

O-142-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3054968
BY KERRY-ANN LOUTH**

TO REGISTER:



AS A TRADE MARK IN CLASSES 16, 35, 37 & 45

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 403230 BY INTUIT INC.**

BACKGROUND

1. On 9 May 2014, Ms Kerry-Ann Louth (“the applicant”) applied to register the trade mark shown on the cover page of this decision for a range of goods and services in classes 16, 35, 37 and 45. The application was published for opposition purposes on 15 August 2014.

2. The application is opposed by Intuit Inc. (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed only against the following services in class 35 of the application:

Book-keeping and accountancy services; accountancy tax advice; payroll advisory services; payroll accountancy services; preparation of tax returns.

The opponent relies upon the services (shown below) in the following national and Community Trade Marks (“CTM”).

No: 3035455 for the trade mark: **MINT** which was applied for on 18 December 2013 and which is currently shown as status “Opposed”.

Class 35 – Business management; business administration; office functions; accounting; book-keeping; administrative accounting; business management advice and assistance; company and business information.

CTM no: 13005831 for the trade mark: **MINT** which was applied for on 17 June 2014 and which claims an International Convention priority date of 18 December 2013 from the United Kingdom and which is also currently shown as status “Opposed”.

Class 35 - Business management; business administration; office functions; accounting; book-keeping; administrative accounting; business management advice and assistance; company and business information and administrative assistance.

3. In its Notice of opposition, the opponent states that the competing services are identical or similar. In relation to the trade marks at issue, the opponent states:

“The opponent’s earlier applications both relate to the word mark MINT. The applicant’s mark is a complex figurative mark comprising the word MINT in combination with the words “strong roots to support rapid and fruitful growth” and a plant/tree device. MINT forms the dominant and most distinctive element of the mark. The relevant public are likely to regard the other verbal element as a motto or strapline, and the graphical element as representing “mint”. The verbal element “MINT” plays the most important role in identifying the source of the products or services. The respective marks are therefore similar overall. MINT has no meaning in respect of the relevant services, and is distinctive.”

4. The applicant filed a counterstatement in which she stated:

“The allegations made in the Opposition are denied.”

This is the only comment made by the applicant in these proceedings.

5. Neither party filed evidence. Whilst neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing. I will bear these submissions in mind and refer to them, as necessary, below.

DECISION

6. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“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.”

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,

(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. In these proceedings, the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which are at the application stage and both of which are currently under opposition. However, as both trade marks have filing/priority dates which are earlier than that of the application for registration, they would, if they achieve registration, become earlier trade marks under the above provisions. As any registration will take place after the date on which the application was published, it follows that the proof of use provisions contained in section 6A of the Act are not relevant. Although I

shall proceed on the basis that the opponent is entitled to rely upon all of the services it has identified, I will need to return to this point later in my decision.

Section 5(2)(b) – case law

9. The following principles are gleaned from the decisions 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.

The principles:

- (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 greater 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. The competing services are as follows:

Opponent's services	Applicant's services
No: 3035455 Class 35 – Business management; business administration; office functions; accounting; book-keeping; administrative accounting; business management advice and assistance; company and business information. CTM no: 13005831 Class 35 - Business management; business administration; office functions; accounting; book-keeping; administrative accounting; business management advice and assistance; company and business information and administrative assistance.	Class 35 - Book-keeping and accountancy services; accountancy tax advice; payroll advisory services; payroll accountancy services; preparation of tax returns.

11. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

12. “Book-keeping and accountancy services” in the application are identical to “accounting” and “book-keeping” in the earlier applications. As the remaining services in the application i.e. “accountancy tax advice; payroll advisory services; payroll accountancy services; preparation of tax returns” would all, in my view, be encompassed by, at least, the term “accountancy” in the earlier applications, these services are identical on the principles outlined in *Meric*.

The average consumer and the nature of the purchasing act

13. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services; I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. 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.”

