

O-274-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2643370  
BY HVA LTD TO REGISTER:**



**IN CLASSES 35 & 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 400020 BY  
CAROLE NASH INSURANCE CONSULTANTS LIMITED**

## BACKGROUND

1. On 23 November 2012, HVA Ltd (“the applicant”) applied to register the mark shown on the cover page of this decision. The application was published for opposition purposes on 28 December 2012, for the following services:

**Class 35** - Advertising; business management; business administration; office functions; data storage relating to business; organisation, operation and supervision of loyalty schemes and incentive schemes; advertising services provided via the Internet; radio and television advertising; accountancy; conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes; opinion polling; data processing; provision of business information.

**Class 42** - Arranging and conducting specialist inspections of buildings; arranging and conducting property surveying; assessing energy efficiency and consumption of buildings; assessing CO2 emissions of buildings; advisory and consultancy services relating to energy use and CO2 emissions, energy consumption, energy saving, energy efficiency and energy conservation; energy auditing; consultancy and advisory services relating to all the aforesaid.

2. The application was opposed by Carole Nash Insurance Consultants Limited (“the opponent”) initially on the basis of sections 5(2)(b), 5(3), 5(4)(a), 5(4)(b) and section 56 of the Trade Marks Act 1994 (“the Act”). However, as the opponent elected not to file any evidence in these proceedings, the Trade Marks Registry (“TMR”), in an official letter dated 8 October 2013, advised the parties that the opposition would be deemed withdrawn in respect of all grounds other than that based upon section 5(2)(b). Insofar as the opposition based upon section 5(2)(b) is concerned, the opposition is directed against all of the services in the application with the opponent relying upon all the goods and services in the following Community Trade Marks (“CTM”) registrations:

(1) No. 6453559 of the trade mark **JUST** which was applied for on 20 November 2007 and for which the registration process was completed on 15 April 2009.

**Class 9** - Electronic publications; downloadable electronic publications and information provided on-line from databases or the Internet; electronic publications recorded on computer media; computer software for use in making credit, lending and insurance decisions.

**Class 16** - Printed matter; printed publications; information booklets and leaflets; magazines; periodical publications; books; brochures; stationery; newsletters; posters and pamphlets; bumper stickers; stickers; greeting cards; wrapping and packaging materials; diaries; calendars; advertising and promotional material.

**Class 35** - Advertising and marketing services; promotional services; business management; business administration; computerised database management; systemisation of information into computer databases; business information services; market analysis; business management consultation; preparing business reports; promotion of financial and insurance services, on behalf of third parties; dissemination of advertising matter; management of customer loyalty, incentive or promotional schemes; information, advisory and consultancy services relating to all the aforesaid.

**Class 36** - Insurance services; financial services; assurance services; insurance underwriting services; brokerage services relating to insurance; financial services relating to motor land vehicles and motorcycles; arranging of insurance; insurance claims handling services; administration of insurance plans; assessing and processing insurance claims; computerised processing of insurance claims and payment data; claims adjustment in the field of insurance; provision of insurance premium quotations; financial sponsorship services; consultancy, information and advisory services relating to the aforesaid services.

(2) No. 6452924 for the mark:



which was applied for on 20 November 2007 and for which the registration process was completed on 12 November 2008. Save for insignificant differences in classes 16 and 35, this mark is registered for the same goods and services shown above.

3. In its Notice of opposition, the opponent states:

“[CTM no. 6453559] is wholly contained with the applicant’s mark and represents the dominant and distinctive element of the applicant’s mark. Used in relation to the services applied for, the applicant’s mark is likely to give rise to confusion on the part of the public as to whether the applicant’s services are provided by or connected with the opponent and, in particular, whether the applicant’s services are, in fact, an extension of the opponent’s goods and service offering.”

And:

“The dominant element JUST [in CTM no. 6452924] is wholly contained with the applicant’s mark and represents the dominant and distinctive element of the applicant’s mark...[as above].”

And:

“...The [applicant’s mark] and the earlier marks are confusingly similar from a visual, phonetic and conceptual viewpoint since [the applicant’s mark] includes the word JUST, together with other non-distinctive, descriptive elements, which is visually and conceptually identical to the opponent’s JUST trade mark and which forms the dominant element of [CTM no. 6452924].”

