

O-044-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3153537
BY STEELCASE (SOUTH-EAST) LIMITED
TO REGISTER THE TRADE MARK:**

The image shows the trade mark 'ie' written in a cursive, handwritten style. The 'i' has a solid black dot above it. The 'e' is a continuous loop that starts from the bottom of the 'i', goes down, loops around to the right, and then back up to the top of the 'i'.

IN CLASSES 9, 10, 11, 16, 17, 20, 24, 35, 37, 39, 41, 42 AND 43

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600000468
BY IE DESIGN CONSULTANCY LIMITED**

Background and pleadings

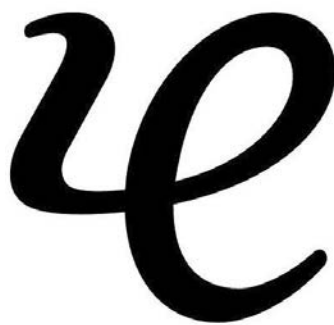
1. On 7 March 2016, Steelcase (South-East) Limited (“the applicant”) applied to register the following trade mark in classes 9, 10, 11, 16, 17, 20, 24, 35, 37, 39, 41, 42 and 43:

The image shows the handwritten trade mark 'ie' in a cursive script. The letter 'i' has a distinct dot above it, and the 'e' is written in a fluid, connected style.

The specification was subject to amendment after publication. The specification as it now stands is reproduced in full as an annex to this decision.

2. The application was published for opposition purposes on 13 May 2016. It is opposed by IE Design Consultancy Limited (“the opponent”) under the fast-track opposition procedure. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against the goods and services in classes 9, 16, 35 and 42 of the application.

3. The opponent relies upon its UK trade mark registration number 2626846 for the following trade mark:

The image shows the handwritten trade mark 'ze' in a cursive script. The letter 'z' is written with a large, sweeping loop, and the 'e' is also written in a cursive style.

4. The opponent’s trade mark was applied for on 3 July 2012 and its registration procedure was completed on 5 October 2012. The opponent relies upon all of the goods and services in its registration, namely:

- Class 9 Computer software; web applications; website development software; computer software for creating websites; computer operating system software; computer firmware; computers; computer hardware.
- Class 16 Printed matter; books, periodicals, newsletters, magazines, brochures, pamphlets, journals, instructional guides and manuals; paper; stationery.
- Class 35 Advertising, marketing and promotional services; digital marketing services; business marketing consultation; database services; computer database management; collection and systemisation of information in to computer databases; advice relating to the organisation, management and promotion of businesses.
- Class 42 Computer services; computer programming; computer consultancy and technical support; all relating to the design and use of computer programs, computers, computer hardware and computer systems; design services relating to computer programs, computer hardware, computer software and computer firmware; building and maintain websites; creating and designing websites; design, drawing and commissioned writing, all for the compilation of web pages; design of marketing material; design of printed matter for use in marketing.

5. The applicant filed a counterstatement denying the grounds of opposition.

6. 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".

7. The 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.

8. 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.

9. Both parties have been professionally represented throughout, the opponent by Barker Brettell LLP and the applicant by Murgitroyd & Company.

Section 5(2)(b)

10. 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”.

11. 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”.

12. In these proceedings, the opponent is relying upon the trade mark shown at paragraph 3, above, which qualifies as an earlier trade mark under the above provisions. As the opponent’s earlier mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

13. 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.

The average consumer and the nature of the purchasing act

14. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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. In its form TM7F, the opponent submits that the average consumer will be the same for both parties' goods and services and will be a member of the general public. It

claims that the respective services will be purchased after “high involvement decisions” and that the services “are likely to be purchased on an infrequent basis”.

16. In its counterstatement, the applicant denies that the average consumer will be the same and argues that the applicant “operates in a different commercial field from that of the Opponent”.

17. At this point of the decision, I would normally identify the average consumer of the products, their traits and the nature of the purchasing act. However, for reasons which will become apparent, I do not propose to do that here; rather, I will return to the average consumer when I consider the likelihood of confusion.

Comparison of goods and services

18. When making the comparison, all relevant factors relating to the services in the specification should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

19. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;

- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

20. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question".

21. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating that:

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

22. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 fur 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”.

