

O-204-14

TRADE MARKS ACT 1994

IN THE MATTER OF OPPOSITION NO 103724
BY BBH PARTNERS LLP
TO APPLICATION NO 2609433
IN THE NAME OF Bh PUBLICATIONS LIMITED

AND

IN THE MATTER OF AN APPLICATION FOR INVALIDATION UNDER NO 84677
BY BBH PARTNERS LLP
TO REGISTRATION NO 2609774
IN THE NAME OF Bh PUBLICATIONS LIMITED

CONSOLIDATED PROCEEDINGS

Background

1. This decision concerns two consolidated proceedings as follows:-

i) Trade mark application No 2609433 which stands in the name of Bh Publications Limited (“Publications”), has a filing date of 7 February 2012 and seeks registration of a series of two marks **bh Exclusive** and **BH Exclusive** in respect of the following goods and services:

Class 16

Graphic designs; printed matter, in particular printed matter relating to luxury life style publications; printed matter relating to franchises.

Class 35

Advertising, in particular advertising relating to luxury life style publications; marketing; business assistance relating to the establishment of franchises; provision of assistance in the operation of franchises; all relating to the aforesaid services.

Class 41

Publishing of printed matter; publishing of printed matter electronically online; copy writing; photography; all relating to the aforesaid services.

Class 42

Graphic design services; design of printed matter for use in marketing; design of advertising material; website design; hosting computer websites; all relating to the aforesaid services.

The application was published in *Trade Marks Journal* No 6941 on 25 May 2012. Following publication, notice of opposition was filed by BBH Partners LLP (“Partners”). Partners bases its opposition on grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) on the basis of the following trade mark registrations:

Trade Mark	Dates	Specification
2184103 BBH	Filing date: 9 December 1998 Date of entry in register: 3 December 1999	Class 35: Advertising and promotional services; marketing services; public relations services; sales promotion services; consultancy, information and advisory services all related to the aforesaid services
2465221 BBH	Filing date: 24 August 2007 Date of entry in register: 25 April 2008	Class 16: Printed matter; printed publications; newsletters; magazines; periodicals; stationery; calendars; diaries; books; catalogues; manuals; graphs; advertising story boards, posters, pictures; instructional and teaching materials, comics, pens, pencils, markers and crayons, cases for pens, pencils, markers and crayons, photographs and prints, printed stamps and ink pads, memo and notice boards, decalcomanias and stickers, postcards, book marks, paper coasters, bookplates and book marks; paper gift bags.

		<p>Class 35: Advertising and promotional services; marketing services; public relations services; sales promotion services; consultancy, market research; production of commercials; planning, buying and negotiating advertising space; commercial information agency services; economic forecasting; business enquiry and investigations; marketing study services; opinion polling; publication of publicity texts; radio and television advertising; sales promotion for others; organisation of exhibitions for commercial or advertising purposes; information and advisory services all related to the aforesaid services.</p> <p>Class 41: Publication of texts and books including online publishing; arranging and conducting seminars for instructional purposes; providing online electronic publications (not downloadable); organisation of competitions; film production; presentation of live performances; provision of recreational facilities; television entertainment, production of television programmes and radio programmes, organisation of exhibitions for cultural or educational purposes.</p>
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ii) Trade mark registration No 2609774 which also stands in the name of Publications and has a filing date of 7 February 2012. It is registered for a series of two marks **bh** and **BH** in respect to what is, with one minor and insignificant difference in punctuation, the same specification of goods and services as its application 2609433. It has a date of entry in the register of 18 May 2012.

On 15 February 2013, Partners filed an application to declare the registration invalid. It does so under grounds under sections 5(2)(b) and 5(3) of the Act, based on the two registrations as set out in the above table. It also objects under section 5(4)(a) of the Act based on use of the mark BBH, in the United Kingdom since 1992, in relation to *advertising and promotional services, marketing and sales promotion, printed matter*.

2. Publications filed counterstatements in each set of (later consolidated) proceedings, denying each of the claims made. Both parties filed evidence with Publications also filing written submissions. The matter came before me for a hearing on 23 April 2014. Publications did not attend and were not represented but did file 'observations' in lieu of attendance. Partners were represented by Mr Ben Longstaff of Counsel, instructed by Kilburn & Strode, its legal representatives in these proceedings. Given that much of the evidence filed by both parties consists of submission rather than evidence of fact, I do not intend to summarise it here but I have read it and will refer to it as appropriate in this decision.

