of various sanitary products in wet rooms, washrooms and toilets; curtain, carpet, mats and upholstery cleaning; cleaning, maintenance and repair of aircrafts, ramps and runways; vermin exterminating (other than for agriculture); snow removal services; janitorial services, namely maintenance, cleaning and repair of buildings; maintenance and repair of electric installations and sanitary installations; clearing, cleaning and repair after fire and water damage; contractor services, namely construction and installation of kitchens; maintenance, inspection and minor reparations of buildings; property development; advisory services relating to development of property; maintenance and repair of electric installations in buildings, mechanical installations and sanitary installations in buildings; advisory services relating to the construction, maintenance and repair of mechanical engineering structures connected with buildings.

Class 45: Security services for the protection of property and individuals; advice on security issues, guard and alarm services; safety control of individuals and property; security services for controlling admission to buildings and public places; night watching; surveillance of burglar and security devices and alarms; civil protection; surveillance of property and individuals; search for missing persons; bodyguard services; security control of persons and luggage in airports; security services for controlling admission in connection with airport check-ins.

ISS

Class 45: Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals; advice on security issues, guard and alarm services; safety control of individuals and property; admittance control; night watching; surveillance of burglar and security devices and alarms; civil protection; surveillance of property and individuals; search for missing persons; bodyguard services.

2) It should be noted, i) that I-Smart's application initially contained services in class 39 but these were withdrawn by it, ii) that ISS' graphic mark is protected for further classes of services, but I have not listed them because in its written submissions ISS argues only on the basis of the classes listed in the above table, and iii) that both of ISS' earlier marks are International Marks which have designated the Community for protection.

3) I-Smart filed a counterstatement denying that there was a likelihood of confusion; it considers the respective marks and the respective services to be dissimilar. Only ISS filed evidence. This consists of nothing more than print-outs of its earlier marks so there is no need to mention this evidence further. Neither side requested a hearing. ISS filed written submissions in lieu of attending a hearing, I-Smart did not. I will, of course, bear in mind all of the arguments that have been presented in the papers before me.

Section 5(2)(b) – the legislation and the leading case-law

4) Section 5(2)(b) of the Act 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.”

5) The Court of Justice of the European Union (“CJEU”) has issued a number of judgmentsⁱ which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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 or 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;

(e) 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;

(f) 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 of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

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

(j) 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;

(k) 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."

Comparison of the services

6) When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its 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 intended purpose and their method of use and whether they are in competition with each other or are complementary."

7) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

"(a) The respective uses of the respective goods or services;

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

8) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

“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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

9) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in 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 the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². However, I must

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

“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.”

10) I will consider the matter with reference to the services for which I-Smart seeks registration.

Class 45 - Legal advisory services

11) In its submissions, ISS argues that the above services are “contained within the scope of, and/or are similar to the following”:

“Personal and social services rendered by others to meet the needs of individuals; advice on security issues”

12) A legal advisory service constitutes a service by which a person or business is provided with advice on the law or other legal matters. In contrast, “advice on security issues” constitutes a service by which a person or business is provided with advice on matters of security such as (when the nature of class 45 is considered) personal or home security. The purpose of the services, therefore, differs. The services do not compete. I see no complementary relationship as defined by the case-law. There is nothing to suggest that the channels through which the services are offered will coincide. The user may be the same and they are both advisory services, but this creates no meaningful aspect of similarity. No evidence has been provided to demonstrate that the services are similar. Beyond its basic claim of similarity, ISS has not even explained why the services are similar. **Legal advisory services are not similar to advice on security matters.**

13) “Personal and social services rendered by others to meet the needs of individuals” is a somewhat vague term. It does not clearly indicate what the precise service actually is. It is, obviously, some form of service the purpose of which meets a personal or social need of an individual. In case C-307/10, *IP TRANSLATOR*, the CJEU expressed concern over vague specifications and that goods and services within a trade mark registration must be identified with sufficient clarity and precision to determine the extent of the protection conferred by the mark; it was also stated that whilst some of the general indications in the class headings of the Nice Classification (of which the term under discussion here is one) may meet the requirement of clarity, this was not the case where such terms were “*too general and cover goods or services which are too variable to be compatible with the trade mark’s function as an indication of origin*”. If the term to be compared is not clear then it follows that a comparison cannot be

made and it follows that similarity or identity cannot be held³. Even if I am wrong on this and some form of comparison should be made, it would be my view that “personal and social services rendered by others to meet the needs of individuals” covers services which are specifically offered to meet a particular requirement or need of a person such as the requirement for an escort, a bodyguard etc etc. I do not consider that such a term should be taken to include anything akin to a legal advisory service. **Legal advisory services are not similar to personal and social services rendered by others to meet the needs of individuals.**

Class 36: Insurance; financial services; claims handling services; debt management services

