

O-508-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3143748 BY
ZEBRA HOLDING LIMITED**

TO REGISTER:



AS A TRADE MARK

IN CLASS 39

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000440 BY
ZEBRABOX SERVICES SA**

BACKGROUND & PLEADINGS

1. On 11 January 2016, Zebra Holding Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following services in class 39:

Transport; Transport brokerage; Transport by pipeline; Transportation logistics; Freight forwarding; Packaging of goods; Storage of goods; Warehousing; Rental of warehouses; Parcel delivery.

The application was published for opposition purposes on 25 March 2016.

2. On 24 June 2016, the application was opposed in full by Zebrabox Services SA (“the opponent”) under the fast track opposition procedure. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) .The opponent relies upon International Registration (“IREU”) no. 1121983 which designated the EU on 1 May 2012 (claiming an International Convention priority date of 5 April 2012 from an earlier filing in Switzerland) and which was granted protection in the EU on 5 June 2013. The trade mark relied upon is shown below:



“Colours claimed: Black, white and yellow.

Trade mark type: Mark consists of colour or colours per se.”

I will return to the specification of this IREU later in this decision.

3. The applicant filed a counterstatement in which it stated:

“The applicant deems that the applied trade mark is quite different from the opponent’s registered trade mark. Here are the grounds:

1. The applied mark consists of the stylised wording of “zebra” with the numbers “360” on the top left. And there is designed circle on the left. While the opponent’s mark consists of the white stylised wording “zebra box” in a black square shadow with incomplete square separated by white bars.
2. The two marks differ in the wording elements. Once is 360 zebra while the other is zebra box. It is easy to tell the two trade marks in the wording identity.
3. From the appearance, they are totally different at first sight. The applied trade mark is not in a surrounding while the opponents is totally in a black and white surrounding. Therefore, the consumers will not confuse the two marks while selecting the goods in the market.

Therefore, we deem that the applied will not create any confusion in the mark with the opponent’s trade mark and the opponent’s opposition could not be workable.”

4. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

5. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

6. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) 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; neither party filed

written submissions beyond those contained in the Notice of opposition/counterstatement.

DECISION

7. The opposition is based 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. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark is not subject to proof of use, the opponent is entitled to rely upon all of the services it has identified.

Section 5(2)(b) – case law

10. 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

11. In its Notice of opposition, the opponent argues that “all of the services covered by the application are identical to services [covered by the opponent’s specification in class 39]” or if not identical are “highly similar”. In its counterstatement, the applicant did not deny that was the case. Although the opponent initially relied upon all of its services in classes 36 and 39 it has limited its comparison to the competing services in class 39; I shall do the same.

12. In approaching the comparison, I note that the opponent’s specification in class 39 has been subject to a limitation; unfortunately the limited specification is, as far as I can tell, only available in French. As the opponent has not provided a certified

translation of its services into English, I considered suspending these proceedings and directing that such translations be provided. However, having considered the terms which appear in the applicant's specification and those in class 39 of the earlier right (and deploying my own very basic knowledge of the French language but checking that understanding using the translation tool provided at collinsdictionary.com), I have decided that such an approach is unnecessary. The competing services are as follows:

The applicant's services

Transport; Transport brokerage; Transport by pipeline; Transportation logistics; Freight forwarding; Packaging of goods; Storage of goods; Warehousing; Rental of warehouses; Parcel delivery.

