

O-271-19

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 3275184
BY QUBE LEASING LIMITED
TO REGISTER**

**Q U B E
L E A S I N G**

AS A TRADE MARK IN CLASS 36

AND

OPPOSITION NO. 412618 THERETO

BY

QUBE LEASEHOLD PROPERTY MANAGEMENT LIMITED

BACKGROUND

1) On 05 December 2017, Qube Leasing Limited ('the applicant') applied to register the following, as a trade mark:

Q U B E
L E A S I N G

Class 36: Agencies or brokerage for leasing or renting of land.

2) The application was published in the Trade Marks Journal on 02 March 2018 and notice of opposition was later filed by Qube Leasehold Property Management Limited ('the opponent'). The opponent claims that the trade mark application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act')¹. Relevant details of the mark relied upon are:

UK registration No. 2485421

Filing Date: 19 April 2008

Date of entry in the register: 12 December 2008



Class 36: Real estate affairs; management of real estate, property and buildings; real estate consultancy and information; financial management and drawing up of budgets in connection with real estate management; real estate agencies; property

¹ Other grounds, pleaded under sections 5(3) and 5(4)(a) of the Act, were withdrawn by the opponent, as per its correspondence dated 24 September 2018.

management agency services; financial affairs; financial analysis; insurance; monetary affairs; lifestyle counselling and consultancy (financial).²

3) The opponent's registration is an earlier mark, in accordance with section 6 of the Act. As it completed its registration procedure more than five years prior to the publication date of the contested mark, it is, in principle, subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the services relied upon. The opponent claims that the respective services are identical and the parties' marks similar such that there exists a likelihood of confusion.

4) The applicant filed a counterstatement. I note the following points made therein:

- Proof of use of the earlier mark is not requested.³
- The applicant asserts that it is a leasing broker for computing equipment whereas the opponent provides real estate services. As such it states that the parties operate in significantly different fields such that there has not been, and is no likelihood of, confusion.
- The applicant provides a list of 24 trade mark numbers from the trade mark register which, it states, all contain the word 'Qube'. It further states that there are over 260 live companies on the Companies House database also containing the word 'Qube'. This information is said to show that the parties' marks (and companies) are unlikely to be mistaken for each other.

5) The opponent is represented by Blake Morgan LLP; the applicant represents itself. Neither party has filed evidence in these proceedings nor requested to be heard before the decision is made. Only the opponent filed written submissions in lieu⁴. I now make this decision after a careful consideration of the papers before me.

² The registration also covers other classes but only class 36 is relied upon by the opponent.

³ As per question 7 of Form TM8.

⁴ Dated 12 March 2019.

DECISION

6) 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,

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

7) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

The correct approach

8) Before going any further, it is necessary, for the benefit of the unrepresented applicant, to explain why the comments it makes in the counterstatement about the actual services it provides being different to those of the opponent do not assist it. This is because I am required to make the assessment of the likelihood of confusion notionally and objectively based on the applicant's services, as applied for, and the opponent's services, as registered (since proof of use has not been requested), in accordance with the relevant case law. For example, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Further, in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

It follows that the actual services which either party may currently be providing in the marketplace is irrelevant to the assessment of the likelihood of confusion.

9) Further, the applicant's reference to there being a number of company names containing the word 'Qube' is irrelevant, as is the fact that there may be other trade marks on the register containing that word. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court ('GC') 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). “

Comparison of services

10) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*‘Meric’*), the GC held:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

In the case before me, the applicant's services, as applied for, are 'Agencies or brokerage for leasing or renting of land' which must be considered identical to the opponent's 'real estate affairs' since the former falls within the latter.

Average consumer and the purchasing process

11) It is necessary to determine who the average consumer is for the respective services and the manner in which they are likely to be selected. 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."

12) The average consumer for the services at issue is the general public and professional consumers. The marks are likely to be encountered primarily by visual means from signage on high street premises or use on websites and the like. That is not to say though that the aural aspect should be ignored since the services may sometimes be the subject of discussions with sale representatives, for example. Generally speaking, the services are not inexpensive and, for the general public at least, are unlikely to be purchased on a frequent basis. Whilst a professional consumer may utilise the services more frequently, I would expect both types of consumer to pay at least a medium degree of attention during the purchase.

Comparison of marks



13) 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.”