I will return to the opponent’s comments on the similarity in the competing goods and services later in this decision.

4. The applicant filed a counterstatement which consists, in essence, of a denial of the grounds upon which the opposition was based.

5. Only the applicant filed evidence. Whilst neither party asked to be heard, the applicant filed written submissions in lieu of attendance at a hearing. I will return to these submissions, as necessary, below.

## **EVIDENCE**

6. This consists of a witness statement accompanied by three exhibits from Robert Hawley, a trade mark attorney at Mathys & Squires LLP, the applicant’s professional representatives. I do not propose to summarise this evidence here but will refer to it as necessary below.

## **DECISION**

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

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

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

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

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. In these proceedings, the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As neither of the earlier trade marks had been registered for more than five years when the application was published, the earlier trade marks are not, despite the applicant’s request, subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

### **Section 5(2)(b) – case law**

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

### **The CJEU cases**

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

### **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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

## Comparison of goods and services

11. In these proceedings, the opponent is relying upon the two marks shown in paragraph 2 above. Later in this decision I will explain why, in my view, no. 6453559 offers the opponent the best prospect of success. However, I mention it here, because it is on the basis of this registration that the following comparison is made. The competing goods and services are as follows:

<b>Opponent's goods and services (based upon CTM no. 6453559)</b>	<b>Applicant's services</b>
<p><b>Class 9</b> - Electronic publications; downloadable electronic publications and information provided on-line from databases or the Internet; electronic publications recorded on computer media; computer software for use in making credit, lending and insurance decisions.</p> <p><b>Class 16</b> - Printed matter; printed publications; information booklets and leaflets; magazines; periodical publications; books; brochures; stationery; newsletters; posters and pamphlets; bumper stickers; stickers; greeting cards; wrapping and packaging materials; diaries; calendars; advertising and promotional material.</p> <p><b>Class 35</b> - Advertising and marketing services; promotional services; business management; business administration; computerised database management; systemisation of information into computer databases; business information services; market analysis; business management consultation; preparing business reports; promotion of financial and insurance services, on behalf of third parties; dissemination of advertising matter; management of customer loyalty, incentive or promotional schemes; information, advisory and consultancy services relating to all the aforesaid.</p> <p><b>Class 36</b> - Insurance services; financial services; assurance services; insurance</p>	<p><b>Class 35</b> - Advertising; business management; business administration; office functions; data storage relating to business; organisation, operation and supervision of loyalty schemes and incentive schemes; advertising services provided via the Internet; radio and television advertising; accountancy; conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes; opinion polling; data processing; provision of business information.</p> <p><b>Class 42</b> - Arranging and conducting specialist inspections of buildings; arranging and conducting property surveying; assessing energy efficiency and consumption of buildings; assessing CO2 emissions of buildings; advisory and consultancy services relating to energy use and CO2 emissions, energy consumption, energy saving, energy efficiency and energy conservation; energy auditing; consultancy and advisory services relating to all the aforesaid.</p>

underwriting services; brokerage services relating to insurance; financial services relating to motor land vehicles and motorcycles; arranging of insurance; insurance claims handling services; administration of insurance plans; assessing and processing insurance claims; computerised processing of insurance claims and payment data; claims adjustment in the field of insurance; provision of insurance premium quotations; financial sponsorship services; consultancy, information and advisory services relating to the aforesaid services.	
---	--

12. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case 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.

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

"... 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."

14. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, in which the General Court (GC) stated:

"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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

15. In relation to complementary goods and services, the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

"82 It is true that goods are complementary if there is a close connection between them, 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48)."

16. In relation to complementarity, I also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test:

"20. In my judgment, the reference to "legal definition" suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither

necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

17. Finally, the comments of Jacob J in *Avnet Incorporated v Isoact Limited* [1998] FSR 16 are also relevant:

“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.”

