

O-428-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2654010
BY PARKER WHITE CONSULTING LIMITED
TO REGISTER THE SERIES OF TWO TRADE MARKS**

parker ● white

parker ● white

**IN CLASSES 35 & 45
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 400869 BY
MR DIPAK PATEL**

BACKGROUND

1) On 7 December 2012, Parker White Consulting Limited (hereinafter the applicant) applied to register the series of two trade marks shown on the front page in respect of the following services:

In Class 35: Advertising services relating to the recruitment of personnel; personnel recruitment advertising; recruitment advertising; advertising of commercial or residential real estate; personnel recruitment agency services; personnel recruitment services; professional recruitment services; recruitment and placement services; employment recruitment; business administration services; business operation, business administration and office functions; office administration services [for others]; employment conselling and consultancy services; recruitment consultancy services; compilation and systemisation of information into computer databases; compilation of computer databases; databases management services; payroll advisory services; payroll assistance; payroll preparation; payroll processing services [for others]; wage payroll preparation; temporary personnel employment services; temporary personnel services; business management services relating to the development of business.

In Class 45: Vetting Services.

2) The application was examined and accepted, and subsequently published for opposition purposes on 21 June 2013 in Trade Marks Journal No.2013 / 025.

3) On 19 September 2013 Mr Dipak Patel (hereinafter the opponent) filed a notice of opposition. The ground of opposition is in summary:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Date of application / registration	Class	Specification relied upon
PARKER LLOYD	2330447	25.04.03 24.10.03	35	Accountancy, business management, business administration, office functions, data processing.

b) The opponent contends that the mark in suit is confusingly similar to his registered trade mark. He states that the services applied for in the mark in suit are similar or identical to the services relied upon, as shown above. The mark in suit therefore offends against Section 5(2)(b) of the Act.

4) On 23 December 2013, the applicant filed a counterstatement denying the ground of opposition. The applicant put the opponent to strict proof of use of his mark upon the services relied upon. It also contended:

“17. It is therefore unclear under which services, and on what basis the Opponent is objecting to the registration of the Applicants mark under the requirement for there to be identical or similar goods or services already registered.

18. Notwithstanding the Applicants contentions under paragraph 17, the Applicant recognises the duplicate services between the two marks and the potential similarity between the services such as payroll processing and accountancy, but would submit that the service 'accountancy' as registered under the Opponents mark is too general to be considered similar to the payroll services claimed under the Applicants mark.

19. The Applicant would suggest that, to the public, there would be an expectation of an accountancy firm and a recruitment consultancy; providing work to temporary workers, being engaged in business administration, office functions and indeed any form of payroll processing and pay services as an industry standard. It would therefore follow that the provision of such services is not industry specific, or indeed company specific so as to be eligible for general restriction under the registration of a Trademark.

20. The Applicant therefore submits that there is not sufficient similarity between the goods and services claimed between the marks so as to fall foul of s5 2(b) of the Act.

Channels of Trade and Distribution

21. As stated the Opponent is a Chartered Accountant based in London. The Applicant is a Recruitment Consultancy based in Bristol specialising in the IT and Manufacturing industries.

22. Whilst the Applicant deals with clients and applicants nationally, the Applicant would suggest that both companies are significantly separated by both geography and the business market place.

23. The Applicant submits that there is therefore very little chance of the general public coming across both companies during the normal course of business, therefore further limiting the chance of confusion between the two marks as required under the Act.”

5) Only the opponent filed evidence. Both sides request costs. Neither side wished to be heard in the matter, only the applicant provided written submissions.

OPPONENT’S EVIDENCE

6) The opponent himself filed a witness statement, dated 3 March 2014. Mr Patel states that he is the proprietor of Parker Lloyd a position he has held since September 1996.

He states that the mark was first used in 2003 and has been used subsequently on accountancy services. He states that in the years 1996-2013 annual turnover has varied between £70,000-£300,000 and that in the years 2000-2010 annual spend on advertising has varied between £120-£300. He provides copies of two letters, dated 17 January 2014 and 7 February 2014 which appear to relate to accounts for clients.

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

8) The only ground of opposition is based on section 5(2)(b) which reads:

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

(a)

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

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

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

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

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

10) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The opponent has been put to strict proof of use by the applicant. Section six of the Act states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

11) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made. In the instant case the publication date of the application was 21 June 2013, therefore the relevant period for the proof of use is 22

June 2008 – 21 June 2013. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed person O-371-09 *SANT AMBROEUS*:

“(a) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(b) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(c) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(d) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(i) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(ii) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(e) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(f) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For

example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

12) The evidence of the opponent is sparse to say the least. The two exhibits are both dated after the relevant period. There is confusion over when the first use occurred with different dates being provided. All I have to go on is the bold statement that turnover in accountancy services in the relevant period is said to be between £70,000 and £300,000 per annum with between £120 to £300 spent annually on advertising of an unspecified nature. Whilst I accept that his evidence has not been challenged I do not consider this sufficient to meet the onus which is placed upon the opponent to make a prima facie case. To my mind the opponent has failed to discharge the onus to show that he has used his mark upon the services relied upon in the opposition, as such it has no services which it can rely upon for the comparison test and **the opposition therefore fails.**

