

O-429-19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3279969
BY COLIN MACKENZIE
TO REGISTER THE TRADE MARK



FOR SERVICES IN CLASS 36

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 412304
BY MEERKAT ENTERPRISE LIMITED

BACKGROUND AND PLEADINGS

1. On 2 January 2018, Colin Mackenzie (“**the Applicant**”) applied to register, in respect of *Estate agent services; Real estate agents services* in Class 36, the figurative mark shown on the cover of this decision, featuring the text “meerkatmoves.com Making moving simple”.
2. The application was published for opposition purposes in the Trade Marks Journal on 26 January 2018 and is opposed by Meerkat Enterprise Limited (“**the Opponent**”). The only ground for consideration in this decision is a claim under section 5(2)(b) the Trade Marks Act 1994 (“**the Act**”).¹ Thus, the question to be determined is whether the Applicant’s mark is similar to the earlier mark and is to be registered for identical or similar goods or services as the earlier mark, such that there is a likelihood of confusion and that the application should therefore not proceed to registration.
3. The Opponent relies on its ownership of UK trade mark registration No. 3145747 for the word “MEERKAT”, for services in classes 37, 39, 43 and 44.² The Opponent applied for its trade mark on 22 January 2016; therefore, in relation to the opposed mark, the Opponent’s is an “earlier mark” as defined in section 6 of the Act. The earlier mark completed its registration process on 17 June 2016, so had not been registered long enough to engage the proof of use provisions under section 6A of the Act; the Opponent is therefore able to rely on its earlier mark in these proceedings in respect of its claimed services without having to prove that it has used the mark at all.
4. As I explain below, there were points of inconsistency in the notice of opposition (Form TM7) filed on behalf of the Opponent by Keltie LLP, but it appears that this opposition relies only on the following services in classes 37 and 43:

¹ The notice of opposition (as amended) had originally also made claims under sections 5(3) and 5(4)(a) of the Act, but because the Opponent filed no evidence of reputation or goodwill in the earlier rights claimed, the grounds made under section 5(3) and 5(4)(a) were not supported and the Registry struck those grounds from the opposition (per the registry’s official letter 27 September 2018).

² The full list of the services under trade mark registration No. 3145747 is set out as Annex 1 to this decision.

Goods and services covered by the earlier trade mark relied upon for the opposition.

Class 37 - "Building construction, repair and installation services; Cleaning of the interior and exterior surfaces of buildings; Cleaning of clothing, fabrics, upholstery and blinds; Cleaning equipment hire; Cleaning of culverts; Cleaning of drains; Cleaning of drains by high pressure water jetting; Cleaning of public buildings; Cleaning of site roads; Cleaning of stone work; Cleaning of residential houses; Building construction and repair; Building maintenance and repair; House building; House painting; Property maintenance; Renovation and repair of buildings; Renovation and restoration of buildings; Renovation of property; Rental of building construction machinery; Rental of building equipment; Rental of building machines;

Class 43 - "Accommodation reservation services; Booking services for hotels; Hotel accommodation services; Providing accommodation for functions; Providing accommodation for meetings; Providing convention facilities; Providing facilities for fairs and exhibitions; Providing hotel accommodation; Providing temporary housing accommodations; Rental of beds; Rental of blankets; Rental of camping sites; Rental of holiday accommodation; Rental of holiday homes"

Points of inconsistency:

