

O-125-19

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3253561
BY ASIA STANDARD MANAGEMENT SERVICES LIMITED
TO REGISTER THE SERIES OF TWO TRADE MARKS**

The logo consists of a stylized 'AS' monogram in red, followed by the words 'ASIA STANDARD' in a black, serif, all-caps font.

The logo consists of a stylized 'AS' monogram in black, followed by the words 'ASIA STANDARD' in a black, serif, all-caps font.

IN CLASSES 16, 35, 36, 39, 41 & 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 411006 BY
STANDARD INTERNATIONAL MANAGEMENT LLC**

BACKGROUND

1) On 30 August 2017, Asia Standard Management Services Ltd (hereinafter the applicant) applied to register the series of two trade marks shown on the front page in respect of the following goods and services:

In Class 16: Cards; Business Cards; Envelopes [stationery]; Letterheads; Forms, printed; Greeting cards; Magazines [periodicals]; Newsletters; Newspapers; Note books; Pictures; Postcards; Printed matter; Printed publications; Stationery.

In Class 35: Business management of hotels.

In Class 36: Accommodation bureau [apartments]; Apartment house management; Leasing of real estate; Real estate management; Rental of offices [real estate]; Renting of apartments; Renting of flats.

In Class 39: Arranging of tours; Booking of seats for travel; Car parking; Sightseeing [tourism]; Transport reservation; Travel reservation.

In Class 41: Amusements; Arranging and conducting of concerts; Booking of seats for shows; Conducting of concerts (arranging and); Club services [entertainment or education]; Entertainer services; Entertainment; Health club services [health and fitness training]; Night clubs; Organization of sports competitions; Party planning [entertainment]; Presentation of live performances; Production of shows; Providing casino facilities [gambling].

In Class 43: Accommodation bureau [hotels, boarding houses]; Bar services; Cafés; Cafeterias; Canteens; Food and drink catering; Hotel reservations; Hotels; Motels; Rental of meeting rooms; Rental of temporary accommodation; Restaurants; Self-service restaurants; Snack-bars; Tourist homes.

2) The application was examined and accepted, and subsequently published for opposition purposes on 15 September 2017 in Trade Marks Journal No.2017/037.

3) On 8 December 2017 Standard International Management LLC (hereinafter the opponent) filed a notice of opposition, subsequently amended. A further amendment was also made just prior to the

hearing in the opponent's skeleton arguments. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
THE STANDARD	3049342	31.03.14 18.07.14	38	Providing computer/online Internet access facilities.
			39	Parking valet services.
			41	Entertainment; entertainment services provided by hotels; entertainment services provided in hotels, restaurants and nightclubs; nightclub services; providing meeting/convention room facilities for educational conventions.
			43	Services for providing food and drink; temporary accommodation; restaurant services; bar, café, cocktail lounge services; providing banquet and social function facilities for special occasions; catering services; hotels; hotel services; providing meeting/convention room facilities for other types of convention.
			44	Barber shop services/beauty salon services; spa services.
The Standard	EU 10749729	09.03.12 07.01.13	35	Retail sales services of goods in retail stores and through and interactive on-line website, namely in connection with cosmetics, soaps, perfumery, essential oils, hair and body lotions, candles, magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, cameras, cases and holsters for laptops, i-pads and mobile phones made from different materials, glasses and sunglasses, headphones,

