

O-342-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3049690
BY WOODLAND ESTATE AGENTS LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 36:**




AND

**OPPOSITION THERETO (NO. 402261) BY
WOODLAND INVESTMENT MANAGEMENT LIMITED**

Background and pleadings

1. The above trade mark was filed by Woodland Estate Agents Ltd (“the applicant”) on 2 April 2014. It was published for opposition purposes on 2 May 2014. Registration of the mark is opposed by Woodland Investment Management Limited (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on UK registration 3025831, which was filed on 11 October 2013 and registered on 21 March 2014. In view of all this, this case boils down to an alleged conflict between the following marks and services:

Applied for mark	Earlier mark
 Class 36: Sales of residential properties; Lettings of residential properties; Property management.	WOODLANDS Class 36: Real estate affairs

2. Given its date of filing, the opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act. The earlier mark had not been registered for more than five years at the date on which the applicant’s mark was published meaning that the proof of use provisions contained in section 6A do not apply. The earlier mark may, consequently, be taken into account in these proceedings for its specification as registered.

3. The applicant filed a counterstatement denying the ground of opposition. It highlights the differences that exist between the marks, including the singular (without an S) nature of its mark. It states that the opponent’s name (Woodland Investment Management Limited) does not “clearly highlight” that it deals with real estate. The applicant states that it simply wishes to register a different logo (compared to the applicant’s mark), a logo it has been using since 2005.

4. Both sides are self represented. However, as will be seen below, the opponent has received advice from a solicitor. Both sides filed evidence, albeit a large amount of submission was included as opposed to evidence of fact. Neither side requested a hearing or filed written submission in lieu of attendance.

The evidence

5. The opponent’s evidence comes from Mr Daniel Davies, a solicitor at the firm Elevation Legal. Mr Davies states that Elevation Legal is advising the opponent in this matter, although I note that it has not been appointed as a representative. Mr Davies makes a number of submissions including that Woodland is the dominant part of the applied for mark. He refers to another sign used by the opponent which consists of the domain name woodlands.co.uk within a lozenge shaped logo. Mr

Davies states that the opponent has used the colour red in its signage for many years, since at least the early to mid 1990s.

6. In relation to the opponent's business, he states that the opponent changed its name to its current name in 1989. It registered a domain name (woodlands.co.uk) in 1996, has an annual turnover of around £5 million and "sells around 150 woodlands a year with around 1500 woodland and other property sold to date". These sales are said to include meadows and pastures as well as woodland. The opponent has attended trade shows, including one in the South East of England. The opponent has a website and a Facebook page. It has around 200 signs on public roads. Mr Davies has himself seen some of them. He provides a photograph of one example which depicts a sign near some woodland which reads "WOODLAND FOR SALE" below which is the lozenge logo described above. Some of the woodland it sells contains buildings, he gives an example of woodland sold in Tolleshunt (Essex) which contains a hut. A picture is provided of this hut. It is little more than a large shed. Mr Davies states that the opponent has previously (and presently) sold in Essex which is where the applicant is most likely to sell (the applicant's address is in Ilford, Essex). He believes that the use of the parties' signage will cause confusion. Mr Davies provides printouts from the opponent's website and Facebook page. The lozenge logo is used. It should be noted that much of Mr Davies' evidence is hearsay as he was informed of the facts by someone else. Nevertheless, I have no reason to doubt the primary facts he gives, so I will still give his evidence some weight.

7. The applicant's evidence comes from its director, Mr Vicash Chott. Mr Chott makes a number of submissions about the marks used by the respective parties and the differences that exist between the signage used (for the opponent's signage he provides a picture of the one containing the lozenge logo). Mr Chott makes a number of submissions regarding the trade of the respective parties. In essence, the submission is that the fields of interest are different, the applicant offering the sale (and letting) of residential property, the opponent selling woodland. He highlights that the hut depicted in the opponent's evidence is not a residential dwelling.

Section 5(2)(b)

8. Section 5(2)(b) of the Act states that:

"5.-(2) A trade mark shall not be registered if because – ..