14) In its submissions, ISS argues that the above services are “contained within the scope of, and/or are similar to the following”:

i) **Class 35:** Business management, namely advice on...employment, office logistics services, management of real estate, building management services, outer and inner building maintenance and cleaning, cleaning of facilities, industrial premises, public areas, roads and gardens, architectural services, building construction, clearing, cleaning and repair after fire and water damage, waste disposal services, transportation services,.....engineering services, IT services and solutions, security services..; management of business processes for companies concerning outsourcing relating to employment services, office logistics services, management of real estate, building management services, outer and inner building maintenance and cleaning, cleaning of facilities, industrial premises, public areas, roads and gardens, building projects, clearing, cleaning and repair after fire and water damage, waste disposal services, transportation services,....engineering services, IT services and solutions,....security services; business consultancy services all relating to property and estate management, projects management..”

ii) **Class 36:** Administration and management of real estate.

15) Also, the opposed services are said to be similar to “building related construction services”, by way of example, but not limited to:

iii) **Class 37:** Advisory services relating to development of property; advisory services relating to the construction, maintenance and repair of mechanical engineering structures connected with buildings.

³ See, by way of analogy, Case T-162/08 *GREEN BY MISSAKO*, in which the GC held that “*retail services in shops*” was too vague to allow a proper comparison because it did not specify the goods, or types of goods, to which the retail services related.

16) In relation to the above claims, ISS has provided no evidence or any explanation as to why the services conflict. I will deal with the claims in reverse order. In relation to the opposed services, they cover a number of discrete financial services (Insurance; claims handling services; debt management services) and financial service at large. Financial services is a broad term, the services that fall within would include banking, insurance, dealing in stocks and shares, financial management, etc etc. However, I see nothing in either the discrete terms or anything that would fall within the ambit of the broad term which is obviously similar to “building related construction services”. The purpose of the services differs, the nature differs, methods of use differ. The services do not compete. There is nothing to suggest a complementary relationship. Whilst a particular type of financial service may be required, in some circumstances, to fund building construction, this does not create a complementary relationship as defined by the case-law. There is nothing to suggest that the services coincide through the same trade channels. **Insurance; financial services; claims handling services; debt management services are not similar to the “building related construction services” in class 37.**

17) I next consider whether the opposed services are similar to, or are included within, administration and management of real estate. I should firstly say that the term financial services would not include administration and management of real estate within its ambit. The latter is not something which would ordinarily be classed as a financial service. It is not financial in nature but relates, instead, to real estate. But are the services similar? The purpose of administering and managing real estate has no real obvious similarity to a financial service. The purpose is different, the nature is different, there is no evidence that the trade channels coincide, neither are they complementary as defined by the case-law. Any aspect of similarity is extremely tenuous, such as the potential for the users to be the same - this can be said of most things. That a person’s (or business’) assets could be based in real estate or in monetary property does not make the services similar. With no evidence to the contrary, **insurance; financial services; claims handling services; debt management services are not similar to, administration and management of real estate.**

18) I finally consider whether the opposed services are similar to, or are included within, the services listed at paragraph 14) i) above. The opposed services can not be included within those of the earlier mark as they fall in different classes and, thus, cannot be the same; this is not the case of a multi-function product which may fall in more than one class⁴. In relation to the discrete financial services listed in class 36, I see no basis whatsoever for coming to the view that there is similarity. The nature, purpose, channels of trade, methods of use etc do not coincide nor do I see a competitive or complementary relationship. **Insurance; claims handling services; debt management services are not similar to ISS’ services in class 35.**

⁴ See *OMEGA* BL 0-352-09, a decision of an IPO Hearing Officer (Mr Landau). This decision has been appealed to the High Court and the Court of Appeal, neither disturbed the finding.

19) That leaves financial services at large. For the reasons expressed above most of the discrete services that fall within the ambit of such a term are likewise not similar. ISS has not identified any specific financial service it considers to be similar. In my view, there is only one type of financial service that has an obvious capacity to be similar. That service would be financial management. Financial management services can be a service provided to businesses to assist in the effective management of the monetary and other financial aspects of that business in order to meet organisational and strategic goals. The services of ISS' earlier mark include business management services which although not necessarily financial in nature, are, nevertheless, also aimed at assisting the business with effective management of certain aspects in order to meet organisational and strategic goals. Although some of the business management services of the earlier mark are in the field of facilities management, others are more general, including, for example, business management relating to employment, office logistics, IT solutions. I consider that this creates some degree of similarity in overall purpose. Although the services are not strictly competitive or complementary, it may be that service providers will offer a range of management services to a business including those of the type under discussion. I consider that there is a reasonable, but not high, degree of similarity between **financial services (insofar as it covers financial management) and the business management type services in class 35.**

20) Given my findings in respect of the similarity of the services, the opposition against the terms “Insurance; claims handling services; debt management services” and “legal advisory services” is hereby dismissed⁵. The opposition is also dismissed to the extent that it is based upon ISS' plain word mark for the letters ISS because its services are not within the scope of where I have found similarity between the services. I will, therefore, focus only upon ISS' stylised mark from this point forward.