				<p>jewellery, precious stones, horological and chronometric instruments, paper and cardboard goods, printed matter, photographs, posters, stationery, artists' materials, plastic materials for packaging, leather and imitations of leather, goods made of leather and imitations of leather, trunks and travelling bags and accessories for trunks and travelling bags, umbrellas parasols, walking sticks, pillows, houseware, glassware, porcelain, earthenware, textiles and textile goods, bed covers, bed linens, blankets, table covers, travel sets (textile goods made from alpaca wool), travelling sets, clothing, footwear, headgear, snow globes, toys, toys for adults, games and playthings, gymnastic and sporting articles, works of art, baskets, silkscreen prints, candleholders, bookends, paperweights, ceramic wall art, canvas flags, pictures, paintings (framed or unframed), flower-stands, flower-pot pedestals, vases, artificial flowers, artificial fruit, artificial garlands, porcelain articles for decoration purposes, glass articles for decoration purposes, articles of wood, cork, reed, cane, wicker, horn, bone, ivory, shell, amber, mother-of-pearl for decoration purposes.</p>
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a) The opponent contends that its mark 3049342 and the mark applied for are very similar and that some of the goods and services applied for are identical and/or similar to the goods for which the earlier mark is registered. The goods and services which it regards as being identical/similar are: All of the services applied for in class 35, 36, 39, 41 (other than "Organization of sports competitions") and 43. As such the mark in suit offends against Section 5(2)(b) of the Act. The opponent also contends that its mark EU 10749729 is similar to the

mark in suit and that the goods in class 16 (except for “letterheads; forms, printed; notebooks”) in the application are similar to the class 35 services for which its mark is registered. As such the mark in suit offends against Section 5(2)(b) of the Act.

4) On 13 February 2018 the applicant filed a counterstatement basically denying that the marks and goods and services are similar, and it denies that there is a likelihood of confusion. It puts the opponent to strict proof of use of its marks.

5) Both parties filed evidence, and both also seek an award of costs in their favour. The matter came to be heard on 29 January 2019 when Mr Hall of Counsel instructed by Messrs Boulton Wade Tennant LLP represented the opponent; the applicant was represented by Mr Harbottle of Counsel instructed by Messrs Joshi Worldwide IP Limited

OPPONENT’S EVIDENCE & EVIDENCE IN REPLY

6) The opponent filed two witness statements, dated 8 May 2018 and 28 September 2018, by Amar Lalvani the CEO of the opponent. He states that his company offers accommodation services via its hotels. In addition, the hotels also provide services such as restaurants, nightclubs, entertainment, food, drinks, meeting and event facilities, spa facilities and on-line booking services. All this is done under the name “The Standard”. All of the hotels operated by the opponent are in the USA but it contends it has a large number of clients from the UK. As the only ground of opposition is under section 5(2)(b) I shall therefore look for evidence of reputation in the UK in the opponent’s evidence which might aid the distinctiveness of its marks. At exhibit 1 he provides a copy of a decision issued by the IPO in an earlier dispute between the two parties in the instant case. Mr Lalvani states that much of the evidence he files in the instant case is identical to that filed in the earlier decision (albeit renumbered) although he does include some additional material which is clearly identified. I note that the original decision was not challenged by the applicant and they have had an opportunity to comment on the evidence and any relevant comments they make will be taken into account in reaching my decision.

APPLICANT’S EVIDENCE

7) The applicant filed two witness statements. The first is by Lun Pi Kan, the second by Woo Wei Chun Joseph both of whom are directors of the applicant, Both statements are dated 27 July 2018.

For the most part this is a critique of the evidence of the opponent, in particular aspects of the opponent's evidence which I did not find to assist my decision. I have, therefore, not set these comments out in a summary. I shall take the evidence into account as and when relevant in my decision.

DECISION

8) The first ground of opposition is under section 5(2)(b) which reads:

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

(a)

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

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

9) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

10) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. Neither fall foul of the proof of use requirements; the mark in suit was published on 15 September 2017 and the opponent's marks were registered less than five years prior to this date on 18 July 2014 and 7 January 2013 respectively. As the proof of use grounds do not apply the opponent can rely upon both marks and the full specification for which they are registered.

11) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

(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.

The average consumer and the nature of the purchasing decision

12) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods 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.”