The opponent's services in class 39 (in French accompanied by the English translation in brackets in bold)

Transport (**transport**); emballage et entreposage de marchandises (**packaging and storage of goods**); prestation d'informations en matière d'entreposage (**provision of information storage**); informations en matière de transport (**information related to transportation**); distribution de colis (**parcel delivery**); livraison de marchandises (**delivery of goods**); location d'automobiles (**car rental**); transport et entreposage de marchandises (**transport and storage of goods**); services de conseillers en matière d'entreposage (**services of advisers in warehousing**); prestation de conseils en matière de transport (**provision of advice on transport**); prestation de conseils en matière d'entreposage de marchandises (**provision of advice on storage of goods**); services de conseillers en matière de transport (**advisers on transport services**); services de stockage en entrepôt (**warehouse storage services**); déménagement (**moving**); entreposage de bateaux (**storage of boats**); dépôt de marchandises (**deposit of goods**); informations en matière d'entreposage (**information storage**); entreposage (**storage**); services de réservation de voitures de location (**car rental reservation services**); transport de meubles (**transport of furniture**); services de déménagement de meubles (**furniture moving services**); organisation de l'entreposage de marchandises (**organising the storage of goods**);

transport en automobile (**automobile transport**); camionnage (**trucking**); services de transport par automobile de location (**transport by car rental services**); services de transport par camionnette de déménagement (**transport by van moving services**); transport de marchandises (**transport of goods**); services de transport des meubles de tiers par camion (**furniture transport services by truck**); location de véhicules (**rental of vehicles**); location de garages (**rental of garages**); location de garages et places de stationnement (**rental of garages and parking places**); location de conteneurs d'entreposage (**rental of storage containers**); location d'installations d'entreposage (**rental of storage facilities**); location d'entrepôts (**rental of warehouses**); location d'espaces d'entreposage (**rental of storage space**) mise en entrepôt de marchandises (**cargo warehouse layout**).

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, 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).”

13. The opponent’s specification contains either identical terms, terms which are alternative ways of describing services contained in the application or broad terms which include services contained in the application. For example, the identical term “transport” appears in both parties’ specifications. As (at least) the term “transport” in the opponent’s specification is broad enough to include “transport brokerage”, “transport by pipeline” and “transportation logistics” in the application, these services are to be regarded as identical on the principle outlined in *Merica*. In addition,

“Packaging of goods”, “storage of goods”, “warehousing”, “rental of warehouses” and “parcel delivery” in the application, are identical to: “emballage et entreposage de marchandises” (**packaging and storage of goods**), “services de stockage en entrepôt” (**warehouse storage services**), “location d’entrepôts” (**rental of warehouses**) and “distribution de colis” (**parcel delivery**) in the earlier trade mark’s specification. As to the term “freight forwarding” which appears in the application, collinsdictionary.com defines a “freight forwarder” as a person, agency, or enterprise engaged in the collection, shipment, or delivery of goods.” This, once again in my view, is simply an alternative way of describing a number of the services contained in the earlier trade mark’s specification, for example, “transport” and “parcel delivery” services and, as a consequence, are also to be regarded as identical.

The average consumer and the nature of the purchasing act

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue; I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. 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.”

15. While the average consumer of the, broadly speaking, transport/delivery and related services at issue in these proceedings is either a member of the general public or a business user, it is much more likely that services such as “transportation logistics” and “rental of warehouses” (for example) will be selected by a business user than a member of the public. Although there is no evidence or submissions as

to how the services at issue are selected, my own experience as a member of the public tells me that when selecting, for example, parcel delivery services, the average consumer is likely to review documentation (both in hard copy and on-line) for initial indicators of price, timescale, locations to which the provider delivers etc. While visual considerations will, in my view, play an important part in the selection of such services, as further enquiries may be necessary (both face-to-face and by telephone) and as word-of-mouth recommendations are also likely, aural considerations must also be kept in mind. Absent evidence or submissions to assist me, I see no reason why a business user wishing to engage a company in the (broadly speaking) transportation sector would not begin by reviewing similar documentation to a member of the public (albeit supplemented by materials directed at the trade) as well as seeking advice (both face-to-face and by telephone) from other business users.



16. Insofar as the degree of care that will be taken when selecting such services is concerned, as even a member of the general public is likely to be alive to the factors I have mentioned above, I would expect them to pay at least a normal degree of attention to the selection of the services targeted at them. The role of the transport-related services at issue are likely to be crucial to the well-being of a business and, combined with what may be the long-term nature of the relationships involved and the not insignificant sums likely to be in play, I am led to conclude that a business user will pay a fairly high degree of attention when selecting the services at issue.

