

O-523-19

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3278702
BY WASIM SARWAR
TO REGISTER


LifeSecure

AS A TRADE MARK
IN CLASS 36
AND OPPOSITION THERETO (UNDER NO. 411992)
BY
KILLIK & CO LLP

Background & pleadings

1. Wasim Sarwar ('the applicant') applied to register the trade mark **LifeSecure** on 21 December 2017. The mark was published on 2 February 2018 for services in class 36. However only the following services are opposed in these proceedings: *Advisory services relating to life insurance; Arranging of life insurance; Providing information relating to life insurance brokerage; Providing information relating to life insurance underwriting.*

2. Killik & Co LLP ('the opponent') opposes the application under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of its UK trade mark and the services set out below.

UK TM No. 3108148	Services relied on:
 Filing date: 12 May 2015 Registration date: 5 June 2015	Information services relating to finance; Information services relating to finance, provided on-line from a computer database or the internet; advice on finance during retirement; advice on finance for retirement; advisory services relating to finance; consultancy services relating to finance; consultancy services relating to personal finance; personal finance services.


3. The opponent's above trade mark has a filing date that is earlier than the filing date of the application and, therefore, is considered as an earlier mark, in accordance with Section 6 of the Act. However the earlier mark is not subject to proof of use, having not been registered for five years prior to the publication date of the contested application.

4. The applicant filed a counterstatement in which he denied the ground of opposition.

5. During these proceedings both parties have represented themselves.

6. Nothing further was received from the opponent beyond the notice of opposition. Only the applicant filed evidence. No hearing was requested and neither party filed written submissions in lieu of a hearing. I now make this decision from the material before me.

Applicant's evidence

7. The applicant provided his own witness statement and appended five exhibits. The witness statement contained a number of submissions rather than evidence of facts. I have considered the exhibits and do not find any material which assists my decision as they relate to Companies House and Financial Conduct Authority listings in addition to Google search engine results for the opponent's mark. The applicant appears to have a misunderstanding about the matters at hand which I believe is appropriate to address before continuing. The applicant refers to company names and being unable to find the words **SecureLife** on the Companies House Register or on the Financial Conduct Authority's website. I would point out that whilst the opponent's trade mark contains the words **SecureLife** in a stylised presentation namely , the opponent's company name is Killik & Co LLP. Trade marks and company names are different entities and are governed by different legislation. This decision is not made in relation to company names but to trade marks.

8. Secondly, the applicant states that he has been trading with his mark since 2011, some four years before the opponent's mark was registered. The viability of such a defence has been considered previously by Ms Anna Carboni, sitting as the Appointed Person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O/211/09, in which she rejected the defence as being wrong in law. If an applicant claims to have an earlier right which could be used to invalidate the trade mark relied on by the opponent, and the applicant wished to invoke that earlier right, then the proper course of action is to apply to invalidate the opponent's mark.

9. Finally the applicant claims there is an absence of confusion in the market place as his mark does not appear in the results of a search for the words **SecureLife**

using the Google search engine. The absence of confusion defence was addressed in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

“80. ...the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

10. It is settled law that in assessing whether there is a likelihood of confusion I must make my comparison on the basis of notional and fair use over the whole range of services covered by the applicant’s and (since the earlier mark is not subject to proof of use under section 6A of the Act) the opponent’s respective specifications. It is the *inherent* nature of the services contained within the specifications which I have to consider. Current use is not relevant to this notional comparison. My task, therefore, is to conduct the comparison simply on the marks and on the services as they are set out in the respective specifications. The concept of ‘notional and fair use’ is also outlined in the *Roger Maier* decision, particularly paragraph 78,

“78. ...the court must... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used

at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

Section 5(2)(b)

11. Section 5(2)(b) of the Act states 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. 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.

Comparison of services

13. The case law relating to the comparison of goods and services is set out below. In *Canon*, the CJEU 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”.

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur 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”.

This principle applies equally to services.

15. The services to be compared are set out below.

Opponent's services	Applicant's services
Class 36: Information services relating to finance; Information services relating to finance, provided on-line from a	Class 36: Advisory services relating to life insurance; Arranging of life insurance; Providing information relating

computer database or the internet; advice on finance during retirement; advice on finance for retirement; advisory services relating to finance; consultancy services relating to finance; consultancy services relating to personal finance; personal finance services	to life insurance brokerage; Providing information relating to life insurance underwriting.
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16. It is settled law that financial services includes insurance services¹. I note the opponent has the term *personal finance services* within its specification. I find this term is another way of saying financial services, as it is simply the provision of financial services in a personal basis. As such the applicant's services fall under this term and are considered identical on the *Meric* principle. Moreover, I would in any case have found a high degree of similarity between the applicant's insurance services and the opponent's personal finance services by virtue of the average consumer's perception of the nature of the respective services and their channels of trade.

