

**O-051-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3199454 BY  
TWIN THINKING LTD  
TO REGISTER:**

**MARSHMALLOW**

**AS A TRADE MARK IN CLASSES 9, 35 & 36**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 408652 BY MARSH LIMITED**

## BACKGROUND & PLEADINGS

1. On 29 November 2016, Twin Thinking Ltd (“the applicant”) applied to register the trade mark **MARSHMALLOW** for goods and services in classes 9, 35 and 36, full details of which can be found in Annex A to this decision. The application was published for opposition purposes on 9 December 2016.

2. On 1 March 2017, the application was opposed in full by Marsh Limited (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon three registrations, full details of which are shown in Annex B of this decision. The opponent states:

“6. The mark of the Application consists of the words "Marshmallow". This mark is highly similar to the Earlier Trade Marks of the Opponent as it only differs by the word "Mallow" which could be easily confused by members of the public. The prominent part of the mark is the word "Marsh" in each case. Further, the Contested services against which the Opposition is directed are identical or similar to the services for which the Earlier Trade Mark of the Opponent is registered.”

3. The applicant filed a counterstatement which consists, in essence, of a denial of the ground upon which the opposition is based.

4. In these proceedings, the opponent is represented by Chancery Trade Marks and the applicant by Trade Mark Wizards Ltd. While only the opponent filed evidence, the applicant filed written submissions during the course of the evidence rounds. Although neither party asked to be heard, the applicant elected to file written submission in lieu of attendance at a hearing. I shall refer to the submissions filed, as necessary, later in this decision.

## **The opponent's evidence**

5. This consists of a statutory declaration and exhibit from Wendy Marsh, the opponent's Assistant Company Secretary. Although I have read Ms Marsh's declaration, for reasons which will shortly become clear, there is no need for me to summarise it here.

## **DECISION**

6. 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.”

7. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), 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.”

8. In these proceedings, the opponent is relying upon the three UK trade mark registrations shown in Annex B to this decision, all of which qualify as earlier trade marks under the above provisions. As all of the opponent’s earlier trade marks had been registered for more than five years at the date the application was published, they are subject to the proof of use provisions. The opponent indicates that its earlier trade marks have been used upon all the goods and services for which they are registered, and in its counterstatement, the applicant asks the opponent to make good this claim.

### **Section 5(2)(b) – case law**

9. The following principles are gleaned from the decisions of the courts of the European Union 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 greater 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.

### **Preliminary observations**

10. The opponent's case appears to be confused in a number of respects. Firstly, in its Notice of Opposition it indicates that its opposition is directed against all of the goods and services in the application. However, in, inter alia, paragraph 4 of its Statement of Grounds accompanying the opposition it states: "The opposition is directed against all the services of [the application]" whereas in the final paragraph of its Statement of Grounds, it asks for the application to be "refused in its entirety". In Ms Marsh's declaration, she refers to the opponent being the proprietor of "a number of UK trade mark registrations in classes 35 and 36..." and provides details at pages 1-4 of her exhibit. However, as the opponent is only relying upon three of the twenty five trade marks mentioned, the relevance of the other trade marks is unclear. When comparing the competing trade marks, Ms Marsh identifies the opponent's trade mark as the word "MARSH" (which one can see from Annex B is not the case) stating, for example:

"Therefore I say that members of the public on seeing the Applicant's mark MARSHMALLOW and also see (sic) my company's name and mark MARSH..."

11. Finally, Ms Marsh refers to services in classes 35 and 36 (but not to the goods in class 9 being relied upon) which are significantly broader than those of the earlier rights shown in Annex B. In other circumstances, it may have been necessary for me to resolve these apparent inconsistencies before proceeding. However, for reasons which will become clear, that is not necessary.

