

O/1035/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003586689

**BY LIFEWORK COMMUNITIES LTD TO REGISTER THE FOLLOWING TRADE
MARK:**

LIFEWORK

IN CLASSES 35 AND 36

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 427454 BY LIFEWORLD.BE NV**

1. On 29 January 2021, Lifework Communities LTD ('the Applicant') filed an application to register the mark shown on the front page of this Decision, number UK00003586689. The application was published for opposition purposes in the *Trade Marks Journal* on 9 July 2021. Registration is sought in respect of the following:

Class 35: *Arranging of contracts for others for the buying and selling of goods; advertising; business consulting; providing online marketplaces for sellers of goods and or services; procuring of contracts for the purchase and sale of goods; arranging of buying and selling contracts for third parties; sales promotions at point of purchase or sale, for others; provision of an on-line marketplace for buyers and sellers of goods and services; marketing; marketing services; promoting the goods and services of others; sales promotion; provision of an online marketplace for buyers and sellers of goods and services.*

Class 36: *Lease of real estate; leasing of real estate.*

2. The application was opposed by LIFEWORLD.BE NV ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act").¹ The Opposition is directed against all of the Applicant's services. The Opponent relies on the following earlier registration, relying on all of the services in its specification:

UK00917832692

LIFEWORLD

Filing date: 19 February 2018

Date of entry in register: 11 July 2018

¹ The Opposition was initially also based upon section 5(3) of the Act. The Opponent subsequently failed to adduce supporting evidence for its claim under this ground. The Opposition was therefore withdrawn in respect of the section 5(3) claim;

The Applicant's references, in its written submissions, to the opposition under the section 5(1) ground are presumed to be an error.

Registered for following services:

Class 36: *Building management; management of property; building leasing; rental of buildings; leasing of real estate; rental of office space; real estate management; real estate management services related to building complexes; real estate management relating to residential buildings; estate agency services for sale and rental of buildings; provision of housing accommodation; housing agency; providing information related to the sale and rental of buildings; real estate brokerage; real estate consultancy; rental of offices for co-working; financial management services relating to buildings; financial sponsorship of arts events.*

Class 37: *Building; house building; building of apartment buildings; building of commercial properties; construction of public facilities; construction of complexes for residential, commercial, educational or work purposes; erecting of housing areas; building services; building consultancy; construction management services; advisory services relating to building construction.*

Class 41: *Educational services, namely, organizing and arranging training, classes, seminars, workshops in the fields of arts, architecture, business, cinema, design, fashion, food, health, marketing, photography, social networking and technology; coaching; arranging and conducting workshops, lectures and conferences; entertainment; cultural activities; art exhibitions; cultural, educational or entertainment services provided by art galleries; art gallery services provided on-line via a telecommunications link; photography; organisation of fashion shows for entertainment purposes; music concerts; organising of recreational events; publishing of web magazines; electronic online publication of periodicals and books; provision of social*

clubs services; arranging and conducting parties, camps, concerts for business purposes; organising music and entertainment programmes and events; production of music, videos and movies; live musical concerts; consultancy on music, video and movie production; publication of books in the fields of arts, architecture, business, cinema, design, fashion, food, health, marketing, photography, social networking and technology; entertainment services provided by hotels.

Class 42: *Building design services; design of building interiors and exteriors; design of buildings; research on building construction or city planning; architectural services for the design of buildings for residential, commercial, educational or work purposes; construction drafting; construction planning; development of construction projects; construction design; design of hotels; services for the planning [design] of hotels.*

Class 43: *Temporary accommodation; providing accommodation for meetings and social gatherings; rental of meeting rooms; room rental for exhibitions; hire of temporary office space; provision of temporary work accommodation; operating membership accommodation; hotel services; hotel accommodation services; providing food and drink; catering; cafe services; bar services; restaurant services; snackbars; hire of temporary office space, equipped with private offices, office equipment, mailroom, printing center, receptionist, kitchen, meeting rooms, telecommunications equipment and other office amenities; providing work space containing business equipment and other amenities to emerging, start-up and existing companies; membership club services, namely, providing facilities related to the conducting of business meetings; providing facilities for business conferences and conventions and for exhibitions for business purposes.*

