

O/0922/24

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO. 3773100
IN THE NAME OF PT MRI INDONESIA
TO REGISTER**

MOORES ROWLAND

AS A TRADE MARK IN CLASSES 35, 36, 45

AND

OPPOSITION THERETO UNDER NO. 438931

BY

DR. CURTIS N. RHODES, JR.

Background and pleadings

1. On 1 April 2022, PT MRI Indonesia (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision, under number UK00003773100 (“the Contested Mark”). Details of the application were published for opposition purposes on 28 October 2022. Registration is sought for the following services:

Class 35 Commercial affairs; business management advice, business economics advice, business administration advice; professional business consultancy; business consulting, business project management; outsourcing services [business assistance]; accountancy; assistance and advice on management of commercial affairs; corporate development services; business advice; internal and external verification of invoices, accounts, business research, supply of commercial and business information, cost analysis and related advice; business management planning and development, business risk management; business project management, management of business processes; business research; business advice on business ventures and business acquisitions, starting of companies and internal company investigations; legal accountancy services; fraud investigations in relation to accounts, finance and tax; business investigations and business advice on insolvent companies; advice and information relating to electronic commerce services; tax preparation and filing services; tax reporting services; administrative services; market studies; provision of on-line information relating to commercial affairs and business management; auditing services; data analytics relating to commercial affairs and business; data analysis services relating to commercial affairs and business; payroll preparation; payroll services; data modelling services relating to business; computer software verification services; data collection, compilation and systemisation services; compilation of computer data-bases; computer data services, namely computerised data verification, computerised data management, computerised data processing, computer data entry services, and collating of data in computer database; data management services; advertising services;

media monitoring services; auditing services; tax reporting services relating to accountancy, book keeping and auditing; tax advice services relating to accountancy, book keeping and auditing; information, consulting advisory services relating to all the aforesaid services; all of the aforementioned services not related to employment agency services, outplacement services, personnel management consultation and evaluation services, personnel recruitment services, and personnel relocation and travel services.

Class 36 Financial and monetary affairs; actuarial services; fiscal valuation; financial analysis; financial research and information services; investment analysis; advice on creditor and debtor control investments, grants and financing of loans; financial affairs; consultancy and advice in relation to financial affairs and taxation; tax services (not accounting); financial tax reporting services; financial tax advice services; corporate finance services including advising on financial affairs, financial evaluation and financial consultancy; fiscal assessment and evaluation; advisory services relating to credit and debt control; financial investigation; business appraisals for financial valuation; financial risk assessments; analysis of financial information; provision of online information relating to financial affairs; investment services; financial investment services; investment management services; investment, grants and financing of loans; investment asset management; arranging investments, in particular capital investments, financing services and insurance; pension services; provision of pension information; pension advisory services; pension planning services; money saving advice; real estate advice and management; information, consulting advisory services relating to all the aforesaid services; all of the aforementioned services not related to employment agency services, outplacement services, personnel management consultation and evaluation services, personnel recruitment services, and personnel relocation and travel services.

Class 45 Legal services; services pertaining to legal matters including consultancy, advocacy, litigation and handling of legal formalities; tax

law consultancy; drafting of deeds, legal instruments and legal documents; advisory services relating to legal matters; legal tax advice services; training on legal systems; information, advisory and consulting relating to the aforesaid; none of the aforesaid relating to intellectual and industrial property.

2. On 30 January 2023, Dr. Curtis N. Rhodes, Jr. (“the opponent”) opposed the application under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following UK prior trade mark registration (“the Earlier Mark”):

Mark: Moores Rowland

UK registration number: UK00916952161

Filing date: 5 July 2017

Registration date: 23 October 2017

Services relied upon:

Class 35 Advertising, publicity; book-keeping, accounting; business management assistance; business inquiries; business auditing; business management and organization consultancy; business management consultancy; business efficiency expert services; business appraisals; business investigations; business organization consultancy; business research; advisory services for business management; professional business consultancy; business management of reimbursement programs for others; commercial administration of the licensing of the goods and services of others; cost price analysis; data search in computer files for others; economic forecasting; employment agency services; import-export agency services; invoicing; layout services for advertising purposes; market studies; marketing research; negotiation and conclusion of commercial transactions for third parties; organization of exhibitions for commercial or advertising purposes; outsourced administrative management for companies; outsourcing services (business assistance); payroll preparation; personnel management consultancy; personnel recruitment; secretarial services; tax preparation; tax filing services.

