

O-244-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3109448
BY JVM VENTURES LIMITED**

TO REGISTER THE TRADE MARK:

WHITESPACE

IN CLASSES 35 AND 36

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000296
BY JONATHAN CARRIER**

BACKGROUND

1. On 19 May 2015 JVM Ventures Limited (the applicant) applied to register the mark shown on the cover page of this decision in respect of services in classes 35 and 36.
2. The application was published for opposition purposes on 26 June 2015, following which Jonathan Carrier filed notice of opposition under the fast track opposition procedure.
3. The opposition is based on Section 5(2)(b) of the Trade Marks Act 1994 (the Act) and is directed against all of the services in the application.
4. Mr Carrier relies on his earlier UK Registered Trade Mark no. 3039793



which has a filing date of 28 January 2014 and was registered on 23 May 2014 in respect of services in classes 35 and 42.

5. Mr Carrier argues that the services claimed by the applicant are identical or very similar to those covered by his mark, and that the marks are similar. The applicant filed a counterstatement in which it denied the basis of the opposition.
6. Subsequently, the applicant filed a Form TM21B to amend its class 35 specification. For ease of reference, the parties' specifications (following amendment) are reproduced in the Annex A to this decision.
7. Mr Carrier was invited by the Registrar to comment on the above amendments and, whilst he did not do so, in his written submissions, he reiterated his position that the competing services are similar referring to the terminology of the amended specification specifically. Accordingly, I consider that the opposition is maintained against the full specification as amended.
8. Rules 20(1)-(3) of the Trade Marks Rules (TMR) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
9. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.
10. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal

with the case justly and at proportionate cost. Otherwise written arguments will be taken. A hearing was neither requested nor considered necessary. Both parties filed written submissions which I will refer to as necessary, below.

DECISION

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

“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”.

12. An earlier trade mark is defined in Section 6 of the Act, 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 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) Reference 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.”

13. Given its date of filing, Mr Carrier’s mark is an earlier mark in accordance with Section 6 of the Act. The earlier mark had not been registered for more than five years at the date on which the applicant’s mark was published meaning that the proof of use provisions contained in Section 6A do not apply. Mr Carrier can, as a consequence, rely upon its full specification as registered.

Section 5(2)(b) case law

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

15. In comparing the respective specifications, all the relevant factors should be taken into account. In *Canon*, Case C-39/97 the Court of Justice of the European Union (CJEU) stated at paragraph 23:

“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”.

16. In *Gérard Meric v OHIM*, Case T- 133/05 the General Court (GC) provided the following guidance which, while referring to goods, is equally applicable when considering the parties’ competing services:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

17. Other factors which may be considered include the criteria identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons limited (Treat)* [1996] RPC 281 for assessing similarity between goods and services:

- (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.”

18. I also bear in mind the decision in *Boston Scientific Ltd v OHIM*, Case T-325/06, where the GC stated that “complementary” means:

“...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”.

19. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

20. In *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 Jacob J stated:

“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.”

21. In *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch) Floyd J stated:

“12. There are sound policy reasons for this. 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) (IPTRANSLATOR)* [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. Both parties filed submissions in respect of the services to be compared. I reproduce Mr Carrier’s comments as given in his statement of grounds where he said: “the goods and services are identical. The application covers the class headings in classes 35, and covers all the goods and services within that class” and he made a number of comments about his business offering “consulting and a range of professional services relating to new venture activities in the automotive and transportation industry”. Further, in his written submissions he stated (again, reproduced as written):

“1.4. The opponent has not filed any evidence as the opponent believed that the application form, with the rationale provided was sufficient, reflecting an opposition against an application in the same class for the existing trade mark.

Grounds of opposition

3.1 The opponent believes there sufficient evidence in the comparison of services, independent of the sector. In Class 35 the evidence is supported by the specification of services: business management services; business strategic planning services; business investigations, analysis and research; business data analysis; providing industry insights, strategy guidance, business consulting, business management in the sectors of software development, artificial intelligence, information technology and the internet of things.

The automotive industry is undergoing significant transformation, having to transition from a product to a service based business model. The vehicles are increasingly connected and the market digital, as people consumer mobility through the smartphone. To develop these services requires direct application of services in the sector of software development, artificial intelligence and information technology. The car is now the connected car, and is a mobile device on four wheels.

