

O-285-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3141351

BY

LUCRE HOLDINGS LIMITED

TO REGISTER AS A TRADE MARK

SEARCH SAVVY PR

IN CLASSES 35, 41 AND 42

AND

THE OPPOSITION THERETO

UNDER NO 406426

BY

SAVVY MARKETING LIMITED

BACKGROUND

1. On 18 December 2015, Lucre Holdings Limited (the applicant) applied to register the above trade mark. Following an amendment of the specification, the mark stands as follows:¹

Class 35

Public relations; copywriting; preparation of advertising brochures and press releases; speech writing for advertising purposes.

Class 41


Video production services.

Class 42

Website development services; design, creation and curation of website content; creation, design, development and maintenance for others of blogs and websites for photo-sharing and social networking.

2. The application was published on 15 January 2016, following which Savvy Marketing Limited (the opponent) filed notice of opposition against all of the services in the application.

3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act) and relies upon the following series of two trade marks:

Mark details and relevant dates	Goods and services relied upon
Mark: 2546195  Filed: 28 April 2010 Registered: 7 September 2012	Class 16 Paper, cardboard and goods made from these materials, not included in other Classes; printed matter, stationery, office requisites, printed publications; parts and fittings for any or all of the aforesaid goods in this Class. Class 35 Advertising; marketing; analysis relating to marketing; business advice relating to marketing and strategic marketing; business consultancy services relating to marketing; conducting of marketing studies; direct marketing; investigations of marketing strategy; marketing agency services; marketing analysis; marketing assistance;

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

	<p>marketing managing advice; marketing research and studies; planning of marketing and marketing strategies; product marketing; promotional marketing; provision of marketing reports; research services relating to marketing; preparation and publication of publicity material, advertising material, and marketing material; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class; including any or all of the aforementioned services in this Class provided via the Internet, online and/or as a web-based offering.</p> <p>Class 41 Education; providing of training; training services relating to marketing and marketing skills; lecture services relating to marketing and marketing skills; publication of printed matter, including marketing matter and materials; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class; including any or all of the aforementioned services in this Class provided via the Internet, online and/or as a web-based offering.</p> <p>Class 42 Design services; design of marketing material; design of printed matter for use in marketing; design services relating to the publication of documents; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class; including any or all of the aforementioned services in this Class provided via the Internet, online and/or as a web-based offering.</p>
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4. The opponent states that a significant and distinctive element of the applicant's mark is the word SAVVY, which is the whole of the earlier mark, which leads to similarities between the two marks, 'including on a phonetic, visual and conceptual level'. It claims that the goods and services are identical or highly similar. It concludes that there is a likelihood of confusion.

5. The applicant filed a counterstatement in which it denies the ground on which the opposition is based.

6. Both sides filed evidence and the opponent filed submissions. A hearing subsequently took place before me, by video conference, at which the applicant was represented by Mr Jamie Muir Wood of Counsel, instructed by Dehns Mohun LLP. The opponent did not attend but did file submissions in lieu of attendance.

EVIDENCE

Opponent's evidence

Witness statement of Paul Laurence Brandon and exhibits PLB1-PLB3

7. Mr Brandon is a trade mark attorney employed by the opponent's representative, Appleyard Lees IP LLP. His statement is dated 18 August 2016. His evidence comprises prints of the opponent's trade mark from the UK trade mark register and a copy of its examination report.

Applicant's evidence

Witness statement of Tamarind Wilson-Flint

8. Ms Wilson-Flint is one of the founding directors of the applicant. Her witness statement is dated 7 November 2016. It contains submissions regarding the similarity of the parties' marks and the similarity between the goods and services.

Opponent's evidence in reply

Witness statement of Rachel Louise Garrod and exhibits RLG1-RLG11

9. Ms Garrod is a trade mark attorney employed by the opponent's representative. Her statement is dated 6 January 2017. Exhibits attached to her statement are prints from the opponent's website regarding the nature of its business and definitions of the terms, 'advertising', 'marketing' and 'public relations'.