5. The Form TM7 had originally indicated by the response to Question 1 that the Opponent relied on all its registered services, but the Opponent's representatives amended the Form TM7 to state that only some of the registered services are relied on for the opposition, which it identified as those services "*in Annex 2*". The registry's file for this case showed nothing identified as "Annex 2", but the final of the additional pages filed with the amended Form TM7 was headed "*Goods [sic] and services covered by the earlier trade mark relied upon for the opposition*" – which are those as indicated in the extracted text (above). Consistent with those being the services in fact relied on, the response to Question 5 of the Form TM7 explicitly states that "*the services as included at Annex 2, namely services in respect of Class 37 and Class 43 of the earlier registration are similar to the Class 36 services as applied for under the opposed application ...*" claiming that they "*are complimentary [sic] and/or overlap*" with the Applicant's "Estate agent services; real estate agents services."
6. Question 5 then referred the reader further to paragraphs 4 - 8 of the Statement of Grounds. At paragraph 5 of the Statement of Grounds the Form TM7 states that the Applicant's services "*are highly similar to those subject to the Opponent's earlier trade mark*" – this phrasing fails to narrow the full range of its services from classes 37, 39, 43 and 44. However, it continues at paragraph 6 to state that "*in particular, the services in Classes 37 and 39 [sic] are complimentary [sic] of the goods [sic] covered by the application.*" Since the Opponent's services in Class 39 are not expressly referred to elsewhere in its opposition,

and since those services are transport services (as set out in Annex 1 to this decision), which lack any apparent overlap with the applied-for services, it seems likely that the paragraph 6 reference to “Class 39” may simply be an error and that the services on which the Opponent in fact relies are those in Classes 37 and 43, as set out earlier in this pleadings section of this decision. Nonetheless, at the point of comparing the services I shall make appropriate reference to the Class 39 services.

The Applicant’s defence

7. The Applicant submitted a Form TM8 notice of defence, including a counterstatement denying the claims.

Papers filed, representation and hearing

8. The Opponent was initially represented by Keltie LLP, but latterly has acted on its own behalf in these proceedings. During the evidence rounds the Opponent filed a single witness statement which I address briefly below. On conclusion of the evidence rounds, the Opponent requested an oral hearing of its opposition claim; a hearing was therefore scheduled to take place on Wednesday, 5 June 2019. However, on 1 June 2019, the Opponent informed the registry that it was no longer able to attend the hearing or to arrange an alternate attendee. The Opponent at that time filed its final submissions in lieu of attending an oral hearing, along with a completed tribunal costs pro-forma.
9. The Applicant has acted on his own behalf throughout these proceedings. The Applicant also chose not to attend an oral hearing, so the scheduled hearing was vacated, and the Applicant filed his own final submissions in lieu of attending an oral hearing. I have read all the papers filed and shall refer to the parties’ points, where I consider it warranted to do so.

The Opponent’s evidence

10. The Opponent’s evidence was a short witness statement, dated 26 September 2018, in the name of Asif Ali, who is director of the Opponent company. His evidence relates to use of the mark relied on and to his company’s registration of eight domain names featuring the word ‘meerkat’, including one called meerkatmove.com, said to have been registered on 15 October 2016. As I stated above, the Opponent is not required to show use of its mark because it had been registered for less than five years when the Applicant’s mark was published for opposition. I find that the evidence filed plays no role in my consideration of

the various aspects of the Opponent's section 5(2)(b) claim; my assessments focus on the mark and the specified services as they appear in the register and considering fair and notional use.

DECISION

11. Section 5(2)(b) of the Act, 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”.

12. Determination of a section 5(2)(b) claim must be made in light of the following principles, which 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 include the following:

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

13. The contested services applied for are simply “*estate agent services; real estate agents services*” in Class 36. The list of services relied on by the Opponent under its classes 37 and 43 are set out just a few paragraphs above, so I shall not repeat them fully here. Instead I refer below to aspects of those claimed specifications in Classes 37 and 43 that I consider most pertinent in the analysis of similarity between the services. I shall also refer briefly to Class 39. Before I compare the services based on the applicable criteria arising from case law, I shall deal firstly with a point submitted by the Applicant as a central line of its argument contesting the similarity between the services, which was to highlight that its services lie in Class 36, whereas none of the services under the Opponent’s mark is in that class. However, that fact is of little, if any, significance in the matter at hand, as is confirmed by the wording of section 60A of the Act, which reads as follows:

60A Similarity of goods and services

- (1) For the purposes of this Act goods and services — (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;
 - (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
- (2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.