14. In its submissions, the opponent states:

“2.25...The relevant public in respect of both the applicant’s services and the opponent’s services as identified will be businesses seeking accountancy and other business support services and, in some cases, will be private individuals.”

15. I agree with the opponent’s conclusions in this regard. As to how such services will be selected, I note that in its submissions, the opponent states:

“2.8...since aural referral is likely to be a key means of acquiring the services.”

16. Whilst I accept that aural recommendations from, for example, one business user to another are likely to form part of the selection process, in the absence of evidence to assist me, I am not in a position to conclude, as the opponent suggests, that the aural component will be “a key means of acquiring the services”. Equally likely, in my view, is that those requiring the services at issue will be exposed to the trade marks in, for example, promotional material, trade publications etc. available in both hard copy and on-line, indicating that visual considerations will also play an important part in the selection process. In short, I intend to proceed on the basis that the selection process is likely to consist of a mixture of visual and aural considerations. As to the degree of care the average consumer will display during the selection process, given the nature of the


services at issue and their obvious importance to, for example, the efficient running of an undertaking or the financial wellbeing of an individual, I would expect at least an above average degree of attention to be deployed during their selection.

Comparison of trade marks

17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

18. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks. The trade marks to be compared are as follows:

Opponent’s trade marks	Applicant’s trade mark
MINT	

19. As the opponent’s trade marks consist exclusively of the well-known English language word MINT presented in upper case that is where their distinctiveness lies and is the overall impression they will convey.

20. The applicant’s trade mark consist of a number of elements. The black rectangle and the circular device in which the other elements appear are banal and have no distinctive character. As to the other elements, the opponent suggests that the words which appear at the top and bottom of the trade mark would be construed as a single

phrase i.e. “STRONG ROOTS TO SUPPORT RAPID & FRUITFUL GROWTH”. It states that this phrase is “laudatory and promotional in character” and that:

“2.4...The relevant public are likely to regard these words as describing the positive impact the services offered may have on the business using them.”

21. I agree that if the words are construed in the manner the opponent suggests, the words would be regarded in the manner it indicates. However, much more likely, in my view, is that the words “RAPID & FRUITFUL GROWTH” and “STRONG ROOTS TO SUPPORT” would be read in that order and construed as separate and distinct phrases. Regardless, and notwithstanding that the words “RAPID & FRUITFUL GROWTH” appear at the top of the trade mark, both phrases are still likely, in my view, to be regarded as promotional in nature and will, as a consequence, have a very low relative weight in the overall impression the applicant’s trade mark conveys. The remaining elements are the letter “MI” and “NT” presented in upper case either side of the stem of a device of what the opponent submits the relevant public:

“2.4...are likely to regard as...representing the plant “mint”.

22. Despite the device being much larger than the letters and despite the letters being separated by the stem of the device, I agree with the opponent that the letters will be understood as the word MINT with the device element most likely being construed as a representation of the plant of the same name. Given their size and positioning it is, in my view, these two distinctive elements that will dominate the overall impression the trade mark conveys

23. Turning to the visual, aural and conceptual comparisons, although the applicant’s trade mark contains a number of elements, as the word MINT and the device (which I have already concluded will likely be construed as a representation of the mint plant) dominate the overall impression it conveys, there is, in my view, at least a medium degree of visual similarity between the applicant’s trade mark and the opponent’s trade marks which consist of the word MINT alone.

24. In relation to aural similarity, the opponent states:

“2.7 When people refer to the applicant’s mark they will pronounce the word MINT, and will not attempt to put the graphical element into verbal elements or pronounce the other words.

2.8 The verbal element MINT plays the most important role in identifying the source of the respective services...”

25. It is well established that when a trade mark consists of a combination of words and figurative elements, it is by the word elements that the trade mark is most likely to be referred. Although the applicant’s trade mark contains the additional phrases mentioned above, given the size and positioning of the element that will be construed as the word

MINT in relation to these phrases, it is by the element MINT that the applicant's trade mark will be referred; the competing trade marks are, as a consequence, aurally identical.