Preliminary issue

3. Whilst no reference to it was made in its counterstatement, in her second witness statement filed on behalf of Publications, Ms Dykes states:

"Under UK trade mark the (sic) law the equitable defences of "laches" has been used to avoid liability in similar cases to the matter in question. I contend that there has been "unreasonable and inexcusable delay" by the claimant in bringing a cause of action against my registered mark since it became known

in the marketplace over 6 years ago and the claimant's delay in bringing a cause of action has prejudiced my business, since the Bh mark has now acquired distinctive character in relation to the goods and services for which it is registered, coupled with a substantial reputation in the marketplace. I therefore assert laches to bar the claimant from making a claim for invalidity."

4. It is not appropriate to make claims of this nature, for the first time, in evidence. If such a claim is to be relied upon, it should be made in the counterstatement. I decline to deal with it. Even if I had, I note the registration the subject of the invalidation action has an application date of 7 February 2012 and was entered in the register on 18 May 2012. The application for invalidity was filed on 15 February 2013. There has been no delay.

Decision

5. The application for invalidation against registration No 2609774 is brought under the provisions of section 47 of the Act, the relevant parts of which state:

"47.-(1)

(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.

(3) ...

(4) ...

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(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:

Provided that this shall not affect transactions past and closed."

6. Both the invalidation and opposition actions rely on section 5(2)(b) of the Act which states:

"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.”

7. 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) or 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,

(b)

(c)

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. The trade marks relied on by Partners are earlier marks within the meaning of the Act. Only 2184103 would be subject to the proof of use provisions set out in section 6A of the Act. In its counterstatements, however, Publications has indicated that it does not put Partners to such proof and, in any event, the services set out in 2184103 are included within Partner’s other earlier mark. The end result is that Partners is entitled to rely on both of its earlier marks in respect of all goods and services for which they are registered.

9. In considering this ground of objection, and the likelihood of confusion between the respective marks, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (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 case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR] O/333/10, Mr Hobbs Q.C., 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.

10. In essence, the test under section 5(2)(b) is whether there are similarities in the respective marks and goods or services which, when taking into account all the surrounding factors, would combine to create a likelihood of confusion. Given that both of Partners' earlier registrations are for the same mark and that the services as

set out in 2184103 are included within the specification as registered under 2465221, I intend to confine my comparison to this latter mark.

Comparison of goods and services

11. The goods and services to be compared are as follows:

Partners' specification of goods and services	Publications' specification of goods and services
<p>Class 16: Printed matter; printed publications; newsletters; magazines; periodicals; stationery; calendars; diaries; books; catalogues; manuals; graphs; advertising story boards, posters, pictures; instructional and teaching materials, comics, pens, pencils, markers and crayons, cases for pens, pencils, markers and crayons, photographs and prints, printed stamps and ink pads, memo and notice boards, decalcomanias and stickers, postcards, book marks, paper coasters, bookplates and book marks; paper gift bags.</p> <p>Class 35: Advertising and promotional services; marketing services; public relations services; sales promotion services; consultancy, market research; production of commercials; planning, buying and negotiating advertising space; commercial information agency services; economic forecasting; business enquiry and investigations; marketing study services; opinion polling; publication of publicity texts; radio and television advertising; sales promotion for others; organisation of exhibitions for commercial or advertising purposes; information and advisory services all related to the aforesaid services.</p> <p>Class 41: Publication of texts and books including online publishing; arranging and conducting seminars for instructional purposes; providing online electronic publications (not downloadable); organisation of competitions; film production; presentation of live performances; provision of recreational facilities; television entertainment, production of television programmes and radio programmes, organisation of exhibitions for cultural or educational purposes.</p>	<p>Class 16 Graphic designs; printed matter, in particular printed matter relating to luxury life style publications; printed matter relating to franchises.</p> <p>Class 35 Advertising, in particular advertising relating to luxury life style publications; marketing; business assistance relating to the establishment of franchises; provision of assistance in the operation of franchises; all relating to the aforesaid services.</p> <p>Class 41 Publishing of printed matter; publishing of printed matter electronically online; copy writing; photography; all relating to the aforesaid services.</p> <p>Class 42 Graphic design services; design of printed matter for use in marketing; design of advertising material; website design; hosting computer websites; all relating to the aforesaid services.</p>

12. In her witness statement dated 29 July 2013, Louise Dykes, who states she is co-founder of and gives evidence on behalf of Publications, states that it publishes two magazines and that:

“The activities we carry (sic) are as follows:

- a) The selling of advertising and editorial space therein, 80% of which is sourced within the geographical catchment area served by Bournemouth.
- b) Magazine distribution via Waitrose, Marks & Spencer and free distribution via our own delivery teams to selected AB households and businesses in the BH postcodes.