10. I do not intend to summarise the parties' evidence and submissions but will refer to the content as necessary below.

Preliminary issues

11. The opponent relies upon a series of two marks which differ in the case and font in which they are presented. Throughout the rest of this decision I will refer to the opponent's mark as 'SAVVY', by which I mean to refer to both versions of the mark, the differences between them have no material impact on the determinations I am required to make.

12. At the hearing, the applicant submitted that the parties have been trading side by side for twelve years and there has been no confusion to date. This pleading was not advanced in the applicant's counterstatement and no evidence has been filed in support of it. The case law is clear that absence of actual confusion is rarely significant and in a trade mark case may be due to matters unrelated to the opponent's registered trade mark.² Absent evidence, I cannot consider this point and will say no more about it.

DECISION

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

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

14. 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 -

² See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220 and *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283.

(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.”

15. The opponent's earlier mark is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.³

Section 5(2)(b) case law

16. 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.

(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

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

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 goods and services

17. The goods and services to be compared are as follows:

The opponent's goods and services:	The applicant's services:
<p>Class 16 Paper, cardboard and goods made from these materials, not included in other Classes; printed matter, stationery, office requisites, printed publications; parts and fittings for any or all of the aforesaid goods in this Class.</p> <p>Class 35 Advertising; marketing; analysis relating to marketing; business advice relating to marketing and strategic marketing; business consultancy services relating to marketing; conducting of marketing studies; direct marketing; investigations of marketing strategy; marketing agency services; marketing analysis; marketing assistance; marketing managing advice; marketing research and studies; planning of marketing and marketing strategies; product marketing; promotional marketing; provision of marketing reports; research services relating to marketing; preparation and publication of publicity material, advertising material, and marketing material; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class; including any or all of the aforementioned services in this Class provided via the Internet, online and/or as a web-based offering.</p> <p>Class 41 Education; providing of training; training services relating to marketing and marketing skills; lecture services relating to marketing and marketing skills; publication of printed matter, including marketing matter and materials; consultancy, advisory and</p>	<p>Class 35 Public relations; copywriting; preparation of advertising brochures and press releases; speech writing for advertising purposes.</p> <p>Class 41 Video production services.</p>

information services for or in relation to any or all of the aforementioned services in this Class; including any or all of the aforementioned services in this Class provided via the Internet, online and/or as a web-based offering.

Class 42

Design services; design of marketing material; design of printed matter for use in marketing; design services relating to the publication of documents; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class; including any or all of the aforementioned services in this Class provided via the Internet, online and/or as a web-based offering.

Class 42

Website development services; design, creation and curation of website content; creation, design, development and maintenance for others of blogs and websites for photo-sharing and social networking.

18. When making the comparison, all relevant factors relating to the goods and 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,⁴ 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;

⁴ [1996] R.P.C. 281

- 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. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁵ the General Court stated that:

“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”.

21. 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*,⁶ 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

⁵ *Case T- 133/05*

⁶ [2012] EWHC 3158 (Ch)

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. In *Avnet Incorporated v Isoact Limited*,⁷ 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”.

23. In *Kurt Hesse v OHIM*,⁸ 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 General Court (“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*,⁹ the General Court 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

⁷ [1998] F.S.R. 16

⁸ Case C-50/15 P

⁹ Case T-249/11

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 O/255/13:

“18. [...] 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.”

25. Whilst on the other hand:

“19. [...] 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”.

26. In the same case, Mr Alexander also 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*”.

27. 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.¹⁰

¹⁰ 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].

28. In its skeleton argument the applicant divides the services in its application into four categories:

- “a) public relations;
- b) copywriting (copywriting, preparation of advertising brochures and press releases; speech writing for advertising purposes);
- c) Video production services; and
- d) Website and social networking services (the class 42 services).”

29. With regard to the services at (b) the applicant submits:

“19 Although the Opponent has failed to set out which services it relies upon, it is accepted that the services at (b) are similar to those for which the Trade Mark is registered, namely ‘preparation and publication of publicity material, advertising material, and marketing material’.

20. It is accepted, therefore, that if the Sign is found to be similar to the Trade Mark, the services at (b) should be removed from the specification for the Application.”

