

O/797/21

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION FOR TRADE MARK NO. 3499640
IN THE NAME OF GOT YOU COVERED LIMITED FOR THE SERIES OF SIX**

TRADE MARKS



IN CLASSES 35, 36, 41 AND 45

AND

THE OPPOSITION THERETO UNDER NUMBER 421737

BY

THE TRAVELERS INDEMNITY COMPANY

Background and pleadings

1. On 11 June 2020, Got You Covered Limited (“the applicant”) applied for the series of six trade marks shown on the cover page of this decision (number 3499640) for a range of services in classes 35, 36, 41 and 45.

2. The application was published for opposition purposes in the *Trade Marks Journal*, on 10 July 2020. On 12 October 2020, The Travelers Indemnity Company filed an opposition to the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The section 5(2)(b) and 5(3) grounds are based upon the following earlier registered series of two marks:

2481284: filing date 3 March 2008; registered 19 August 2011

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3. Under section 5(2)(b), the opponent relies upon all of its registered services in classes 36 and 41. Under section 5(3), it relies upon *insurance; information and advisory services relating to all the aforesaid; all of the foregoing related to property and casualty insurance (including surety)*. I will give more detail about the parties’ respective services later in this decision.

4. The opponent claims that the parties’ marks are visually and conceptually similar, for identical or highly similar services, leading to a likelihood of confusion under section 5(2)(b) of the Act. The opponent states that the likelihood of confusion is increased as a result of the reputation of the earlier trade mark. Under section 5(3), the opponent claims a reputation in its mark for the services listed above such that the relevant public will believe the parties’ marks are used by the same undertaking or an economically linked undertaking. The opponent also claims that use of the applicant’s mark will erode the distinctiveness of the earlier mark, damage its reputation, and give an unfair advantage to the applicant by virtue of the reputation of the earlier mark.

5. The opponent's section 5(4)(a) ground is based on use of an unregistered right corresponding to its registered trade mark. The opponent claims that it has used its sign since at least 2008, throughout the UK, in relation to *insurance services*. The opponent claims that its goodwill entitles it to prevent the use of the applicant's mark under the law of passing off.

6. The applicant denies all of the grounds of opposition. It makes statements about the low distinctiveness and common use of umbrella devices in the insurance sector; and, statements about what the parties sell. I will say more about these issues later in this decision.

7. The earlier mark completed its registration process more than five years before the date the contested application was filed. The opponent has made a statement that it has used the mark for the services relied upon; however, the applicant indicated in its defence and counterstatement that it does not require the opponent to prove that it has made genuine use of the earlier mark in relation to the services upon which it relies.¹

8. Throughout the proceedings, the opponent has been professionally represented by Keltie LLP. The applicant initially represented itself, later appointing Bird & Bird LLP as its professional representatives, during the evidence rounds. The opponent also filed submissions with its evidence in chief. Both parties filed evidence and submissions in lieu of a hearing. I make this decision after a careful reading of all the papers, referring to the evidence and submissions as necessary.

Evidence

9. The opponent's evidence comes from Mr Benjamin Britter, a partner at Keltie LLP. He has filed two sets of evidence, the first being the opponent's evidence-in-chief and the second filed in reply to the applicant's evidence. Mr Britter's two witness statements are dated 15 March 2021 and 13 July 2021. The applicant's evidence

¹ See section 6A of the Act.

comes from Mr Robert Leigh, its Chief Executive Officer. His witness statement is dated 13 May 2021.

Decision

Section 5(2)(b)

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

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

(a) ...

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

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

11. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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.²

² Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived

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;

from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

(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

12. In its defence and counterstatement, the applicant states:

We provide different services to those provided by the challenger. Whereas the challenger is an insurer and sells insurance direct to consumers, we are an insurance broker. Furthermore Got You Covered lines of business are focused in Personal Lines insurance products such as car and van insurance and only operate in the UK whereas the product range offer by Travelers in the UK do not sell Personal Lines products but is purely concentrated on Commercial Lines such as: Cyber, Corporate, Kidnap and Liability – none of which are products sold, or are likely to be sold in the future, by Got You Covered. The average consumer of the relevant services goes through a detailed quotation and contracting process prior to purchasing those services. As a result of the above, there can be no risk of confusion between the two for the purposes of Section 10(2) of the Trade Marks Act 1994 ("TMA"), nor any misrepresentation (and therefore no resulting damage) for the purposes of passing off.

13. There are similar submissions made in the applicant's evidence. As a matter of law, it is not relevant what services are actually being provided by either party. Trade marks are entitled to legal protection against the use or registration of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. Once a trade mark has been registered for five years, the opponent can be required to provide evidence of use of its mark. The consequence of the opponent not being required to prove, because the applicant did not request it, is that it is entitled to rely upon all its services, as registered in classes 36 and 41, on the basis of normal

and fair use.³ I must also assess the applicant's terms in their specifications on the basis of normal and fair use of what those terms cover, not what the applicant currently provides, or intends to provide.⁴

14. I will begin with the parties' class 36 specifications. The applicant's specification is particularly lengthy and contains repetitious terms. The opponent's services have all been limited to "all [...] related to property and casualty insurance (including surety). This appears to be insurance for any type of property (not just buildings) and insurance against third party injury.

15. The law requires that goods/services be considered identical where one party's description of its goods/services encompasses the specific goods/services covered by the other party's description (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, General Court ("GC"). On that basis, and on the basis of those terms which are either identically worded or nearly so, I list below the applicant's class 36 services which are identical to the opponent's *insurance; insurance underwriting services; insurance claims processing and administration; assessment of insurance claims; insurance agency and brokerage services; information and advisory services relating to all the aforesaid; all of the foregoing related to property and casualty insurance (including surety).*

Accident insurance underwriting; Automobile accident insurance underwriting; Brokerage of insurance; Brokerage of non-life insurance; Caravan insurance services; Consultancy and brokerage services relating to home insurance; Consulting and information concerning insurance; Consulting and information concerning insurance; Estimates for insurance purposes; Evaluation (Financial -) [insurance, banking, real estate]; Evaluation for insurance purposes; insurance consultancy; Financial evaluation for insurance purposes; Financial evaluation for reinsurance purposes; Financial evaluation [insurance, banking, real estate]; Financial evaluation services relating to insurance; Financial services relating to insurance; Financial services relating to the insurance of motor vehicles; Financial services rendered by insurance