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

9. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson*

Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

10. 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.”

11. 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.”

12. 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. 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

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

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."

13. Even if the services are not worded identically, they can still be considered identical if one term falls within the ambit of another (or vice versa), as per the judgment in *Gérard Meric v OHIM*, Case T-133/05.

14. The main point argued by the applicant is that the respective parties operate in different fields, the applicant selling (and letting) residential property, the opponent selling woodland. However, and as difficult as this may be for the applicant to accept, this has no bearing on the assessment to be made. The opponent's mark is registered for "real estate affairs". It is not limited to real estate affairs connected with the sale of woodland. The opponent's mark is not subject to the proof of use requirement so the fact that the opponent may only use its mark in connection with the sale of woodland does not mean that I should apply some form of *de facto* limitation to its specification. It would be wholly inappropriate to do so. The opponent's mark must be taken into account for its specification as registered.

15. I must nevertheless determine what the term "real estate affairs" covers. In my view, it is a reasonably broad term that would encompass a range of services including the sale of various property assets including both residential property and rural land. It would also, in my view, include property management. Given this, it is clear to me that all of the services applied for by the applicant (sale of residential properties; Lettings of residential properties; Property management) are all types of real estate affairs. Therefore, all of the applied for terms fall within the ambit of the opponent's specification, and, in accordance with the principles in *Gerard Meric*, the services must be considered as identical.

Average consumer and the purchasing act

16. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

17. The average consumer (of the identical services) will be a member of the public wishing to buy (or sell) residential property, to let (or offer to let) residential property, or for someone wishing to avail themselves of property management services to look after their properties. Such services could also be used by those in the trade who have, for example, a portfolio of property. Clearly, more attention will be focused upon the property itself if one is interested in buying as opposed to the business that is selling it on behalf of the owner. Nevertheless, at least a reasonable degree of care and attention will be paid when selecting the service provider to sell (or let) a property or to buy (or let) from. In fact, given issues to do with trust, reliability, security etc, the selection process may be slightly more considered than the norm, albeit not of the very highest level.

18. The service provider’s mark will be encountered on signage (both at the premises of the service provider and on for sale boards), on website pages and on property listing advertisements. This all suggests a selection process than focuses more on the visual impact of the competing trade marks. However, I will not ignore the aural impacts completely as discussions will often taken place over the telephone and, also, word of mouth recommendations may play a role.

Comparison of marks

19. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

20. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. In its submissions the applicant makes a comparison between its mark and the lozenge logo used by the opponent. This is not the correct comparison as the opponent’s earlier mark is just for the word WOODLANDS. The marks to be compared are:



v WOODLANDS

21. The word WOODLANDS is the only component of the earlier mark, so that comprises its overall impression. There are two distinct components in the applied for mark, the word Woodland and the device of half a tree. Given the role the word plays in the mark (its central prominence), this is the element that has greatest relative weight in its overall impression. The device, though, still plays an important role so will not be ignored from the assessment. I accept that there are other elements in the mark. One element is the red background, however, this is just a background colour so its relative weight is limited. In any event, the colour is not something which should be taken to create a difference with the earlier mark because the earlier mark could, potentially, be used on a red background itself³. There are other elements of get-up such as the partial oval surrounding the half tree, but the relative weight of this is much more limited.

22. Aurally, the marks will be articulated as Wood-land/WOOD-LANDS. The only difference is the S sound at the end of the earlier mark. The marks have a very high degree of aural similarity.

23. Conceptually, both marks' concepts are based upon a woodland or woodlands, (land covered with trees). The marks are conceptually identical.

24. Visually, there are some differences as highlighted by the applicant. The most notable is the addition of a device of half a tree. The get-up creates a further difference, as does the additional S, but given the roles that these aspects play in the overall impression, such differences are not overly significant in terms of assessing the visual similarity between the marks. The main point of similarity is the sharing of the words Woodland/WOODLAND[S]. That there is a difference in casing is another point that does not matter because the opponent's mark could also, potentially, be used in upper and lower case. I consider there to be a reasonably high (but not the highest) level of visual similarity between the marks bearing in mind my assessment of their overall impressions.