The services do not exclude the automotive industry as presented by the applicant. Software, IT and AI are not industries and do not exclude the automotive industry.

Furthermore, there is sufficient evidence of venturing activity in the automotive industry, which indicates not only the new type of digital development taking place, but also the new type of business models that have to be developed. Specifically this relates to

The opponent submits as evidence the activities of BMV iVentures, GM Ventures and other automotive businesses that are actively involved in corporate venturing, investing in start-ups and establishing their own ventures. This directly relates to WHITESPACE and identifies overlap.

The opponent is currently applying his services directly for one of the UKs largest automotive businesses, in the space of developing start-up ventures for connected car, smart transportation and mobility alongside new vehicle concepts. This includes services such as car sharing, requiring new business models, together with the vehicle. For confidentiality and contractual reasons, the opponent is unable to divulge specific activities.

3.7 The services for the opponent existing trade-mark do not refer to marketing only services, also referring to business consulting, strategy development with the development, definition and positioning of new vehicles and concepts relating to the automotive market. This includes pricing, sales volume etc, as well as costs, requiring a strong financial and economic analysis. Marketing is by definition part of business strategy, as is product development..."

23. The applicant stated, inter alia:

“3.7. The Registered Services in Class 35 are all marketing services in nature. These services are typically offered to businesses by marketing consulting agencies. Such services focus on the analysis of customer behaviour and market trends. The purpose of such services is to assist businesses with product development and the promotion/advertising of such products.

3.3 The Applicant submits that the scope of protection conferred to the Registered Services is narrow and should not be unduly extended beyond the core of marketing services and automotive design and car development. Such services are neither identical nor similar to the Opposed Services.

3.4 The nature of the Opposed Services in Class 36 is financial and such services are typically provided by financial institutions or investors, their purpose is to make an investment, the methods of use will be investment following consultation with the provider. Such institutions/investors do not tend to provide marketing or product design or car development services. The purpose and nature of the Opposed Services in Class 36 are dissimilar to the purpose and nature of the Registered Services. The Applicant submits that the Opposed Services in Class 35 are dissimilar to the Registered Services in Class 35 because there is no direct connection between the Opposed Services in Class 35 and the Registered Services in Class 35, in the sense that one is indispensable for the use of the other....”

24. Mr Carrier’s argument, that since the applied for class 35 specification includes the class headings it covers all the possible services in that class, must be rejected as it is contrary to the UK Intellectual Property Office’s approach. This is set out at paragraph 3.9 of the Trade Marks Registry’s Work Manual which states that “when a class heading is used as a specification, it loses its capacity to function as a class heading and becomes part of an application or registration as a statement of goods or services”. Accordingly, in order to determine what is included in the applied for specification the question of what a class heading includes or does not include is irrelevant. I must consider only the services stated in the specification.

25. Mr Carrier also submitted that he had filed no evidence as he believed that “the rationale provided was sufficient, reflecting an opposition against an application in the same class for the existing trade mark”. The significance of classification and the relevance of class numbers have been considered by the courts in *Altecnic Ltd’s Trade Mark Application (CAREMIX)* [2002] RPC 639 and *Avnet Incorporated v Isoact Limited* [1998] FSR 16. In *Proctor & Gamble Company v Simon Grogan*, Ms Anna Carboni sitting as the Appointed Person, referred to *Altecnic* and said:

“ 34.The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd’s Trade Mark Application (CAREMIX)*. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.”

26. It is clear that the fact that both specifications cover the same class does not necessarily mean that the competing services are similar. Mr Carrier bases the comparison on his business and on alleged market practices, however, as pointed out by the applicant, this is not the correct approach. Since the earlier mark is not subject to proof of use, under Section 5(2)(b) I must consider the similarity of the services on the basis of the specifications as registered and applied for and what they cover in notional and fair use.