³ See *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41, at paragraph 22

⁴ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, CJEU

companies; Financial valuation, adjustment and settlement services relating to insurance claims; Fire insurance; Fire insurance underwriting; Fire insurance valuations; Accident insurance; Accident insurance underwriting services; Administration of insurance business; Arranging of insurance; Automobile accident insurance underwriting; Brokerage (Insurance -); Brokerage advisory services relating to insurance; Brokerage of insurance; Consultancy and brokerage services relating to accident insurance; Consultancy and brokerage services relating to vehicle insurance; Consultations [insurance]; Consulting and information concerning insurance; Estimates for insurance purposes; Evaluation (Financial -) [insurance, banking, real estate]; Evaluation for insurance purposes; Extended guarantee insurance; Extended warranty insurance; Extended warranty insurance services; insurance consultancy; Financial evaluation [insurance, banking, real estate]; Financial evaluation for insurance purposes; Financial evaluation services relating to insurance; Financial services relating to insurance; Financial services relating to the insurance of motor vehicles; Financial services rendered by insurance companies; Financial valuation, adjustment and settlement services relating to insurance claims; Fire insurance; Fire insurance underwriting; Fire insurance valuations; Guarantee insurance; Guarantee insurance services; Home contents insurance; Home insurance services; Household insurance services; Information (Insurance -); Information services relating to insurance; Provision of insurance premium quotations; Provision of insurance services to insurance companies; Provision of insurance services to reinsurance companies; Provision of ten year insurance policies; Real estate insurance services; Research (Insurance -); Service insurance contracts; Settlement of insurance claims; Ship insurance agency; Studies (Insurance -); Telephone banking and insurance services; Transit insurance brokerage; Transport insurance brokerage; Underwriting (Insurance -); Underwriting of insurance (Services for the -); Underwriting of personal accident insurance (Services for the -); Underwriting relating to marine insurance; Underwriting relating to transport insurance; Valuation of cargo for insurance purposes; Vehicle insurance services; Warranty insurance services; Insurance; Insurance (Arranging of -); Insurance actuarial services; Insurance administration; Insurance advice; Insurance advisory services; Insurance against loss of documents; Insurance agencies; Insurance agency and brokerage; Insurance agency services; Insurance and financial information and consultancy services; Insurance arranging services; Insurance brokerage; Insurance brokerage consultancy and information; Insurance brokerage for

property; Insurance brokerage relating to pets; Insurance brokerage services; Insurance brokering; Insurance brokers (Services of -); Insurance broking; Insurance claim assessments; Insurance claim settlements; Insurance claims adjustment; Insurance claims adjustment and settlement services; Insurance claims adjustment services; Insurance claims administration; Insurance claims assessment; Insurance claims processing; Insurance consultancy; Insurance consultancy services relating to explosions; Insurance consultancy services relating to fires; Insurance consultation; Insurance consultation services; Insurance for garages; Insurance for hotels; Insurance for offices; Insurance for property owners; Insurance for third party liability; Insurance for vans; Insurance guarantees; Insurance information; Insurance information and consultancy; Insurance investigations; Insurance loss assessment; Insurance management services; Insurance of anti-theft systems; Insurance of buildings; Loss adjusting services in the field of insurance; Loss adjustment in the field of insurance; Marine accidents insurance underwriting; Marine fire insurance underwriting; Marine insurance; Marine insurance underwriting; Marine transportation insurance underwriting; Motor insurance; Motor insurance brokerage; Motor mechanical breakdown insurance warranty services; Motor vehicle insurance services; Non-life insurance underwriting; Personal insurance services; Processing of insurance claims; Professional indemnity insurance; Property (Real estate -) insurance; Property insurance underwriting; Providing information in insurance matters; Providing information relating to claims adjustment for non-life insurance; Providing information relating to insurance; Providing information relating to insurance premium rate computing; Providing information relating to non-life insurance underwriting; Providing insurance information; Providing insurance premium quotations; Providing online information about insurance from a computer database or the Internet; Provision of equipment guarantee insurance; Provision of information relating to insurance; Provision of information relating to insurance; Provision of insurance information; Insurance; Insurance (Arranging of -); Insurance actuarial services; Insurance administration; Insurance advice; Insurance advisory services; Insurance against loss of documents; Insurance agencies; Insurance agency and brokerage; Insurance agency services; Insurance and financial information and consultancy services; Insurance arranging services; Insurance brokerage; Insurance brokerage consultancy and information; Insurance brokerage for property; Insurance brokerage relating to pets; Insurance brokerage services; Insurance brokering;

Insurance brokers (Services of -); Insurance broking; Insurance claim assessments; Insurance claim settlements; Insurance claims adjustment; Insurance claims adjustment and settlement services; Insurance claims adjustment services; Insurance claims administration; Insurance claims assessment; Insurance claims processing; Insurance consultancy; Insurance consultancy services relating to explosions; Insurance consultancy services relating to fires; Insurance consultation; Insurance consultation services; Insurance for garages; Insurance for hotels; Insurance for offices; Insurance for property owners; Insurance for third party liability; Insurance for vans; Insurance guarantees; Insurance information; Insurance information and consultancy; Insurance investigations; Insurance loss assessment; Insurance management services; Insurance of anti-theft systems; Insurance of buildings; Insurance of communications apparatus; Insurance of goods while in transit; Insurance plans (Administration of -); Insurance premium financing services; Insurance relating to personal possessions; Insurance relating to property; Insurance research; Insurance services; Insurance services for mobile telephones; Insurance services for thatched properties; Insurance services for the construction industry; Insurance services for the protection of drivers; Insurance services relating to aviation; Insurance services relating to boats; Insurance services relating to goods in transit; Insurance services relating to holiday accommodation; Insurance services relating to mechanical breakdown; Insurance services relating to motor vehicles; Insurance services relating to nursing homes; Insurance services relating to property; Insurance services relating to real estate; Insurance services relating to sea cargo; Insurance services relating to structured settlements rendered to property casualty insurers; Insurance services relating to thatched roofs; Insurance services relating to the loss of personal possessions; Insurance services relating to the theft of personal possessions; Insurance services relating to vehicles; Insurance subrogation; Insurance underwriting; Insurance underwriting and appraisals and assessment for insurance purposes; Insurance underwriting consultancy; Accident insurance; Accident insurance underwriting; Accident insurance underwriting services; Administration of group insurance; Administration of group insurance plans; Administration of insurance business; Administration of insurance claims; Administration of insurance claims adjustment; Administration of insurance plans; Administration of insurance portfolios; Advice relating to insurance; Advisory services relating to insurance claims; Advisory services relating to insurance contracts; Appraisals for insurance claims of personal

