

O/064/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK 3262682

BY

PROPERTIES@LTD

TO REGISTER THE FOLLOWING MARK IN CLASS 36

Living@

AND

THE OPPOSITION UNDER NO. 411713 THERETO

BY

LIVING LIMITED

## Background and Pleadings

1. PROPERTIES@LTD (the Applicant) applied to register the mark Living@ on the 11 October 2017 for services in Class 36 shown below. It was accepted and published on the 24 November 2017.

Class 36: Property rental services; residential property rental services.

2. LIVING LIMITED (the Opponent) opposes the application under section 5(2)(b) of the Trade Mark 1994 (the Act) relying on its earlier UK registered mark LIVING registration number UK 3151056 which was filed on the 22 February 2016 and registered on the 1 July 2016. The mark is registered in respect of services relied upon in classes 36 and 43 outlined below:

Class 36: provision of estate agency and financial services.

Class 43: provision of hotel facilities and ancillary hotel facilities.

3. The Opponent relies on all its services in class 36 and 43 for which the mark is registered. The Opponent claims that there is a likelihood of confusion because under section 5(2)(b) the trade marks are similar and are to be registered for services identical with or similar to those for which the earlier marks are protected.

4. The Opponent submits in its statement of grounds that:

*“The two applications are similar as regards the word “LIVING” the difference as regards the Applicant is the “@” emblem is added at the end of the word ie LIVING@.*

*The emblem “@” is international meaning “at” a particular email address. It is used billions of times every day example JoeBloggs@ xyz.co.uk ).*

*Anyone looking at LIVING and LIVING@ cannot readily think they are two different trade marks.*

*Since lodging our objection and in readiness for the launch of a project we have established an email address: LIVE@LIVING.CO.UK.*

*We request rejection of the application. Approval will confuse the market. Too similar. “*

5. The Applicant filed a defence and counterstatement denying the claims made and submitting that

*“It is not agreed that there is a likelihood of confusion as suggested by the Opponent and the Opponent is put to strict proof of this.”*

6. The Applicant is represented by Swindell and Pearson Ltd whereas the Opponent is unrepresented. Neither party has filed evidence and only the Applicant has filed submissions in lieu of a hearing. The decision is taken upon the careful perusal of the papers.

### **Preliminary issues**

7. Within the papers I have sight of a letter dated 17 July 2018 from the Opponent setting out negotiation terms to which, ordinarily, I would not be privy. However, the Applicant has not made any application to exclude this document and whilst I have had sight of this letter its content plays no part in my decision

## Decision

8. The opposition is based on section 5(2)(b) of the Act which states:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

9. 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.”

10. In these proceedings, the Opponent is relying upon its UKTM registration shown above, which qualifies as an earlier trade mark under section 6 of the Act. As the earlier mark had been registered for less than five years at the date the application was published it is not subject to the proof of use provisions contained in section 6A

of the Act. Consequently, the Opponent is entitled to rely upon all the services of its registration without having to establish genuine use.

11. 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 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of

confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of the services**

12. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

“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”.

13. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) 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”.

15. The competing services are as follows:

Applicant’s services	Opponent’s services
Class 36: Property rental services; residential property rental services	Class 36: Provision of estate agency and financial services.
	Class 43: provision of hotel facilities and ancillary hotel facilities.



16. The services provided by estate agents not only include the buying and selling of properties (residential or commercial) but they also provide rental and letting services. The Opponent's "*Provision of estate agency services*" are therefore identical according to the case of *Meric* as they incorporate the contested "*Property rental services; residential property rental services.*" On this basis I need not go on to consider the Opponent's services in class 43.

### **Average Consumer**

17. When considering the opposing marks, I must determine first of all who the average consumer is for the goods and services and the purchasing process. The average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods and services in question.<sup>1</sup>

18. 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."

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<sup>1</sup> Lloyd Schuhfabrik Meyer, case c- 342/97.

19. The parties' services are targeted towards those consumers in the rental/purchasing market although I do not discount professional consumers. The purchasing process is likely to be primarily visual either with consumers accessing those services online through websites and internet search engines or actual brick and mortar estate agents displaying the accommodation in their window. I do not discount aural methods however from recommendations or telephone enquiries. In relation to both the rental and purchasing market I would consider the level of care and attention required to be reasonably high due to a number of factors including the aesthetic characteristics of the actual property, the facilities on offer, the cost, size and location and the fact that most transactions of this type require the signing of legal contracts. This type of purchase is unlikely to be casual or frequent and would require a measured approach with a high degree of care taken before contracts are signed. The degree of attention paid therefore will be reasonably high.