27. To come to a conclusion of whether the competing services are similar, I need to consider what are the core activities covered by the respective specifications and, as Jacob J stated in the *Treat* case, I have to construe what is covered by a term within the context of the trade. Some of the terms used in the specification are vague and I have no evidence to assist me but I will proceed on the basis that where I am able to establish that there is similarity, this is because I consider it to be self-evident¹. I will make the comparison by addressing each of the terms within the specification of the application in turn, and, where appropriate grouping terms together² and I will also bear in mind the effect, if any, of the limitation '*relating to the automotive industry*' in the specification of the earlier mark. However, if I am silent on this point, this is because I consider that the applicant's services could equally relate to the automotive sector.

The limitation in the class 35 specification of the earlier mark

28. Before moving on to the comparison of services, it is necessary for me to consider how the specification of the earlier mark should be construed. The class 35 services of the earlier mark cover *marketing consulting, strategic market analysis for new product development, customer segmentation, marketing forecasting and vehicle concept definition relating to the automotive industry*. The limitation, i.e. *relating to the automotive industry*, is ambiguous because it could be construed as either referring to *marketing forecasting and vehicle concept definition* alone or to all the services included in the specification. Having re-read Mr Carrier's statement of grounds and his submissions, I see nothing which might suggest that the limitation is intended to apply narrowly to only some parts of the specification. On the contrary, all of Mr Carrier's submissions and arguments focus on his business being conducted in relation to the automotive industry. Bearing in mind that the earlier mark includes the word AUTOMOTIVE and that its class 42 services are all restricted to "the field of automotive design and car development", in the absence of any submissions to the contrary, I take the view that the limitation in this class can be best interpreted as meaning that Mr Carrier's intention was to seek a monopoly for marketing services relating to the automotive industry. This approach is preferable as it more precisely defines Mr Carrier's activities and reflects the nature and extent of his business.

29. *Marketing consulting* would include advice on, for example, how to market/sell a product. The core of *strategic market analysis for new product development* is the analysis of markets with a particular focus on current and future market trends. The

¹ *Raleigh International trade mark* [2001] R.P.C. 11

² *Separode Trade Mark* BL O-399-10

services are aimed at providing a horizon scanning of the automotive sector, i.e. to predict future market developments and customer demand, in order to inform business decisions as to the development of new products. *Customer segmentation* denotes, in my view, activities aimed to dividing customers into segments and identifying target buyers (and their requirements). *Marketing forecasting* is likely to be concerned with projecting future market trends or predicting the sales of products. I am not sure what *vehicle concept definition* entails and Mr Carrier has not considered it necessary to explain the terminology. Collins English Dictionary defines the meaning of the term 'concept' in relation to a product, in particular to a car as '*created as an exercise to demonstrate the technical skills and imagination of the designers, and not intended for mass production or sale*'. I therefore understand that a vehicle concept is a prototype. The definition of a vehicle concept will, in my view, involve the definition of the characteristics of the prototype, taking into account, for example, the results of the market analysis. All these services are normally offered by marketing consultants/agencies.

30. The class 42 services of the earlier mark are professional consultancy services in the field of automotive design and car development. Collins English Dictionary defines 'automotive' as '*relating to motor vehicles*'; the same dictionary defines 'motor vehicle' as '*a road vehicle driven by a motor or engine*'. The services are, therefore, for the design of motor vehicles, e.g. cars, trucks, motorcycles, buses and for vehicle parts and for the development of cars. I would expect the services to be provided by specialist technical consultants, i.e. automotive designers and engineers.

Class 35 services

31. Whilst Mr Carrier's opposition is directed against all the applied for services, he specifically attacks the following class 35 services: *business management services; business strategic planning services; business investigations, analysis and research; business data analysis; providing industry insights, strategy guidance, business consulting, business management in the sector of software development, artificial intelligence, information technology and the internet of things*. My assessment in relation to all the applied for services is as follows:

Business management services; providing business management guidance.

These are services usually rendered by business consultants and their purpose is to provide commercial undertakings with help and advice on how to run their business and assist them in coordinating and controlling their resources. The purpose and nature of the service is different to those of the earlier mark, the services are provided through different trade channels and there is nothing obvious that would create a competitive or complementary relationship with any of services of the earlier mark in classes 35 and 42. It is not clear to me how these services are self-evidently similar to any of services of the earlier mark and, in the absence of evidence or clear submissions to the contrary, I find that there is no similarity.

