

O/690/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003387082

BY ANDREW JAMES SHELDRAKE

TO REGISTER THE TRADE MARK:



IN CLASS 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600001149 BY

LITTLE WHEELERS LIMITED

## BACKGROUND AND PLEADINGS

1. On 27 March 2019, Andrew James Sheldrake (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 7 June 2019. Registration is sought for the following services:

Class 41      Coaching [training].

2. The application was opposed by Little Wheelers Limited (“the opponent”) by way of the Fast Track opposition procedure commenced on 20 June 2019. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on UK registration no. 3379372 for the following trade mark:



3. The opponent’s mark was filed on 28 February 2019 and registered on 17 May 2019. The opponent relies upon all services for which the mark is registered, namely:

Class 41      Sports tuition, coaching and instruction.

4. The opponent submits that there is a likelihood of confusion because the services are identical or similar, and the marks are similar.

5. The applicant filed a counterstatement denying the basis of the opposition.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

8. Both parties are unrepresented.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate costs; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary and neither party filed written submissions in lieu.

## **PRELIMINARY ISSUE**

10. In his counterstatement, the applicant has made reference to the fact that the parties target different age groups and the services listed on their websites differ. In *O2 Holdings Limited, O2 (UK) Limited v Hutchinson 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, my assessment must take into account the applied-for mark and services and any potential conflict with the earlier trade mark and its listed services and not any difference between their current marketing strategies and use in practice.

## **DECISION**

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

“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.”

12. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. As the opponent’s trade mark had not completed its registration process more than 5 years before the date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the services it has identified.

### **Section 5(2)(b) – case law**

13. 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:

(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 services

14. The competing services are as follows:

<b>Opponent's services</b>	<b>Applicant's services</b>
<u>Class 41</u> Sports tuition, coaching and instruction.	<u>Class 41</u> Coaching [training].

15. 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 for 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.”

16. Tuition and instruction, in the context of sports training, are alternative names for ‘coaching’. Consequently, “sports tuition, coaching and instruction” in the opponent’s specification falls within the broader category of “coaching [training]” in the applicant’s specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

## **The average consumer and the nature of the purchasing act**

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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.”

18. The average consumer for the services will be a member of the general public. There will be various factors taken into account during the purchasing process such as type of training offered and skill level required to engage with the activities. The cost of the services will vary. The parties' respective specifications are broad enough to cover coaching of both adults and children. I recognise that parents considering where to send their children for coaching or tuition will be more cautious than perhaps they would when purchasing the services for themselves. Taking all of these factors into account, I consider that a medium degree of attention will be paid during the purchasing process.

19. The services are most likely to be selected following inspection of the website of the service provider or following review of adverts (either in the form of leaflets or posters, or alternatively, in the form of social media or online promotions). Consequently, visual considerations are likely to dominate the selection process for the services. However, I recognise that word-of-mouth recommendations may also

play a part and I do not, therefore, discount that there will be an aural component to the purchase of the services.

### **Comparison of trade marks**



20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade 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:



Opponent's trade mark	Applicant's trade mark
	

23. The opponent's mark consists of the words LITTLE WHEELERS presented in title case. The wording is white on pink and blue backgrounds. At the top right of the mark is a device of a child on a bicycle. The eye is naturally drawn to the elements of the mark that can be read, although the device of the child is larger in size. The device reinforces the meaning of the wording. I consider that the wording will play the greater role in the overall impression of the mark, followed by the device and with the use of colour and stylisation playing a lesser role. The applicant's mark consists of the words MINI WHEELERS presented in an upper case stylised green font. The word MINI is larger than WHEELERS. The words are divided by a line and a circular device. I consider that the words MINI WHEELERS play a greater role in the overall impression, with the device, line and use of stylisation and colour playing a lesser role.

24. Visually, the marks coincide in the presence of the word WHEELERS. They differ in the use of the words MINI and LITTLE and the devices used in each mark. The colours used also differ. I consider the marks to be visually similar to between a low and medium degree.