Comparison of trade marks

17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

18. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

The opponent’s trade mark	The applicant’s trade mark
	

The opponent states:

“3.4. The earlier mark is a highly distinctive figurative mark, comprising a black and white “zebra stripe” pattern on the left hand side, accompanied by the words “zebra” and “box”, to the right of the striped pattern. The words “zebra” and “box” are arranged on top of one another. The highly distinctive word “zebra” is the dominant element of the earlier mark.

3.5. The applicant’s mark comprises a black and white “zebra stripe” pattern on the left-hand side, accompanied by the number/word combination “360 zebra” on the right-hand side. The number “360” and the word “zebra” are arranged on top on one another. The word “zebra” is larger and significantly emboldened when compared with the skinnier, italicized “360” and striped

device element of the applicant's mark. The word "zebra" is, by far, the dominant element of the applicant's mark, and will attract the focus of the average consumer's attention.

3.8...Indeed, the "360" element of the applicant's mark merely brings to mind the idea of global services, and/or that the services are available all of the time, and/or that the services are fully comprehensive, catering for all requirements. The "360" element of the applicant's mark is, therefore, a descriptive element, as it will be perceived by consumers as simply descriptive of the relevant services..."

19. The opponent's trade mark consists of a number of components. The black square upon which the words "zebra" and "box" appear in lower case letters in white and yellow respectively merely serves as a background; it has little or no distinctive character and will make little or no contribution to the overall impression the trade mark conveys. The same cannot be said of the striped pattern which appears to the left of the words. Given its size and positioning in the trade mark and as it echoes the word "zebra" which appears to its right, it will make an important contribution to the trade mark's overall impression and distinctiveness. Finally, the word components. As the words "zebra" and "box" do not "hang together" to form a unit and as the word "box" is, when considered in the context of the transport related services at issue, likely to be considered descriptive, I agree with the opponent that the word "zebra" will make an important contribution to both the overall impression the trade mark conveys and its distinctiveness. Considered overall, the striped pattern and the word "zebra" will, in my view, make a roughly equal contribution to both the overall impression the trade mark conveys and its distinctiveness.

20. As to the applicant's trade mark, it too consists of a number of components. The first, is what I consider to a device of a striped globe. The fact that the device bears stripes which, like the opponent's trade mark, echo the word "zebra" which appears to its right, is likely to be noted by the average consumer. Given the nature of the transport-related services for which the application seeks registration, devices of globes are inherently non-distinctive. Although the addition of stripes to the globe device elevates it somewhat from the norm, it is, despite its positioning, unlikely to

make much of a contribution to either the trade mark's overall impression or distinctiveness. As to the numeral "360", I agree with the opponent that given the presence of the globe device, the average consumer is, once again given the services at issue, likely to interpret these numerals as a reference to the fact that the applicant's services are provided on a global basis; as a consequence, the numerals have very little if any distinctive character and will make very little if any contribution to the overall impression the trade mark conveys. That leaves the word "zebra" presented in lower case letters in bold. Like the opponent's trade mark, this word will make an important contribution to the overall impression the applicant's trade mark conveys and to its distinctiveness. Considered overall, although I accept that the stripes may add some distinctiveness to the otherwise non-distinctive globe device present (but, in my view, very limited distinctiveness), the overall impression and distinctiveness of the applicant's trade mark will, in my view, be heavily weighted in favour of the "zebra" component.

21. When considered from a visual perspective, both parties' trade marks contain a striped component to the right of which appears, inter alia, the word "zebra" presented in lower case. The fact that the other components in the competing trade marks are unlikely to make a significant contribution to the overall impression either trade mark conveys, results, in my view, in an above average degree of visual similarity between them.