Business administration services; office functions; recruitment services; maintenance, creation and management of databases; compiling, storing, retrieving and maintaining data and information in a database, including accounting, financial, business, trade and statistical data and information;

data-processing services; tax preparation and consulting services. These services can be described as business management/administration or office function services. They are usually rendered by business consultants to help with the administrative and day-to-day running of a business. The nature, purpose and channels of trade of the respective services are different; there is neither complementarity nor competition and I find that the services are dissimilar.

Providing business strategy guidance; business strategic planning services. Strategic planning is concerned with defining a business strategy; the purpose of a business strategy is to set out the business's operational goals and the various actions intended to achieve those goals. The services are usually rendered by business consultants and are aimed to provide commercial undertakings with assistance in building their business strategy and their implementation plan. In class 35 of the earlier mark *market analysis* is qualified as *strategic*, this means that the outcome of the market analysis is likely to inform business decisions as to a new product development (which would be included within the broad terms mentioned above). For example, if the market analysis is positive, the result of the analysis may feed into the business strategy and to that end the client company may need to have recourse to business strategy services. This creates a complementary connection and I find that there is a **low to medium degree of similarity** between *providing business strategy guidance; business strategic planning services* and *strategic market analysis for new product development*.

Business advice relating to the acquisition and sale of businesses; business advisory services relating to business risk management; business advice relating to business re-organisation; business advice relating to growth financing; business advice relating to financial re-organisation, business development services, business restructuring services. These are all business services whose purpose is to advise and assist companies on complex issues relating to business operations and to minimise risks of various type. The services will be provided by, for example, business consultants. The nature, purpose and channels of trade are different; there is neither complementarity nor competition with any of the services of the earlier mark and I find that the services are dissimilar.

Business investigations, analysis and research; providing business information; business data analysis; providing statistical information. These services fall within the ambit of marketing to the extent that they are a necessary aid to any successful market analysis operation. On that basis they are self-evidently similar to the earlier mark's *strategic market analysis for new product development* which is likely to involve, for example, the investigation, analysis and research of competitors' businesses, the collection and analysis of business data relating to the relevant market segment and the identification of trends and statistics. To my mind, the services are **similar to a low to medium degree**.

Providing industry insights and business information in the sectors of software development, artificial intelligence, information technology and the Internet of things. Mr Carrier submits:

“...The vehicles are increasingly connected and the market digital, as people consumer mobility through the smartphone (sic). To develop these services

requires direct application of services in the sector of software development, artificial intelligence and information technology. The car is now the connected car, and is a mobile device on four wheels...”

Making the best I can of these submissions, it seems to me that Mr Carrier might be referring to instances where, for example, software applications are used to provide a service connected to cars/vehicles. I do not know if such services exist and what they would involve. In the absence of evidence to assist me, I find that the services of *providing industry insights* denote an activity aimed at providing information about an industry which is akin to market research. While this creates a degree of similarity with the earlier mark’s *strategic market analysis for new product development*, both services are restricted to specific industries. There is a clear demarcation between the fields in which the applicant will provide its services and Mr Carrier’s field. The services of the earlier mark concern a niche area of market analysis for motor vehicles whose aim is to provide a horizon scanning of the automotive industry in order to offer awareness of markets, future trends and customers’ needs. Such knowledge will be used to create new automotive products whereas the applied for services relate to software development, artificial intelligence....etc. Software and IT relate to all areas of business activity since nowadays all industries use these technologies and whilst it can be said that parts of vehicles might use software, the applied for services are, in my view, one step removed from the services of the earlier mark. This is because the purpose of the earlier mark’s *strategic market analysis for new product development* is to look at how well a new product meets the market needs, rather than to investigate possible technologies underlying parts of the new product which is yet to be developed. In my view, the specialised nature of the services and the apparent separation between the industries concerned cancels out any similarity created by the fact that both involve an element of business research and I find that overall there is no meaningful degree of similarity.

Providing strategy guidance, business consulting and business management in the sectors of software development, artificial intelligence, information technology and the Internet of things. By parity of reasoning with my findings above, there is no similarity here either.

Information, advisory and consultancy services relating to any of the aforementioned services... My findings in relation to the above services also applies to the corresponding *information, advisory and consultancy services*. There is no similarity.