property; Appraisals for insurance claims of real estate; Appraisals for insurance purposes; Arranging for financing of insurance premiums; Arranging insurance; Arranging insurance; Arranging of insurance; Arranging of insurance claims assessment; Assessing and processing insurance claims; Assessing insurance claims; Automobile accident insurance underwriting; Aviation insurance; Brokerage (Insurance -); Brokerage advisory services relating to insurance; Brokerage agency relating to ship insurance; Brokerage of casualty insurance; Brokerage of insurance; Brokerage of non-life insurance; Caravan insurance services; Casualty insurance underwriting; Claim adjustment for non-life insurance; Claim assessments (Insurance -); Claims adjustment (Insurance -); Claims adjustment for non-life insurance; Claims adjustment in the field of insurance; Commodities insurance; Computerised information services relating to insurance; Computerised processing of insurance claims; Consultancy and brokerage services relating to accident insurance; Consultancy and brokerage services relating to home insurance; Consultancy and brokerage services relating to vehicle insurance; Consultancy services relating to insurance; Consultations [insurance]; Consulting and information concerning insurance; Estimates for insurance purposes; Evaluation (Financial -) [insurance, banking, real estate]; Evaluation for insurance purposes; Extended guarantee insurance; Extended warranty insurance; Extended warranty insurance services; insurance consultancy; Financial evaluation [insurance, banking, real estate]; Financial evaluation for insurance purposes; Financial evaluation services relating to insurance; Financial services relating to insurance; Financial services relating to the insurance of motor vehicles; Financial services rendered by insurance companies; Financial valuation, adjustment and settlement services relating to insurance claims; Fire insurance; Fire insurance underwriting; Fire insurance valuations; Guarantee insurance; Guarantee insurance services; Home contents insurance; Home insurance services; Household insurance services; Information (Insurance -); Information services relating to insurance; Loss adjusting services in the field of insurance; Loss adjustment in the field of insurance; Marine accidents insurance underwriting; Marine fire insurance underwriting; Marine insurance; Marine insurance underwriting; Marine transportation insurance underwriting; Motor insurance; Motor insurance brokerage; Motor mechanical breakdown insurance warranty services; Motor vehicle insurance services; Non-life insurance underwriting; Personal insurance services; Processing of insurance claims; Professional indemnity insurance; Property (Real estate -)

insurance; Property insurance underwriting; Providing information in insurance matters; Providing information relating to claims adjustment for non-life insurance; Providing information relating to insurance; Providing information relating to non-life insurance underwriting; Providing insurance information; Providing insurance premium quotations; Providing online information about insurance from a computer database or the Internet; Provision of equipment guarantee insurance; Provision of information relating to insurance; Provision of information relating to insurance and financial services; Provision of insurance information; Insurance; Insurance underwriting in the field of professional liability insurance; Insurance underwriting services; Provision of insurance premium quotations; Provision of insurance services to insurance companies; Provision of insurance services to reinsurance companies; Provision of ten year insurance policies; Real estate insurance services; Research (Insurance -); Service insurance contracts; Settlement of insurance claims; Ship insurance agency; Studies (Insurance -); Telephone banking and insurance services; Transit insurance brokerage; Transit insurance underwriting; Transport insurance brokerage; Underwriting (Insurance -); Underwriting of insurance (Services for the -); Underwriting of personal accident insurance (Services for the -); Underwriting relating to marine insurance; Underwriting relating to transport insurance; Valuation of cargo for insurance purposes; Vehicle insurance services; Warranty insurance services.

16. Insurance risk management is identical to the opponent's *risk management related to property and casualty insurance (including surety)*.

17. The applicant, in its written submissions in lieu of a hearing, accepts that the parties' services are similar, although it does not say what that level of similarity is. Clearly, some of the services are identical, as above. Bearing in mind this concession, it is not open to me to find no similarity, but it is necessary to assess what the level of similarity is for the other services because the degree of similarity is a factor in the global assessment as to whether there is a likelihood of confusion.

18. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where 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.”

19. In *Kurt Hesse v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“82 ... there is a close connection between [the goods], in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”.

20. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

21. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [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."

22. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

23. The services in the applicant's class 36 specification which I have not found to be identical to the opponent's services fall into the following two groups:

(i) Arranging of travel insurance; Credit insurance; Credit risk insurance; Credit risk insurance [factoring]; Credit services for payment of insurance premiums; Credit services for the payment of insurance premiums; Dental health insurance administration; Dental health insurance underwriting and administration; Consultancy and brokerage services relating to travel insurance; Credit insurance; Credit risk insurance; Credit risk insurance [factoring]; Credit services for payment of insurance premiums; Credit services for the payment of insurance premiums; Dental health insurance administration; Dental health insurance underwriting and administration; Endowment insurance services; Health insurance; Health insurance underwriting; Health insurances services relating to coach couriers; Health insurances services relating to coach drivers; Legal expenses insurance; Provision of mortgage loan insurance; Savings schemes relating to health insurance; Time and cost completion risk insurance; Time and cost overrun risk insurance; Travel insurance; Travel insurance services; Underwriting insurance for pre-paid health care; Underwriting insurance for pre-paid legal services; Underwriting of business insurance (Services for the -); Underwriting of company insurance (Services for the -); Underwriting of credit insurance (Services for the -); Underwriting of health insurance (Services for the -); Variable insurance investment services; Insurance administration of prescription drug benefit plans; Insurance against loss of credit; Insurance for businesses; Insurance for

legal expenses; Life insurance brokerage; Medical insurance; Medical insurance brokerage services; Medical insurance services provided to companies; Medical insurance underwriting; Mortgage banking insurance; Mortgage insurance; Personal insurance relating to liability for repayment of loans; Personal insurance services relating to the supply of legal advice; Personal insurance services relating to the supply of legal services; Private health insurance; Insurance administration of prescription drug benefit plans; Insurance for businesses; Insurance premium rate computing; Insurance services for the protection of mortgages; Insurance services for the provision of emergency cash; Insurance services for the repayment of medical expense; Insurance services relating to cancelled bookings for holidays; Insurance services relating to contingency planning; Insurance services relating to credit; Insurance services relating to credit agreements; Insurance services relating to credit cards; Insurance services relating to legal costs; Insurance services relating to life; Insurance services relating to mail order businesses; Insurance services relating to pension funds; Insurance services relating to purchase protection, price protection and extended warranty for goods purchased using credit cards; Insurance services relating to sport; Insurance services relating to structured settlements rendered to lawyers; Insurance services relating to the provision of credit; Insurance services relating to travel; Advisory services relating to life insurance; Agency services for arranging travel insurance; Arranging of credit insurance; Arranging of life insurance; Arranging of travel insurance; Banking insurance; Consultancy and brokerage services relating to health insurance; Consultancy and brokerage services relating to life insurance; Consultancy and brokerage services relating to travel insurance; Credit insurance; Credit risk insurance; Credit risk insurance [factoring]; Credit services for payment of insurance premiums; Credit services for the payment of insurance premiums; Dental health insurance administration; Dental health insurance underwriting and administration; Endowment insurance services; Health insurance; Health insurance underwriting; Health insurances services relating to coach couriers; Health insurances services relating to coach drivers; Legal expenses insurance; Life insurance; Life insurance agencies; Life insurance brokerage; Life insurance underwriting; Medical insurance; Medical insurance brokerage services; Medical insurance services provided to companies; Medical insurance underwriting; Mortgage banking insurance; Mortgage insurance; Personal insurance relating to liability for repayment of loans; Personal insurance services relating to the supply of legal advice; Personal insurance