- c) Graphic design and associated skills enabling bh Publications Limited to publish and market Bh Exclusive magazine.
- d) Print and production which is outsourced to third parties.

In contrast, the opponent is an advertising agency which buys advertising and marketing space on behalf of its clients.”

She goes on to state:

“Purchasers of my company’s services are considered, discriminating buyers, who exercise due care before purchase and who can readily distinguish between the opponent’s creative advertising agency website, www.bartleboogleharty.com which reflects and offers state of the art communications media and my luxury title publishing business website, www.bh-publications.co.uk which offers the best produced magazines in the UK.....The domain names and descriptions contained therein the websites demonstrate the completely different styles of language employed in copywriting, the individual character, expressions, images, content and terminology between the two and confirm that the two sets of goods and services are sold by different businesses, with different ethos, from different ‘shelves’, which together demonstrate they originate from different sources thus guaranteeing the distinctive origin of the goods and services offered by my company”.

Ms Dykes further submits that her business “is not and never will become an advertising agency in the sense that is widely understood by the relevant public...”.

13. I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

“67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed.”

14. I also bear in mind the findings of the same court in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the

general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors-whether carried out or not- which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

15. The effect of these decisions is that, in essence, I have to make my comparison not on the basis of what the parties may already do or intend to do in the future or what might appear on particular websites. Rather, I must consider matters on a notional basis taking into account the full specifications of goods and services as registered or applied for by the respective parties.

16. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28, Jacob J gave advice as to how similarity should be assessed. He identified the following factors to be taken into account:

- (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.”

17. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc*, the CJEU stated:

“23. In assessing the similarity of the goods or services concerned.....all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

18. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, the General Court said:

“...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...”

19. In comparing the respective services, I take account of the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, where he 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 meaning attributable to the rather general phrase.”

20. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

21. Considering, first, Publications’ specification in class 16, whilst the term *graphic designs* is, perhaps, somewhat vague, such goods as are included in class 16 will be in the form of printed matter. The specification in this class includes printed matter limited so as to relate to franchises but also includes printed matter at large (the use of the italicised term in “printed matter, *in particular* printed matter relating to luxury lifestyle publications” does not act so as to limit the nature or content of that printed matter to luxury lifestyle publications). All of Publications’ goods in this class are, therefore, printed matter. As *printed matter* appears in Partners’ earlier mark, the goods are identical. I would point out that the position would be the same even if Publications’ specification were to be limited to what appears to be their main area of interest, luxury life style publications.

22. The same argument is applicable to Publications’ advertising and marketing services as set out in class 35: all are included within the term *Advertising and promotional services* and *marketing services* as appears in the earlier mark and so are identical services to these latter services. Publications’ services in this class also include *business assistance relating to the establishment of franchises* and *provision of assistance in the operation of franchises* which will include, and therefore are identical to the *advertising* and *marketing services* and the related *information and advisory services* as are included within Partners’ specification. In short, each of Publications’ services in this class is identical to services included within Partners’ specification in this class.

23. Publications' specification in class 41 includes *publishing of printed matter* and *publishing of printed matter electronically online* and are therefore identical to *publication of texts and books including online publishing* and *providing online electronic publications (not downloadable)* as appears in Partners' earlier mark on the basis of *Meric*. *Copy writing* is the writing of text and is at least highly similar to *publication of texts and books* (class 41) and *printed matter*, whilst *photography* is highly similar to *photographs and prints* (class 16) as appears in Partners' earlier mark. I note in passing that copywriting per se is a service which is proper to class 35 and would also be highly similar if not identical to advertising services in this class.

24. Publication's specification in class 42 includes *graphic design services* per se, as well as services which are obvious extensions to complement those services. They are highly similar if not identical to Partners' *advertising and promotional services* in class 35 and *publication of texts and books including online publishing* and *providing online electronic publications (not downloadable)* in class 41.

The average consumer and the nature of the purchasing process

25. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services and then to determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade.