The applicant’s class 36 services

32. The applicant’s class 36 services include a range of financial services. In making my assessment of the similarity of these services with the services of the earlier mark, the applicant referred me to a previous decision of the Tribunal in BL-O-475-15. I note that in that decision the services under consideration were different from the ones at hand; in any event, previous decisions of the Tribunal are not binding on the law or on the facts. That said, the decision of the GC in Case T 323/14³, quoted

³ The same approach was recently confirmed by the CJEU in *AgriCspital Corp v OHIM*, Case C- 440/15 where the Court upheld the GC’s decision that financial and real estate services are not similar.

in that decision, is important to bear in mind. Here, in dismissing the argument that financial and real estate services are similar, the court found that:

“...it should be noted that, while financial and banking services may play a significant role in the purchase of a property, it cannot be inferred from that fact alone that consumers would be led to believe that the same undertaking was responsible for real estate services and financial services. It cannot be claimed that consumers looking for a property turn to a financial institution in order to carry out that task. On the contrary, in such cases, consumers generally turn, first, to a real estate agency to search for a property and, secondly, to a financial institution in order to fund the property transaction. To conclude otherwise would imply that any non-financial procedure which, on the basis of its scale or other criteria, depends upon the provision of financing is complementary to a financial service, even where the only link lies precisely in the need to obtain financing and where consumers would in no way assume that the same undertaking was responsible for those services (see, to that effect, judgment in *METRO*, cited in paragraph 35 above, EU:T:2013:375, paragraphs 46 to 49).”

33. The same principle applies by analogy to other non-financial services. In the present case, the services of the earlier mark are one step removed from the position held by the Court in relation to real estate services. This is because while, in the UK, real estate services have traditionally converged, to some extent, with financial services⁴, such degree of convergence cannot be said to exist between financial services and the services of the earlier mark in classes 35 and 42. Taking into account all the above my assessment is as follows:

Financial affairs; financial services; financial consultancy services; financial advisory services; financial analysis services; financial information services; financial management services; asset management; financial assistance, advice, consultation, information and research services; monetary affairs; venture capital fund services; corporate finance services; capital investment services; investment, investment fund, investment dealing, investment holding, investment management, investment planning and investment trust services; financial incubation services; raising, management and administration of funds; private equity investment services; private equity services. These are either financial services at large or investment services. The nature and intended purpose is financial; the services are rendered by banks and other financial institutions and may be aimed equally at both businesses and private individuals. They are different from the services of the earlier mark in classes 35 and 42 which are niche marketing and design/development services provided by marketing and technically qualified consultants and directed at vehicle manufacturers (or those who wish to enter that market). The mere fact that the development of a car may have to be financed or that the concerned class 35 services might assist an undertaking in identifying marketing opportunities, which might potentially require long-term investments, is not enough to find similarity. Further, as I said, the nature of the services of the earlier mark is akin to a horizon scanning analysis of the automotive industry which looks ahead to future product developments and so the

⁴ For example, it is not uncommon for estate agencies to offer in-house mortgage advice

investment, if required, is not going to be immediate. There is neither competition (as one would not choose one service over another) nor complementarity as consumers would not expect those providing niche marketing and design/development services to provide financial services. The services are dissimilar.

Fundraising service. Fundraising is the act of collecting or producing money for a particular purpose. The services would be provided by fundraising professionals or specialised firms and would, in my view, include activities such as providing professional advice on fundraising strategies and assistance in raising the funds for those seeking the service. The nature, purpose and channels of trade are different. In the absence of any evidence or detailed submission from Mr Carrier as to why I should find to the contrary, and bearing in mind the principle in *Avnet*, I conclude that there is no similarity with any of the services of the earlier mark.

Sponsorship services. A fair reading of the term *sponsorship services* within a class 36 specification must be interpreted as referring to financial sponsorship, but it is not self-evident what a financial sponsorship service involves. Consequently, I can only rely on the obvious meaning of the term. Collins English Dictionary defines sponsorship as '*financial support received from a sponsor*' and I conclude that, on a very general level, the service involves a sponsor providing funds to either individuals or commercial entities. The services do not cover *promotional sponsorship*, i.e. where the sponsorship is provided in return for advertising, which belongs to class 35. The nature and purpose of the respective services is different, the services would be provided by different trade channels, i.e. specialised firms or investment/financial institutions and there is neither competition nor complementarity. Once again, in the absence of any evidence or detailed submissions from Mr Carrier as to why I should find to the contrary, and bearing in mind the principle in *Avnet*, I conclude that there is no similarity with any of the services of the earlier mark.