3. The Opponent claims that:
 - the parties' respective marks are highly similar;
 - the parties' respective services are 'identical, highly similar and/or complementary' and 'also have the same relevant consumer';
and
 - that there is therefore a likelihood of confusion between the marks.
4. The Applicant filed a Defence and Counterstatement in which it concedes that there is some level of similarity between the marks but denies that such similarity would give rise to a likelihood of confusion.
5. The Opponent is represented by Stobbs; the Applicant is represented by Birketts LLP.
6. Neither party has filed evidence. Written submissions were filed during the evidence round by the Applicant only. A hearing was neither requested nor thought necessary. Neither party has filed written submissions in lieu of a hearing.
7. The following decision has been made after careful consideration of the papers before me.

Decision

Section 5(2)(b) of the Act and related case law

8. 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.”

9. In accordance with section 6 of the Act, the Opponent’s mark is an earlier mark by virtue of its earlier filing date (19 February 2018) which falls before the filing date of the applied-for mark on 29 January 2021.
10. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is not engaged because the Opponent’s mark had been registered for less than 5 years on the date on which the Applicant filed its application. The Opponent is therefore entitled to rely upon all of the goods that it seeks to rely upon.
11. The following principles are derived from the decisions of the Court of Justice of the European Union² (“CJEU”) 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 C120/04; *Shake 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;

² Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Preliminary issues

12. I note the following submission from the Applicant:³

‘No evidence of actual confusion has been brought forward by the Opponent to support a claim under s5(2)(b) TMA 1994, which should be available due to the overlapping period of use made by the Applicant of their LIFEWORK mark in the UK. The obvious conclusion being that no confusion has occurred in this 2 years+ period.’

13. It is not incumbent on the Opponent to demonstrate that there has been actual confusion between the parties’ marks. In the case of *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, 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

³ Applicant’s written submissions, paragraph [5].

one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

14. State of the Register evidence

The Applicant has submitted the following:⁴

“LIFE is an extremely common prefix for company names and their associated branding. A UK Companies House search on LIFE gains 20,050 hits; a similar search on LIFEWOR gains 65 hits; and one on LIFEWORK gains 49 hits (including the Applicant). None of these companies sought to oppose the subject mark only a Belgium based entity [...]”

15. The presence, or otherwise, of other company names containing ‘LIFE’, ‘LIFEWOR’ or ‘LIFEWORK’, registered with Companies House, does not weaken the Opposition against the Applicant’s mark; and has no bearing on the instant proceedings. My assessment is concerned only with the particular *marks* pertinent to this opposition; company names are not trade marks.

16. In the case of *46 Maras*⁵, Mr Thomas Mitcheson Q. C., sitting as the Appointed Person, held that:

‘...It is well established that mere evidence of the state of the register is of little assistance in determination of disputes of this nature. Without evidence of use and reputation, the existence of other registrations can have no bearing on the question of the likelihood of confusion.

Comparison of services

17. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

⁴ Applicant’s written submissions, paragraph [7].

⁵ O/112/21 at para [20].

(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 1975.”

18. In making an assessment between the competing services, I bear in mind the decision of the General Court (‘GC’) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05:

“29. ... the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM-Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to a parties’ goods and services must be taken into account:

“[23] “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”.

20. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281⁶, identified the following factors for assessing similarity of the respective goods and services:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and, in particular, whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

21. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.⁷

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods [or services]. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, 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”.