13) There are a wide range of goods and services sought to be registered. Some goods and services such as greetings cards, renting of flats, car parking and health club services will be aimed at the general public as the average consumer. Others such as business cards, business management of

hotels and rental of offices will have businesses as the average consumer. Whilst other goods and services (stationery, real estate management and booking of seats for shows) will have average consumers consisting of a mixture of the general public and businesses. The level of attention paid by the average consumer will vary enormously; a post card or a piece of stationery will not require or involve a great deal of thought, whereas having a company managing your hotel is something which will be given a great deal of time and consideration. When I consider the likelihood of confusion I will deal with the different levels of attention I believe will be given to choice of the various goods and services. In the case of all the goods and services sought to be registered visual considerations are likely to be the most important part of the selection process as most will be selected from advertising (magazine, on-line etc), from a view point on a street or from a shelf. However, given the likelihood of personal recommendations for services such as restaurants etc I must take into account aural considerations.

Comparison of goods

14) The goods and services of the two parties to be compared are exactly the same as those that formed the comparison in the earlier decision involving both parties (O-375-17). In comments attached to its revised TM8, dated 29 June 2018 the applicant stated:

“5. However, the applicant does not seek in this opposition to challenge the factual findings in the 2017 decision concerning enhanced distinctiveness and similarity/identity or otherwise of goods and services to the extent (which is explained further below) that those findings are material to this opposition.”

And:

“The applicant admits that as at 21 January 2016, the opponent’s goods and services were similar to or as the case may be identical with those covered by the applicant’s mark to the extent found in paragraphs 16 to 36 of the 2017 decision and that it is to be inferred that the same applies as at 30 August 2017.”

15) As such I can simply adopt the findings of the Hearing Officer in the earlier decision, which are shown in column three alongside the goods and services to be compared:

Applicant's specification	Opponent's relevant specification	Similarity etc.
In Class 16: Cards; Envelopes [stationery]; Greeting cards; Magazines [periodicals]; Newsletters; Newspapers; Pictures; Postcards; Printed matter; Printed publications; Stationery.	10749729: In Class 35: Retail sales services of goods in retail stores and through and interactive on-line website, namely in connection with paper and cardboard goods, printed matter, photographs, posters, stationery.	Similar to a reasonable degree
In Class 35: Business management of hotels.	3049342: In Class 43: hotel services;	Similar to a moderate degree.
In Class 36: Accommodation bureau [apartments]; Apartment house management; Leasing of real estate; Real estate management; Rental of offices [real estate]; Renting of apartments; Renting of flats.	3049342: In Class 43: temporary accommodation; hotels; hotel services;	Similar to a low degree.
In Class 39: Car parking.	3049342: In Class 39: Parking valet services.	Identical
In Class 39: Arranging of tours; Booking of seats for travel; Sightseeing [tourism]; Transport reservation; Travel reservation.	3049342: In Class 43: hotel services;	Similar to a reasonable degree
In Class 41: Amusements; Entertainer services; Entertainment; Presentation of live performances; Night clubs; Club services [entertainment]; Club services [education];	3049342: In Class 41: Entertainment; nightclub services; nightclub services; providing meeting/convention room facilities for educational conventions.	Identical

In Class 41: Providing casino facilities [gambling].	3049342: In Class 41: entertainment services provided by hotels; entertainment services provided in hotels, restaurants and nightclubs;	Similar
In Class 41: Health club services [health and fitness training];	3049342: In Class 43: hotel services; In Class 44: spa services.	Reasonable degree of similarity
In Class 41: Arranging and conducting of concerts; Booking of seats for shows; Conducting of concerts (arranging and); Party planning [entertainment]; Production of shows;	3049342: In Class 41: Entertainment; entertainment services	Reasonable degree of similarity
In Class 43: Accommodation bureau [hotels, boarding houses]; Bar services; Cafés; Cafeterias; Canteens; Food and drink catering; Hotel reservations; Hotels; Motels; Rental of meeting rooms; Rental of temporary accommodation; Restaurants; Self-service restaurants; Snack-bars; Tourist homes.	3049342: In Class 43: Services for providing food and drink; temporary accommodation; restaurant services; bar, café, cocktail lounge services; providing banquet and social function facilities for special occasions; catering services; hotels; hotel services; providing meeting/convention room facilities for other types of convention.	Identical

Distinctive character of the earlier trade mark

16) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“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).”