30. The applicant denies that the remaining services at (a), (c) and (d) are similar to those for which the earlier mark is registered.

31. The opponent provides the following definitions from Collins Dictionary in its evidence: ¹¹

Public Relations –

*The practice of creating, promoting or maintaining goodwill and a favourable image among the public towards an institution, public body, etc.*¹²

¹¹ Printed from www.collindictionary.com – the date is not shown.

¹² See Exhibit RLG2

Marketing –

*The provision of goods or services to meet customer or consumer needs.*¹³

Advertising –

1. The promotion of goods or services for sale through impersonal media, such as radio or television.

*2. The business that specialises in such publicity.*¹⁴

32. Paragraph 22 of the opponent's submissions, dated 17 March 2017, draws my attention to its own exhibit RLG6,¹⁵ stating that it is:

"...very illustrative in showing how marketing, advertising and public relations are heavily interconnected and therefore easily confused – this extract states that advertising and PR are promotion methods which fall under the 'marketing' umbrella term – thus directly linking PR and marketing services."

The applicant's services in class 35

33. The applicant submits that *"public relations services are used to promote the image of a company or person in the press and media whereas marketing and advertising services are focused on selling physical products."*¹⁶ In my experience, the nature of marketing and public relations is similar in that both are used by those who wish to develop a promotional strategy. In the case of public relations such a strategy is more likely to be concerned with the public image of an individual or company, whereas marketing more generally concerns the promotion, selling and distribution of a product or service. Consequently, their natures are similar, the users may be the same and trade channels may be the same for both. With regard to the complementarity between them, these are services that may be used together, though one is not indispensable for the use of the other. However, I find it highly likely that the consumer of these services may believe that responsibility for both services lies with the same

¹³ See Exhibit RLG3

¹⁴ See Exhibit RLG5

¹⁵ RLG6 is an article taken from www.targetjobs.co.uk. It is titled, 'What's the difference between marketing, advertising and PR'? It is not dated.

¹⁶ Paragraph 25 of the applicant's skeleton argument.

undertaking or with economically connected undertakings. I find these services to be highly similar.

34. The applicant accepts that there is some similarity between 'copywriting; preparation of advertising brochures and press releases and speech writing for advertising purposes' in its specification and the services in the opponent's specification.

35. 'Preparation of advertising brochures and press releases' and 'speech writing for advertising purposes' are clearly both terms included within the broader term 'advertising'. 'Copywriting' is essentially the writing of text for advertising and is also included within the term 'advertising'.

36. In accordance with *Meric*, I find these services to be identical to advertising in class 35 of the opponent's specification. Even if I am found to be wrong in this, they are at least highly similar services.

The applicant's services in class 41

37. The applicant's services in this class are video production services. The opponent has not provided any indication as to which of its goods and services it considers to be similar to these services in the application. The opponent's services in this class are broadly education and training services and publication of printed matter. Whilst a film or video may be used for training purposes, this is not analogous to providing video production services. Having considered the nature of the goods and services, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which the competing goods and services coincide and find that they are dissimilar.

38. With regard to the opponent's goods and services in classes 16, 35 and 42, having considered the users, nature of the goods and services, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which the competing goods and services coincide.

The applicant's services in class 42

39. The opponent has not stated which of its goods or services it considers to be similar to those in the applicant's specification. I will base the comparison on its design services, in class 42, as these are the closest services to those in the application.

40. The opponent's 'design services' is a broad term which encompasses many different types of design and consequently, many types of user. It could include designing flyers and posters, the provision of online services enabling consumers to design their own business cards or party invitations and may also include design services for designing websites and blogs of the type included in the applicant's specification.

41. Design and creation of website content and the creation and design of blogs and websites are design services and in accordance with *Meric* are identical to the opponent's design services.

42. Website development and blog development clearly involve considerable design considerations. Websites and blogs are encountered visually by the user with careful consideration given to their appearance and to the user's ability to navigate them. The curation of websites and blogs and the maintenance of blogs are services which are very closely related to the website and blog design services contained within the opponent's design services. For example, curating website and blog content requires selection and presentation of information, which will involve design considerations. The users and trade channels are the same and there is a clear complementary relationship between them. It would not be possible to develop a website or blog without curating the content and ensuring its ongoing maintenance. I find it highly likely that the average consumer would expect the services to be provided by the same undertaking. In conclusion, I find these services to be highly similar to the opponent's services in the same class, particularly given the complementary relationship between them.