Class 36 Actuarial services; business liquidation services, financial; capital investment; charitable fund raising; credit bureau services; debt advisory services; arranging finance for construction projects; financial customs brokerage services; financial evaluation (insurance, banking, real estate); financial management; financial analysis; financial consultancy; financial information; financial sponsorship; financing services; fiscal valuation; insurance consultancy; insurance information; investment of funds; repair costs evaluation (financial appraisal); retirement payment services.

Class 45 Arbitration services; intellectual property consultancy; legal document preparation services; legal administration of licenses; licensing of intellectual property; licensing of computer software (legal services); litigation services; mediation; security consultancy.

3. For the purposes of the opposition, the opponent relies upon all of the services for which the Earlier Mark is registered as indicated above.
4. The opponent's registration is a comparable mark¹. By virtue of its earlier filing date of 5 July 2017, that registration constitutes an earlier mark within the meaning of section 6 of the Act. As the Earlier Mark had not completed its registration process more than five years before the filing date of the application in issue, 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 without having to demonstrate use.
5. In its statement of grounds, the opponent contends that the respective marks are visually, aurally, and conceptually identical and the services are identical or highly similar. Due to the identity between the Contested and Earlier Mark and the identity of the services, the opponent submits the application should be refused under section 5(1) of the Act. Due to the identity of the marks and the high similarity of the services, the opponent also submits that there exists a likelihood of confusion

¹ Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

on the part of the public, including the likelihood of association, and that the contested application should be refused under section 5(2)(a) of the Act.

6. The applicant filed a counterstatement, denying the grounds of opposition. In particular, the applicant submits that the opponent's mark is stylised consisting of upper- and lower-case letters whilst the applicant's mark is represented in standard characters without stylisation. The applicant also submits that many of the contested services are wholly different from the opponent's ones.
7. In these proceedings both parties are represented. The opponent is represented by Taylor Wessing LLP. The applicant is represented by Murgitroyd & Company.

Subsequent revocation action

8. On 10 November 2022 the applicant filed a revocation action for non-use against the opponent's Earlier Mark number UK00916952161 (CA000505551). According to case law, where the revocation date of an earlier mark falls after the filing date of a contested mark, an opponent can still rely upon its earlier mark within opposition proceedings against that mark because it was still a valid registration when the contested mark was filed.² In this case, the cancellation applicant requested revocation to take effect from 24 October 2022. Therefore, in the eventuality the revocation is successful, at the filing date of the contested mark (1 April 2022) the Earlier Mark would constitute a valid mark for the purposes of this opposition. The outcome of the revocation action mentioned within the opponent's statement of grounds therefore has no impact on these proceedings.

Relevance of EU law

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

² BL O/220/12, [27] - [42].

10. During the evidence rounds the opponent filed evidence in the form of a witness statement from Lara Pentreath³ and Exhibits LP1-LP5. The applicant filed written submissions only.⁴ The evidence and submissions will not be summarised here but will be referred to as and where appropriate during this decision. Neither party requested a hearing, but the applicant filed submissions in lieu. This decision is taken following a careful perusal of the papers.

Section 5(1)

Decision

The law

11. The relevant part of section 5 of the Act is as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

Identity of the marks

12. It is a prerequisite of section 5(1) that the respective trade marks are identical. Both marks consist of the same word, ‘MOORES ROWLAND’, absent any stylisation. The opponent’s mark is represented in lower-case letters with exclusively the first letter of each word composing the mark being capitalised. The Contested Mark is all capitalised. In its defence, the applicant argued that the opponent’s mark is stylised, whereas the Contested Mark is represented in standard characters.

13. Since the protection conferred by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic features that the mark might possess (T 254/06, RadioCom, EU:T:2008:165, § 43; *LA Superquimica v EUIPO*, Case T-24/17, § 39), it is irrelevant whether a word mark is depicted in lower- or upper-case letters, or in a combination thereof in a manner that does not depart from the usual way of writing, as in the case of the Earlier Mark. Consequently, the difference in the signs under comparison is immaterial. Therefore, the Contested Mark reproduces all the elements of the

³ Dated 21 June 2023.