17) In comments attached to its revised TM8, dated 29 June 2018 the applicant stated:

“5. However, the applicant does not seek in this opposition to challenge the factual findings in the 2017 decision concerning enhanced distinctiveness and similarity/identity or otherwise of goods and services to the extent (which is explained further below) that those findings are material to this opposition.”

And:

“6. **Inherent distinctiveness.** The applicant contends that UK trade mark No. 3049342 has no or no significant inherent distinctiveness while EU Trade Mark No. 20749729 has slight inherent distinctiveness.

7. **Acquired distinctiveness.** The applicant admits that as at 21 January 2016 the opponent’s marks had enhanced distinctiveness to the extent found in paragraphs 51 and 53 (final bullet point) of the 2017 decision. The applicant will contend that so far as UK trade mark No. 3049342 is concerned, any enhanced distinctiveness found in the 2017 decision is limited to hotels and

hotel services. So far as EU Trade Mark No. 20749729 is concerned the applicant denies that any enhanced distinctiveness found in the 2017 decision is relevant to any of the goods or services which are relevant to this opposition. Save to that extent, the applicant puts the opponent to strict proof of its assertions that its marks had enhanced distinctiveness as at 30 August 2017.”

18) In the earlier decision the Hearing Officer found:

“There can be little doubt, however, that at the relevant date and despite the opponent having no place of business in the UK, it had had a significant number of bookings from UK customers, there were many travel agents who booked the opponent’s hotels for clients and a large number of business clients who booked rooms for themselves. The hotels are all known as “The Standard” followed by their specific location, e.g. The Standard Hollywood. The invoices exhibited all show the “inverted” EUTM and, whilst the screenshots exhibited of the opponent’s website post-date the relevant date, they show both earlier marks which indicates a consistent use of the mark over a fairly long period of time and the evidence as a whole casts light backwards in time as to what would have been visible to customers and potential customers. In short, I consider the distinctive character of the earlier marks will have been enhanced through their use.”

19) The Hearing Officer did not specify which goods or services this enhancement related to, which was clearly an oversight. It is clear from the summary of the evidence relied upon that it could not extend beyond hotels and hotels services. The evidence filed in the instant case is almost identical to that filed in the earlier case. The numbering has been altered but from the earlier case only exhibits 20 and 23 are missing whilst exhibits 12,15,21,26,28 & 29 in the instant case are new. It is clear from my reading of the evidence that the opponent has, at best, shown that it has enhanced distinctiveness in relation to hotels and hotel services. I therefore accept the applicant’s concession.

20) In respect of inherent distinctiveness, I fully agree with the view expressed by the Hearing Officer in the earlier decision where she stated:

“46. As set out above, the opponent’s earlier mark 3049342 consists of the words **THE STANDARD**. These are ordinary dictionary words in everyday use with a meaning that will be well-known to the average consumer though [it] is not descriptive of any particular goods or services. I consider it to be a mark with an average degree of



inherent distinctive character. The earlier EUTM has a slightly higher (though not materially so) degree of inherent distinctive character due to its presentation.”

Comparison of trade marks

21) 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 them, 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.”

22) It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The applicant’s mark is a series of two marks which are effectively identical and so it is only necessary to compare one mark to the opponent’s marks. The trade marks to be compared are:

Opponent’s trade marks	Applicant’s trade mark
3049342 THE STANDARD	
EU107497729 	

23) The applicant submitted:

“11. **Visual.** There is a very low level of visual similarity having regard to the presence of the logo and the additional length derived from the inclusion of ASIA. There is a particular

lack of similarity in the case of the EUTM given the black box, the upside down presentation and the use of title case.

12. **Aural.** If the consumer pronounces the “a” and the “s” there will be very little aural similarity. If not, there is still not much. ASIA is significant, the definite article is absent and STANDARD is at the end.