14. My task is therefore to consider the terms that appear in the respective specifications, regardless of class, and to assess the extent to which there may be similarity between those services, taking into account the factors identified as relevant by case law, including as follows. The Court of Justice of the European Union (CJEU) in *Canon*³ it stated that:

“In assessing the similarity of the goods ... all the relevant factors relating to those goods .. 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”.⁴

15. In *Boston Scientific*⁵, the General Court described goods as “complementary” in circumstances where “... *there is a close connection between [the goods], 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*” – again, what is there said of goods will have similar applicability in respect of services. I also take note that in *Kurt Hesse v OHIM*⁶, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.

16. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case⁷ for assessing similarity were:

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

³ Case C-39/97, at paragraph 23.

⁴ The essence of case law points on similarity made in relation to goods applies correspondingly to services.

⁵ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

⁶ *Case C-50/15 P*

⁷ *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

- (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) [...];
- (f) The extent to which the respective goods or services are competitive.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court stated⁸ that 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 (and vice versa).
18. I also bear in mind that in *Avnet*, Jacob J. (as he then was) stated his view that: “*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.*”⁹
19. The Opponent argues that the services in Class 37 and 43 are similar to the applied-for Class 36 estate agency services on the claimed basis that they overlap and are complementary. The Class 37 services relate broadly to the processes of construction, maintenance and repair. Estate agent services will centrally involve introducing a client who wishes to sell or rent a property to a third party (or potentially their property agent) who wishes to purchase or take a lease of the property. A consumer looking to sell, buy or rent a property may also be interested to improve the physical condition of the property and therefore to engage services of the type under Class 37. I find there is a degree of similarity based on shared users of such services, although the services clearly differ in nature and intended purpose. Estate agent services will not generally be in competition with the Class 37 services – however, and although I am without evidence on full extent of “real estate agents services”, I find that the average consumer of such services might anticipate that a business that is engaged to manage the rental of property may also have responsibility for carrying out necessary repair work and maintenance. In that context and from the perspective of the average consumer, there would be an overlap in channels of trade between the Applicant’s services and, for example, the Opponent’s protection for “*property*

⁸ Case T- 133/05 at paragraph 29 of that judgment.

⁹ *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16

maintenance services; cleaning of residential housing; building maintenance and repair” in Class 37. The connection between the services in that context may be considered “*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*” and those services therefore complementary in the case law sense. Overall, I find a medium degree of similarity between the applied-for services and certain of the Opponent’s services in Class 37 as I have indicated.

20. In respect of the Class 43 services I find that most of the terms there give rise to no similarity. However, the exception to that finding is the specification of “*providing temporary housing accommodations*”. No evidence or submissions have been filed as to the remit of that term, but it seems to me that an ordinary understanding of the words would cover letting houses or flats for occupation on a time-limited basis. Such a description would apply comparably to some of the basic services of an estate agent and to that extent those services overlap in channels of trade, share the same nature, purpose and respective users and uses, and inevitably involve competition. On that basis, the applied-for services may be considered highly similar to the Opponent’s protection for “*providing temporary housing accommodations*” in Class 43.
21. Although I indicated above the possibility that the Opponent intended to rely additionally on its services in Class 39, such services (as set out in Annex 1) are self-evidently less similar to the Applicant’s services in Class 36, than are the services I have dealt with in Classes 37 and 43 – the Class 39 services are in fact dissimilar and I put them out of further consideration.

The average consumer and the purchasing process

22. In *Hearst Holdings Inc*,¹⁰ Birss J. explained that “... *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 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 word “average” denotes that the person is typical ...*”.

¹⁰ *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), at paragraph 60.