23. Goods (or services) may be grouped together for the purposes of assessment:

⁶ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

⁷ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

Separode Trade Mark BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

24. The services to be compared are as follows:

Earlier mark:	Applied-for mark:
<p>Class 36: <i>Building management; management of property; building leasing; rental of buildings; leasing of real estate; rental of office space; real estate management; real estate management services related to building complexes; real estate management relating to residential buildings; estate agency services for sale and rental of buildings; provision of housing accommodation; housing agency; providing information related to the sale and rental of buildings; real estate brokerage; real estate consultancy; rental of offices for co-working; financial management services relating to buildings; financial sponsorship of arts events.</i></p>	<p>Class 35: <i>Arranging of contracts for others for the buying and selling of goods; advertising; business consulting; providing online marketplaces for sellers of goods and or services; procuring of contracts for the purchase and sale of goods; arranging of buying and selling contracts for third parties; sales promotions at point of purchase or sale, for others; provision of an on-line marketplace for buyers and sellers of goods and services; marketing; marketing services; promoting the goods and services of others; sales promotion; provision of an online marketplace for buyers and sellers of goods and services.</i></p>
<p>Class 37:</p>	<p>Class 36:</p>

<p><i>Building; house building; building of apartment buildings; building of commercial properties; construction of public facilities; construction of complexes for residential, commercial, educational or work purposes; erecting of housing areas; building services; building consultancy; construction management services; advisory services relating to building construction.</i></p> <p>Class 41: <i>Educational services, namely, organizing and arranging training, classes, seminars, workshops in the fields of arts, architecture, business, cinema, design, fashion, food, health, marketing, photography, social networking and technology; coaching; arranging and conducting workshops, lectures and conferences; entertainment; cultural activities; art exhibitions; cultural, educational or entertainment services provided by art galleries; art gallery services provided on-line via a telecommunications link; photography; organisation of fashion shows for entertainment purposes; music concerts; organising of recreational events; publishing of web magazines; electronic online publication of periodicals and books;</i></p>	<p><i>Lease of real estate; leasing of real estate.</i></p>
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provision of social clubs services; arranging and conducting parties, camps, concerts for business purposes; organising music and entertainment programmes and events; production of music, videos and movies; live musical concerts; consultancy on music, video and movie production; publication of books in the fields of arts, architecture, business, cinema, design, fashion, food, health, marketing, photography, social networking and technology; entertainment services provided by hotels.

Class 42:

Building design services; design of building interiors and exteriors; design of buildings; research on building construction or city planning; architectural services for the design of buildings for residential, commercial, educational or work purposes; construction drafting; construction planning; development of construction projects; construction design; design of hotels; services for the planning [design] of hotels.

Class 43:

Temporary accommodation; providing accommodation for meetings and

<p><i>social gatherings; rental of meeting rooms; room rental for exhibitions; hire of temporary office space; provision of temporary work accommodation; operating membership accommodation; hotel services; hotel accommodation services; providing food and drink; catering; cafe services; bar services; restaurant services; snackbars; hire of temporary office space, equipped with private offices, office equipment, mailroom, printing center, receptionist, kitchen, meeting rooms, telecommunications equipment and other office amenities; providing work space containing business equipment and other amenities to emerging, start-up and existing companies; membership club services, namely, providing facilities related to the conducting of business meetings; providing facilities for business conferences and conventions and for exhibitions for business purposes.</i></p>	
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25. Neither party has advanced any argument as to which specific services have similarity/identity with each other. I will therefore make my own comparison.

Class 35

26. Contested services: *Arranging of contracts for others for the buying and selling of goods*

The Applicant's services, to my mind, will entail performing a range of exercises, on behalf of a contracting party, aimed at putting a contract in place. These will include, *inter alia*: negotiating the contractual terms; coordinating discussions between the contracting parties; and the administrative aspect of concluding the contracts, i.e. the 'paperwork'. This term is drafted to cover contracts specifically for the buying and selling of goods as opposed to services.

27. The Opponent's services cover, broadly speaking, the following areas:

- Class 36 - services related to real estate and property management;
- Class 37 - services related to construction
- Class 41 - services related to the provision of education, entertainment and cultural events
- Class 42 - services related to building design
- Class 43 – services related to accommodation, facilities and catering

28. The purpose of the Applicant's services is to formally set out the legal rights and remedies enjoyed by buyers and vendors of goods when transacting. This purpose, in my view, differs greatly from the respective purposes of the Opponent's services. Having also considered uses, users and trade channels for the parties' respective services, and whether or not the services are in a competitive or complementary relationship, I find the parties' services to be dissimilar.