services relating to the supply of legal services; Private health insurance; Providing information relating to insurance premium rate computing; Providing information relating to life insurance brokerage; Providing information relating to life insurance underwriting; Providing purchase protection insurance for goods purchased using credit cards; Provision of holiday insurance; Provision of mortgage loan insurance; Savings schemes relating to health insurance; Time and cost completion risk insurance; Time and cost overrun risk insurance; Travel insurance; Travel insurance services; Underwriting insurance for pre-paid health care; Underwriting insurance for pre-paid legal services; Underwriting of business insurance (Services for the -); Underwriting of company insurance (Services for the -); Underwriting of credit insurance (Services for the -); Underwriting of health insurance (Services for the -); Variable insurance investment services.

(ii) Financial consultancy⁵; Provision of information relating to financial services; financial information and consultancy services; Arranging investments, in particular capital investments, financing services.

24. Group (i) comprises insurance services broadly falling into financial, legal, travel and medical insurance. Although not identical to the opponent's insurance, because of the limitation at the end of the opponent's class 36 specification, these services are nevertheless all insurance services. The purpose of all is to provide protection and compensation in case the event or circumstance insured against happens. Insurers and underwriters provide different types of insurance and the administration thereof. There will be shared trade channels. There is at least a medium level of similarity. In case I am wrong about any of the services I have found to be identical, they must fall into this category, for the same reasons.

25. Group (ii) comprises financial services. Even with the opponent's class 36 limitation, I find that the services in group (ii) are identical to the opponent's 'insurance' (limited) on the basis of *FIL Limited and Anor v Fidelis Underwriting Limited and Others* [2018] EWHC 1097 (Pat). In that case, Arnold J (as he then was) said:

⁵ This term appears three times in the applicant's list of class 36 services.

“87. Fidelity contend that the term "financial services" should be given its ordinary and natural meaning, and that, if this is done, it covers insurance services.

88. Fidelis contend that the term "financial services" should be narrowly construed so as to exclude insurance services for three reasons. First, in order to confine it to the core of the ordinary and natural meaning. Secondly, because otherwise one term in the specifications of the Trade Marks (namely "financial services") will subsume another term (namely "insurance services"). Thirdly, because the class headings and explanatory notes to the relevant editions of the Nice Classification distinguish between "insurance" and "financial affairs".

89. In my judgment Fidelity are correct. Wikipedia defines "financial services" as follows:

"Financial services are the economic services provided by the finance industry, which encompasses a broad range of businesses that manage money, including credit unions, banks, credit-card companies, insurance companies, accountancy companies, consumer-finance companies, stock brokerages, investment funds, individual managers and some government-sponsored enterprises. Financial services companies are present in all economically developed geographic locations and tend to cluster in local, national, regional and international financial centers such as London, New York City, and Fujian."

The entry goes on to discuss various types of financial services, including insurance. In my view this definition accords with ordinary use of the expression "financial services". For example, and importantly from the consumer perspective, it accords with the fact that, as discussed above, the FSCS covers insurance services (including but not limited to unit-linked pension policies as discussed in paragraph 39 above).

90. So far as Fidelis' first point is concerned, I consider that insurance services are within the core of the ordinary meaning of "financial services". As for the

second point, it is commonplace for one term in a specification of goods or services to be a subset of a second term. Turning to the third point, the short answer to this is that the Nice Agreement is an agreement as to classification, not as to the effect of classification: see Article 2(1). Save to the limited extent recognised in *Altechnic Ltd's Trade Mark Application* [2001] EWCA Civ 1928, [2002] RPC 34, class has no bearing on the interpretation of terms in specifications of goods or services. Still less does the terminology used in the Nice Classification affect the interpretation of terms falling within one class (particularly where, as here, there is no issue arising out of the use of class headings pursuant to Communication 4/03 of the President of the Office of Harmonisation in the Internal Market.) Moreover, the terms used in the specifications of the Trade Marks are "insurance services" and "financial services", not "insurance" and "financial affairs". Furthermore, the explanatory notes state that "services relating to financial or monetary affairs *comprise* [emphasis added]" six particular categories of services, thus leaving open the possibility that other services may be included. Finally, Jessie Roberts, *International Trademark Classification: A Guide to the Nice Agreement* (OUP, 4th ed, 2012) states at page 224:

"Insurance services are a significant factor in the investment industry, therefore, these services are properly classified in Class 36. The purchase of insurance is a monetary investment. ... Furthermore, the investment industry is dependent on insurance funds for its very existence."

26. If I am wrong about *Arranging investments, in particular capital investments, financing services* being identical, they are similar to at least a medium degree given the quotation immediately preceding this paragraph.

27. The parties' class 41 services are as follows:

Earlier mark	Application
Education; providing of training; providing training programs in the field	Courses (Training -) relating to insurance; Educational courses relating

of insurance; all of the foregoing related to property and casualty insurance (including surety).	to insurance; Courses (Training -) relating to insurance; Educational courses relating to insurance.
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28. These services are identical on the *Meric* principle, the applicant's services covering the opponent's services.

29. The applicant's Class 35 services are *The bringing together, for the benefit of others, of a variety of insurance services, enabling consumers to conveniently compare and purchase those services; Administrative services relating to dental health insurance; Administrative services relating to referrals for insurance agents; Business management of insurance agencies and brokers on an outsourcing basis; Promotion of financial and insurance services, on behalf of third parties; Promotion of insurance services, on behalf of third parties; The bringing together, for the benefit of others, of a variety of insurance services, enabling consumers to conveniently compare and purchase those services.*

30. *The bringing together, for the benefit of others, of a variety of insurance services, enabling consumers to conveniently compare and purchase those services* (which appears twice). This is the retail of insurance services, which includes the retail of the type of insurance which the opponent's class 36 specification covers. Although the purpose of the services differs, and they are not in competition, they are complementary and will be accessed through the same trade channels.⁶ They are similar to a medium degree.