23. The average consumer for the services at issue will include members of the general public at large, who will encounter the marks in relation to the services at issue in promotional publications/advertisements, or on websites or on shop/business signage. I consider the selection and purchase process to be a primarily visual one, but aural considerations may also play a part, such as on the basis of word of mouth recommendations, so I also take into account the aural impact of the marks in the assessment of a likelihood of confusion. In selecting such services the average consumer would pay normal degree of attention.

Comparison of the marks

24. It is clear from *Sabel* 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 in *Bimbo* 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.”

25. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

<p>The Opponent’s earlier trade mark:</p>	<p>MEERKAT</p>
<p>The Applicant’s contested trade mark:</p>	

26. The overall impression of the earlier mark is, inevitably and simply, that it is the word MEERKAT. The overall impression of the Applicant's mark comes mainly from the words "meerkat" and "moves", since they are its largest components and differentiated by their colours. I find the word "meerkat" more dominant, as it is the first and longer word, and its emphasis is reinforced by the depiction of a meerkat sporting a hat and tie (which also contributes to the overall impression). The words "making moving simple" also have a role in the overall impression of the contested mark, but will be seen by the average consumer as a promotional strapline, secondary to the core component of trade mark message, which will be perceived resting in the words "meerkat moves". The ".com" component is small and may go unnoticed by the average consumer; it would anyway be understood as a suffix to a URL or web address and it carries little or no distinctiveness.

Visual similarity

27. The notice of opposition, as amended, at Q5, states that the opposed application is identical to the earlier registration for MEERKAT— plainly, it is not; elsewhere, in the statement of grounds the claim is that the marks are "highly similar". I find that from a visual perspective, there are striking differences, since the applied-for mark clearly has numerous additional word and pictorial elements that are entirely absent from earlier mark. (Although the text of the Applicant's figurative mark is predominantly in lower case and involves gradations of the colour blue, those points have no bearing in assessing visual similarity, since fair notional use of the earlier word mark would permit its presentation in a blue colour and in another standard typeface, including lower case.) However, since the whole of the earlier mark features as the dominant and most distinctive aspect of the Applicant's mark, and the pictorial component essentially depicts and reinforces the same word, I find that the marks are visually similar to a medium degree, despite the additional material in the latter mark.

Aural similarity

28. I find that the average consumer will likely voice the Applicant's mark as "meerkat moves", or possibly as "meerkat moves dot com". The average consumer will not voice the additional words "making moving simple", which will be perceived as a slogan, secondary within the mark. When I bear in mind the negligible distinctiveness of the "dot com" element, and that the whole of the earlier mark forms the beginning of the Applicant's mark as its dominant and most distinctive component, I consider the marks to be aurally similar to medium degree.

Conceptual similarity

29. The earlier mark inevitably invokes the concept of a meerkat, which is an animal belonging to the mongoose family. The same word is in the Applicant's mark and carries the same conceptual significance. The Applicant's mark has elaborations that carry their own additional concepts: "moves" suggests something to do with moving, which is not strongly distinctive in the context of the applied-for services; dot com raises the concept of a web address, but is of very limited distinctiveness; and finally the "making moving simple" slogan states a laudatory message about the ease arising from the subject services. Despite the additional conceptual angles in the applied-for mark, I find the shared distinctive and dominant presence of "meerkat" means that the marks are conceptually similar to a medium degree.

Distinctiveness of the earlier mark

30. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.¹¹ In *Lloyd Schuhfabrik*, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce

¹¹ *Sabel* at [24]

and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)”.

31. The earlier mark is “MEERKAT”. The mark is not descriptive or laudatory in relation to the registered services, but nor is it an invented word, rather it is, as will be known by at least a significant portion of the relevant public, the name of an animal. I find that the earlier mark may be considered to have an at least average degree of inherent distinctiveness. There is no evidence of use, promotion, market share or so on, so there is no possible enhancement of the distinctive character.