Distinctive character of the earlier marks

25. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

³ I place no weight on the opponent's claim that red is something associated with it, there is not enough evidence to support such a finding.

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

26. The opponent has filed some evidence of use, however, I am far from satisfied that the use has materially enhanced the earlier mark’s inherent distinctive character. Its number of sales does not seem that high and I have no idea what slice of the relevant market such sales represent.

27. In terms of the inherent characteristics of the mark, it would not have been open to me to find that the earlier mark lacks distinctive character completely. Whilst there are mixed national authorities on the point⁴, the judgment of the CJEU in *Formula One Licensing BV v OHIM* indicates that a registered trade mark must be considered to have at least a minimum degree of distinctive character. Nevertheless, in relation to services which include the sale of land covered with trees, the earlier mark must be possessed of an extremely low degree of inherent distinctive character. However, and as highlighted already, the services of the opponent also include sales (and letting) of residential property akin to those of the applicant. Distinctiveness can vary depending on the goods and services involved. In relation to the sale (and letting) of residential property (and related property management services) there is no direct link between the word WOODLANDS and such services. I consider the mark to be possessed of an average level of inherent distinctive character in relation to such services.

Likelihood of confusion

28. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific

⁴ Compare *Wella Corporation v Alberto-Culver Company* [2011] EWHC 3558 with *Samuel Smith Old Brewery v Philip Lee* [2011] EWHC 1879 at paragraph 82

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.

29. That there is identity between the services is an important point because a lesser degree of similarity between the marks may be offset by a greater degree of similarity (in this case identity) between the services. In any event, these marks are visually similar to a reasonably high degree, aurally similar to a very high degree, and conceptually identical.

30. The concept of imperfect recollection must also be borne in mind. Consumers rarely have the chance to see the competing marks side-by-side and must, instead, rely on the imperfect picture of them kept in mind. Even taking into account the higher than average level of care and attention, I must bear in mind that the conceptual hook of both marks is based upon the word Woodland/WOODLANDS. The additional S is something which could easily be forgotten through the effects of imperfect recollection. Given that this word has the greatest relative weight in the overall impression of the applied for mark, the exact get-up may also be lost through imperfect recollection so meaning that the marks could be confused directly for one another. **There is a likelihood of confusion having regard to all these factors.** Even if I am wrong on this, there is another aspect that must be considered. Confusion does not need to be direct, but can, instead, be indirect. This was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

31. Of course, I bear in mind that the three categories of indirect confusion identified by Mr Purvis QC are just illustrative – he stated that indirect confusion “tends” to fall in one of them. I come to the view that even if the average consumer recalled that one mark had a half tree device and the other did not, the similarities I have assessed will nevertheless lead to the average consumer believing that the identical services in play are the responsibility of the same or an economically linked undertaking. **Therefore, even if there is not direct confusion, there is a likelihood of indirect confusion. The opposition succeeds.**

Costs

32. The opponent has succeeded and is entitled to a contribution towards its costs. My assessment is as follows:

Official fee - £100

Preparing a statement and considering the other side’s statement - £150

Filing and considering evidence – £200

33. There are a number of points I need to make in relation to the above assessment:

- i) The official fee actually paid by the opponent was £200. However, it only needed to pay £100. The applicant should not have to make up for the opponent overpaying. If the opponent wishes to request a refund from the IPO for this overpayment then it is entitled to do so.
- ii) In relation to costs generally, I have taken into account that the opponent was not formally represented so would not have incurred legal expenses, albeit I note that it has received some advice (but how much is not clear) from a firm of solicitors (indeed, the solicitor filed evidence on behalf of the opponent). I have balanced these factors in accordance with what I consider to be an appropriate award to make.
- iii) Although the evidence filed included some submissions, the evidence of fact it contained had little bearing on the outcome. This is why the award is of a fairly limited amount.

34. I therefore order Woodland Estate Agents Limited to pay Woodland Investment Management Limited the sum of £450. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of July 2015

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