31. *Administrative services relating to dental health insurance* is similar to the opponent's class 36 services, in particular, to 'providing information in insurance matters and medical care coordination including assisting employers and providers in processing medical claim forms and payment of medical claims'. Processing medical claims forms is an administrative service, and the opponent's services provide information about processing medical claims forms. Dental health insurance is either

⁶ See, for example, *Oakley, Inc v OHIM*, Case T-116/06, General Court, and *Tony Van Gulck v Wasabi Frog Ltd* BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person.

identical to or highly similar to medical care insurance. Consequently, these services are highly similar.

32. *Administrative services relating to referrals for insurance agents; business management of insurance agencies and brokers on an outsourcing basis.* These are business operations services, rather than insurance services. There is no explanation as to why they are similar beyond the opponent's submission that the applicant's services all relate to insurance. This is over-simplification. The applicant's services do not relate to insurance *per se*. The end users will be different; the purpose and nature of the services differ. I cannot detect any competition or complementarity, or shared trade channels. The similarity will be very low.

33. *Promotion of financial and insurance services, on behalf of third parties; Promotion of insurance services, on behalf of third parties.* As above, these services are not insurance services, they are advertising services for third parties. For example, a third party may be an insurance provider, but the third party outsources the promotion of its business to an undertaking providing advertising or promotional services. The end users differ, the services fulfil different purposes, are not of the same nature, are not in competition and do not appear to be complementary in the sense described in the caselaw above. The similarity will be very low.

34. The applicant's class 45 services are *Fraud detection services in the field of health care insurance; Investigation services related to insurance claims; Legal services relating to social insurance claims.* These services are likely to be provided by insurers, and would form part of the claims assessment process and loss prevention. Fraud detection in the field of health care insurance is likely to form part of the process of assisting employers and providers in processing medical claim forms and payment of medical claims, which are the opponent's services. These are complementary, will and share trade channels. I find there is a medium level of similarity.

The average consumer and the purchasing process

35. 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. The parties' services include some provided to the general public, and some to businesses and specialists. However, for all types of average consumer, at least an average degree of thought will be given to the prospective purchase; for example, car or home contents insurance. For services provided to businesses, the degree of attention will be higher. Purchasing is primarily likely to take place on a visual basis, but there will also be an aural aspect to the purchase, such as advice given by brokers to prospective customers.

Comparison of marks

36. 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 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.”

37. 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.

38. The marks to be compared are:

Opponent's marks	Applicant's marks
 <p>TRAVELERS </p> <p>TRAVELERS </p>	 <p>GOT YOU COVERED </p> <p>GOT YOU COVERED BUSINESS </p> <p>GOT YOU COVERED HOUSEHOLD </p> <p>GOT YOU COVERED MOTOR </p> <p>GOT YOU COVERED VAN & TRUCK </p> <p>GOT YOU COVERED TAXI </p>

39. The earlier mark comprises two elements, the word TRAVELERS and a device of an umbrella in a single colour. The overall impression of the mark resides in the whole, but by virtue of its size and position in the mark, TRAVELERS is the dominant element.

40. The application comprises six marks in a series. The second to sixth marks contain words which are wholly descriptive of types of insurance (i.e. BUSINESS, HOUSEHOLD, MOTOR, VAN & TRUCK, and TAXI). The marks also contain banal devices to represent these types of insurance. These elements are descriptive of the class 36 services and carry little, if any, weight in the overall impression of the marks in relation to such services. The overall impression is dominated by the phrase GOT YOU COVERED and the large umbrella, the handle of which forms the U in the word YOU. The umbrella is comprised of segments, with red being the middle colour in between the two black segments. The words are likely to be read first, but the size of the umbrella device means that these two elements are equally dominant in the overall impression.

41. The only point of similarity between the marks is the umbrella device. The opponent's umbrella is a single colour device. One of the opponent's series of marks has a red umbrella, and the other is black which gives coverage for all single colours, including black. If the device in the earlier mark is either black or red, this creates more visual similarity with the applicant's device than if it were any other colour. The opponent's umbrella device is not segmented. Notional and fair use of the opponent's device does not extend to segmentation into red and black (or any other colours), which is an arbitrary arrangement not suggested by the single colour representation of the device in the earlier mark.

42. The opponent's device appears at the end of its mark. It extends a little higher than the word before it. The word and device appear on one horizontal line. In the application, GOT YOU COVERED appears in a vertical arrangement. The U of YOU is slanted to the right, formed by the handle of the umbrella which is large and covers the descriptive devices and half of the wording, being considerably higher than the words. The visual similarity of the parties' marks is at a low level, even if the earlier mark's umbrella is red or black.

43. The marks are not aurally similar because the only similar element is a device which will not be articulated.⁷

⁷ GC, Case T-424/10, *Dosenbach-Oschner AG v OHIM*, paragraph 46

44. An umbrella provides protection for the user against rain. The concept of the umbrella devices in the parties' marks is identical. I have already referred to the descriptive nature of the types of insurance represented by the words BUSINESS, HOUSEHOLD, MOTOR, VAN & TRUCK, and TAXI and the corresponding banal devices. Of course, the first mark in the series does not contain a word or device such as these. The element GOT YOU COVERED will be perceived, particularly in the context of insurance, as a truncated approximation to "don't worry, we are protecting you". The word in the earlier mark, TRAVELERS, is the US spelling of TRAVELLERS. It will be perceived as meaning more than one traveller, or possibly the possessive form of traveller, even though there is no apostrophe. The respective words in the parties' marks are not similar in meaning. The only point of conceptual similarity between the marks resides in the umbrella devices. The marks are conceptually similar to a low to medium degree.