18. In its notice of opposition, the opponent states:

**The services applied for in Class 35 under the Sign which include "Advertising; business management; business administration; office functions; data storage ... advertising services ..." are identical with the services protected in Class 35 by the Opponent's Earlier Marks and for which the Opponent enjoys earlier rights. The Class 35 services of the Application namely "provision of business information", are also similar and/or complementary to the goods of the Earlier Marks in Classes 9 and 16 since such information may be provided in paper or electronic form.**

**The services applied for in Class 42 under the Sign which include "specialist investigations of buildings ... property surveying ..."consultancy and advisory services relating to the aforesaid" are similar to or at the very least complementary to the services protected in Class 36 of the Opponent's earlier marks and for which the Opponent enjoys earlier rights.**

**The goods protected in Classes 9 and 16 by the Opponent's Earlier Marks and for which the Opponent enjoys earlier rights are all similar and/or complementary to the services in Classes 35 and 42 covered by the Sign, since they are goods necessary for the provision of these services, for example electronic publications and printed matter.**

19. In its written submissions, the applicant admits that “advertising services”, “business management”, “business administration” and “office functions” (the latter of which only appears in the class 35 specification of no. 6452924) are identical. In his witness statement, Mr Hawley states:

“6. However, it is not admitted that there is identity or similarity in respect of any other of the parties' goods and services. In particular, the opponent has not put forward any evidence of fact to support/prove its supposition that goods in classes 9 and 16, and services in class 36 are (or are likely to be regarded as) confusingly similar to the applicant's services in class 35 and/or that goods in classes 9 and 16, and services in classes 35 and 36 are (or are likely to be regarded as) confusingly similar to the applicant's services in class 42.”

20. Mr Hawley also refers to the TMR's Cross-Search list, relevant pages from which are provided as exhibit RJH-01.

### **Class 35**

21. The terms "advertising", "business management", "business administration" and "business information" appear in both parties' specifications and are identical. As the term "office functions" in the applicant's specification and "business administration" (which appears in both parties' specifications) both involve the provision of assistance to an undertaking in connection with its administrative tasks, the competing services are, if not identical, clearly similar to a high degree. Given the similarity in their respective users, intended purpose, method of use and complementarity, "Data storage relating to business" and "data processing" in the applicant's specification, is, if not identical, highly similar to "computerised database management; systemisation of information into computer databases" appearing in the opponent's specification.

22. As "Organisation, operation and supervision of loyalty schemes and incentive schemes" in the applicant's specification is simply an alternative way of describing the "management of customer loyalty, incentive or promotional schemes" which appears in the opponent's specification, these services are identical. As "advertising services provided via the Internet" and "radio and television advertising" are all sub-sets of "advertising" which appears in the opponent's specification, they are identical services on the principles outlined in *Meric*.

23. Given the similarity in their respective users, intended purpose, method of use and complementarity, the term "conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes" in the applicant's specification is, in my view, highly similar to (at least) "advertising and marketing services" and "promotional services" in the opponent's specification. As "opinion polling" appearing in the applicant's specification would be encompassed by, at least, "market analysis" appearing in the opponent's specification, these services are identical on the principles outlined in *Meric*.

24. That leaves "accountancy" services in the applicant's specification to consider. The opponent's mark is registered in class 36 for "financial services" at large. Such a wide phrase would include financial management, preparation of reports etc. which, as exhibit RJH-01 to Mr Hawley's statement indicates, the TMR considers to be similar to "auditing" in class 35. Although the TMR's Cross-Search list is only a guide, when one considers the similarity in the respective users, intended purpose, method of use and complementarity between the services highlighted in class 36, and as "auditing" services is a sub-set of accountancy services, there is, in my view, (at least) a reasonable degree of similarity between "accountancy" in the applicant's specification and the financial services in the opponent's specification in class 36.

## Conclusion in relation to class 35

**25. The applicant's services in this class are either identical, highly similar or similar to (at least) a reasonable degree to the opponent's services in this class.**

## Class 42

26. The opponent states that the applicant's services in this class are: "similar to or at the very least complementary to the services in class 36 of [its] mark." However, as the applicant points out, it does not identify why it considers these services to be similar, nor does it explain why it considers (if indeed it does) its services in class 35 are similar to the services in this class. That being the case, I have only the comparison with the opponent's goods in classes 9 and 16 (which the opponent explains) and its services in class 36 (which the opponent does not explain) to consider.