13) However, in case I am wrong on this I will go on to consider the matter fully, on the basis that the only services in the opponent’s specification that it can rely upon in the comparison test are accountancy services as these are the only services referred to in its evidence. From paragraph 21 of its counterstatement (see paragraph 4 above) it would appear that the applicant accepts this position. When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU in *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, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *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 (LIMONCELLO)* and *Bimbo SA v OHIM* C591/12P. The principles which emerge from these cases are:

“(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) however, it is also possible that, in a particular case, an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks 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.”

14) Taking the above case law and principles into account, the test I have to apply in considering an objection under section 5(2)(b) is whether there are similarities in the respective marks and services which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the services, the category of services in question and how they are marketed.

Comparison of services

15) The General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05, said:

“...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...”

16) The same principle applies equally to services. In its counterstatement the applicant stated:

“the Applicant recognises the duplicate services between the two marks and the potential similarity between the services such as payroll processing and accountancy, but would submit that the service 'accountancy' as registered under the Opponents mark is too general to be considered similar to the payroll services claimed under the Applicants mark”.

17) The term “accountancy services is very wide ranging and I bear in mind the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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) Taking a very simplistic and cursory approach I consider that the following class 35 services applied for could be identical or highly similar to the accountancy services of the opponent; “business administration services; business operation, business administration and office functions; office administration services [for others]; payroll advisory services; payroll assistance; payroll preparation; payroll processing services [for others]; wage payroll preparation”. I take this stance as to my mind “accountancy services” could encompass payroll services and it is reasonably common for accountancy companies to offer administration functions.

19) The following services which form part of the application are clearly dissimilar to accountancy services.

In Class 35: Advertising services relating to the recruitment of personnel; personnel recruitment advertising; recruitment advertising; advertising of commercial or residential real estate; personnel recruitment agency services; personnel recruitment services; professional recruitment services; recruitment and placement services; employment recruitment; employment conselling and consultancy services; recruitment consultancy services; compilation and systemisation of information into computer databases; compilation of computer databases; databases management services; temporary personnel employment services; temporary personnel services; business management services relating to the development of business.

In Class 45: Vetting Services.

The average consumer and the nature of the purchasing process


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

21) The respective services are all in the financial/business administration field and as such are likely to be chosen with a great deal of care. Whether it is payroll services, the production of accounts or business administration these are services which will initially be chosen from advertising either in magazines or on the internet or by word of mouth recommendation. Subsequently a meeting would be required in order to finalise details. These types of services could be required by businesses at all levels of the spectrum as well as individuals who may be self employed.

Comparison of marks

22) 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.

23) For ease of reference, the marks to be compared are:

Applicant's mark	Opponent's mark
 <p>A series of two marks.</p>	<p>PARKER LLOYD</p>

24) Both marks consist of two words, neither of which are portrayed in a manner different from the other word in the mark. The applicant's mark also has a dot device between the two words which whilst it will be noticed by the average consumer will be thereafter broadly ignored. The words "Parker", "White" and "Lloyd" are very common

surnames. As far as I am aware, none of the words has a meaning in relation to the services involved in the instant case. The marks share the initial first word “Parker” but are thereafter quite different. There is clearly a degree of visual and aural similarity but equally visual and aural differences. Conceptually both indicate a business partnership between two individuals.

Distinctiveness of the earlier mark

25) I must also assess the distinctive character of the earlier mark which can be appraised only, first, by reference to the services for which it is registered 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 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 mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

26) Given the paucity of the opponent’s evidence of use of its earlier mark, I am unable to find that its distinctiveness has been enhanced through use. I am willing to accept that it is a mark with an average degree of inherent distinctive character.

Likelihood of confusion

27) In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. I also have to factor in the distinctive character of the earlier mark as the more distinctive it is the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she has retained in mind.

28) I have found that some of the respective services are identical or highly similar and that the respective marks have a degree of similarity which is at least equalled by their differences. I also found that some of the services were dissimilar and therefore there cannot be a likelihood of confusion (*Wedgewood*). Consumers are used to differentiating individuals by their surnames and the same applies to businesses where two surnames are used to identify the origin of the services. Taking all matters into account, I have no hesitation in finding that there is no likelihood of direct confusion or even indirect confusion in respect of all services of the application.

CONCLUSION

29) The opponent has failed in its opposition under Section 5(2)(b).

COSTS

30) As the opposition has failed the applicant is entitled to a contribution towards its costs, albeit reduced as it was not professionally represented.

Preparing a statement and considering the other side's statement	£200
Considering the opponent's evidence	£100
Preparing submissions	£300
TOTAL	£600

31) I order Mr Dipak Patel to pay Parker White Consulting Limited the sum of £600. This sum 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 7th day of October 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**