29. Contested services: *procuring of contracts for the purchase and sale of goods*

The Applicant's services will, in my view, encompass exercises including: sourcing suppliers; implementing processes to manage bids; and negotiating contracts. It is clear from the wording of the term that the services relate to the purchase and sale of goods rather than services. For the reasons provided above at [28], I find the parties' respective services to be dissimilar.

30. Contested services: *arranging of buying and selling contracts for third parties*

I compare these services against the Opponent's *catering* services in class 43. The Applicant's services, as already noted, will include, *inter alia*: negotiating contractual terms; coordinating discussions between the contracting parties; and the administration of contracts. The Opponent's services entail the provision of food and drink. The purposes of the respective services are therefore very different. In my view, users will overlap in certain instances. One such situation is where an organisation wishes to engage catering services by way of tendering, i.e. inviting bids for a catering contract. In this situation, the organisation looking to 'buy in' catering services may wish to engage the Applicant's services to arrange the catering contract on its behalf. The methods of use for the respective services are very different; the Applicant's services are intended to arrange contracts, in contrast to the Opponent's services concerning the provision of food and drink. Trade channels will, in my view, be separate. I find the respective services to be neither competitive nor complementary. In the light of the foregoing, I find the parties' services to be dissimilar. I find this to be the case even though there may be user overlap in certain situations. User overlap alone is, to my mind, insufficient to support a finding of similarity between the services.

31. I also compare these services to the Opponent's *estate agency services for sale and rental of buildings*. The respective services will overlap in purpose only to the very broad extent that both involve selling. However, the specific purposes are very different. Estate agencies' services focus on the marketing of property for sale or rent and do not, in my view, deal with the arranging of contracts.⁸ Class 35 services are services sought out by businesses etc to increase awareness of brands and sales. Marketing of a property in class 36 is simply part of a real estate service for increasing footfall into a house for the purpose of selling it for an individual. Users will overlap; a prospective purchaser of a property will engage both estate agency services as well as services to arrange the contract for the purchase of the property. Trade channels will unlikely overlap. I find the respective services to be neither competitive nor complementary. In the light of the foregoing, I find the parties' services to be dissimilar. User overlap alone is, to my mind, insufficient to support a finding of similarity between the services.

⁸ Arranging of contracts for sale or rental of property are the domain of conveyancing solicitors.

32. Contested services: *sales promotions at point of purchase or sale, for others; marketing; marketing services; promoting the goods and services of others; sales promotion*

I compare these terms against the Opponent's *estate agency services for sale and rental of buildings*. The Applicant's terms encompass services aimed at promoting goods or services to generate publicity and/or sales. The Opponent's services encompass activities conducive to the buying/selling/leasing of property,⁹ which will include marketing of the property. The purposes of the parties' respective services therefore overlap to the broad extent that both are aimed at generating sales, albeit the Opponent's services focus on real property. I consider it unlikely that users would overlap. Although both parties' services will include a marketing aspect, consumers seeking services in the field of real property would, in my view, specifically seek an estate agent or real property specialist rather than providers of the Applicant's more general promotional/marketing services, or services concerned with the sale of goods.¹⁰ I find trade channels to be distinct. The parties' respective services are not, in my view, in a competitive relationship; neither is substitutable for the other. I do not find the respective services to be complementary, either. Although marketing and promotion are important aspects of the Opponent's services, I consider it unlikely that the average consumer would presume the same undertaking to be responsible for both *estate agency services* [...] and the Applicant's marketing and promotional services listed above. I find the parties' services to be dissimilar.

33. Contested services: *providing online marketplaces for sellers of goods and or services; provision of an on-line marketplace for buyers and sellers of goods and services; provision of an online marketplace for buyers and sellers of goods and services.*

These three terms are synonymous. I compare these services to the Opponent's *estate agency services for sale and rental of buildings*. The purpose of the

⁹ Buildings i.e. real property, as opposed to mere buildings (e.g. sheds), are not goods; they are bundles of legal rights.

¹⁰ As above.