27. Insofar as the clash between the opponent's goods in classes 9 and 16 and the applicant's services in this class are concerned, the opponent submits that its goods are: "all similar and/or complementary" to the applicant's services: "since they are goods necessary for the provision of these services, for example, electronic publications and printed matter." Having applied the case law mentioned above and in particular the guidance in *Boston Scientific/LOVE*, the mere fact that the provision of any service is likely to be supported by a range of, inter alia, documentation in both electronic and paper format, does not, without more, for example, a positive indication that the documentation concerned relates to the same field of activity as the services in question, make, in my view, the opponent's goods in classes 9 and 16 similar/complementary in any meaningful way to the applicant's services in this class.

28. As to the opponent's services in class 36, in its notice of opposition, the opponent states the applicant's services in this class "which include "specialist investigations of buildings...property surveying...consultancy services relating to the aforesaid" are similar to or at the very least complementary to the services protected in class 36...". However, as I mentioned above, it does not explain why it considers this to be the case.

29. In its notice of opposition, the opponent explains it is a:

"UK company involved primarily in the insurance industry. The company is one of the largest brokers of motorcycle insurance in the United Kingdom..."

30. For the most part, its specification in class 36 reflects this statement i.e. "Insurance services; insurance underwriting services; brokerage services relating to insurance; financial services relating to motor land vehicles and motorcycles; arranging of insurance; insurance claims handling services; administration of insurance plans; assessing and processing insurance claims; computerised processing of insurance claims and payment data; claims adjustment in the field of insurance; provision of insurance premium quotations. Having applied the case law mentioned above and

having reminded myself of the comments in *Avnet*, I cannot (without further explanation) see any meaningful relationship between the insurance services mentioned and the services of the applicant. Although the opponent's specification in class 36 includes the broad terms "financial services" and "assurance services", once again, I am not, in the absence of an explanation from the opponent as to why these services should be considered similar to those of the applicant, prepared to conclude that they are. That leaves "financial sponsorship services" and "consultancy, information and advisory services relating to the aforesaid services" to consider. The former are, in my view, self evidently, not similar to any of the applicant's services. As far as the latter is concerned, as I have already concluded that the services to which they relate are not similar, it follows that they too are not similar.



### **The average consumer and the nature of the purchasing decision**

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

32. The key services at issue in these proceedings are, broadly speaking, a range of: (i) business related services in class 35, (ii) financial primarily, insurance services in class 36, and (iii), building inspection services in class 42. Whilst the average consumer of the services in class 35 is more likely to be a business user, the average consumer of the services in classes 36 and 42 will be both business users and members of the general public. As to how such services will be selected, I have the applicant's evidence and my own experience to assist me. The applicant's evidence shows that both parties have websites showing the services which they provide. This is not surprising and supports my own view that the services at issue in these proceedings are, most likely, to be selected by the eye having inspected marketing documents, reviews etc. either in paper form or on-line. Whilst oral/aural considerations may also play a part in the selection process, in the absence of evidence to the contrary, it is the visual aspect of the competing marks that is, in my view, likely to dominate the selection process. As to the degree of care that is likely to be taken when selecting the services at issue, I would expect, given the potential importance as well as the not insignificant sums that are likely to be in play when a business user is selecting, for example, an undertaking to store its data or to arrange a trade show on its behalf, an above average degree of attention to be paid. Similarly a business user or, in my experience, a member of the public will pay an above average degree of attention when selecting insurance services of any kind as they will when selecting an undertaking to assess, for example, the energy efficiency of their homes or, in the case of a business user, their commercial properties.

## Comparison of marks

33. The marks to be compared are:

Opponent's marks	Applicant's mark
<p>JUST</p> 	

34. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

### Distinctive and dominant components

35. In these proceedings, the opponent is relying upon the two trade marks shown above. As no. 6452924 contains both a dominant and distinctive device element and the descriptive words "Motorcycle Insurance", it is no. 6453559 consisting of the word JUST alone which, as I mentioned earlier, offers the opponent the best prospect of success, and it is this mark I will use for the purposes of the comparison. If the opponent does not succeed in relation to the word JUST alone, it cannot, in my view, be in any better position in relation to CTM no. 6452924.