⁴ Dated 21 August 2023.

Earlier Mark and contains differences so insignificant that the competing marks are deemed to be identical.⁵

Comparison of services

14. In order for the opponent to succeed under section 5(1) of the Act, the services covered by the Earlier mark and the Contested mark must be considered identical. I am therefore only concerned with whether the services are identical at this stage. If any of the applicant's services prove not to be identical to the opponent's at this stage, I will consider the similarity of those services later in relation to the opponent's section 5(2)(a) ground.

15. Where services are worded identically in both specifications, it is clear they should be considered identical. Additionally, where the wording of a term differs to the wording of another term, but both terms share an identical meaning, again those services are self-evidently identical and should be considered as such. Finally, the General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods⁶ are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

"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".

16. The competing services are as follows:

Opponent's goods	Applicant's goods
<u>Class 35</u>	<u>Class 35</u>
Advertising, publicity; book-keeping, accounting; business management assistance; business inquiries;	Commercial affairs; business management advice, business economics advice, business administration advice;

⁵ S.A. *Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/0, [54].

⁶ This will also apply to services.

<p>business auditing; business management and organization consultancy; business management consultancy; business efficiency expert services; business appraisals; business investigations; business organization consultancy; business research; advisory services for business management; professional business consultancy; business management of reimbursement programs for others; commercial administration of the licensing of the goods and services of others; cost price analysis; data search in computer files for others; economic forecasting; employment agency services; import-export agency services; invoicing; layout services for advertising purposes; market studies; marketing research; negotiation and conclusion of commercial transactions for third parties; organization of exhibitions for commercial or advertising purposes; outsourced administrative management for companies; outsourcing services (business assistance); payroll preparation; personnel management consultancy; personnel recruitment; secretarial services; tax preparation; tax filing services.</p>	<p>professional business consultancy; business consulting, business project management; outsourcing services [business assistance]; accountancy; assistance and advice on management of commercial affairs; corporate development services; business advice; internal and external verification of invoices, accounts, business research, supply of commercial and business information, cost analysis and related advice; business management planning and development, business risk management; business project management, management of business processes; business research; business advice on business ventures and business acquisitions, starting of companies and internal company investigations; legal accountancy services; fraud investigations in relation to accounts, finance and tax; business investigations and business advice on insolvent companies; advice and information relating to electronic commerce services; tax preparation and filing services; tax reporting services; administrative services; market studies; provision of on-line information relating to commercial affairs and business management; auditing services; data analytics relating to commercial affairs and business; data analysis services relating to commercial affairs and business; payroll preparation; payroll services; data</p>
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	<p>modelling services relating to business; computer software verification services; data collection, compilation and systemisation services; compilation of computer data-bases; computer data services, namely computerised data verification, computerised data management, computerised data processing, computer data entry services, and collating of data in computer database; data management services; advertising services; media monitoring services; auditing services; tax reporting services relating to accountancy, book keeping and auditing; tax advice services relating to accountancy, book keeping and auditing; information, consulting advisory services relating to all the aforesaid services; all of the aforementioned services not related to employment agency services, outplacement services, personnel management consultation and evaluation services, personnel recruitment services, and personnel relocation and travel services.</p>
<u>Class 36</u>	<u>Class 36</u>
<p>Actuarial services; business liquidation services, financial; capital investment; charitable fund raising; credit bureau services; debt advisory services; arranging finance for construction projects; financial customs brokerage services; financial</p>	<p>Financial and monetary affairs; actuarial services; fiscal valuation; financial analysis; financial research and information services; investment analysis; advice on creditor and debtor control investments, grants and financing of loans; financial affairs; consultancy and advice in relation to</p>

evaluation (insurance, banking, real estate); financial management; financial analysis; financial consultancy; financial information; financial sponsorship; financing services; fiscal valuation; insurance consultancy; insurance information; investment of funds; repair costs evaluation (financial appraisal); retirement payment services.