Applicant's services is to facilitate the buying and selling of goods or services online by providing the platform through which consumers may transact. As noted above at [28], the Opponent's services concern the marketing of property to induce a sale. The respective purposes of the parties' services will overlap only to the broad extent that the ultimate aim of both is to bring about sales. The specific purposes differ to the extent that the Applicant's services are for the purpose of providing a platform which enables the buyers and sellers to transact directly with one another, whereas the Opponent's services entail managing the entire process of agreeing a sale on the consumer's behalf. I find user overlap unlikely. Although both services are concerned with buying and selling, a consumer seeking to transact in an online marketplace would not seek out the Opponent's services for this purpose.¹¹ Trade channels will be separate. I find the respective parties' services to be neither competitive nor complementary. In the light of the foregoing, I find the parties' services to be dissimilar.

34. Contested services: *advertising*

I compare these services against the Opponent's *estate agency services for sale and rental of buildings*. The purpose of the Applicant's services is to publicise or promote. Advertising is an important aspect of the Applicant's *estate agency services [...] services*, although other activities will also be included under the term: e.g. conducting viewings of property; managing offers, amongst other activities. The purposes of the respective services therefore overlap somewhat. However, *advertising* services will typically be engaged by businesses seeking to boost sales/promote their business, whereas the Opponent's estate agency services will be engaged by an individual or business looking to buy/sell or rent a property. I consider user overlap to be unlikely because, to my mind, a consumer seeking to purchase/sell/lease a property would engage the Opponent's estate agency services, an element of which is advertising/promotion, rather than engaging a service comprising *advertising* alone. Trade channels will be separate. The respective services are not in a competitive relationship. I do not find

¹¹ Conversely, a consumer looking to buy/sell/lease a property would unlikely seek out the Applicant's services for this purpose.

complementarity either; although *advertising* will be an important aspect of the Opponent's estate agency services, I consider it unlikely that the average consumer would presume both the Opponent's services and *advertising*, as a separate service, to be offered by the same undertaking. In the light of the foregoing, I find the parties' services to be dissimilar.

35. Contested services: *business consulting*

I compare these services against the Opponent's *rental of offices for co-working*. The purpose of *business consulting* services is to provide advice, knowledge and expertise to businesses to enable them to run efficiently and profitably. The purpose of the Opponent's services is, self-evidently, the provision of office space to enable people to work together. The purposes of the respective services are therefore very different. Users will, in my view, overlap somewhat; consumers of both parties' services will include businesses. Trade channels may overlap; both parties' services may be listed in directories of business-related services, for example. The parties' respective services are not, in my view, in a competitive relationship; neither is substitutable for the other. I do not find complementarity, either; neither service is necessary or important for the other. In the light of the foregoing, I find the parties' services to be dissimilar.

36. I also compare these services to the Opponent's *real estate consultancy* (class 36) and *building consultancy* (class 37). The parties' respective services coincide in purpose only to the very broad extent that all terms involve consultancy of some sort i.e. the provision of knowledge and expertise in a certain field. The subject matter of the respective consultancy services is very different. Having also considered uses, users and trade channels for the parties' respective services, and whether or not the services are in a competitive or complementary relationship, I find the parties' services to be dissimilar.

Class 36

37. Contested services: *Lease of real estate; leasing of real estate*

The above terms are synonymous and are self-evidently identical with the Opponent's *leasing of real estate*.

Average consumer and the purchasing act

38. 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.

39. In *Hearst Holdings Inc*¹² Birss J. (as he then was) described the average consumer thus:

“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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

40. I consider that the average consumer of the services that come into play in this opposition (i.e. *lease of real estate/leasing of real estate* in class 36) will include both the general and professional public. Services relating to the purchase of a lease of a commercial premises, for example, will almost always be made by a professional, whereas services relating to residential premises would more likely be engaged by the general public. Many purchases will be made after initially viewing the service provider's website, an advertisement or the façade of the premises. The purchasing act will, therefore, in most cases, be primarily visual. These services are not 'everyday' purchases. Many purchases will involve entering into lengthy written contracts. I consider that most transactions would not