Distinctive character of the earlier mark

45. 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.⁸ In making my assessment of the earlier mark's distinctive character, I bear in mind that the distinctive character of the earlier mark will only increase the likelihood of confusion where the distinctiveness is provided by an aspect of the mark which has a counterpart in the later mark. If distinctiveness is provided by an element which is not common to the later mark, it will not increase the likelihood of confusion and is more likely to point away from it.⁹ The only point of similarity is the umbrella devices, the distinctiveness of which has been the subject of much of the parties' evidence and submissions. Paying particular attention to this, I will begin by considering the inherent distinctive character of the earlier mark *per se*, taking into account the guidance of the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*. I will review the parties' evidence and arguments which go to this issue, before looking at the opponent's claim that its mark has an enhanced level of distinctive character as a result of its use.¹⁰

⁸ *Sabel BV v Puma AG*, Case C-251/95

⁹ See *Kurt Geiger v A-List Corporate Limited* BL O/075/13 at paragraphs 38 to 39, Mr Iain Purvis QC, sitting as the Appointed Person

¹⁰ Case C-342/97

46. Dictionary words are usually said to have a medium degree of inherent distinctive character if they do not describe or allude to any characteristic of the goods or services. I consider the same to be the case for simple representations of common objects if they do not describe or allude to any characteristic of the goods or services. An umbrella is an everyday object and the device depicting an umbrella in the earlier mark is a simple, unstylised, umbrella. An umbrella in a trade mark, which is not for umbrellas or for goods or services relating to umbrellas, is likely to be understood as a metaphor for protection. An umbrella alludes to goods or services which provide a degree of protection for individuals or businesses. This is particularly pertinent considered against insurance services, which are the opponent's class 36 services and to which its class 41 services relate: insurance provides protection against unforeseen and unwanted events. Consequently, I consider that the umbrella device has a low to medium degree of inherent distinctive character. The other element of the earlier mark, TRAVELERS, does not improve matters for the opponent because it does not have a counterpart in the application (it is not directly descriptive of the opponent's services because they do not appear to cover travel insurance).

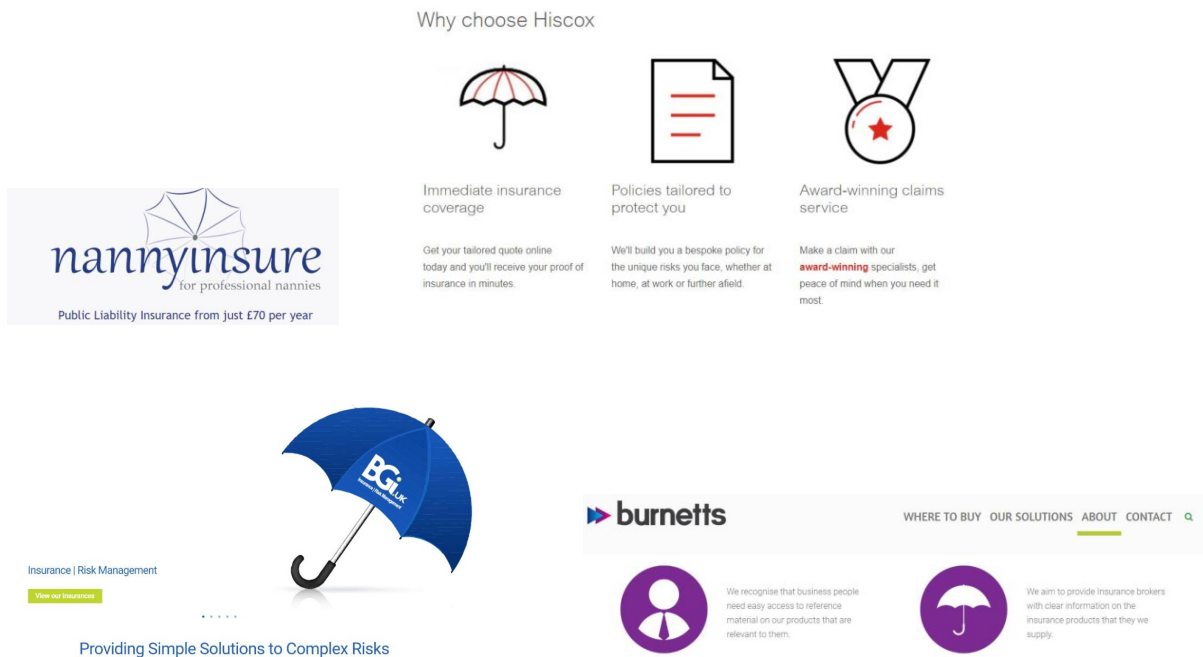
47. Having decided that the inherent distinctive character of the umbrella device is low to medium, I will now consider whether my view is altered by what the parties say about the distinctiveness of umbrellas in relation to insurance.

48. Mr Leigh, the applicant's Chief Executive Officer, states:

"I designed the Mark myself in 2016. I incorporated an umbrella as part of our logo because the notion of insurance is synonymous with 'protection' and 'cover' for rainy days, i.e. times of need or trouble in anticipation of which individuals and businesses purchase insurance cover. I was just starting the Got You Covered business at the time and I therefore set out to design a logo which would immediately communicate to consumers that we were in the business of providing insurance. I included an umbrella as part of the logo because the use of umbrella imagery was at that time, and remains, so widespread in the insurance industry."

49. To support this statement, Mr Leigh refers to Exhibit RJL-3, comprising a selection of forty-four third-party trade mark registrations, for unspecified services in class 36, all of which, except for a Bulgarian registration, were applied for prior to the date on which the contested application was filed (“the relevant date”). I note that many of these registrations are not UK registrations, or EU trade marks which at the relevant date would have covered the UK. The registrations all include an umbrella device of some kind.

50. Exhibit RJL-4 comprises screenshots dated between 2019 and 2021 (2021 is after the relevant date) which Mr Leigh states show the use by third parties of umbrella devices in and or in relation to the UK insurance industry. The examples dated prior to the relevant date are as follows:





51. This evidence is not well-marshalled. Seventeen of the forty-four registrations in Exhibit RJL-3 derive from the UK or the EU trade mark office (as opposed to national rights in individual EU member states). However, there are quite a few duplications of essentially the same mark. There are only ten individual marks which can be attributed to the UK or the EU trade mark office. There is no information about what services are covered in class 36. There is no information about whether these marks were present on the UK market at the relevant date.¹¹ None of them appear in the screenshots shown above (marks or signs which were present on the market prior to the relevant date). 'Legal & General' marks appear in Exhibit RJL-3, but those that appear as screenshots in Exhibit RJL-4 date from 2021, the year after the relevant date (the applicant places significance on the fact that Legal & General Group plc has also opposed the application). Exhibit RJL-4 contains only five uses of an umbrella device in relation to insurance. This is not enough to make a finding that umbrellas are so widespread as to have affected the inherent distinctive character of the

¹¹ See the decision of the GC, *Zero Industry Srl v OHIM*, Case T-400/06, at paragraph 73.

opponent's mark; or, rather, the common element which is the umbrella. Consequently, it is not necessary to examine in detail the opponent's reply evidence which details the steps it has taken to challenge various third-party applications and registrations which include umbrella devices.