financial affairs and taxation; tax services (not accounting); financial tax reporting services; financial tax advice services; corporate finance services including advising on financial affairs, financial evaluation and financial consultancy; fiscal assessment and evaluation; advisory services relating to credit and debt control; financial investigation; business appraisals for financial valuation; financial risk assessments; analysis of financial information; provision of online information relating to financial affairs; investment services; financial investment services; investment management services; investment, grants and financing of loans; investment asset management; arranging investments, in particular capital investments, financing services and insurance; pension services; provision of pension information; pension advisory services; pension planning services; money saving advice; real estate advice and management; information, consulting advisory services relating to all the aforesaid services; all of the aforementioned services not related to employment agency services, outplacement services, personnel management consultation and evaluation services, personnel recruitment services, and personnel relocation and travel services.

<u>Class 45</u>	<u>Class 45</u>
Arbitration services; intellectual property consultancy; legal document preparation services; legal administration of licenses; licensing of intellectual property; licensing of computer software (legal services); litigation services; mediation; security consultancy.	Legal services; services pertaining to legal matters including consultancy, advocacy, litigation and handling of legal formalities; tax law consultancy; drafting of deeds, legal instruments and legal documents; advisory services relating to legal matters; legal tax advice services; training on legal systems; information, advisory and consulting relating to the aforesaid; none of the aforesaid relating to intellectual and industrial property.

17. In the Witness Statement of Lara Pentreath,⁷ the opponent submitted that the EUIPO in its prior decision number B 3075842, concerning the same marks and services at hand, found that:

“the Decision upheld the Opponent’s opposition for all of the contested services in Classes 35 and 45 and all the contested services in Class 36 with the exception of “real estate advice management”. All the contested services in Classes 35 and all other contested services in Class 36 were found to be identical to the services for which the Opponent’s mark is registered, with the contested services in Class 45 being at least similar to the Opponent’s “litigation services”.

18. I note the decision from the EUIPO provided by the opponent where similarity or identity was found between all the competing services with the exception of “*real estate advice management*”. However, while I note the contents and findings of the same, I am not bound by previous decisions of the EUIPO and I must draw my own

⁷ Dated 21 June 2023.

conclusions on the identity of the services before me, as rationalised in the following paragraphs.

Class 35

- “*Commercial affairs*”

19. The applicant’s “*commercial affairs*” can be defined as the commercial exchange of goods and services. I find this term to be a synonymous of the opponent’s “*negotiation and conclusion of commercial transactions for third parties*” and, thus, identical.

- “*business management advice, business economics advice, business administration advice; professional business consultancy; business consulting, [...]; outsourcing services [business assistance]; assistance and advice on management of commercial affairs; business advice; business advice on business ventures and business acquisitions, starting of companies and internal company investigations; advice and information relating to electronic commerce services; administrative services; provision of on-line information relating to commercial affairs and business management [...] information, consulting advisory services relating to all the aforesaid services*”

20. The services above essentially are business advice. Therefore, I find these terms to fall within the general category of “*professional business consultancy*” and be identical in line with *Meric*.

- “*business project management; corporate development services; business management planning and development, business risk management; business project management, management of business processes; information, consulting advisory services relating to all the aforesaid services*”

21. Business management can be essentially defined as the overseeing and supervising business operations, processes, and resources to achieve organisational goals and objectives. Therefore, I find the terms above fall within the general category of “*business management and organization consultancy*” of the Earlier Mark and vice versa. These services are considered identical in line with *Meric*

- *“tax preparation and filing services; [...] information, consulting advisory services relating to all the aforesaid services”*

22. The terms above are respectively identical to the opponent’s “*tax preparation*” and “*tax filing services*”.

- *“payroll preparation; payroll services; [...] information, consulting advisory services relating to all the aforesaid services”*

23. The terms above are self-evidently identical to the opponent’s “*payroll preparation*”.

- *“book keeping and auditing; [...] information, consulting advisory services relating to all the aforesaid services”*

24. The terms above are self-evidently identical to the opponent’s “*business auditing*”.

- *“tax reporting services relating to accountancy, [...]; tax advice services relating to accountancy; accountancy; legal accountancy services; [...] information, consulting advisory services relating to all the aforesaid services”*

25. The terms above fall within the opponent’s wider category of “*book-keeping, accounting*”. Therefore, they are identical in line with *Meric*.