26. In her witness statement of 29 July 2013, Ms Dykes states:

"Purchasers of my company's services are considered, discriminating buyers, who exercise due care before purchase and who can readily distinguish between the opponent's creative advertising agency website... and my luxury title publishing business website"

27. Again, I have to take into account the average consumer for the goods and services as registered and for which registration is applied, on a notional basis. The parties' own websites and what may appear on them, are not relevant for the purposes of the matter I have to decide.

28. The respective goods in class 16 are relatively low cost and everyday items as will be bought by the general public. They are goods which are often bought on impulse and with little consideration being given to their purchase. They are goods which are widely available from a number of sources including high street stores (whether physical or online) or by mail order. The purchasing act is likely to be primarily visual as they will be the subject of self selection from a shelf or via a screen or catalogue.

29. In contrast, the respective services are such as are most likely to be purchased by business users. They are services which range from e.g. placing an advert in a newspaper (which could also be done by a member of the public), to creating a multimedia advertising campaign and from photographing an event to producing books but all are likely to be bought with some, though not necessarily the highest,

degree of care. Both visual and aural considerations will come to the fore in respect of these services given that they may be bought in a number of ways e.g. via face to face, Internet or telephone contact.

Comparison of the respective marks

30. For ease of reference, the marks to be compared are:

Partners' earlier mark	Publications' marks
2465221 BBH	2609774 bh BH
	2609433 bh Exclusive BH Exclusive

31. Comparing, first, Publications' mark no 2609774 with Partners' earlier mark, the former consists of two letters, Partners' of three. The two letters in Publications' mark appear in the same order at the end of Partners' mark. The additional letter in Partners' mark is duplicative of another letter within it, with that duplication appearing as the first two of the three letters within the mark. I acknowledge there is a greater capacity for the difference caused by the additional letter to be noticed because of the relative shortness of the respective marks, however, I consider there is still visual similarity between the marks, due to the common presence of the same two letters in the same order and the proximate duplication of one of the letters. Whether or not the letters are presented in upper or lower case has no effect on this finding. I consider the respective marks to be visually similar to a reasonable degree.

32. Aurally, each of these marks will be pronounced with reference to the letters from which they are made up given that those letters do not make up a word with which the average consumer will be familiar. Again, the common presence of the same letters in the same order, coupled with the additional letter being a proximate duplicate of one of those letters, leads me to consider there is a reasonable degree of aural similarity between them.

33. In her evidence, Ms Chan states that the letters BBH are an abbreviation of the names of the three original founders of Partners. She exhibits a number of extracts from various publications wherein Partners and its work is the subject of the article and where the founders' names are mentioned. Many of these articles have been taken from specialist marketing publications and some are from the media pages of national newspapers. Whilst it may be that some, especially those in the advertising industry, on seeing Partners' mark, will be aware of the derivation of the letters and whilst others may assume the mark to be an abbreviation, there is no evidence that the average consumer will see it as anything other than 3 letters. Similarly, Publications state their mark was "derived from the postal code of the district from where the business still operates" but there is no evidence that the average consumer for the goods and services concerned, whether located in the BH postal code area or elsewhere, will see the mark as anything other than two letters. I consider the position is neutral from the conceptual perspective.

34. Moving on to compare Publications' mark no 2609433 with the earlier mark, the former is for a series of two marks, BH Exclusive/bh Exclusive. Again, nothing hangs on the fact that the letters BH appear in block capitals in one mark within the series and in lower case in the other.

35. In her witness statement dated 29 July 2013, Ms Dykes states that she:

“[denies] the opponent's allegation that EXCLUSIVE is non-distinctive, or has a very low distinctive character”

and continues:

“The expression EXCLUSIVE is used by my company as an important noun in conjunction with bh referring to goods and services of distinctive quality and luxury, unique and special, offered to the marketplace, not in the opponent's sense of an 'exclusive offer' such everyday usage belonging to below-the line advertising media, with which the opponent is undoubtedly familiar”.

36. Whether intended to be used in an adjectival sense or as a noun, the word Exclusive is an ordinary dictionary word used in common parlance. It is a word which, as Ms Dykes acknowledges, suggests a degree of quality or uniqueness. Whilst it contributes something to the overall impression of the mark and reduces the degree of visual and aural similarity, the word is descriptive and its capacity to distinguish is very limited with more focus being placed on the letters BH, so meaning that the reduction in the degree of similarity is very slight. These respective marks again have a reasonable degree of visual and aural similarity with the conceptual position being neutral.