52. Therefore, I remain of the view that the element of the earlier mark which is common to the application – the umbrella device – is of low to medium inherent distinctive character.

53. I will now look at whether the opponent's evidence entitles it to claim that the earlier mark's distinctive character has been enhanced through use made of it. Mr Britter's first witness statement gives details of the opponent's use of its mark. He states that the opponent's parent organisation, The Travelers Companies, Inc, has over 160 years of history in the insurance industry. However, it is clear from the rest of the witness statement that the opponent/its parent organisation has not operated in the UK for anywhere near as long as that. The evidence about its US history is irrelevant to the question of whether its distinctive character has been enhanced in the eyes of UK consumers. The date of first use of the earlier mark given for the UK is 2008.

54. Mr Britter exhibits extracts from the opponent's UK affiliate from between 2015 and 2019.¹² The gross written premiums for the UK business were:

2015 - £209.2m

2016 - £195.9m

2017 - £232.8m

2018 - £232.8m

2019 - £277m

55. Exhibit BNB2 comprises examples of advertising activity in the UK from 2016 to 2020, including:

¹² Exhibit BNB1

- An advertorial in The Law Society Gazette, 25 July 2016 about professional indemnity insurance for lawyers ;
- Advertisement in Insurance Post magazine, 25 February 2016 about the above services;
- Advertising on HFM Week, The Lawyer and Insurance Business websites, 7 September 2017, 10 July 2018 and 11 July 2019, which appear to relate to risk management but without any real detail as to the services offered;
- Use in a small format without any services detail on the websites of Insurance Times, The Lawyer, and Insurance Business, 29 November 2019, 5 September 2019 and 7 May 2020.

56. Exhibit BNB4 shows use of the mark at the bottom of an article in The Lawyer magazine, September 2017, about lawyers and professional indemnity insurance.¹³ An advertisement in the same magazine says that the opponent provides property, liability and professional indemnity insurance and risk solutions for the private, public and institutional sectors.¹⁴

57. The mark was used in sponsorship of ‘The Lawyer’ awards in 2016, 2017 and 2018 and 2019, held at the O2 and at Grosvenor House in London:¹⁵



¹³ Exhibit BNB4, page 66

¹⁴ Exhibit BNB4, page 71

¹⁵ Exhibit BNB3, pages 48 to 50, 52, and 54 to 56

58. The mark was also used in sponsorship of the 2018 HFM Week European Operational Leaders Summit.¹⁶ Mr Britter states that the opponent has been the title sponsor of the Travelers Championship, an annual PGA Tour event held in Connecticut, USA since 2007. He states that the competition is broadcast to more than 200 countries via satellite, cable and internet streaming and that fans from the UK 'can view' information about the even on the tournament's website. That UK residents 'can' view a website is usually the case: that is the nature of the internet. It does not mean that UK residents have viewed the website. Exhibit BNB5 is said to provide evidence of the level of exposure of the earlier mark in connection with the tournament and the various coverage of the event in the UK via Sky Sports. I note that the first page, referring to TV times and how to watch live on Sky Sports, is dated 28 June 2020, after the relevant date. However, other pages in the exhibit comprise screen shots from the Sky Sports website in 2016, 2017 and 2018, showing the mark (or a close variant of it) visible on hoardings alongside golfers and spectators. There are no details regarding viewing figures from the UK. I do not know enough about golf to understand whether the Connecticut event is likely to have been watched by enough UK consumers of the type of insurance services covered by the earlier mark's specification for it to have had an effect upon its distinctive character, and there is no evidence to assist me. In any event, the logo by itself does not tell the UK average consumer watching television what the product or service is that is offered by the sponsor.

59. Although this 'logo-only' problem could be said to be the case for the usage at legal awards and events, they are professional events at which the attendees are likely to know what type of insurance the sponsor/opponent provides. Indeed, the majority of the opponent's evidence is about professional indemnity insurance for the legal profession. The sponsorship of UK legal professional awards assists in showing that the mark had a reputation at the relevant date, but the golfing event evidence does not. Nor does the content of Exhibit BNB6, which is described by Mr Britter as examples of the opponent's commercials on the opponent's page on YouTube.com. There are no details as to viewing figures by UK consumers if, indeed, there were any views. It is not clear to me why anyone would log onto YouTube to watch commercials

¹⁶ Exhibit BNB4, page 51

and, if there is other content on the opponent's YouTube page which consumers may want to look at, and would therefore also see the commercials, this is not explained. This exhibit contains prints from the said YouTube page as well as some from Facebook, Twitter and LinkedIn. There are no figures as to how many followers or likes are from the UK. There are some dates for the Facebook, Twitter and LinkedIn pages, but not for all. Where there are dates, they are from just a few months, in 2020, prior to the relevant date.

60. The industry award sponsorship and the gross premium figures point to a successful business in the UK at the relevant date. I note that the Annual Reports refer to claims made for property damage; e.g. from storms, and one advertisement refers to various types of insurance. However, the rest of the evidence is almost entirely focussed upon professional indemnity insurance and risk management for legal professionals. The gross premium figures are not apportioned to different types of insurance. Distinctive character is a measure of how strongly the mark identifies the services of the opponent; determined, according to *Lloyd Schuhfabrik Meyer & Co.*, by assessing the proportion of the relevant public which, because of the mark, identifies the services as originating from a particular undertaking. As said earlier, the evidence is not well-marshalled; not well enough to support a finding of enhanced distinctive character across the specification of services. That said, given the high-profile sponsorship at major legal profession awards, I would be prepared to find that the distinctive character of the earlier mark as a whole is enhanced from low to medium (inherently) to above medium for legal professional indemnity insurance. The evidence is not detailed enough to make a finding at a level which is any higher than that. However, I am not even sure that, in view of the limitation to the opponent's services, that its class 36 specification covers such services. As will become clear, this makes no difference to the outcome of this decision.

Likelihood of confusion

61. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by

a greater degree of similarity between the trade marks, and vice versa. In this case, the parties' services range from identical to similar to a very low degree.

62. The dominant element of the earlier mark is TRAVELERS, which has no counterpart in the application. The application has two co-dominant elements, GOT YOU COVERED and the umbrella device. The only element which is common to both parties' marks are the umbrella devices, which are represented quite differently to one another, even if the umbrella in the earlier mark was notionally used in either red or black. The visual similarity is low, there is no aural similarity, and the only similar concept is the umbrella, resulting in low to medium conceptual similarity. The umbrella element is of only a low to medium level of distinctive character for the opponent's services and any enhancement to distinctive character is for the mark as a whole. I will assume in the opponent's favour that, contrary to my earlier findings, the earlier mark has enhanced distinctive character for all the services relied upon to a medium level. In my view, there would still be no likelihood that the marks would be so imperfectly recalled that they would be mistaken for each other, given the various differences between them, especially factoring the at least average and potentially high level of attention paid by average consumers in purchasing the parties' services.