22. It is well established that when a trade mark consists of a combination of words and figurative elements, it is by the word elements that the trade mark is most likely to be referred. The opponent's trade mark may be referred to in one of two ways i.e. as "zebra box" or, given that "box" is likely to be considered descriptive by the average consumer, by the word "zebra" alone. As to the applicant's trade mark, this may be referred to as either "three sixty zebra", "three six zero zebra", "three six o zebra" or, as the numeral "360" is likely to be considered descriptive, by the word "zebra" alone. The above scenarios indicate that it is quite possible that the competing trade marks are aurally identical. However, even if the competing trade marks are referred to in the other ways I have suggested, the fact that the word "zebra" would be the first word articulated in the opponent's trade mark or as a

separate and definable component of the applicant's trade mark still, in my view, results in an above average degree of aural similarity between them.

23. Finally, the conceptual comparison. Given the symbiotic relationship between the striped components and the word "zebra" which appear in both parties' trade marks and as the other components in the competing trade marks do nothing to modify the conceptual message conveyed by those components, the competing trade marks are, in my view, conceptually identical.

Distinctive character of the earlier trade mark

24. 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 services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

25. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark. As a consequence, I have only the inherent characteristics of its earlier trade mark to consider. In this regard, the opponent states:

"3.8...the animal the zebra being completely unrelated to the relevant services."

26. As Mr Iain Purvis Q.C as the Appointed Person pointed out in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, it is the distinctiveness of the shared component(s) that is key i.e. the striped device and the word "zebra".

Not only are these components neither descriptive of nor non-distinctive for the services upon which the opponent relies, they are, in my view, somewhat unusual. As a consequence, they are, as is the opponent's trade mark as a whole, possessed of an above average degree of inherent distinctive character.

Likelihood of confusion

27. 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 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 trade 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 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 competing services are identical;
- the average consumer is either a member of the general public or a business user;
- the average consumer will select the services by a mixture of visual and aural means paying a degree of attention ranging from at least normal (the general public) to a fairly high degree (business users);
- the striped pattern and the word "zebra" will make a roughly equal contribution to the overall impression the opponent's trade mark conveys and its distinctiveness;

- the overall impression of the applicant's trade mark and its distinctiveness will be heavily weighted in favour of the word "zebra" which appears in it;
- the competing trade marks are visually and aurally similar to an above average degree and conceptually identical;
- the components in the opponent's trade mark which conflict with the applicant's trade mark and the opponent's trade mark as a whole are possessed of an above average degree of inherent distinctive character.

28. In reaching a conclusion, I remind myself that the competing services are identical. Although I have concluded that the average consumer will pay at least a normal degree of attention during the purchasing process (thus making him less susceptible to the effect of imperfect recollection), the above average degree of visual and aural similarity and the conceptual identity I have identified earlier when combined with the above average degree of inherent distinctive character the earlier trade mark possesses, is more than sufficient for me conclude there is a likelihood of confusion. As the differences between the competing trade marks do not play a significant role in the overall impression the trade marks conveys, I think it is quite possible that the parties' trade marks will be mistaken for one another i.e. there will be direct confusion. However, even if I am considered to be wrong in that regard, applying the guidance provided by Mr Iain Purvis Q.C, as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, I am satisfied that the overall impression conveyed by the combination of the striped components and the word "zebra" in the competing trade marks (an impression which is not affected by the other components in the competing trade marks) is also sufficient to lead to a likelihood of indirect confusion i.e. the similarities I have identified will lead the average consumer to assume the identical services at issue originate from undertakings which are economically linked.

Overall conclusion

29. The opposition has been successful and, subject to any successful appeal, the application will be refused.

Costs

30. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice (“TPN”) 2 of 2015. Using that TPN as a guide, I award costs to opponent on the following basis:

Official fee: £100

Preparing a statement and considering
the applicant’s statement: £200

Total: £300

31. I order Zebra Holding Limited to pay to Zebrabox services SA the sum of £300. 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 7th day of November 2016

C J BOWEN
For the Registrar