13. **Conceptual.** The meaning of ASIA STANDARD (the application of an Asian standard to or presence of Asian characteristics in the manufacture or sale of goods and the provision of services in the UK or the EU) is very different to that of THE STANDARD (the best in the UK/EU as the case may be). The upside down nature of the EUTM would be taken to suggest that there is something unconventional about the goods and services (while “setting the standard”).

14. **Conclusion.** There is obviously some similarity derived from STANDARD but the level is low.”

24) Whilst the opponent contended:

“30. The Hearing Officer set out the relevant law in paragraph 40 of the Decision, which we adopt herein. We further agree with her reasoning in paragraphs 41-44 that there was a medium degree of similarity between the sign ‘ASIA STANDARD’ and each of the Opponent’s earlier marks.

31. We therefore address below the significance of the additional element which the Applicant has added to the words ‘ASIA STANDARD’. The Hearing Officer set out the relevant law in paragraph 40 of the Decision, which we adopt herein. We further agree with her reasoning in paragraphs 41-44 that there was a medium degree of similarity between the sign ‘ASIA STANDARD’ and each of the Opponent’s earlier marks.

32. We accept the additional element is not present in the Opponent’s earlier marks, and to that extent the degree of similarity found to exist in the earlier opposition must be reduced to a certain extent. However, that reduction is limited, for the following reasons.

- (a) The Applicant in its pleading asserts that the additional element is a stylised representation of the letters ‘A’ and ‘S’. We agree, and that aligns with how the average consumer would perceive the mark. Since the average consumer would appreciate that

the additional element is nothing more than the first letters of the words ASIA STANDARD, the element adds very little to the words, both visually and conceptually.

- (b) Visually, the element occupies a much smaller proportion of the mark than the ASIA STANDARD element, such that the word element continues to carry the majority of the distinctive character.
- (c) Aurally, the average consumer will either pronounce the mark as 'Ay'-'Ess'-'Asia Standard', or simply as 'ASIA STANDARD'. In our submission, the latter is the more natural reading of the mark, but even if we are wrong about that, there will undoubtedly be many consumers who will pronounce the mark in this way. Ultimately, if a significant proportion of consumers are confused, that is sufficient to bar registration of the trade mark even if there is also a significant proportion of consumers who will not be confused. As Kitchen LJ put it in *Interflora v Marks & Spencer (No.5)* at paragraph 129:

“129. ...we do not accept that a finding of infringement is precluded by a finding that many consumers, of whom the average consumer is representative, would not be confused. To the contrary, if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then we believe it may properly find infringement.”

33. Overall, we suggest the reduction in similarity is sufficiently small that the marks continue to share a 'medium', or at least a reasonable, degree of similarity.”

25) In the earlier decision the Hearing Officer found:

“42. Each of the respective marks contain two words, the second of which is the word **STANDARD**. In the applicant's mark it follows the word **ASIA**, both words presented in plain block capitals. The word **ASIA** has a geographical meaning and, as the applicant accepts is “somewhat allusive to the kind or style of certain of the contested Goods/Services”. In the opponent's mark 3049342, the word **STANDARD** follows the word **THE**, again both words being presented in plain block capitals. The word **THE** is the definite article which leads me to find that it is the word **STANDARD** which is the dominant and distinctive element of the opponent's mark. In its EUTM the same words are presented in title case, the whole inverted and on a black

rectangular background. Whilst the inversion adds to the distinctiveness of the mark, it is the word element within the mark which is dominant.

43. Comparing the applicant's mark, first, with the opponent's mark 3049342, the fact that both contain the word **STANDARD** as the second of the two words making up each mark leads to clear visual and aural similarities between them. There are also clear visual differences due to the first words being **ASIA/THE** respectively. Overall, I find there is medium degree of visual and aural similarity between these marks. Comparing the applicant's mark with the opponent's EUTM, the fact that the latter is inverted leads me to find that the visual similarities are slightly less. Despite the inversion, the EUTM will still be pronounced in the usual way so there remains a medium degree of aural similarity between the respective marks.