Conclusion as to likelihood of confusion

32. I conclude by making a global assessment of likelihood of confusion that takes account of my findings set out in the foregoing sections of this decision and of the various principles from case law outlined in paragraph 12 above, including the principle that there is an interdependence of factors, such that a lesser degree of similarity between the marks may be offset by a great degree of similarity between the services.
33. I have found the Applicant’s services are similar to some of the services relied on by the Opponent – to a high degree on the basis of services in Class 43 services, and to a medium degree on the basis of services in Class 37. The purchasing process will tend to entail a normal level of attention; the consumer will primarily encounter the marks visually and I have found the marks to have a medium degree of visual similarity based on the dominant distinctive component. The average consumer may also encounter the marks by oral recommendation or reference, and I find the marks also have medium degree of aural similarity. The marks also share a common distinctive concept. The Opponent’s earlier trade mark has an at least average degree of inherent distinctiveness.
34. On a global assessment, I consider that even though the average consumer is deemed to be reasonably well-informed and reasonably circumspect and observant, there does exist in this case a likelihood of confusion on the part of the relevant public. When I bear in mind that the average consumer rarely has the chance to make direct comparisons between marks and must instead rely on the imperfect picture of them he or she has in his or her mind, I find that it quite possible that there may be direct confusion (which in effect occurs when the average consumer mistakes one mark for the other). I bear in mind that the whole of the distinctive earlier mark

is dominantly present in the Applicant's mark, along with the less distinctive "moves" component, and I note too case law guidance that the average consumer tends to pay more attention to the beginning of a mark.

35. Alternatively, I find that there may be indirect confusion, where the average consumer may realise the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related. Indirect confusion (and its distinction from direct confusion), was considered by Mr Iain Purvis QC, sitting as the Appointed Person¹², in *L.A. Sugar Limited v By Back Beat Inc*,¹³ where he noted 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 as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case)

¹² An Appointed Person is a senior lawyer, expert in intellectual property law, who hears appeals against decisions of the trade mark tribunal.

¹³ Case BL-O/375/10

(b) *where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).*

(c) *where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”*

36. I duly take note that no likelihood of confusion arises where a later mark merely calls to mind the earlier mark (mere association). Sitting as the Appointed Person in *Eden Chocolat*¹⁴, James Mellor QC stated as follows:

“81.4 ... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining¹⁵ in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”

37. It seems to me that indirect confusion is likely to arise in this case in that the applied-for mark may be perceived as a brand extension, still incorporating the inherently distinctive meerkat trade mark, but elaborated to fit the services targeted at a consumer interested in moving living accommodation.

38. To offer a real-world illustration, one may imagine property listings publication in which the Opponent, under its MEERKAT brand, advertises its services in Class 37 such as property maintenance or cleaning of residential housing (or indeed its Class 43 provision of temporary housing accommodations) – and the Applicant too, under the applied-for mark, targets the same student sector and takes out advertising space in the same publication. Clearly the average consumer may wrongly infer an economic connection between the undertakings.

COSTS

39. This opposition has succeeded in full and the Opponent is entitled to a contribution towards its costs, based on the scale published in Tribunal Practice Notice 2/2016. I make no award

¹⁴ Case BL O-547-17 *Eden Chocolat be more chocstanza* (word & device) v Heirler Cenovis GmbH (27 October 2017)

¹⁵ In *L.A. Sugar Limited v By Back Beat Inc* Case BL-O/375/10 –above.

in respect of the evidence filed as I did not find it necessary or useful for the decision before me. I also take account of the limited extent to which the Opponent has relied on legal representatives in this matter. The award breakdown is as follows:

Official fee for filing the Form TM7	£100 ¹⁶
Preparing a statement of grounds and considering the other side's counterstatement	£200
Total	£300

40. I order Colin Mackenzie to pay Meerkat Enterprise Limited the sum of £300 (three hundred pounds) which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated 25 July 2019