26. In relation to conceptual similarity, the opponent states:

"2.9 The dominant element of the applicant's mark is MINT. To this extent the marks are conceptually identical.

2.10 The concept evolved (sic) by the other wording in the applicant's mark is secondary, and may not be picked up at all by the relevant consumer. To the extent that the other wording is picked up by the relevant consumer, it conveys a concept that is supportive of MINT, and it does not contradict or override the concept of MINT."

27. I agree that the presence of an element in the applicant's trade mark which will be construed as the word MINT will send an identical conceptual message to the opponent's trade marks. I also agree that the presence of a device which I have concluded will most likely be construed as a mint plant and the distinct phrases which include references to "GROWTH" and "ROOTS" are, as the opponent suggests, "supportive of MINT."

Distinctive character of the earlier trade marks

28. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought 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 trade 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 trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As no evidence has been filed in these proceedings, I have only the inherent characteristics of the earlier trade marks to consider. In its submission, the opponent states:

"2.12 MINT has no meaning in respect of the relevant services, and is distinctive."

29. Although a well-known word with a number of well-known meanings, the word MINT is neither descriptive of, nor non-distinctive for, the services at issue. Absent use, the opponent's trade marks are, in my view, possessed of an average degree of inherent distinctive character.

Likelihood of confusion

30. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade marks as the more distinctive these trade marks are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the 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 upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the competing services are identical;
- the average consumer is either a business user or a member of the general public;
- the services at issue will be selected by a mixture of visual and aural means with at least an above average degree of attention being paid during the selection process;
- the overall impression of the opponent's trade marks stems from the word itself, whereas the overall impression of the applicant's trade mark will be dominated by an element which will be construed as the word MINT and a device which is likely to be construed as a mint plant;
- the competing trade marks are visually similar to at least a medium degree and aurally and conceptually identical;
- the opponent's MINT trade marks are possessed of an average degree of inherent distinctive character.

31. If, as the opponent suggests, "aural referral is likely to be a key means of acquiring the services", then having concluded that the competing services are identical and the competing trade marks are aurally identical, direct confusion i.e. where one trade mark is mistaken for the other, is inevitable. I have also found, however, that visual considerations are likely to play their part in the selection process. When considered from a visual perspective, the visual differences between the competing trade marks, are sufficient, in my view, to militate against direct confusion. However, notwithstanding the at least above average degree of attention that will be paid during the selection process (which will make the average consumer less prone to the effects of imperfect recollection), the fact that the overall impression of the applicant's trade mark will be dominated by what I have concluded will be construed as the word MINT and the device of a mint plant results in a likelihood of indirect confusion i.e. where the average

consumer notices the differences in the competing trade marks but assumes that the identical services at issue come from undertakings which are economically linked. Consequently, whether direct or indirect, there is a likelihood of confusion between the respective trade marks.

Conclusion

32. Whilst the opponent has been wholly successful in relation to the only services it opposed i.e. those in class 35, my decision is a provisional one. I cannot give a final decision to refuse registration of the application in relation to those services until such time as one or other of the opponent's MINT trade marks has achieved registration for the services being relied upon in these proceedings. In the meantime, the application insofar as it covers goods and services in classes 16, 37 and 45 which have not been opposed may proceed to registration. In order for this to be done, the applicant would have to file a request to divide the application accordingly.

Next steps

33. I direct the opponent to advise me within one month of the date on which its earlier applications are finally determined. Registration of one of the earlier applications for the services being relied upon will, of course, suffice for the opposition to succeed. On receipt of this information, I will issue a supplementary decision giving a full determination of the opposition proceedings and informing the parties of my decision in respect of an award of costs. Finally, as mentioned above, if a request for division is made, the application may proceed to registration in relation to the goods and services in classes 16, 37 and 45.

Dated this 16th day of March 2016

C J BOWEN
For the Registrar
The Comptroller-General