

O-518-19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3327797

BY STEVE DAVIDSON

TO REGISTER THE FOLLOWING TRADE MARK:

Woodman's Business Services

IN CLASS 35

AND

OPPOSITION THERETO UNDER NO. 413958

BY WOODMAN ASSET MANAGEMENT AG

BACKGROUND AND PLEADINGS

1. On 27 July 2018, Steve Davidson (“the applicant”) filed trade mark application number UK00003327797 for the mark **Woodman’s Business Services**. The application was accepted and published for opposition purposes on 17 August 2018, in respect of the following services:

Class 35 Business administration and management; Business administration services in the field of healthcare; Business advisory services, consultancy and information; Project studies for businesses; Project studies relating to business matters (Preparation of -).

2. Woodman Asset Management AG (“the opponent”) opposes the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon International Registration designating the UK (“IR(UK)”) no. WO0000001374889, the pertinent details of which are as follows:

Representation: 

International registration date: 8 August 2017

Date of Designation of the UK: 8 August 2017

Date protection granted in UK: 9 February 2018

Priority date: 21 March 2017

Services (as relied upon): Class 35 (Business management and organization consultancy; business investigations; commercial business appraisal; preparation of business reports; compilation of statistics; compilation of information into computer databases.)

3. The opponent’s IR(UK) qualifies, under section 6 of the Act, as an earlier mark for the purpose of these proceedings. As the IR(UK) has a date of protection within five years of the date of the application, it is not subject to the proof of use conditions set out under section 6A of the Act.

4. The opponent's case under section 5(2)(b) is that there is similarity between the marks and the services at issue, resulting in a likelihood of confusion.

5. The applicant filed a counterstatement in which it denies a likelihood of confusion due to the marks at issue not being similar and there not being "enough similarity" between the services, which, the applicant states, only extends to "Business Administration and Management".

6. Both parties filed evidence. Neither party requested a hearing. Only the applicant filed written submissions in lieu of a hearing. The applicant represents itself. The opponent is represented by Norbert Hebels/Friedrich Graf von Westphalen.

Preliminary issue

7. It has come to my attention that an error was made by the opponent in its notice of opposition, which was not previously noticed by the Tribunal. It appears that the list of services being opposed (as applied for by the applicant) were written in the box asking which of the services (covered by the opponent's earlier trade mark) are being relied upon for the opposition, and vice versa. However, I think it is clear, particularly since the opponent's evidence makes comparisons between its entire class 35 specification and the applicant's entire class 35 specification, that this is what the opponent intended to communicate within the notice of opposition. As such, I will proceed on this basis.

DECISION

Section 5(2)(b)

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

"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.”

Relevant 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 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 might 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 shown in the table below:

Earlier mark	Applied-for mark
Class 35: Business management and organization consultancy; business investigations; commercial business appraisal; preparation of business reports; compilation of statistics; compilation of information into computer databases.	Class 35: Business administration and management; Business administration services in the field of healthcare; Business advisory services, consultancy and information; Project studies for businesses; Project studies relating to business matters (Preparation of -).

11. The General Court (“GC”) confirmed in *Gérard Meric v OHIM*¹ that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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. In the judgement of the Court of Justice of the European Union (“CJEU”) in *Canon*,² the court stated at paragraph 23 of its judgment that:

“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”.

¹ Case T-133/05

² Case C-39/97

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case³ for assessing similarity were:

- (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.

14. *Business management* is identically included in both parties' lists of services.

15. In its specification, the opponent has the terms 'business management and organization consultancy' and 'business investigations'. These are broad terms which cover various business-related activities. Taking into account the nature, purpose, uses and users of the aforementioned services, it is clear that they are highly similar to the following applied-for services:

Business administration; business administration services in the field of healthcare; business advisory services in the field of healthcare; business advisory services, consultancy and information.

16. Taking the same factors into account, I also find the terms 'project studies for businesses' and 'project studies relating to business matters (Preparation of -)' in the applicant's specification to be (at least) highly similar to the opponent's 'preparation of business reports'.

³ [1996] R.P.C. 281

The average consumer and the nature of the purchasing act

17. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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*.⁴

18. 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*,⁵ 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.”

19. The parties' specifications cover services that are most likely aimed at more specialised commercial customers. There is likely to be a high level of attention paid to the purchase and considerable discussion prior to entering into the purchasing act. There will also be considerations such as the particular type of service offered and the cost of such service. Overall, I find that the level of care and consideration that will be adopted during the purchasing process would be higher than average. The consumer will, for the most part, encounter the marks visually; on shop fronts, in catalogues or leaflets, or via the internet, for example. However, since word of mouth recommendations may also play a part in the selection process, there is an aural element to the purchase.

⁴ Case C-342/97

⁵ [2014] EWHC 439 (Ch)


Comparison of marks

20. It is clear from *Sabel* 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 CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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.”

21. 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 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.

22. The trade marks to be compared are as follows:

Earlier mark	Applied-for mark
 The logo for 'WOODMAN' features the word in a bold, sans-serif font. The letter 'O' is stylized with a circular symbol inside it. A horizontal line is positioned below the text.	Woodman's Business Services

23. The parties have made submissions on the similarities and differences of the marks. I have considered them all in reaching my decision and will refer below to some

of the arguments raised (although I do not propose to reproduce the submissions in full).

24. I will, however, deal with one aspect of the applicant's submissions. The applicant, in its counterstatement, submits:

“You will also see from my branding (refer to the header and footer of this letter) that there is no similarity between our logos or strap lines.”