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods and services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, 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”.

24. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

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

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I

therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

26. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O/399/10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

Class 9

Computer software for electronic conferencing; computer hardware and software for providing web-based access to applications and services through a web operating system or portal interface for room and space scheduling; monitors; apparatus for recording, transmission or reproduction of sound or images; electric switches; electronic controllers; electronic sensors; display screens; display monitors; video conferencing apparatus; electric power units; electronic notice boards; electronic memo boards; electronic display panels; electric luminescent display panels; interactive graphics screens

27. These goods are included within the opponent’s broad terms “computer software” and “computer hardware”, the latter of which would cover goods such as Central Processing Units, webcams, monitors, graphic and sound cards, and computer power adaptors. The goods are, on the principle outlined in *Meric*, identical.

Power strips with movable sockets

28. This term has not been explained by either party. It strikes me as relating to power extension leads. I have already indicated that power adaptors would be included in the opponent’s “computer hardware”. There is, therefore, a good degree of similarity in the nature and purpose of the respective goods. The applicant submits that the users for

these goods (among others) are different but does not say why.¹ I take the view that the users for both parties' goods will be members of the public and that the channels of trade may coincide. However, the goods are neither in competition nor complementary in the sense defined in the case law. The goods have a reasonably high degree of similarity.

Class 16

Dry-erase writing boards; whiteboards

29. I can see no meaningful similarity between these goods and the goods and services of the opponent. The physical nature and purpose are different, the methods of use will vary and they are neither in competition nor complementary in the sense defined in the case law. The users may be the same at a very superficial level, in that they may be members of the general public, but this is insufficient for an overall finding of similarity. The goods are not similar.

Class 35

Business management services in the field of office furniture, office furnishings; business project management

30. The above services relate to the control and organisation of a business to enable it to achieve certain strategic and organisational goals. The opponent's "advice relating to the organisation, management and promotion of businesses" are concerned with the same subject matter. The applicant's business project management services may include projects relating to the organisation, management structure or promotion of a business and in such circumstances are identical services. In any case, I find these services to be at least highly similar.

¹ Counterstatement, paragraph 10.

Business relocation services

31. While these services are different in nature from the opponent's "advice relating to the organisation, management and promotion of businesses", the opponent's services could include advice about business relocation. The users will be identical and the channels of trade may be the same. The services may have a complementary relationship, though they are unlikely to be in competition. There is a low degree of similarity between the services.

Retail services connected with the sale of computer software for electronic conferencing, computer hardware and software for providing web-based access to applications and services through a web operating system or portal interface for room and space scheduling, monitors, apparatus for recording, transmission or reproduction of sound or images, electric switches, electronic controllers, electronic sensors, display screens, display monitors, electronic power supplies, power strips with movable sockets, video conferencing apparatus, electric power units, electronic notice boards, electronic memo boards, electronic display panels, electric luminescent display panels, interactive video apparatus, interactive video software, interactive graphics screens; furniture adapted for medical use, lighting, electrical office and interior lighting, dry-erase writing boards, whiteboards, furniture, office furniture, furnishing and upholstery fabrics, furnishing and upholstery fabrics for furniture, textiles for furnishings.

32. The opponent states that it objects to the applied-for retail services "on the basis that the opponent has the earlier rights for the class 9 and class 16 goods".

33. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use from goods, retail services for particular goods may be complementary to those goods and distributed through the same trade channels, and therefore similar to a degree.

34. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut”.

35. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*,² and *Assembled Investments (Proprietary) Ltd v. OHIM*,³ upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*,⁴ Mr Hobbs concluded that:

- (i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

² Case C-411/13P

³ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁴ Case C-398/07P

- (ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- (iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- (iv) The GC's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

36. The goods and services are different in nature and purpose, and they are not in competition. I found at paragraph 30 that there is no similarity between the applicant's "dry-erase writing boards; whiteboards" and the opponent's goods. In addition to a different nature and purpose, the applicant's retail services for those goods are also likely to differ from the goods of the earlier mark in their channels of trade. The services are not those normally associated with the goods and I can see no meaningful complementary relationship between them. "Retail services in connection with the sale of dry-erase writing boards; whiteboards" are not similar to any of the goods of the earlier mark.