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

14) The marks to be compared are:

Opponent's mark	Applicant's mark
	

15) The applicant's mark consists of the distinctive word 'QUBE' presented above the descriptive word 'LEASING'. The former is presented in a large bold font, the latter in a smaller font without emboldening. Whilst the word 'LEASING' is not negligible, it is the word 'QUBE' which has significantly greater weight in the overall

impression, owing to its distinctiveness and relatively more prominent position within the mark as a whole.

16) Turning to the opponent's mark, this consists of the word 'QUBE' presented in a stylised font below an image of blocks/cubes presented in the colours red, black and white (the 'device'). Both the stylised word 'QUBE' and the device element are distinctive and have substantial visual impact such that they enjoy roughly equal weight in the overall impression conveyed by the mark.

17) Visually, there are clear differences between the marks due to the presence/absence of the respective device element and the word 'LEASING'. The marks coincide in respect of the word 'QUBE', albeit in different styles of font. Overall, there is a medium degree of visual similarity. In terms of how the marks will be vocalised, this is likely to be as CUBE v CUBE LEASING. The device element in the opponent's mark will not be verbalised. I find there to be a medium degree of aural similarity. Conceptually, although the word 'QUBE' appears to be invented, it is evocative of the well-known word 'cube' given its close resemblance to that word. That evocation is present in both marks but is particularly strong in the opponent's mark given the cube device which reinforces the message. I find the marks to be conceptually highly similar given that the word 'LEASING' is entirely descriptive of the applicant's services.

Distinctive character of the earlier mark

18) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

19) As there is no evidence of use before me, I have only the inherent distinctiveness of the opponent’s mark to consider. I also remind myself that it is the distinctiveness of the common element which is key⁵. The common element between the marks at issue is the word ‘QUBE’. Whilst it is likely that this invented word will be perceived as being evocative of the well-known word ‘cube’, it does not have any clear relevance to the services covered by the opponent’s registration. I find that it has a good degree of inherent distinctiveness.

Likelihood of confusion

20) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor

⁵ In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

21) I have found that:

- The respective services are identical.
- The average consumer, being the general public and professional consumers is likely to pay at least a medium degree of attention and encounter the marks primarily by visual means.
- The marks are visually and aurally similar to a medium degree and conceptually highly similar.
- The common element, 'QUBE', has a good degree of inherent distinctiveness.

Weighing all of these factors, I find that one mark is unlikely to be mistaken for the other bearing in mind, in particular, that the marks are likely to be encountered mainly by visual means and the visual similarity is only of a medium degree. There is therefore no likelihood of direct confusion.

22) Turning to whether there is nevertheless a likelihood of the consumer believing that the respective services emanate from the same (or linked) undertaking(s) (also known as 'indirect confusion'), I note that 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 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.”

23) Further, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

24) I find that the similarities between the marks as a whole, stemming from the common element ‘QUBE’, together with the identity of the services, are likely to lead the average consumer to believe that the applicant’s mark is another brand or sub-brand of the opponent. There is a likelihood of indirect confusion.

OUTCOME

25) The opposition succeeds and, subject to any successful appeal, the application will be refused.

COSTS

26) As the opponent has been successful, it is entitled to a contribution towards its costs. Using the guidance in Annex A of Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Preparing the Notice of Opposition and reviewing the counterstatement	£200
Official fee (Form TM7)	£100
Written submissions	£300

Total:

£600

27) I have not overlooked that the opponent paid an Official fee of £200 when it filed the notice of opposition (Form TM7). The reason that amount was paid is because the opposition was originally pleaded under sections 5(2)(b), 5(3) and 5(4)(a). However, the opponent opted to withdraw the latter two grounds after the counterstatement was filed and before it had filed any evidence. In the light of this, I have only awarded £100 because that is the fee which is applicable to oppositions launched and fought under section 5(2)(b) only which is, effectively, the case here.⁶

28) I order Qube Leasing Limited to pay Qube Leasehold Property Management Limited the sum of **£600**. 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 21 May 2019

Beverley Hedley
For the Registrar,
the Comptroller-General

⁶ This is in contrast to the situation in *JetBlue Airways Corporation v Airblue Limited*, BL O/600/18, where the opponent had fought all of its pleaded grounds, including filing evidence in support, and was therefore entitled to be awarded the full £200 Official fee.