25. I am required to make a comparison of the marks in question, as they are registered (as shown in the table at paragraph 22 of this decision). What the applicant has used as its header and footer of its letter are much more stylised versions of the plain word mark it has applied for. There are multiple stylistic elements that have been added to the plain word mark, as well as the letters 'WBS' and a strapline consisting of a further eight words. The marks in the applicant's header and footer are not the marks I will be comparing to the opponent's earlier mark.

Overall impression

26. The applied-for mark consists solely of the words 'Woodman's Business Services', with no stylisation or figurative elements. I consider that the word 'Woodman's' has the greatest impact in the overall impression. A lesser role is played by the words 'Business Services' which will be seen as descriptive by the average consumer, since they describe what services are offered.

27. The earlier mark consists of the word 'WOODMAN', written in grey, in a fairly standard typeface, and underlined. The two 'o's within the word 'WOODMAN' overlap slightly, creating a degree of stylisation within the mark. However, this does not affect the average consumer clearly seeing the word 'WOODMAN' which is where the overall impression rests. The underlining of the word will be noticed by the average consumer but plays an insubordinate role in the overall impression of the mark.

Visual comparison

28. Aside from the stylisation to the two 'o's in the earlier mark, and the different typeface, the similarity rests in the word WOODMAN. The different typeface does not make a material difference to the comparison, since a word mark can be written in any normal font.⁶ The difference is in the addition of the apostrophe and letter 's' and the words 'Business Services' in the applied-for mark. Overall, I find a medium degree of visual similarity between the marks.

Aural comparison

29. Given the descriptive nature of the words Business Services in the applied-for mark, I am of the view that the average consumer will shorten this mark to 'Woodman's'. The earlier mark will be articulated as 'Woodman'. I find a high degree of aural similarity between the marks.

Conceptual comparison

30. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*.⁷ The assessment must be made from the point of view of the average consumer.

31. 'Woodman' will either be seen as a surname or as the ordinary dictionary definition of that word, being "a person who looks after and fells trees used for timber".⁸ In either case, the concept will be the same for both marks. The addition of the apostrophe and letter 's' in the applied-for mark does not create a difference since it is well known to the average consumer that an apostrophe followed by the letter 's' is regularly used to show possession; in this instance, belonging to 'Woodman'. Similarly, the words 'Business Services' do not create a materially different concept, since they are purely

⁶ See the comments of Professor Ruth Annand in *Bentley Motors Limited v Bentley 1962 Limited* BL O/158/17

⁷ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

⁸ www.collinsdictionary.com

descriptive of the services for which the mark is seeking registration. Overall, I find a high degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

32. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* 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).”

33. The opponent has not claimed to have used its earlier mark to the extent that it has an enhanced degree of distinctive character. However, even if it had, I have not been provided with any evidence to determine whether the earlier mark has an enhanced distinctive character. Accordingly, I have only the inherent distinctiveness of the earlier mark to consider.

34. The opponent's earlier mark is an ordinary dictionary word (recognisable to the average consumer as an ordinary word or as a surname) with slight stylisation. The word WOODMAN is not descriptive or allusive of the services for which the mark is registered. Consequently, I find the earlier mark to have an average degree of distinctive character.

Likelihood of confusion

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

36. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods and services down to the responsible undertaking being the same or related).

37. The marks have been found to be visually similar to a medium degree, aurally similar to a high degree and conceptually highly similar. The services have been found to be identical or highly similar.

38. Taking into account the common element between the marks (the word WOODMAN), and bearing in mind the concept of imperfect recollection, as well as the fact that the services are identical or highly similar, I consider it likely that the average consumer will mistake one mark for the other, resulting in a likelihood of direct confusion.

39. For the sake of completeness, I go on now to consider indirect confusion.

40. Indirect confusion was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*⁹

“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 recognised 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.).

⁹ BL O/375/10

(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).”

41. I have borne in mind that the examples given by Mr Purvis QC are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹⁰

42. I go on now to consider whether the average consumer, if they do recognise that the marks are different, considers the common element of both marks and determines, through an instinctive mental process, that the marks are related and originate from the same, or an economically linked undertaking.

43. Considering that the differences in the marks are: (i) the possessive apostrophe and letter ‘s’; (ii) the descriptive words Business Services; and (iii) the minor stylisation to the earlier mark, I think it likely that the consumer will either consider the differences as expected in a sub-brand or brand extension (i.e. the undertaking has decided to add or remove the descriptive ‘Business Services’) or consider the change in stylisation of the word WOODMAN entirely logical with a re-branding.

CONCLUSION

44. The opponent’s case under section 5(2)(b) has been successful. Subject to appeal, the applicant’s mark is refused registration.

COSTS

45. As the opponent has been successful I consider that it is entitled to an award of costs in its favour. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. The opponent filed a cost pro-forma. However, the opponent is represented and therefore costs will be decided on the normal scale, in accordance with TPN 2/2016.

¹⁰ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

Official fee:	£100
Preparing a statement and considering the other side's statement:	£200
Considering the applicant's evidence and preparing evidence in reply:	£300 ¹¹
Considering the applicant's written submissions in lieu of a hearing:	£150 ¹²
Total:	£750

46. I order Steve Davidson to pay Woodman Asset Management AG the sum of **£750**. This sum is 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 this 04th day of September 2019

Emily Venables
For the Registrar,
The Comptroller-General

¹¹ This is below the scale minima due to the evidence being exceptionally light

¹² This is below the scale minima due to the submissions being exceptionally light and the opponent not filing submissions