¹² *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).

conclude until the purchaser had discussed the potential purchase with the service-provider and inspected the property for let. However, the consumer's focus will be on the property being leased, rather than on the selection of the services offered by the estate agent handling the matter. Where the average consumer is the owner of a property that they wish to let, factors affecting the choice of service will include, *inter alia*, the consumer's particular needs; the fees for the service and the often the reliability and reputation of the provider. The average consumer in this situation would therefore display some level of care when making their choice. I find that the parties' services will be purchased with a medium – high level of attention; i.e. an individual would likely pay a medium level of attention whereas a professional would likely pay a high level of attention.

Comparison of the marks

Opponent's (earlier) mark	Applicant's (contested) mark
LIFEWORLD	LIFEWOR

41. 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.”

42. 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.

43. The Opponent's mark is a word mark¹³ consisting of the single word 'LIFEWORLD', all characters rendered in a plain sans-serif typeface and in upper case. Whilst the mark comprises two identifiable components, namely the English words LIFE and WORLD, the overall impression of the mark resides in the mark in its entirety.

44. The Applicant's mark is also a word mark and consists of the single word 'LIFEWORL', all characters rendered in a plain sans-serif typeface and in upper case. Again, whilst this comprises two identifiable components LIFE and WORL the overall impression of the mark resides in the mark in its entirety.

45. Visual comparison

The Applicant has submitted¹⁴ that 'Whilst the respective marks are similar due to each commencing with LIFEWOR+, they are not confusingly similar due to the differing ending applied to the respective marks.'

46. The marks share the first seven letters 'LIFEWOR'. The only points of visual difference are the endings: 'LD' and 'K' in the Opponent's and Applicant's marks, respectively. The marks are of a similar length; the Opponent's mark comprising nine characters as compared to the Applicant's eight-character mark. I find the marks to have a high level of visual similarity.

¹³ In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

'[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).'

¹⁴ Applicant's written submissions in lieu of a hearing, paragraph [6].

47. Aural similarity

The Opponent's mark comprises two syllables and will be articulated as 'LIFE-WURLD'. The Applicant's mark, also comprising two syllables, will be articulated as 'LIFE-WURK'. In the case of both marks, I find that the emphasis will be on the first syllable. The marks share an aurally identical first syllable. The only real aural difference between the marks resides in the endings of the second syllable: 'URLD' in the Opponent's mark as opposed to 'URK' in the Opponent's mark. I find the marks to have a high level of aural similarity.

48. Conceptual comparison

The Applicant has submitted¹⁵ that 'The differences and distinguishable meanings between WORK (i.e. activity involving mental or physical effort done in order to achieve a purpose or result or a task to be undertaken) and WORLD (i.e. the earth, together with all of its countries) even when both prefixed by LIFE will not be missed by consumers and neither will the subject bring to mind or be associated or otherwise be confused with the Opponent's mark as a result of these differences [...]'

49. The Opponent's mark comprises the words 'life' and 'world' coalesced into one 'word'. Both words appear in the English dictionary and will be familiar to the average UK consumer. The dictionary definition of 'life' includes the following meanings:¹⁶

- the state of being alive;
- a general reference to a group of beings that have the quality of being alive e.g. plant life; animal life;
- a reference to an aspect of one's life, or an activity regularly undertaken during one's life, or part thereof, e.g. one's 'personal life' or 'professional life'.

¹⁵ Applicant's written submissions, paragraph [8].

¹⁶<https://www.collinsdictionary.com/dictionary/english/life> accessed 8 November 2022 at 08:45.

50. The dictionary definition of 'world' includes the following meanings:¹⁷

- the planet that we live on, or a planet in general;
- as a reference to all the people who live on this planet;
- as an adjective to describe someone or something of great importance or significance e.g. China as a world power;
- as a reference to a particular field of activity e.g. the art world;
- as a reference to a group of living things e.g. the animal or plant world.

51. In my view, the Opponent's mark 'Lifeworld' will be perceived by the average consumer as an amalgam of the words 'life' and 'world'. In my view, the amalgamation of the two words will not create a new meaning beyond the meaning conveyed by the separate words.