44. The word **STANDARD** is an ordinary dictionary word in common usage which means a level of quality or attainment which is considered acceptable, usual or normal or a level used to judge the quality of something else. Preceded either by the definite article or the geographical word **ASIA**, I find that there is a medium degree of conceptual similarity between each of the respective marks."

26) The only difference between the marks in the original decision and in the instant case are the stylised letters "A" and "S" at the start of the mark. At the hearing Mr Harbottle contended that the average consumer would not immediately recognise the stylised letters as the letters "A" and "S" but would only come to the realisation of what they are after reading the whole of the mark. I tend to agree with him on this point and would go further in suggesting that some consumers would never make the connection and would simply regard the letters as being an obscure logo with no meaning at all, being just a simple geometric shape. However, I do not believe that this significantly assists the applicant. In my view, the average consumer is likely to look at the stylised letters and initially dismiss them as being of no consequence, only realising after they have read the rest of the mark that they are the letters "A" and "S" and so are a shorthand reference to Asia Standard. **In my opinion, the reduction of similarity represented by the stylised letters "AS" at the start of the applicant's mark is sufficiently small that the marks continue to share a medium degree of similarity overall.**

Likelihood of confusion

27) 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 goods and 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 mark as the more distinctive the trade mark is, 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 upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is a member of the general public including businesses who will select the goods and services by predominantly visual means, although I do not discount aural considerations and that they are likely to pay different degrees of attention to the selection of said goods and services.
- the marks of the two parties have a medium degree of similarity.
- the opponent's marks have an average level of inherent distinctiveness (EU 10749729 being very slightly higher than average) and can benefit from an enhanced distinctiveness through use in relation to hotels and hotel services only..
- the goods and services of the two parties have varying degrees of similarity ranging from identical to merely similar (paragraph 15 above refers).

28) It is necessary to consider the likelihood of both direct and indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person, explained 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.

29) I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

30) At the hearing Mr Harbottle identified a number of services which he felt would be chosen with a high level of attention. As I stated at the hearing, it is my opinion that if the average consumer will pay a high level of attention to the selection of a service which is only similar/reasonably similar or moderately similar to the opponent’s services and I find a likelihood of confusion, it follows that where the degree of attention is less or where the goods and services are of greater similarity there must be an even greater chance of a likelihood of confusion. Therefore, I need only to consider a service or good which is merely similar but where the average consumer will pay a high level of attention to the selection. One such service identified by the applicant is “providing casino facilities (gambling)” in class 41. This was found to be merely similar to the opponent’s services in class 41. It is my opinion that even given the high level of attention that would be paid to the selection of such services and the fact that the services of the two parties are merely similar the similarity of the marks is such that there is a likelihood that the average consumer whilst not directly confusing them, would view the applicant’s mark as a specific sub-brand having a particular style or as an extension to the opponent’s brand. I can envisage a casino having an “Asian” style décor (a mix of that one might find at Indian, Thai or Chinese restaurants in the UK) with perhaps pagoda styling, with bamboo, lanterns, statues all finished in predominantly gold and red. In addition or possibly instead of such décor, there might be what would be regarded as “Asian” betting games such as mah-jong, fan tan, pai gow or pachinko in addition to standard casino games such as roulette, blackjack and baccarat. Therefore, the opposition succeeds in respect of all the goods and services for which the application was made and which have been found to be identical or similar to whatever degree.

CONCLUSION

31) The opposition succeeds in full in respect of all the goods and services which have been opposed. The application can proceed to registration in respect only of those goods and services which were not opposed. They are:

- In Class 16: Letterheads; Forms, printed; Note books; Business Cards;
- In Class 41: Organization of sports competitions

COSTS

32) As the opponent has succeeded in it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Expenses	£200
Preparing evidence	£800
Attendance at the hearing	£1,000
TOTAL	£2,300

33) I order Asia Standard Management Services Limited to pay Standard International Management LLC. the sum of £2,300. This sum to 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 6 March 2019

George W Salthouse
For the Registrar,
the Comptroller-General