36. As the opponent's mark consists exclusively of the word JUST presented in upper case, there are no dominant elements; any distinctiveness lies in the mark as a whole. Turning to the applicant's mark, this consists of a number of elements. The first element is a device consisting of three parallelograms presented in red, orange and yellow respectively. Although somewhat smaller than the elements which accompany it, it is, as far as I am aware, a distinctive element, and, as it appears at the beginning of the mark, it is also, in my view, a dominant element of the mark. The second and third elements are the word "Just" in title case presented in green and the letters EPC in upper case presented in red and with the letters E and P elided. Although the letters EPC are slightly larger than those in the word Just, the difference is, in my view,

minimal. As the applicant's mark is presented in the colours mentioned above, the comments of Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) are relevant. As the earlier mark is not limited to colour, the colours in which the applicant's mark appears is not relevant and it will, as per the comments of Mann J, be drained of colour for the purposes of the comparison of the respective marks.

37. As to the distinctiveness of the word JUST, I note that in *Bignell v Just Employment Law Ltd* - [2008] FSR 6, Mr Robert Englehart QC sitting as a deputy judge concluded that the words "Just Employment" were descriptive of, inter alia, legal services relating to employment matters. The TMR's approach to trade marks containing the word "Just" has been drafted with this decision in mind and indicates that trade marks containing, inter alia, the word "Just" can mean, inter alia, we specialise in (Just Education) or to denote purity (JUST JUICE) or to mean all that is required (JUST PLUG IT IN). Equally the practice indicates that:

"...this practice will not be applied blindly, and trade marks containing words such as "just" and "simply" will be assessed in their totality."

38. When considered in the context of an undertaking trading in any goods and services, the word Just alone is, in my view, most likely to indicate to the average consumer that the undertaking concerned specialises in a particular area of trade (for example, books, advertising, insurance, energy services etc.) As a consequence, any distinctive character the word JUST alone possesses is, in my view, likely to be very limited. As to the letters EPC, exhibit RJH-02 to Mr Hawley's witness statement indicates that the letters EPC in the applicant's mark are intended as a reference to "Energy Performance Certificates". I note from [www.gov.uk/buy-sell-your-home/energy-performance-certificates](http://www.gov.uk/buy-sell-your-home/energy-performance-certificates), that an Energy Performance Certificate is required whenever a property is built, sold or rented and contains information relating to a property's energy use, typical energy costs, recommendations about how to reduce energy use and save money and gives a property an energy efficiency rating from A (most efficient) to G (least efficient) and it is valid for 10 years. That being the case, the letters EPC in the applicant's mark is, in my view, clearly descriptive when considered in relation to all of the applicant's services in class 42 and to any services in class 35 which may relate to EPCs. The word "Just" and the letters "EPC" in the applicant's mark "hang together" (in the same way that "Just" and "Employment" hangs together in the case mentioned above), and will be understood by the average consumer as a descriptive reference to an undertaking which specialises in services relating to Energy Performance Certificates. As a consequence, they are not, despite being a dominant element of the applicant's mark, a distinctive element when considered in relation to all of the services in class 42 and to any services in class 35 which may relate to EPCs. However, when considered in the context of services in class 35 for which the letters EPC are distinctive, the word Just and letters EPC still, in my view, hang together but in so doing create a meaningless combination, the totality of which is both an independent and distinctive element of the applicant's mark.