Accounting, auditing and book keeping; accounting management, consulting and analysis services. These are services aimed at maintaining and auditing accounting records and preparing reports on the assets and/or liabilities of, for example, a business. These services are normally provided by accountants or other professionals with the object of facilitating the running of a business. The nature, purpose and channels of trade are different, and there is neither competition nor complementarity. There is no similarity with any of the services of the earlier mark.

Insolvency services. These services are provided by professional consultants and are aimed at helping businesses or individuals either to avoid or to deal with insolvency. This would include, inter alia, advice and consultancy on bankruptcy, creditor liquidation, business sale, etc. Once again, the nature and purpose of the services is different, the services are rendered through different channels and there is neither competition nor complementarity. There is no similarity with any of the services of the earlier mark.

Real estate affairs. Real estate describes property consisting of land and buildings; the term includes the services provided by estate agencies such as rental and valuation of buildings as well as helping a buyer to find a property and assisting in the sale and purchase of a property. The nature, purpose and trade channels are

different and there is neither complementarity nor competition. There is no similarity with any of the services of the earlier mark.

Information, advisory and consultancy services relating to any of the aforementioned services... My findings in relation to the above services also applies to the corresponding *information, advisory and consultancy services*. There is no similarity with any of the services of the earlier mark.

Average consumer

34. 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 services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

35. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

36. As the matter is to be approached on a notional basis, there is no need for me to consider the average consumer for the services which I have found are not similar, in which case there can be no likelihood of confusion. On the basis of my findings, there is no similarity between the services of the earlier mark and the following applied for services:

Class 35

Business administration services; business management services; providing business management guidance; business advice relating to the acquisition and sale of businesses; business advisory services relating to business risk management; business advice relating to business re-organisation; business advice relating to growth financing; business advice relating to financial re-organisation; business development services; business restructuring services; office functions; recruitment services; maintenance, creation and management of databases; compiling, storing, retrieving and maintaining data and information in a database, including accounting, financial, business, trade and statistical data and information; data-processing services; tax preparation and consulting services; providing industry insights, strategy guidance, business consulting, business management and business information in the sectors of software development, artificial intelligence, information technology and the Internet of things; information, advisory and consultancy services relating to any of the aforementioned services; including all the aforesaid services provided through communication networks, including provided on-line from a

computer, a computer database, the Internet, Internet portals, websites, email, instant messaging, social media platforms, social networks, search engines, mobile applications, mobile devices, blogs, forums, computer or other communication channels.

Class 36

Financial affairs; financial services; financial consultancy services; financial advisory services; financial analysis services; financial information services; financial management services; asset management; financial assistance, advice, consultation, information and research services; accounting, auditing and book keeping; insolvency services; accounting management, consulting and analysis services; monetary affairs; real estate affairs; fundraising services; sponsorship services; venture capital fund services; corporate finance services; capital investment services; investment, investment fund, investment dealing, investment holding, investment management, investment planning and investment trust services; financial incubation services; raising, management and administration of funds; private equity investment services; private equity services; information, advisory and consultancy services relating to any of the aforementioned services; including all the aforesaid services provided through communication networks, including provided on-line from a computer, a computer database, the Internet, Internet portals, websites, email, instant messaging, social media platforms, social networks, search engines, mobile applications, mobile devices, blogs, forums, computer or other communication channels.