37. However, with the exception of retail services in relation to "furniture adapted for medical use, lighting, electrical office and interior lighting, furniture, office furniture, furnishing and upholstery fabrics, furnishing and upholstery fabrics for furniture, textiles for furnishings", the applicant's remaining retail services are those which would normally be associated with the goods relied upon by the opponent. The channels of trade are also likely to coincide. In my view, the goods and services are complementary. I consider that "retail services connected with the sale of computer software for electronic

conferencing, computer hardware and software for providing web-based access to applications and services through a web operating system or portal interface for room and space scheduling, monitors, apparatus for recording, transmission or reproduction of sound or images, electric switches, electronic controllers, electronic sensors, display screens, display monitors, electronic power supplies, power strips with movable sockets, video conferencing apparatus, electric power units, electronic notice boards, electronic memo boards, electronic display panels, electric luminescent display panels, interactive video apparatus, interactive video software, interactive graphics screens” share a medium degree of similarity with the goods of the earlier mark.

38. As regards the applicant’s “retail services in connection with the sale of furniture adapted for medical use, lighting, electrical office and interior lighting, furniture, office furniture, furnishing and upholstery fabrics, furnishing and upholstery fabrics for furniture, textiles for furnishings”, I do not consider that the goods subject to the retail services are similar to the goods in the earlier specification. More particularly, the goods are unlikely to be the subject of the same retail services as the goods in the earlier specification and the applicant’s retail services are not likely to be important for the sale of the opponent’s goods. The applicant’s “retail services in connection with the sale of furniture adapted for medical use, lighting, electrical office and interior lighting, furniture, office furniture, furnishing and upholstery fabrics, furnishing and upholstery fabrics for furniture, textiles for furnishings” are not similar to the goods of the earlier mark.

39. Without wishing to make a better case for the opponent than it has made for itself, I will briefly consider these remaining retail services against the earlier mark’s “advertising, marketing and promotional services”, which, in my view, represents its next best case. The purpose of retail services is the gathering together of goods and offering a variety of services to encourage the consumer to purchase those goods. While I acknowledge that an advertisement is intended to encourage the purchase of particular goods, it seems to me that the opponent’s services are typically provided to assist a client in the whole range of advertising and marketing services, from identifying the target market and the client’s Unique Selling Point to the production of every type of

advertising material. They will be offered to the general public and businesses, irrespective of the particular sector in which they operate. The nature, purpose, methods of use and channels of trade all differ, though I accept that the users may coincide. The services are not in competition and, although a provider of retail services may use the services offered by the opponent, the services are not complementary as defined in the case law. The services are not similar.

Class 42

Furniture design; interior office space planning and design services

40. I can see no meaningful similarity between these services and any of the goods and services in the earlier specification. Their purpose, nature, method of use and channels of trade all differ and there is neither competition nor complementarity. The users may be the same at a very high level of generality but that is insufficient to establish overall similarity. The services are not similar.

41. If there is no similarity between the goods and/or services at issue, there can be no likelihood of confusion.⁵ I have found that there is no similarity between the opponent's goods and services and the following goods and services in the specification applied for: in class 16, "dry-erase writing boards; whiteboards"; in class 35, "retail services connected with the sale of furniture adapted for medical use, lighting, electrical office and interior lighting, dry-erase writing boards, whiteboards, furniture, office furniture, furnishing and upholstery fabrics, furnishing and upholstery fabrics for furniture, textiles for furnishings"; and, in class 42, "furniture design; interior office space planning and design services". The opposition against these goods and services is hereby dismissed.

Comparison of trade marks

⁵ If the goods/services are not similar, there can be no likelihood of confusion. See, for example, *Waterford Wedgwood plc v OHIM*, C-398/07 P (CJEU).