Average consumer and the purchasing act

17. It is necessary to consider the role of the average consumer and how the services are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

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:

¹ *FIL Ltd & Anor v Fidelis Underwriting Ltd & Ors* [2018] EWHC 1097 (Pat) at para 89

“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.”

19. The average consumers for the contested services are the general public. Taking into account that selecting insurance policies will entail detailed discussions of personal circumstances to ensure the correct policy is chosen to suit the requirements of the individual, I find that consumers will pay a normal degree of attention during the purchasing process. The services can be accessed visually through the service provider’s literature or through online means such as websites. There is also likely to be an aural aspect to the purchasing process such as word of mouth recommendations or seeking advice from a specialist broker or advisor.



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, artificially to 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 marks to be compared are set out below.

Opponent's mark	Applicant's mark
 The image shows the opponent's mark, which consists of the words "SecureLife" followed by a trademark symbol (TM) in a serif font. The entire text is enclosed within a rounded rectangular border.	 The image shows the applicant's mark, which consists of the words "LifeSecure" in a bold, sans-serif font.

23. The opponent's mark comprises the conjoined words **Secure** and **Life** and the letters **TM** in superscript, the whole being enclosed by a single line border. The overall impression rests on this presentation.

24. The applicant's mark comprises the conjoined words **Life** and **Secure**. There are no other aspects to the mark and the overall impression rests solely on this conjoined presentation.

25. In terms of visual similarity, the average consumer will notice that both marks contain the words **secure** and **life**. In terms of the opponent's mark, there are features present which do not appear in the applicant's mark but the positioning of the letters TM will merely be seen as denoting a trade mark and will not have a material visual impact. In addition, whilst the single line border around the word element of the opponent's mark is noticeable, it is an unremarkable stylization which in my view will not have a significant visual impact. Overall, I find that the marks are visually similar to a medium degree.

26. Turning to the aural similarity, there is no aural aspect to the single line border around the opponent's mark, so only the word elements need to be considered. It is unlikely that the letters TM will be verbalised. The aural focus will be on the two word

combinations in each mark. Both of the word elements will be pronounced in the same way, albeit in a different order, so I find there is at least a medium degree of aural similarity.

27. In considering the conceptual similarity, I note that neither mark has a meaning when conjoined that is different to the meaning of the words when they are separated. Essentially both marks consist of two words **secure** and **life** and those words will bring their ordinary meanings to mind. The marks share a concept of having something to do with life and being secure. Regardless of which order the words are in, the concept remains the same. On that basis I find the marks are conceptually identical.

Distinctiveness of the earlier mark

28. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through 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).”

29. The opponent has not provided any evidence in these proceedings, so I can only consider the inherent position. The earlier mark is a conjoining of two ordinary dictionary words surrounded by an unremarkable single line border. Though I think there could be said to be a certain degree of allusiveness in relation to the services, the word element of the earlier mark does not directly describe them; overall, I find that the earlier mark is averagely distinctive.

Likelihood of confusion

30. Drawing together my earlier findings into the global assessment of the likelihood of confusion, I keep in mind the following factors and those outlined in paragraph 12:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) 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*).

31. Confusion is considered as direct when the average consumer mistakes one mark for the other.

32. So far in this decision I have found that the services are identical and that an average consumer will be paying a normal degree of attention in a primarily visual purchasing process. In addition, I have found the earlier mark is averagely distinctive and the marks are visually and aurally similar to a medium degree and conceptually identical.

33. In considering the factors relating to direct confusion, the most pertinent is that of imperfect recollection. Both marks contain the same two words, albeit in a different order. It is unlikely that a consumer will see the two marks side by side, but they will have those two words in mind, especially as the concept is the same for both marks. Bearing in mind that I have found the competing services identical, or in any event highly similar, I consider it likely that at least a significant proportion of the relevant public will mistake the marks for one another when used in connection with those services. There is therefore a likelihood of direct confusion in respect of all the services which have been opposed in these proceedings.

Conclusion

34. The opposition succeeds under section 5(2)(b) and, subject to any successful appeal against my decision, the application is refused for *Advisory services relating to life insurance; Arranging of life insurance; Providing information relating to life insurance brokerage; Providing information relating to life insurance underwriting.*

35. The application can proceed to registration for the remainder of the services in class 36 namely *Life insurance brokerage; Consultancy and brokerage services relating to life insurance; Insurance services relating to life* which were not opposed in these proceedings.

Costs

36. The opponent has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the opponent is unrepresented, at the conclusion of the evidence rounds the tribunal invited them, in the official letter dated 2 July 2019, to indicate whether they wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition; it was made clear to the opponent that if the pro-forma was not completed, costs may not be awarded, other than for official fees. The opponent did not respond to that invitation so consequently I make the following award.

£100 Official fee for filing opposition

53. I order Wasim Sarwar to pay Killik & Co LLP 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.

Dated 6 September 2019

June Ralph

For the Registrar,

The Comptroller General