## **My approach to the proceedings**

12. It is at this point in my decision I would normally: (i) assess the opponent's evidence to determine if it had made genuine use of its earlier trade marks and if so decide what represented fair specifications, (ii) conduct a comparison of the competing goods and services, (iii) identify who I consider to be the average consumer for such goods and services and indicate how such consumers would select the goods and services at issue, and (iv) assess the distinctive character of the opponent's earlier trade marks.

13. However, in the interests of procedural economy, I intend to proceed on the basis most favourable to the opponent i.e. (i) the opponent's evidence establishes genuine use of all its earlier trade marks in relation to all the goods and services for which they are registered, (ii) the average consumer of both parties' goods and services is identical and will pay only a low degree of attention to the selection of the goods and services at issue (making them more prone to the effects of imperfect recollection) and (iii) the opponent's earlier trade marks are inherently highly distinctive and the use made of them has improved the opponent's position still further.

## **Comparison of trade marks**

14. 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 them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight

in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

<b>Opponent's trade marks</b>	<b>Applicant's trade mark</b>
MARSH DIRECT MARSH ADVANTAGE MARSH BOWRING	MARSHMALLOW

16. The applicant's trade mark consists of the word MARSHMALLOW presented in block capital letters. As no part of the trade mark is highlighted or emphasised in any way, it has no distinctive and dominant components. The overall impression it conveys and its distinctiveness lie in the single word of which it is composed.

17. The opponent relies upon three trade marks, all of which consists of two separate components, the first of which is the word MARSH presented in block capital letters. The second components in each trade mark i.e. DIRECT, ADVANTAGE and BOWRING are also presented in block capital letters. While the words DIRECT and ADVANTAGE are likely to make very little (if any) contribution to those trade marks' distinctive character, they will, nonetheless, contribute to the overall impression they convey. That does not, however, appear to be the case in relation to the word BOWRING, which will contribute to both the overall impression conveyed and the trade mark's distinctive character. However, once again for the purposes of procedural economy, I shall, rather unusually, proceed on the mistaken basis (more favourable to the opponent) adopted by Ms Marsh in her declaration and compare the competing trade marks as if they were MARSH and MARSHMALLOW.



18. Proceeding on the basis indicated above, the competing trade marks consist of five and eleven letters respectively. Although the first five letters in the applicant's trade mark are the same as the five letters of the word MARSH, the last six letters in the applicant's trade mark are completely alien to that word. Bearing in mind the similarities and differences, and notwithstanding that as a general rule the beginnings of trade marks tend to have more visual and aural impact than their endings (*El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02), I find the competing trade marks to be visually similar to a moderate degree i.e. between low and medium.

19. Aurally, MARSH will be articulated as a single syllable word, whereas the applicant's trade mark will be verbalised as the three syllable word MARSH-MAL-LOW. In my view, that also results in a moderate degree of aural similarity.

20. Finally, the conceptual comparison. The words MARSH and MARSHMALLOW will be very well-known to the average consumer. Although the average consumer will be aware that MARSH is a word meaning "a wet, muddy area of land" (collinsdictionary.com), considered in context, they are more likely to construe it as a surname (support for which can be found in the exhibit to Ms Marsh's declaration). The word MARSHMALLOW will convey only one meaning i.e. "a soft, sweet food that is used in some cakes, puddings, and sweets" (collinsdictionary.com).

21. Whether construed as "a muddy area of land" or as a surname, the meaning conveyed by the word MARSH is entirely different to the meaning that will be conveyed by the word MARSHMALLOW. The competing trade marks are conceptually dissonant.

### **Likelihood of confusion**

22. 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 goods and services and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent's trade marks as the more distinctive they are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

23. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related. In her declaration, Ms Marsh states:

“It is considered highly likely that one mark will be mistaken for the other and as such, there is a (sic) clearly a likelihood of direct confusion.”

24. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

25. I also bear in mind the comments of the General Court (“GC”) in *Nokia Oyj v OHIM*, Case T-460/07 i.e.

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it

possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P Éditions Albert René [2008] ECR I-0000, paragraph 98).”