25. Aurally, the only elements of the marks that will be pronounced are the words. The word WHEELERS will be pronounced identically in each mark. The point of aural difference will be the pronunciation of the words MINI and LITTLE. I consider the marks to be aurally similar to a medium degree.

26. Conceptually, WHEELERS is ambiguous in its meaning. It is likely to be viewed as a reference to a group of people who undertake an activity that relates to wheels in some way (e.g. driving, cycling etc.). In the opponent's mark, the meaning is clarified

by the presence of the device which shows a child riding a bicycle. The words MINI and LITTLE have similar meanings as they both refer to something that is small. The device in the applicant's mark and the use of stylisation/colour in both marks do not add anything to the conceptual meanings conveyed by the marks. I consider the marks to be conceptually highly similar.

### **Distinctive character of the earlier trade mark**

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

28. Registered trade marks possess varying degree of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic

of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

29. The opponent has not pleaded that its mark has acquired enhanced distinctive character through use and has filed no evidence to support such a finding. Consequently, I have only the inherent position to consider. The word WHEELERS is an invented word. However, as noted above, it is likely to give the impression of a group of people who carry out an activity related to wheels in some way (such as cycling, driving etc.) The addition of the word MINI suggests that this is aimed at a younger audience. I consider these words to be distinctive to a slightly lower than medium degree. Whilst the device clarifies the meaning conveyed by the words (as it shows an image of a child on a bicycle), its addition does contribute to the mark's distinctive character, as does the stylisation and use of colour. I consider the mark as a whole to be inherently distinctive to a medium degree.

### **Likelihood of confusion**

30. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

31. Direct and indirect confusion were described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

32. I have found the marks to be visually similar to a low to medium degree, aurally similar to a medium degree and conceptually highly similar. I have found the opponent’s mark to have a medium degree of inherent distinctive character. However, I recognise that part of the earlier mark’s distinctive character lies in the device, colour and stylisation which are not replicated in the applicant’s mark. I remind myself that it is the distinctiveness of the common element that is key.<sup>1</sup> I have identified the average consumer to be a member of the general public who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that the level of attention paid during the purchasing process will be medium. I have found the parties’ services to be identical.

33. As noted above, the purchasing process for the services will be predominantly visual. However, there will be some consumers who come into contact with the marks through word-of-mouth recommendations. Taking all of the above factors into account, for those consumers, the presence of the words MINI and LITTLE (both being

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<sup>1</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

references to something small) and the invented word WHEELERS are likely to lead to the marks being mistakenly recalled or misremembered as each other. This is particularly the case bearing in mind the principle of imperfect recollection and the fact that the marks are registered for identical services. I consider there to be a likelihood of direct confusion.

34. I recognise that for those consumers who encounter the marks visually, the differences created by the stylisation and devices used will assist in distinguishing them and may avoid direct confusion arising. However, in my view, even if the differences in stylisation and devices are recalled by the consumer, the words MINI and LITTLE will remain interchangeable when taking account of the principle of imperfect recollection and this, combined with the word WHEELERS in both marks will lead the average consumer to conclude that they are alternative marks used by the same or economically linked undertakings. This is particularly the case bearing in mind that the differences between the marks will be offset by the identity of the services. I consider there to be a likelihood of indirect confusion.

## **CONCLUSION**

35. The opposition is successful, and the application is refused.

## **COSTS**

36. Awards of costs in fast track proceedings are governed by Tribunal Practice Notice 2/2015. The opponent has been successful and would normally be entitled to a contribution towards its costs. However, as the opponent is unrepresented, the Tribunal wrote to the opponent and invited it to indicate whether it intended to make a request for an award of costs. The opponent was informed that, if so, it should complete a costs proforma, providing details of its actual costs and accurate estimates of the amount of time spent on various activities in the prosecution of the opposition. The opponent was informed that “if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded”. No proforma was filed by the opponent. That being the case, I award the opponent the sum of £100 only, in respect of the official fee.

37. I therefore order Andrew James Sheldrake to pay Little Wheelers Limited the sum of £100. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 13<sup>th</sup> day of November 2019**

**S WILSON**

**For the Registrar**