Matthew Williams

For the Registrar

Annex 1

Full list of the services registered under the earlier mark
<p>Class 37: Dry cleaning services;" "Cleaning services;" "Contract, office and commercial cleaning;" "Building construction, repair and Installation services;" " "Cleaning of the interior and exterior surfaces of buildings;" "Cleaning of airports, factories, hotels, domestic homes, nursing homes, hospitals and commercial and industrial premises;" "Cleaning of clothing, fabrics, upholstery and blinds;;Cleaning equipment hire; Cleaning of culverts; Cleaning of drains; Cleaning of drains by high pressure water jetting; Cleaning of exterior airport runways; Cleaning of exterior ships' decks; Cleaning of machines; Cleaning of property; Cleaning of public buildings; Cleaning of site roads; Cleaning of stone work; Cleaning of storage containers; Cleaning of streets; Cleaning of textiles; Cleaning of windows; Cleaning soft furnishings; Cleaning of residential houses; Cleaning of vehicles; Cleaning (Vehicle -);</p>

¹⁶ (The fee paid was £200, but the opposition proceeded only on the basis of section 5(2)(b); oppositions based only on section 5(1) and/or 5(2) entail an official fee of £100.)

Cleaning (Dry -); Construction of buildings; Construction equipment (Rental of -); Construction of airports; Construction engineering; Construction of bridges ;Construction of carriageways; Construction of civil engineering works; Construction of complexes for business; Construction of complexes for recreational purposes; Construction of complexes for sports purposes; Construction of drainage systems; Construction of exhibition stands; Construction of factories; Construction of foundations for bridges; Construction of foundations for roads; Construction of houses; Construction of sports grounds; Construction of steel structures for buildings; Building construction and repair; Building demolition; Building insulation; Building maintenance and repair; Building of apartment buildings; Building repair and renovation; Burglar alarm installation and repair; Car valet services; Car wash; Car wash services; Carpentry; Construction; Construction consultancy; Construction of roads; Contract cleaning of offices; Domestic cleaning; Doors and windows (Installation of -); Double glazing installation; Dry cleaning; Dry cleaning of clothing; Excavating; Excavating machines (rental of -); Excavation services; Fitting services for tyres; Fur cleaning, care and repair; Garage services for vehicle repair; Heating equipment installation and repair; House building; House painting; Installation of glass; Installation of glass and glazing units; Installation of glazed building structures; Installation of kitchen cabinets; Installation of vehicle security devices; Installation services of building scaffolds; Ironing (linen-);Ironing of clothing; Joinery; Leasing of building machinery; Leasing of construction equipment; Maintenance and repair of motor vehicles; Maintenance and repair of motor vehicles for transportation of passengers; Maintenance of buildings; Masonry; Masonry services; Mobile vehicle tuning services; Motor vehicle wash; Office cleaning services; Painting and decorating; Painting and decorating of buildings; Painting of motor vehicles; Painting of vehicles; Panel beating; Plumbing; Property maintenance; Renovation and repair of buildings; Renovation and restoration of buildings; Renovation of property; Rental of building construction machinery; Rental of building equipment; Rental of building machines; Rental of building scaffolds, working and building platforms; Rental of building tools; Rental of construction equipment; Rental of construction machinery; Rental of hand and power tools; Rental of tools; Repair and maintenance of vehicles; Repair of accident damage to vehicles; Repair of buildings; Repair of tyres; Repair or maintenance of automobiles; Replacement of exhaust pipes; Residential and commercial building construction; Road building; Road construction; Road marking; Road paving; Road sealing and stripping; Road stripping; Road surfacing; Road sweeping; Scaffolding; Scaffolding

dismantling; Scaffolding, earthworks or concrete construction; Scaffolding erection; Scaffolding hire; Scaffolding rental; Scaffolding services; Surfacing of roads; Swimming pool cleaning services; Tyre balancing; Tyre fitting; Tyre repair; Vehicle breakdown assistance [repair]; Vehicle breakdown repair services; Vehicle repair and maintenance; Vehicle servicing; Vehicle upholstery and repair services; Vehicle valeting [cleaning] services; Vehicle wash; Vehicle window replacement services; Vehicle windscreen replacement services; Wheel alignment adjustment; Wheel balancing; Wheel repair; Window cleaning; Window installation; Window maintenance; Window repair; Window replacement