### **Comparison of the marks**

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The "CJEU" stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

21. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

22. The respective trade marks are shown below:

Applicant's Mark	Opponent's mark
Living@	LIVING

23. In comparing the marks there is no difference between the variation in the casing because a word trade mark registration protects the word itself irrespective of the font capitalisation or otherwise. Therefore, a trade mark in capital letters covers notional use in lower case and vice versa.<sup>2</sup>

24. Lengthy submissions have been submitted from the Applicant on the similarity of the marks. Whilst I do not propose to reproduce those here, I have taken them into consideration in reaching my decision.

25. The Applicant's mark consists of a six-letter word "Living" followed by the "@" symbol; both elements conjoined. The Applicant submits that the "symbol @ has become a symbol of modern electronic communication" and that it is capable of carrying significant meaning adding something to the word "Living" over and above its common everyday meaning. I accept entirely that most people would be familiar with the @ symbol which is commonly used in electronic communications and social media tags but I would conclude that because of this it will not play a distinctive role especially by its position at the end of the word. It is the word "Living" therefore which will play a

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<sup>2</sup> *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

more dominant role and which carries the greatest weight in the overall impression of the mark.

26. The Opponent's mark consists of the word only mark LIVING. There are no other elements to contribute to the overall impression, which resides in the totality of the word.

### **Visual comparison**

27. Both marks are word only marks with each mark consisting of the identical word "Living". The only difference in the Applicant's mark is the @ symbol which appears after the common element, Living. As a general rule, greater visual emphasis will be placed at the beginning of marks<sup>3</sup> and therefore on this basis, I consider the marks to be visually similar to a high degree.

### **Aural Comparison**

28. In both cases the word LIVING will be pronounced in an identical way. The only difference being the addition of the @ symbol in the Applicant's mark which will be pronounced "living at" if the symbol is articulated and just "living" if not. Since word marks are normally read from left to right I therefore consider the marks to be aurally similar to a good degree if the "@" is articulated and identical if it is not.

### **Conceptual comparison**

29. Since the average consumer in this case is a member of the general public they will merely take the ordinary meaning of Living and see it as the present participle of

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<sup>3</sup> El Corte Ingles, SA v OHIM, cases T-183/02 and T-184/02

the well-known English verb “to live”. The addition of the symbol “@” will not alter the meaning of Living and will merely convey a question in the consumer’s mind of living somewhere. Although neither mark will particularly bring to mind an obvious link with residential services I find that it may allude to houses and lifestyle and if this is the case this will apply to both marks. The conceptual similarity will therefore be high with the inclusion of the identical word “Living”.

### **Distinctiveness of the earlier mark**

30. 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-0000, 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).”

31. The matter must be considered based on inherent characteristics as the Opponent has not filed any evidence regarding its use of the mark. The earlier mark consists of one word, “LIVING” and is clearly an ordinary English word. “LIVING” is not directly descriptive of the services, although I agree it is allusive to an aspect of residential property and houses and has some allusive association to letting services and estate agents. I would place its level of distinctive character therefore as medium to low.

### **Likelihood of confusion**

32. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

33. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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 recognised 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, I conclude that it is another brand of the owner of the earlier mark.”

34. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective services may be offset by a greater degree of similarity between the respective trade marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Applicants’ trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must consider 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 that he has retained in his mind.

35. When comparing the two marks I take into account the obvious visual similarities between them as a result of the shared presence of word “Living” which is identical in both marks and the services being identical. I take into account that the inherent distinctiveness of the earlier mark is medium to low with no further enhancement attributed to it through use. I note that the average consumer is reasonably well informed and circumspect and a member of the public who will pay a reasonably high degree of attention in the selection process. The marks have a high degree of conceptual similarity.

36. Taking into account the principle of imperfect recollection and the fact that the consumer rarely has a chance to compare marks side by side I conclude that there is a strong likelihood that the Applicant’s mark will be mistaken for the earlier mark despite the average consumer paying a reasonably high degree of attention. The difference with the inclusion of the symbol “@” is not sufficient to allow the average consumer to distinguish between them leading to a likelihood of confusion especially since the respective services are identical.

37. In case I am wrong about direct confusion I will consider indirect confusion as explained in L.A. Sugar. Even if the average consumer does not directly mistake the marks there is sufficient similarity between them that the average consumer perhaps may recognise that the marks are different with the inclusion of the symbol “@” and conclude that it is a sub brand of the earlier mark and that the respective services come from the same or economically linked undertaking. There is therefore a likelihood of indirect confusion.

### **Outcome**

38. The opposition under section 5(2)(b) therefore succeeds; subject to any successful appeal, the application is refused.

### **Costs**

39. The Opponent being unrepresented was invited by the Tribunal to complete and return a pro forma indicating the time spent on various activities associated with the proceedings. As the Opponent has not provided such information, I therefore make no award as a contribution towards costs of the proceedings other than to award the opposition fee of £100.

40. I order PROPERTIES@LTD to pay LIVING LIMITED the sum of **£100**. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

29<sup>th</sup> of January 2019

Leisa Davies

For the Registrar