52. The dictionary definition of 'work' includes the following meanings:¹⁸

- as a verb – people who work have an occupation, usually one which they are paid to do;
to work on something is to spend time and effort on a task;
- as a noun – one's work consists of the activities that one undertakes in one's job

53. The Applicant's mark 'Lifework' will, to my mind, be perceived by the average consumer as an amalgam of the words 'life' and 'work'. In my view, this amalgamation of the two words will not create a new meaning beyond the meaning conveyed by the separate words.

54. In the light of the foregoing, I find the parties' marks to have a medium level of conceptual similarity.

¹⁷<https://www.collinsdictionary.com/dictionary/english/world>, accessed 10 November at 17:07.

¹⁸<https://www.collinsdictionary.com/dictionary/english/work>, accessed 8 November 2022 at 09:07.

Distinctive character of the earlier mark

55. *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).”

56. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

57. 'Lifeworld' is an amalgam of 'life' and 'world'; two words which appear in the English dictionary and with which the average consumer will be very familiar. The mark neither described nor alludes to the services in respect of which it is registered. I find the Opponent's mark to have a medium level of inherent distinctive character.

58. No evidence has been submitted. I am therefore unable to make a finding in respect of enhanced distinctive character.

Likelihood of confusion

59. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v Back Beat Inc*¹⁹. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*²⁰, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or economically linked undertaking.

60. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [11]. When considering all relevant factors 'in the round', I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

¹⁹ Case BL O/375/10 at [16].

²⁰ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

61. I have found the following the Applicant's services to be identical to the Opponent's services: Class 36: *Lease of real estate; leasing of real estate.*

62. In my view, a significant proportion of average consumers would confuse the marks. The respective marks have a high level of visual and aural similarity. They are conceptually similar to a medium degree. I note the observation by the General Court in the case of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 that the beginnings of words tend to have more of a visual and aural impact than the ends of words, although I recognise that this is not an absolute rule. In the instant case, the parties' marks are of a similar length; the only visual difference residing at the ends of the marks i.e. 'LD' (Opponent's mark) versus 'K' (Applicant's mark). In my view, these visual differences between the marks will be easily overlooked by the average consumer when viewing each mark as a whole. It is my view that when the average consumer encounters the Opponent's mark, they may mistake it for the Applicant's mark (or vice versa) because the mind's eye has failed to register or recall the visual differences at the ends of the marks, and consumers do not compare marks side by side. There is a likelihood of confusion. I find this to be the case even though the average consumer will pay a medium to high level of attention when purchasing the services.

63. There will be no likelihood of confusion in respect of those of the Applicant's services that I have found to be dissimilar to the Opponent's services:

Class 35: *Arranging of contracts for others for the buying and selling of goods; advertising; business consulting; providing online marketplaces for sellers of goods and or services; procuring of contracts for the purchase and sale of goods; arranging of buying and selling contracts for third parties; sales promotions at point of purchase or sale, for others; provision of an on-line marketplace for buyers and sellers of goods and services; marketing; marketing services; promoting the goods and services of others; sales promotion; provision of an online marketplace for buyers and sellers of goods and services.*

Conclusion

64. The Opposition has been partially successful. Subject to any successful appeal:

- The application is **refused** in respect of the Applicant's class 36 terms only:
Lease of real estate; leasing of real estate.
- The application **may proceed** only in respect of the remaining services, i.e. those enumerated above at [61].

COSTS

65. The Applicant has enjoyed the greater measure of success and is therefore entitled to a contribution based upon the published scale²¹. I award the Applicant the sum of **£500** calculated as follows:

Consideration of the Opposition and preparation of Defence and Counterstatement:	£200
Preparation of written submissions:	£300
Total:	£500

66. I therefore order LIFEWORLD.BE NV to pay to Lifework Communities LTD the sum of £500. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of November 2022

N. R. Morris
For the Registrar,
the Comptroller-General

²¹ Tribunal Practice Notice 2/2016