Class 39: Transport and delivery service of goods by motorcycle, car, taxi and other land vehicles;" "Transportation of persons by air, rail, road and sea;" "Transportation of passengers by bus, coach, ferryboat and minibus;" "Transport of money and valuables;" "Delivery, dispatching and distribution of newspapers and magazines;" "Pickup, storage, transportation and delivery of documents, packages and freight via air, land, rail and sea;" "booking and arrangement of travel, vacations, excursions, tours and cruises;" "Consultation provided by telephone call centres and hotlines in the field of travel, business travel and tourism;" "travel agency and tourism services;" "consultancy and advice relating to the aforesaid services;" "Baggage handling; Porterage;" "Rental, booking and providing of ships, in particular rowing and motor boats, sailing vessels and canoes;" "Rental of storage containers;" "rental, booking and providing of aircraft;" "Arranging for the rental and leasing of self-drive vehicles and chauffeur-driven vehicles; Airline ticket services; Arrangement of taxi transport; Arranging transportation of passengers by road, rail, air and sea; Chauffeur driven car hire services; Chauffeur services; Vehicle rental, leasing and chartering services; Taxi services; Taxi transport; Taxi transport for people in wheelchairs; Travel and tour agency services; Travel and tour ticket reservation service; Parking services for vehicles; Transportation and delivery services by air, road, rail and sea; Transportation by courier; Minibus transport services; Motor vehicle recovery services; Motorcycle rental; Transport of valuables in security vehicles; Transport services for sightseeing tours; Car park services; Holiday travel reservation services; Parking services for vehicles; Tour operation services; Wrapping of goods; Wrapping services for baggage protection during travel; Yacht and boat charter services; Baggage handling; Travel agency services for

arranging travel; Travel agency and booking services; Travel agency services; Travel agency services for arranging holiday travel; Travel agency services for business travel; Travel agency services for sea travel; Travel agency services, namely, making reservations and bookings for transportation; Pizza delivery.

Class 43: Accommodation reservation services; Bistro services; Booking services for hotels; Cafe services; Cafés; Cafeteria services; Cafeterias; Canteen services; Canteens; Catering services; Homes (Tourist -); Hostels; Hotel accommodation services; Hotel catering services; Hotel reservation services; Hotel room booking services; Hotels; Linen hire; Mobile catering services; Mobile restaurant services; Organisation of catering for birthday parties; Outside catering services; Providing accommodation for functions; Providing accommodation for meetings; Providing convention facilities; Providing facilities for fairs and exhibitions; Providing hotel accommodation; Providing temporary housing accommodations; Rental of beds; Rental of blankets; Rental of camping sites; Rental of carpets; Rental of chairs, tables, table linen, glassware; Rental of cooking equipment for industrial purposes; Rental of crockery; Rental of cutlery; Rental of furnishings; Rental of furniture; Rental of holiday accommodation; Rental of holiday homes; Rental of linen; Rental of meeting rooms; Rental of rooms; Restaurant reservation services; Restaurant services; Restaurants; Tourist homes; Tourist inns; Travel agencies for arranging accommodation; Travel agency services for making hotel reservations; Travel agency services for reserving hotel accommodation; Pizza parlors; Old people's home services

Class 44: Barber shops; Beautician services; Beauty salons; Hair cutting; Hair dressing salon services; Health care; Health care services; Medical care; Medical nursing; Medical services for the treatment of conditions of the human body; Nail care services; Nail salon services; Nursing care; Nursing home services; Nursing homes; Physiotherapy; Professional consultancy relating to health care; Provision of health care services in domestic homes ;Rental of hospital equipment; Rental of medical and health care equipment.