## **The visual, aural and conceptual comparison**

39. The applicant's mark contains a device element which appears at the beginning of the mark and the letters EPC, both of which are alien to the opponent's mark. Although both marks contain/consist of the word Just/JUST, the degree of visual similarity between the competing marks is, as a consequence, in my view, at best, moderate. As to the aural comparison, it is well established that that it is by the words in marks by which the average consumer is most likely refer to it. Notwithstanding the inclusion in the applicant's mark of the letters EPC, the inclusion of the word Just/JUST as the only/first word in both parties' marks will result in a somewhat higher level of aural than visual similarity between them. Finally, insofar as conceptual similarity is concerned, the applicant's mark will, in relation to all of the services in class 42 and to those services in class 35 which may relate to EPCs, send the clear conceptual message I have identified above i.e. we specialise in services relating to Energy Performance Certificates. As the word Just alone is, in my view, most likely to be understood by the average consumer to mean "only", it is likely to result in a degree of conceptual similarity between the competing marks. However, the much more specific and very clear conceptual message conveyed by the applicant's mark results, in my view, in no more than a reasonable degree of conceptual similarity between them. As to the degree of conceptual similarity between the competing marks in circumstances in which the letters EPC will be distinctive, as the combination Just EPC is unlikely to create any concrete message in the average consumer's mind, the only concrete conceptual message is likely to be triggered by the use of the word Just, resulting in a higher degree of conceptual similarity overall.

## **Distinctive character of the opponent's earlier trade mark**

40. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As the opponent has not filed any evidence in these proceedings, I have only the inherent characteristics of its mark to consider.

41. The word JUST is an English dictionary word with a range of meanings that will be well known to the average consumer. I have already concluded that when considered alone, the word JUST (meaning, inter alia, we specialise in) is likely to have limited distinctive character for a wide range of goods and services. Whilst it is clear from the decision of the CJEU in Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*, that it is not permissible for me to regard the opponent's earlier mark



as having no distinctive character, the word JUST must, in my view, and absent use, be possessed of an extremely low degree of inherent distinctive character.

### **Likelihood of confusion**

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

- the average consumer of the key services at issue is either a member of the general public or a business user who is likely to select the services by predominantly visual means and who is likely to pay an above average degree of attention when doing so;
- the applicant's services in class 35 are either identical, highly similar or similar to a reasonable degree to those of the opponent in classes 35 and 36;
- the applicant's services in class 42 are not similar to any of the opponent's goods and services in classes 9, 16 and 36;
- the opponent's mark has no dominant element, any distinctiveness lying in the mark as a whole;
- the device element in the applicant's mark is both a distinctive and dominant element of its mark in relation to all the services applied for;
- whilst the word and letters Just EPC hang together and are a dominant element of the applicant's mark, they are not distinctive for any services relating to EPCs;
- the competing marks are visually similar to a moderate degree, aurally similar to a somewhat higher degree and there is (at worst) a reasonable degree of conceptual similarity;
- whatever inherent distinctive character the opponent's mark possesses, must be extremely low.

43. There must be at least some similarity between the opponent's goods and services and those of the applicant to engage the test for likelihood of confusion. As I have

concluded that there is no similarity between the goods and services of the opponent and those of the applicant in class 42, the opposition directed at this class falls at the first hurdle and is dismissed.

44. Turning now to class 35, I have found that the word and letters Just EPC in the applicant's mark hang together and send a descriptive message in relation to those services in this class which relate to EPCs. For those services for which the word and letters Just EPC are not descriptive, I still concluded they hung together, but in doing so created a distinctive combination. The only similarity between the competing marks is the word Just, which, in relation to the majority of the services in this class performs a descriptive function in the applicant's mark; in relation to those services to which it contributes to a distinctive totality, it does not, in my view, play an independent distinctive role within the applicant's mark. Having also concluded that the opponent's earlier mark is of extremely low inherent distinctive character, I can see absolutely no reason (in either scenario) why this shared element of the competing marks will lead the average consumer to assume that the services of the applicant originate from the opponent or an undertaking economically linked to them. As a consequence, there will, in my view, be no likelihood of confusion in relation to any of the services in class 35.

### **Conclusion**

**45. The opposition to the application fails, and subject to any successful appeal, the application will proceed to registration.**

### **Costs**

46. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent's statement:	£400
Evidence:	£300
Written submissions:	£200
<b>Total:</b>	<b>£900</b>

47. I order Carole Nash Insurance Consultants Limited to pay to HVA Ltd the sum of **£900**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17th day of June 2014**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**