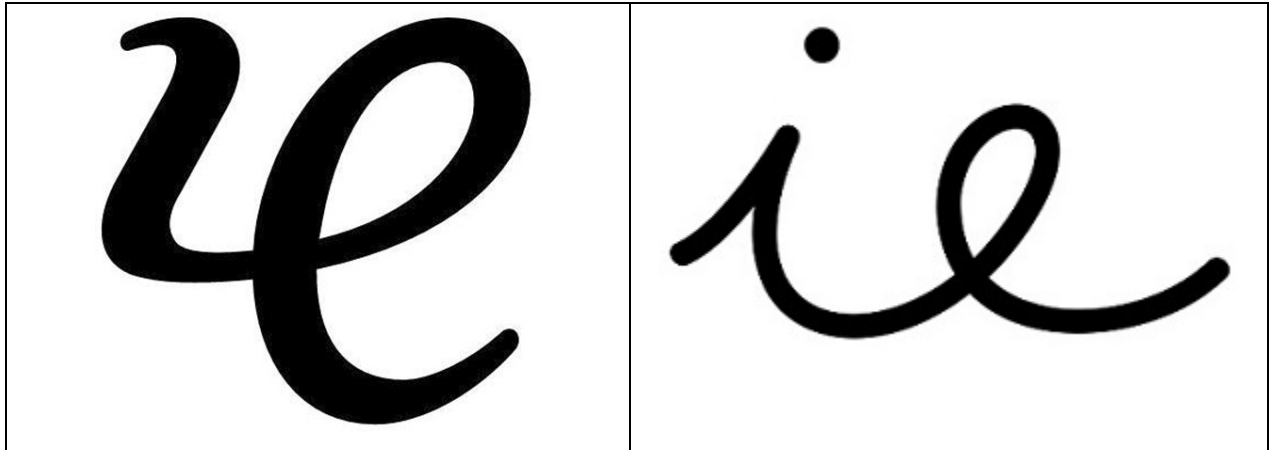
42. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed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

43. 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 created by the marks.

44. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark



45. The parties disagree as to whether the earlier mark will be seen as the letters “ie”, “e” or even an ampersand. For my part, I consider that the average consumer is most likely to perceive the opponent’s mark as a letter “e” with a flourish which resembles a brushstroke. However, I accept that some average consumers will just perceive the mark as one looped line. I do not consider that the average consumer would see the flourish in the earlier mark as the letter “i”. It is not on a level with the letter “e” but extends only as far down as the centre line of the “e”. That in itself points against the flourish being perceived as a letter. There is the additional factor that there is no tittle to give the impression of the letter “i”. It would not be usual for a lower case “i” to be presented without its tittle and there is nothing else in the mark to suggest that the vertical line is a letter “i”. I consider that the letter “e” dominates the overall impression but that the stylisation also plays a strong role.

46. As regards the applicant’s mark, it consists of the letters “i” and “e”, in lower case, in a slightly stylised typeface. Neither letter dominates the other, both playing an equal role in the overall impression. The stylisation makes a contribution to the overall impression but plays a weaker role.

47. The opponent argues that the marks are visually similar to a high degree because “[t]here is a strong loop element in the letter “e”. Both marks have a handwritten script feel”. I accept that there is some visual similarity between the marks, in that both contain the letter “e”. However, there are differences because the applicant’s mark contains a clearly recognisable additional letter, while the earlier mark has a distinctive flourish,

neither of which is present in the other party's mark. I consider that there is a low degree of visual similarity between the marks.

48. The application will be pronounced "EYE-EE". The opponent's mark will be articulated as "EE". The stylisation in the marks will not be vocalised. The marks are aurally similar to a medium degree.

49. The letter "e" has no particular conceptual meaning. Nor do the letters "ie". The conceptual position is, therefore, neutral, there being neither conceptual similarity nor dissimilarity.

Distinctive character of the earlier trade mark

50. 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. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. 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)".

51. The opponent has not claimed that its mark has an enhanced level of distinctive character. Invented words usually have the highest degree of inherent distinctive character; words which are descriptive of the goods and services relied upon normally have the lowest. Single letters per se are not particularly distinctive, given the propensity of many undertakings to use letters as badges of origin. Bearing that in mind, and allowing for the stylisation in the mark, I consider that it has a lower than average, but not the lowest, degree of inherent distinctiveness.

Likelihood of confusion

52. 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 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 bear 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 but relies instead upon the imperfect picture of them he has retained in his mind.

53. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related.