The distinctiveness of the earlier mark

37. I must also assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the goods and services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

38. In her evidence, Ms Evelyn Swee Lian Chan who is a Senior In-House Lawyer for Partners, states that the mark has been used in the UK since 1982 in relation to advertising, marketing, promotion and related services. At Annex 3 she exhibits articles from various trade and national newspapers and magazines showing use of the mark and which are dated between 9 February 2010 and 12 December 2012.

39. In his evidence, Charles Richard Cooper Rudd who is Partners' Managing Director, states that over the last ten years (his witness statement is dated 25

January 2013) the services provided under the mark have been expanded to cover new media including e.g. digital formats, the Internet, mobile phone applications, social media and viral email.

40. No evidence has been provided which gives specific details of the size of the market for the goods and services of the earlier mark or Partners' place within it. Ms Chan has exhibited a list of awards won by Partners but the list refers to awards won in 2012 with the overwhelming majority of them dating from after the relevant date in these proceedings and so this evidence does not assist it. Publications accepts that Partners has a reputation as an advertising agency (Ms Dykes' witness statement of 29 July 2013) but the specification covered by its earlier mark 2465221 goes much wider than this. I am not satisfied on the evidence provided that Partners mark has accrued an enhanced distinctive character in relation to the wider specification. The letters making up the mark have no meaning in relation to the goods and services for which it is registered and it is a mark with an average degree of inherent distinctive character.

Likelihood of confusion

41. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I also have to factor in the distinctive character of the earlier marks as the more distinctive they are the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she has retained in mind.

42. Earlier in this decision I noted that Publications accept that Partners has a reputation as an advertising agency. I found that the earlier trade marks have an average degree of inherent distinctive character, that the respective goods and services are either identical or at least highly similar and that there is a reasonable level of both visual and aural similarity between the respective marks. I found the conceptual position to be neutral. As far as the respective goods are concerned, I found that the average consumer would be a member of the general public who would purchase the goods often on impulse and with little consideration being given to the purchase whereas for the services it would most likely be a business user who took some but not necessarily the highest degree of care over the purchase. In respect of Publications' mark 2609774, taking all matters into account and bearing in mind the commonality of the letters BH in each mark, with the initial letter B being duplicated in Partners mark, leads me to find there is a likelihood of direct confusion between the respective marks. As to Publications' Mark 2609433, the addition of the word EXCLUSIVE, which, as I found above, is descriptive and has a very limited capacity to distinguish, is not sufficient for me to reach any alternative finding. There is also a likelihood of direct confusion between these respective marks.

Fall-back position

43. Publications has proposed an amended specification as a fall-back position. The proposed amendment would see the deletion of those terms shown in bold below:

Class 16

Graphic designs; printed matter, in particular printed matter relating to luxury life style publications; printed matter relating to franchises.

Class 35

Advertising, in particular advertising relating to luxury life style publications; **marketing**; business assistance relating to the establishment of franchises; provision of assistance in the operation of franchises; all relating to the aforesaid services.

44. I do not consider the proposed amendment alters the above findings. This is because the proposed specification consists only of a deletion of certain terms but would still leave specific goods and services which are included within, and therefore identical to, the more general goods and services within Partners' specification.

45. The opposition brought under section 5(2)(b) succeeds in full.

The objections under section 5(3) and 5(4)

46. These objections are brought in respect of the invalidation proceedings against Publications' registered trade mark 2609774 only. In view of my findings above, I do not consider it necessary or proportionate to consider these grounds further.

Summary

47. Both the opposition to application no 2609433 and the invalidation against 2609774 succeed.

Costs

48. Partners having succeeded, it is entitled to an award of costs in its favour. I take note that this decision involved two, consolidated, actions, that evidence was filed by both parties, that during the course of proceedings two case management conferences took place (both short and relatively uncomplicated) and that Publications did not attend the substantive hearing but filed written submissions in lieu of attendance.

49. Taking all matters into account, I make the award on the following basis:

For filing a statement and reviewing the other side's statement:	£300
Fees x 2:	£400

Preparing and reviewing evidence:	£500
Preparation for and attending CMCs and substantive hearing:	£500
Total:	£1700

50. I order Bh Publications Limited to pay BBH Partners LLP the sum of £1700 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of May 2014

Ann Corbett
For the Registrar
The Comptroller-General