The average consumer and the nature of the purchasing act

43. In accordance with the above cited case law, I must determine who the average consumer is for the goods and services at issue and also identify the manner in which they will be selected in the course of trade.

44. 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*,¹⁷ 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.”

45. The parties’ specifications include a wide range of goods and services which may be bought by a member of the general public, such as stationery or printed publications, as well as more specialist services, such as marketing and public relations which are more likely to be commissioned by a business or professional. PR, copywriting, video production and website and blog development services may involve a tendering process or at least a selection process when entering a contract for their provision. Design services may also fall into this category, but also include services which would be offered via a website to members of the general public. The selection process for the services where I have found there to be similarity is likely to be primarily visual, being made from a website or brochure, though I do not discount the fact that there may be an aural element given that some of these services may be purchased as a result of recommendation. For those same services the purchase will be fairly infrequent and the prices may vary. Overall, in respect of the similar services, I find that the average consumer is more likely to be a business or professional than a member of the general public and will pay a higher than average level of attention to the purchase, though not the highest level.

¹⁷ [2014] EWHC 439 (Ch)

Comparison of marks

46. The marks to be compared are as follows:

The opponent's marks	The applicant's mark
 <p>The image shows the opponent's marks. It consists of the word 'SAVVY' in a standard, black, sans-serif font. Below it is the word 'and' in a smaller, lowercase, sans-serif font. Below 'and' is the word 'savvy' in a bold, lowercase, sans-serif font.</p>	 <p>The image shows the applicant's mark. It consists of the words 'SEARCH SAVVY PR' in a bold, uppercase, sans-serif font.</p>

47. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components,¹⁸ but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

48. The opponent's mark is a series of two for the word 'SAVVY'. The first of the series is in capital letters whilst the second mark is presented in lower case in a bold font. In both the overall impression rests in the totality of the mark.

49. The applicant's mark comprises the words 'SEARCH' and 'SAVVY' followed by the letters 'PR', which could be read together to create a phrase. It is presented in capital letters with no stylisation. It is likely that the PR part of the mark will be seen as a reference to 'public relations', meaning that more focus will be placed on the words SEARCH SAVVY and it is these words which play a greater role in the overall impression of the mark.

¹⁸ *Sabel v Puma AG, para.23*

50. In terms of the similarity between the parties' marks, the applicant submits that the applied for mark, being three words in length, is visually and aurally longer than the opponent's mark. In pointing to a further difference it states that the earlier mark consists of two, "*alternative stylised words*", whereas the application is not stylised.

51. The opponent submits that the respective marks are visually highly similar as each contains the "identical distinctive word SAVVY" which "stands out in the mark as applied for, particularly in view of the double 'V' element which is present in the respective marks."

52. With regard to aural similarity the opponent states:

"14...Phonetically, the marks are similar to the extent that the word SAVVY will be pronounced in an identical manner in each case, and this word forms a phonetically distinct sound within both respective marks.

15. It should also be borne in mind that the term 'SAVVY' is clearly a major distinctive element within the Applicant's mark SEARCH SAVVY PR. Thus consumers may simply refer to the mark as 'SAVVY', viewing this mark as 'separable', rendering the 'marks' essentially phonetically identical."

53. I note the applicant's point that its mark is not stylised and therefore differs from the earlier series mark. However, it is clear that normal and fair use of a word trade mark includes use in a range of fonts and cases. Accordingly, the fact that the applicant's mark is applied for in a plain black font in upper case does not prevent its use in a different font or in, for example, lower case, which would reduce the visual difference between the marks. I must consider normal and fair use of both marks in making a comparison between them.