54. Given the nature of the goods and services at issue, the average consumer will vary from a member of the general public to a business professional. The opponent has indicated that it considers that the services will be purchased infrequently, following “high involvement decisions”. It has made no submissions regarding the goods at issue. The level of attention paid to the purchase of the goods will also vary considerably. For example, only a low degree of attention is likely to be paid to the purchase of goods such as “magazines” but a reasonably high degree of attention will be paid to the selection of goods such as “computer software”. The purchase of the goods and services at issue is likely to be dominated by visual considerations, though I accept that there may be an aural component.

55. Given that the purchase of the goods and services at issue is likely to be principally visual, and whilst I recognise that there may be an aural element to the purchase in circumstances where the marks are aurally similar to a medium degree, my finding that the marks are visually similar only to a low degree is of particular importance.⁶ Another

⁶ In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the General Court stated: “49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be

factor is the lower than average degree of inherent distinctiveness enjoyed by the earlier mark, which makes confusion less likely. In my view, even where the goods or services in question are identical and the purchases are made by a member of the general public paying only a low degree of attention, the marks in their totalities are sufficiently different that there is no likelihood of confusion, either direct or indirect, in respect of any of the goods and services at issue.

Conclusion

56. The opposition has failed and, subject to appeal, the application will proceed to registration.

Costs

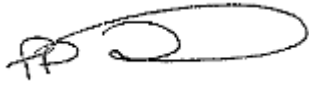
57. The applicant has been successful and is entitled to a contribution towards its costs. Neither party filed evidence or written submissions but I note that the pleadings were reasonably detailed. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 4 of 2007. TPN 2 of 2015 is also relevant. Using those TPNs as a guide, I award costs to the applicant on the following basis:

Considering the notice of opposition and filing a counterstatement	£200
Total:	£200

58. I order IE Design Consultancy Limited to pay Steelcase (South-East) Limited the sum of **£200**. 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.

more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs”.

Dated this 3rd day of February 2017

A handwritten signature in black ink, consisting of a stylized 'H' followed by a large, sweeping loop that ends in a small flourish.

Heather Harrison

For the Registrar

The Comptroller-General

Annex

UKTM 3153537

Class 9: Computer software for electronic conferencing; computer hardware and software for providing web-based access to applications and services through a web operating system or portal interface for room and space scheduling; monitors; apparatus for recording, transmission or reproduction of sound or images; electric switches; electronic controllers; electronic sensors; display screens; display monitors; power strips with movable sockets; video conferencing apparatus; electric power units; electronic notice boards; electronic memo boards; electronic display panels; electric luminescent display panels; interactive graphics screens.

Class 10: Furniture adapted for medical use.

Class 11: Lighting; electrical office and interior lighting.

Class 16: Dry-erase writing boards; whiteboards.

Class 17: Laminated plastic sheets for use in manufacture; laminated plastic sheets for use in the manufacture of furniture.

Class 20: Furniture; office furniture.

Class 24: Furnishing and upholstery fabrics; furnishing and upholstery fabrics for furniture; textiles for furnishings.

Class 35: Business management services in the field of office furniture, office furnishings; business relocation services; business project management; retail services connected with the sale of computer software for electronic conferencing, computer hardware and software for providing web-based access to applications and services

through a web operating system or portal interface for room and space scheduling, monitors, apparatus for recording, transmission or reproduction of sound or images, electric switches, electronic controllers, electronic sensors, display screens, display monitors, electronic power supplies, power strips with movable sockets, video conferencing apparatus, electric power units, electronic notice boards, electronic memo boards, electronic display panels, electric luminescent display panels, interactive video apparatus, interactive video software, interactive graphics screens, furniture adapted for medical use, lighting, electrical office and interior lighting, dry-erase writing boards, whiteboards, furniture, office furniture, furnishing and upholstery fabrics, furnishing and upholstery fabrics for furniture, textiles for furnishings.

Class 37: Repair of furniture; furniture installation services; installation and repair of business and office furniture and furnishings; office furniture and furnishing disposal services; furniture refurbishing and restoration services; maintenance and repair of upholstery.

Class 39: Packaging and storage of goods; warehouse and furniture storage; delivery of furniture; furniture moving services; removal services; storage services.

Class 41: Education; providing of training; arranging and conducting of workshops; arranging and conducting of workshops in the field of office environment, equipment and furnishings.

Class 42: Furniture design; interior office space planning and design services.

Class 43: Rental of furniture.