63. I also find that average consumers are unlikely to consider that the parties' marks belong to the same or an economically linked undertaking, commonly referred to as indirect confusion.¹⁷ In *Duebros Limited v Heirler Cenovis GmbH*, Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. The very different visual representations of the common element, particularly the way in which the applicant's umbrella handle forms part of the U in YOU which is alien to the earlier mark, do not suggest a brand evolution, a sub-brand or an allied brand. In *Dirtybird Restaurants Ltd v. Salima Vellani*, BL O/413/18, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“18. There is no rule or presumption to the effect that the concurrent use of a trade mark and one of its components for identical or similar goods or services

¹⁷ See *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10.

will always or necessarily give rise to the perception that the goods or services concerned come from the same or economically linked undertakings. That might or might not be the case. In order to determine whether it is, the decision taker must give as much or as little significance to the visual, aural and conceptual differences and similarities between the marks in issue as the relevant average consumer would have attached to them at the relevant point in time (which in this case was July/August 2015). It is axiomatic that the relevant average consumer is to be regarded as reasonably well-informed and reasonably observant and circumspect. However, (s)he is not to be regarded as a person who normally engages in extended thought processes for the purpose of pairing and matching trade marks or actively considering how they might be developed or appropriated for use as siblings of other marks. Indirect confusion of the kind described by Mr Iain Purvis QC in paras. [16] and [17] of his decision in L.A. Sugar is a matter of instinctive reaction to precipitating factors rather than the result of detailed analysis, as emphasised by Mr James Mellor QC sitting as the Appointed Person in Duebros Ltd v Heirler Cenovis GmbH (BL O/547/17; 27 October 2017) at para. 81.”

64. For the average consumer to reach a conclusion that the undertakings responsible for the marks are linked, they would need to analyse the marks more than a reasonably observant and circumspect person would normally do and decide that the inclusion of different umbrella devices, which is of only low to medium distinctiveness, points to a common trade origin. I do not think that this is likely; it is stepping over the line of instinctive reaction to one of detailed analysis. There is no likelihood of confusion, either directly or indirectly.

65. That being the case, I do not need to assess whether the applicant’s evidence about its use of its application makes any difference to the likelihood of confusion.

Section 5(2)(b) outcome

66. The section 5(2)(b) ground of opposition fails.

Section 5(3) of the Act

67. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

68. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial

compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

69. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark is similar to the application. Secondly, that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

70. The first condition of similarity between the marks is satisfied: as found earlier in this decision, the earlier mark is visually similar to the application to a low degree; aurally dissimilar; and, conceptually similar to a low to medium degree.

71. The next condition is reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

72. For this ground, the opponent relies upon *insurance; information and advisory services relating to all the aforesaid; all of the foregoing related to property and casualty insurance (including surety)*. Although I bear in mind that the question relates to a knowledge requirement, similar issues arise here as in relation to enhanced distinctive character. The evidence is thin in respect of services other than professional indemnity insurance for legal professionals. Further, I am not sure that the registered specification covers such services and the question must be assessed in relation to services for which the earlier mark is registered, not some other reputation.¹⁸ Even if I were, to give the opponent its best chance, to proceed on the basis that it has met the reputation requirement in relation to all the services relied upon, I do not think that the marks are similar enough, even for identical services, for a link to be made. The only common element is too different visually, and conceptually is not strong enough to cause a mental image of the earlier mark to be recalled. At best, it would be a fleeting bringing to mind; too fleeting for any of the three types of damage. A discerning relevant public, or even one paying only an average level of attention, would not be more likely to buy the applicant's services, or less inclined to buy those of the opponent. The ground is not made out.

¹⁸ See *Tulliallan Burlington Ltd v EUIPO*, Case T-123/16, GC

Section 5(3) outcome

73. The ground of opposition under section 5(3) of the Act fails.

Section 5(4)(a) of the Act: passing off

74. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

75. The three elements which the opponent must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but

it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

76. The applicant has filed evidence that it has used its mark(s) prior to filing the application. This means that although the position must be assessed at the date when the applicant applied to register its series of trade marks, there may, potentially, also be an earlier relevant date.¹⁹

77. The sign relied upon by the opponent for this ground of opposition is the same as the earlier registered mark. In contrast to the other two grounds of opposition, the opponent relies upon goodwill generated by use of the sign in relation to the wider term ‘insurance services’, which covers professional indemnity insurance services for lawyers (this being the focus of the opponent’s evidence, as found earlier).

78. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

79. Although I can make a finding that the opponent enjoyed goodwill at the application date in professional indemnity insurance for lawyers, this takes it no further forward than the section 5(2)(b) ground, where it could rely upon notional and fair use of identical services. For the same reasons as there would be no likelihood of confusion, a substantial number of the opponent’s customers would not be deceived.²⁰ Although the average consumer test is not strictly the same as the ‘substantial number’ test, in the light of the Court of Appeal’s judgment in *Comic Enterprises Ltd v Twentieth*

¹⁹ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person.

²⁰ *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473.

Century Fox Film Corporation [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. I remain of the view that the opponent's customers (or potential customers) will not engage in an analysis which brings them to a conclusion that the different umbrella in the application signifies the opponent's services, or those of a business connected with the opponent. The opponent's sign and the application contain too many differences. The ground is not made out. Consequently, it is unnecessary to look at the applicant's evidence of use.

Section 5(4)(a) outcome

80. The ground of opposition under section 5(4)(a) of the Act fails.

Overall outcome

81. The opposition fails.

Costs

82. The applicant has been successful and is entitled to a contribution towards its costs.²¹ I bear in mind that it was unrepresented when it filed the form TM8 and so I have made some adjustment to the scale figure for filing the TM8. I make no award for the 'state of the register/market' evidence as it did not assist and I reduce the overall evidence award for the trouble to which the opponent was put by this particular evidence, necessitating evidence in reply. The breakdown of the cost award is as follows:

Considering the notice of opposition and
filing the counterstatement

£100

²¹ Tribunal Practice Notice 2/2016.

Considering the opponent's evidence and filing evidence	£300
Filing written submissions in lieu of a hearing	£300
Total	£700

83. I order The Travellers Indemnity Company to pay to Got You Covered Limited the sum of **£700**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of October 2021

Judi Pike
For the Registrar,
the Comptroller-General