54. The opponent's mark consists of one word, 'SAVVY' which is the central element of the applicant's mark. The difference between the respective marks rests in the inclusion in the application of the word 'SEARCH' before the word 'SAVVY' and the letters 'PR' after the word 'SAVVY', neither of which are present in the opponent's mark. I have considered the opponent's submission that the average consumer will

refer to the mark applied for as 'SAVVY' and I am not persuaded by it. The applicant's mark is SEARCH SAVVY PR and I see no reason, and none has been provided, why the average consumer would take a word from the middle of that mark and use that word alone in referring to the applicant's mark. Visually and aurally, I find the respective marks to be similar to a medium degree.

55. The opponent states in its submissions:

"16. Conceptually, there are clear similarities between the respective marks, given the presence of the word SAVVY in each, together with the descriptive nature of the PR element in the Applicant's mark, and the known abbreviation of public relations to 'PR'."

56. The applicant submits that conceptually, the applied for mark is an instruction to do something, whereas the earlier mark is 'a simple laudatory term'.

57. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹⁹ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.²⁰

58. In my view the term SAVVY is a word of which the average consumer is likely to be aware. They may not be able to provide a detailed definition but would be aware that the term relates to having knowledge or being 'street smart'. Consequently, the applicant's mark SEARCH SAVVY PR has a particular meaning which will be understood. The mark will be seen as SEARCH SAVVY followed by PR. It may be seen to be an instruction, as the applicant suggests, though given the PR element, it is more likely to be seen as a characteristic of the undertaking using it. For services relating to public relations the PR element will be considered descriptive and will be given little meaning by the average consumer²¹.

¹⁹ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] *e.c.r.-I-643*; [2006] *E.T.M.R.* 29.

²⁰ *BL O-048-08*

²¹ Neither side disputes that PR is a common abbreviation for public relations and it is a fact I am prepared to accept.

59. To the extent that both marks contain the word SAVVY, which will be clearly understood by the average consumer, there is a degree of conceptual similarity between them. One refers to 'smart' or 'knowledgeable' searching (possibly in the context of public relations services), the other refers to the concept of SAVVY itself - the act of being knowledgeable or street smart.

60. I find the marks to be conceptually similar to a fairly high degree.

Distinctive character of the earlier mark

61. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been used as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.²²

64. I have only the inherent distinctiveness of the earlier mark to consider since no evidence has been filed to show use of the mark. The opponent's earlier mark is SAVVY. It is a common English word which makes no descriptive nor allusive reference to the goods and services at issue.

65. In its skeleton argument and at the hearing the applicant sought to show that SAVVY is a 'common, laudatory word'. It went no further in explaining why this was significant but it appears from submissions made at the hearing that the applicant is suggesting that the earlier mark has a lower than average level of inherent distinctive character.

66. In support of this submission it provides a second witness statement by Ms Wilson-Flint with two exhibits. The first of these shows that there are 395 companies listed at Companies House whose names include the word 'SAVVY' [TWF2, Exhibit 1]. The

²² *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

second shows that there are 99 trade marks on the Register which include the word 'SAVVY' [TWF2, Exhibit 2].

67. With regard to the number of trade marks on the Trade Mark register I bear in mind the guidance in *Zero Industry Srl v OHIM*,²³ when the General Court stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71)."

68. There is no evidence which indicates that any of the 'SAVVY' marks on the list are actually in use, nor anything which indicates that the average consumer has actually encountered them. I note that the print provided at exhibit TWF2 includes marks which are withdrawn and some which are dead. A significant number relate to completely different fields of activity. For all of these reasons, this evidence does not advance the applicant's case and I will say no more about it.

69. Exhibit TWF1, consisting of prints from the Companies House database, is also irrelevant to the matters to be decided in this case. Company names are registered under a different Act, using different criteria and giving very different rights to their holders. In view of this, I have not taken account of this evidence.

²³ *Case T-400/06*

70. I find the opponent's earlier mark to be possessed of a medium degree of inherent distinctive character.

Likelihood of confusion

71. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.²⁴ I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa.