37. Accordingly, **the opposition fails under Section 5(2)(b) of the Act in respect of the above services. As there is no need for me to consider these services further, they form no part of the rest of my decision.**

38. The applied for services in class 35 are directed at business users and individuals in a business setting. The degree of attention paid during the purchasing act will be higher than average but not the highest because the consumer needs to ensure that the particular package of services is selected correctly and is appropriate to the needs of their business. The services of the earlier mark in classes 35 and 42 will most likely be sought by vehicle manufacturers or by those who wish to enter that market; they are sophisticated marketing and technical services which will be selected with a high degree of attention due to the likely investment and long-term impact of choosing an appropriate service provider. As for the manner in which the respective services are selected, this is likely to be visual through perusal of marketing material, websites, advertisements etc. but may also be aural, since the services may be acquired on the basis of personal recommendations or following exploratory meetings and invitation to tender from potential providers. Consequently, the selection process is likely to consist of a mixture of visual and aural considerations.

Comparison of marks

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall

impressions created by 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.”

40. It would be wrong, therefore, artificially to dissect the marks, although, 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.

41. The respective marks are shown below:

Applicant's mark	Earlier mark
WHITESPACE	

Overall impression

42. The applicant's mark consist exclusively of the word WHITESPACE presented in upper case; as no part of the mark is highlighted in any way, its distinctiveness rests in its whole.

43. The earlier mark consists of a number of elements. To the left hand side of the mark there is a square device; within it there are a number of overlapping trapezoid-shaped elements arranged in shades of grey. This makes up approximately the first quarter of the mark. To the right hand side of the mark is the word WHITESPACE presented in a bold typeface and in upper case. Although the word WHITESPACE conjoins two dictionary words, i.e. WHITE and SPACE, as I will explain below, these elements are combined to form one new word. The word WHITE is in a heavier font than the word SPACE. In this regard, the applicant claims that the word WHITE is the dominant element as it is shown in bold. In my view, the visual difference created by the use of different fonts is negligible and it may well go unnoticed. In any event, as the concept of fair and notional use would allow either word to be used in a variety of fonts, it matters not the difference in fonts. Below the word WHITESPACE is the word AUTOMOTIVE, presented in the same size and in upper case but in a normal typeface and in a lighter font. The word AUTOMOTIVE is not distinctive in relation to the services of the earlier mark which are all services relating to the automotive sector and will have little or no weight in the overall impression the mark conveys. While the device has some distinctiveness, on account of the size and consequent impact that the word has on the mark as a whole, it is the word

WHITESPACE that plays the greater role in the overall impression the mark conveys.

Visual similarity

44. On a visual comparison, there is a degree of similarity between the respective marks given that both contain the word WHITESPACE. There are also visual differences between the marks in that the square device and the word AUTOMOTIVE have no equivalents in the applied for mark. Taking all matters into account, the respective marks are similar to a medium degree.

Aural similarity

45. From an aural perspective, the device element will not be articulated. Although AUTOMOTIVE must also be taken into account, in my experience, it is not unusual for the descriptive element of a mark to be dropped in speech and it is likely that the average consumer will refer to the earlier mark by the word WHITESPACE alone, in which case the competing marks would be aurally identical. Were the word AUTOMOTIVE to be articulated, however, I conclude there would be a medium to high degree of aural similarity between the competing marks.

Conceptual similarity

46. Although the word WHITESPACE is presented as one word in each mark, it conjoins two well-known dictionary words, i.e. WHITE and SPACE and will convey the idea of a white space. That creates a conceptual similarity, albeit the presence of the word AUTOIMOTIVE in the earlier mark has no counterpart in the applied for mark. Overall, I find that there is a reasonably high degree of conceptual similarity.

Distinctive character of the earlier mark

47. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or

services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

48. These are fast track opposition proceedings in which it was not necessary for Mr Carrier to provide any evidence of the use he may have made of his earlier mark, thus, I have only the inherent characteristics of his mark to consider.

49. In assessing the distinctive character of earlier mark, I bear in mind that it is the distinctiveness of the common element that is the key⁵. The earlier mark will be perceived as an invented word and although it will convey the concept of a white space, this neither describes nor alludes to any characteristic of the services in any way. In my view, the earlier mark has a high degree of inherent distinctive character.

Likelihood of confusion

50. 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 marks may be offset by a greater degree of similarity between the respective services and vice versa. 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 marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I have concluded that:

- the respective services are similar to a low to medium degree;
- the average consumer of the parties’ services is a business user or an individual. The level of attention paid will range from higher than average to high and the selection process is likely to consist of a mixture of visual and aural considerations;
- the competing marks are visually similar to a medium degree, aurally identical (or at least aurally similar to a medium to high degree) and conceptually similar to a reasonably high degree;
- the earlier mark has a high degree of distinctive character.

51. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it

⁵ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

52. In my view, the low to medium degree of similarity between the competing services and the (at least) higher than average level of attention likely to be paid by the relevant average consumer when selecting the services, are outweighed by the high distinctive character of the earlier mark and by the similarity of the marks. In this case, the word which makes up the applied for mark is the dominant element of the earlier mark and the word AUTOMOTIVE in the earlier mark is merely descriptive and has little or no weight. Taking all matters into account, I find that even if the average consumer pays a high degree of attention and does not directly confuse the marks (i.e. mistake one mark for the other), there will be indirect confusion, as the consumer will assume that the services are the responsibility of the same undertaking or of undertakings with economic connections.

CONCLUSION

53. The ground of opposition therefore succeeds in relation to the following services:

Class 35

Providing business strategy guidance; business investigations, analysis and research; providing business information; business strategic planning services; business data analysis; providing statistical information; information, advisory and consultancy services relating to any of the aforementioned services; including all the aforesaid services provided through communication networks, including provided on-line from a computer, a computer database, the Internet, Internet portals, websites,

email, instant messaging, social media platforms, social networks, search engines, mobile applications, mobile devices, blogs, forums, computer or other communication channels.

Costs

54. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Although Mr Carrier has been successful in relation to a number of services in class 35 of the application, the applicant has succeeded in retaining a far greater degree of success. As a consequence, the applicant is entitled to a contribution towards its costs, albeit reduced on a “rough-and-ready basis” to reflect the measure of Mr Carrier’s success. Using TPN 4/2007 as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent’s statement: £ 180

Written submissions: £ 180

Total: £360

55. I order Jonathan Carrier pay to JVM Ventures Limited the sum of £360. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of May 2016

**Teresa Perks
For the Registrar
The Comptroller – General**

Annex A

The applicant's services (after amendment recorded on 20 January 2016)	The services of the earlier mark
<p>Class 35 <i>Business administration services; business management services; providing business management and business strategy guidance; business advice relating to the acquisition and sale of businesses; business advisory services relating to business risk management; business advice relating to business re-organisation; business advice relating to growth financing; business advice relating to financial re-organisation; business investigations, analysis and research; providing business information; business development services; business restructuring services; business strategic planning services; office functions; business data analysis; recruitment services; maintenance, creation and management of databases; compiling, storing, retrieving and maintaining data and information in a database, including accounting, financial, business, trade and statistical data and information; providing statistical information; data-processing services; tax preparation and consulting services; providing industry insights, strategy guidance, business consulting, business management and business information in the sectors of software development, artificial intelligence, information technology and the Internet of things; information, advisory and consultancy services relating to any of the aforementioned services; including all the aforesaid services provided through communication networks, including provided on-line from a computer, a computer database, the Internet, Internet portals, websites,</i></p>	<p>Class 35 <i>Marketing consulting, strategic market analysis for new product development, customer segmentation, marketing forecasting and vehicle concept definition relating to the automotive industry.</i></p> <p>Class 42 <i>Professional consultancy in the field of automotive design and car development.</i></p>

email, instant messaging, social media platforms, social networks, search engines, mobile applications, mobile devices, blogs, forums, computer or other communication channels.

Class 36

Financial affairs; financial services; financial consultancy services; financial advisory services; financial analysis services; financial information services; financial management services; asset management; financial assistance, advice, consultation, information and research services; accounting, auditing and book keeping; insolvency services; accounting management, consulting and analysis services; monetary affairs; real estate affairs; fundraising services; sponsorship services; venture capital fund services; corporate finance services; capital investment services; investment, investment fund, investment dealing, investment holding, investment management, investment planning and investment trust services; financial incubation services; raising, management and administration of funds; private equity investment services; private equity services; information, advisory and consultancy services relating to any of the aforementioned services; including all the aforesaid services provided through communication networks, including provided on-line from a computer, a computer database, the Internet, Internet portals, websites, email, instant messaging, social media platforms, social networks, search engines, mobile applications, mobile devices, blogs, forums, computer or other communication channels.