The average consumer

21) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods and services can vary, depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The only area in which I have found similar services is in respect of financial management against business management. Although the former can be aimed at businesses or the general public, the clash is only really operative in the business to business environment. Given the relative importance of the services, the likely infrequency of the selection, and the fact that the services are not cheap, the selection of a service provider will not be carried out casually. **A considered approach will be adopted.** I would seem likely that the selection process will involve perusal of

⁵ If goods/services are not similar then there can be no likelihood of confusion; see, for example, the CJEU's judgment in *Waterford Wedgwood plc v OHIM* Case C-398/07.



information on websites and brochures so visual similarity is likely to be more significant than aural similarity – aural similarity will not, though, be ignored from the analysis.

The distinctiveness of the earlier mark

22) The more distinctive the earlier mark, the greater the likelihood of confusion. Distinctiveness can come from the mark’s inherent characteristics or from the use that has been made of it. No evidence of use has been presented so, in this case, it is only the inherent characteristics of the earlier mark that need to be assessed. The mark is dominated by the letters “iss”. Whilst combinations of letters such as this are not highly distinctive, there is nothing suggestive or allusive about them. **The mark has an average level of inherent distinctive character.** I have, of course, borne in mind that the mark is stylized and has an oval background element; however, I do not consider that this materially increases its level of inherent distinctiveness.

Comparison of the marks

23) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

I-Smart’s trade mark	ISS’ trade mark
	

24) Both marks are dominated by the letters included within them. However, it is still a whole mark comparison that is to be made. There are two letters in I-Smart’s mark whereas there are three letters in ISS’ mark. The two letters in I-Smart’s mark appear in ISS’ mark in the same order. There is, of course, the additional letter S in ISS’ mark. Given that the letter combinations in question are relatively short, there is greater capacity for this difference to be noticed than had an additional S been included in a much longer combination of letters. Nevertheless, I still consider there to be some visual similarity due to the common presence of the same initial two letters in the marks. The stylisation differs between the two marks. This creates an additional difference, and thus reduces the visual similarity to some degree. I-Smart argues that the differing

logos play a significant role in reducing visual similarity. My view is that whilst this clearly plays a role, it is not as significant as I-Smart argues. ISS considers the marks to be virtually identical; this is overplaying the degree of visual similarity. **On balance, I consider there to be a moderate to reasonable degree of visual similarity.**

25) From an aural perspective, ISS's mark will be pronounced with reference to the three letters in the mark, I-S-S. The question arises as to whether I-Smart's mark will be pronounced as the two letters I-S or, instead, as the word "is". This is a case where both options are possible. The former creates a reasonable degree of aural similarity, the latter virtually none. ISS argues that the mark will be seen as I-S rather than the word "is" because the name of the applicant is I-Smart. This is not a good argument because there no reason why the average consumer will know of the name of the company that owns the trade mark. However, although the average consumer will normally attempt to articulate letters into a word that he knows, the unusualness of seeing the word presented alone means that the majority, in my view, will pronounce the mark by reference to the letters I-S. ISS argues that the second S in ISS will be lost, so making the similarity high. Again, this is overplaying matters, but I still consider that **there is a reasonable degree of aural similarity.**

26) In terms of concept, neither mark will be conceptualised beyond the letters of which they consist. There is, of course, an overlap in the letters which means that the way in which they will be remembered (I-S-S/I-S) has a degree of commonality. However, absent specific meaning it is difficult to say that the marks are really conceptually similar, but neither are they dissimilar – the position is fairly neutral.

Likelihood of confusion

27) The factors assessed so far have a degree of interdependency. A global assessment of them must be made when determining whether there exists a likelihood of confusion. There is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

28) The earlier mark has an average degree of inherent distinctive character. There is a reasonable (but not high) degree of similarity between the services that remain in conflict. There is a moderate to reasonable level of visual similarity and a reasonable level of aural similarity. I must bear in mind the considered nature of the selection process. This will militate, to a degree, against imperfect recollection causing confusion due to the care that is to be taken. **Nevertheless, I still consider that the degrees of similarity that I have assessed will result in there being a likelihood of confusion in relation to financial services (insofar as it covers financial management services).**

Amendment of specification

29) The application must be refused in relation to the term “financial services” due to financial management services being included within its ambit. However, the term is broad enough to cover other types of financial services (beyond the discrete ones already listed in the specification) for which the opposition would fail. Although no fall-back specification was provided by I-Smart, I consider it reasonable to allow I-Smart 14 days to provide a list of any financial services that fall in class 36 for which it wishes its mark to be registered, but which do not constitute financial management services by their nature. ISS will then be provided with a 14 day period to comment upon the proposed list. A supplementary decision will then be issued with the final outcome, and which will also contain my decision on costs. The appeal period will commence from the date of my supplementary decision.

Dated this 22nd day of May 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**

ⁱ The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).