26. Even proceeding on the basis outlined in paragraphs 13 and 17, I have absolutely no hesitation concluding that the very different conceptual messages conveyed by the words MARSH and MARSHMALLOW (meanings which fix themselves in the mind of the average consumer and act as a hook to aid their recall), are more than sufficient to offset the moderate degree of visual and aural similarity between these words. As the applicant succeeds on this basis, its position is even stronger if one compares its trade mark with the actual trade marks upon which the opponent relies.

### **Overall conclusion**

27. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

### **Costs**

28. As the applicant has been successful, it is entitled to a contribution to its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the applicant on the following basis:

Reviewing the Notice of Opposition and preparing a counterstatement:	£200
Considering the opponent’s evidence:	£300
Written submissions:	£300

**Total:**

**£800**

29. I order Marsh Limited to pay to Twin Thinking Ltd 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 23<sup>rd</sup> day of January 2018**

**C J BOWEN**

**For the Registrar**

**The applicant's goods and services**

**Class 9** - Computer software; computer application software; computer hardware; CD-ROMs, DVDs; videos; audio and audio visual recordings; media content; databases; data communications equipment; downloadable publications; instructional and training manuals in electronic or computer software format; parts and fittings for the aforesaid goods.

**Class 35** - Risk management consultancy; business risk assessment services; business consulting; business research; business management; business administration; business information; business data analysis services; commercial information; statistics (compilation of); statistical business and commercial information; management and compilation of computerized databases; collection and systemization of business data; business consulting; market research and studies; accounting; advertising; business assistance, management and administrative services; providing commercial directory information via the Internet; business advice; retail services connected with the sale of computer software, computer application software, computer hardware, CD-ROMs, DVDs, videos, audio and audio visual recordings, media content, databases, data communications equipment, downloadable publications, instructional and training manuals in electronic or computer software format, publications, books, journals, reports, teaching materials, manuals, educational materials, printed lectures and training materials, parts and fitting for the aforesaid goods; consultancy, information and advisory services to all the aforesaid.

**Class 36** - Provision of financial, investment and credit research, analysis and reporting; financial risk management services; credit risk analysis; credit risk assessment services; financial affairs; financial and credit information, research and analysis services; financial forecasting; financial, investment and real estate risk assessment services; real estate appraisal services; monetary affairs; tax consultancy; insurance; insurance services; insurance underwriting and appraisals and assessment for insurance purposes; reinsurance; reinsurance brokerage; reinsurance services; providing reinsurance information; providing online information about reinsurance from a computer database or the Internet; reinsurance claim settlements; arranging of mortgages; mortgage banking and brokerage; provision of mortgage loans; mortgage loans and financing services; mortgage brokering; mortgage broking; mortgage brokerage; mortgage services; mortgage advice; mortgage refinancing; consultancy, information and advisory services to all the aforesaid services.

**The opponent's earlier trade marks**

**(1)** UK No. 2205623 for the trade mark: **MARSH DIRECT** which was applied for on 12 August 1999 and entered in the register on 18 February 2000. The opponent relies upon all the services in its registration i.e.

**Class 36** – Insurance services.

**(2)** UK No. 2216016 for the trade mark: **MARSH ADVANTAGE** which was applied for on 2 December 1999 and entered in the register on 13 October 2000. The opponent relies upon all the goods in its registration i.e.

**Class 9** – Computer programmes for use in connection with insurance and risk management.

**(3)** UK No. 2483112 for the trade mark: **MARSH BOWRING** which was applied for on 25 March 2008 and entered in the register on 29 August 2008. The opponent relies upon all the services in its registration i.e.

**Class 35** - Business management, assistance and advisory services, all relating to insurance and insurance broking; all included in Class 35.

**Class 36** - Insurance services included in Class 36; reinsurance services and insurance broking services; information, advisory and consultancy services relating to the foregoing.