72. Where there is no similarity between the parties' goods and services, there can be no likelihood of confusion²⁵. In *eSure Insurance v Direct Line Insurance*,²⁶ Lady Justice Arden stated that:

"49. ...I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

73. Consequently, there can be no likelihood of confusion in respect of the following services in the application:

Video production services – class 41

²⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

²⁵ *Waterford Wedgwood plc v OHIM – C-398/07 P (CJEU)*

²⁶ [2008] ETMR 77 CA

74. For the parties' services which are similar, I have found that the average consumer is more likely to be a business or professional and the purchase is more likely to be fairly infrequent. I have concluded that the level of attention paid to the purchase will be higher than average and that the purchasing process is primarily a visual one, though I do not rule out an aural element.

75. I have found the applicant's respective services to similar and identical to services contained in the opponent's specification. The respective marks are visually and aurally similar to a medium degree and conceptually similar to a fairly high degree.

76. The applicant draws my attention to the general rule that the average consumer pays more attention to the beginnings of marks submitting that although SAVVY is present in both marks, it is not the first word in the application. This principle has been established in a number of cases, including, *El Corte Inglés, SA v OHIM*²⁷ and is a general rule which does not replace the principle that each case must be decided on its merits.

77. The applicant also relies on *Whyte & Mackay v Origin Wine*²⁸ submitting that "*the court found that unless the identical part has distinctive significance independent of the sign as a whole, the fact that it is identical should be ignored.*" In my view, this is not an accurate synopsis of the finding in that case. Paragraph 20 of *White & Mackay* refers to the application of the principle established in *Medion v Thomson* and states that the principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independent of the whole.

78. In this case I agree that SAVVY in the applicant's mark does not have an independent distinctive character within the mark. The mark will be seen as 'SEARCH SAVVY' followed by PR. For services not related to public relations the mark stands

²⁷ Cases T-183/02 and T-184/02. See also: GC cases: *Castellani SpA v OHIM, Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*,²⁷ (similar beginnings important or decisive), *CureVac GmbH v OHIM*,²⁷ (similar beginnings not necessarily important or decisive) and *Enercon GmbH v OHIM*,²⁷ (the latter for the application of the principle to a two word mark).

²⁸ [2015] EWHC 1271 (Ch)

as a whole. Where the services are related to public relations then the SEARCH SAVVY element takes on a greater significance with PR being seen as a descriptor and not part of the trade origin.

79. That said, the fact that SAVVY does not have an independent significance with the mark for the purposes of applying the principle in *Medion*, does not mean that I should ignore the SAVVY element when applying the relevant factors applicable to a finding under section 5(2)(b) of the Act.

80. In this case, taking into account the nature of the average consumer, the nature of the purchase and the level of attention to be paid to these services, I do not find that the marks would be directly confused with one another resulting in a likelihood of confusion. However, I do find that the average consumer would confuse the marks indirectly. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person defined indirect confusion in the following terms:

“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 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.”

81. In this case the services are either identical or highly similar, being very closely related to the opponent’s services. Taking into account the degree of similarity between the marks, the medium degree of distinctive character of the earlier mark and the nature of the purchase being made, I find that an average consumer, familiar with

one of the parties' marks, subsequently encountering the other mark would believe that the services originated from the same or linked undertakings. For example, an average consumer familiar with SAVVY as a provider of advertising and marketing services would simply think that public relations services or web development services provided by SEARCH SAVVY PR were services provided by the same undertaking or one that was economically linked to it.

CONCLUSION

83. The opposition succeeds under section 5(2)(b) of the Act in respect of all of the services in classes 35 and 42.

84. The opposition fails under section 5(2)(b) of the Act in respect of the applicant's services in class 41. The application can proceed to registration (subject to the outcome of any appeal proceedings) for the following:

Class 41
Video production services.

COSTS

88. The opposition having been largely successful, the opponent is entitled to a contribution towards its costs, reduced to take account of the fact that it failed against the applicant's services in class 41. I award costs on the following basis:

Official fees:	£100
Preparing a statement and considering the other side's statement:	£200
Commenting on the other side's evidence and filing evidence:	£300
Submission in lieu of attending a hearing:	£200
Total:	£800

89. I order Lucre Holdings Limited to pay Savvy Marketing Limited the sum of £800. 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 19TH day of June 2017

**Ms Al Skilton
For the Registrar,
The Comptroller-General**