- *“business research; internal and external verification of invoices, accounts, business research, supply of commercial and business information; fraud investigations in relation to accounts, finance and tax; business investigations and business advice on insolvent companies; auditing services; data analytics relating to commercial affairs and business; data analysis services relating to commercial affairs and business; data modelling services relating to business; [...] information, consulting advisory services relating to all the aforesaid services”*

26. The above services consist of activities that fall within the wider category of “*business investigations*”. Therefore, these services are identical in line with *Meric*.

- *“market studies”*

27. The term above is self-evidently identical to the opponent’s “*market studies*”.

- *“cost analysis and related advice”*

28. The applicant's "*cost analysis and related advice*" and the opponent's "*cost price analysis*" are two activities carried out to determine the best end price of a good or service. Therefore, both services have the same nature (market and consumer analysis), intended purpose (end price determination), they are provided by the same professionals, share the same trade channels, and address the same public. Considering the above, I find the competing services to be identical.

Class 36

- "*Financial and monetary affairs; actuarial services; fiscal valuation; financial analysis; financial research and information services; investment analysis; advice on creditor and debtor control investments, grants and financing of loans; financial affairs; consultancy and advice in relation to financial affairs and taxation; corporate finance services including advising on financial affairs, financial evaluation and financial consultancy; fiscal assessment and evaluation; advisory services relating to credit and debt control; financial investigation; business appraisals for financial valuation; financial risk assessments; analysis of financial information; provision of online information relating to financial affairs; pension services; provision of pension information; pension advisory services; pension planning services; money saving advice; tax services (not accounting); financial tax reporting services; financial tax advice services; [...] information, consulting advisory services relating to all the aforesaid services; all of the aforementioned services not related to employment agency services, outplacement services, personnel management consultation and evaluation services, personnel recruitment services, and personnel relocation and travel services*"

29. Financial consultancy refers to professionals who can assist with personal financial plan, including budgeting, insurance planning, investments, retirement, and tax strategies. Therefore, I find the above terms to fall within the more generic definition of the opponent's "*financial consultancy*". Thus, these services are identical in line with *Meri*.

- "*investment management services; investment asset management; arranging investments, in particular capital investments, financing services and insurance; [...] information, consulting advisory services relating to all the aforesaid services; all of the aforementioned services not related to employment agency services,*

outplacement services, personnel management consultation and evaluation services, personnel recruitment services, and personnel relocation and travel services”

30. The above terms fall within the opponent’s generic term “*financial management*”. Therefore, I find them to be identical according to *Meric*.

- “*investment services; financial investment services; investment, grants and financing of loans [...] information, consulting advisory services relating to all the aforesaid services; all of the aforementioned services not related to employment agency services, outplacement services, personnel management consultation and evaluation services, personnel recruitment services, and personnel relocation and travel services*”

31. The above terms, although worded differently, can all be defined as “*investment of funds*”. Therefore, I find these services to be identical.

Class 45

- “*Legal services; [...] information, advisory and consulting relating to the aforesaid; none of the aforesaid relating to intellectual and industrial property*”

32. The term above encompasses the opponent’s “*litigation services*” and vice versa. Therefore, the competing terms are identical in line with *Meric*.

- *services pertaining to legal matters including [...] advocacy, litigation and handling of legal formalities; information, advisory and consulting relating to the aforesaid; none of the aforesaid relating to intellectual and industrial property*”

33. The terms above fall within the wider category of the opponent’s “*litigation services*”. Therefore, these terms are identical in line with *Meric*.

- “*drafting of deeds, legal instruments and legal documents; [...] information, advisory and consulting relating to the aforesaid; none of the aforesaid relating to intellectual and industrial property*”

34. The term above is self-evidently identical to the opponent’s “*legal document preparation services*”.

35. I do not consider any of the applicant's remaining services to be identical to the opponent's. As mentioned, in order to succeed under section 5(1), the contested services must be identical to the services relied upon under the Earlier Mark. The opposition therefore succeeds under this ground in respect of the following services only:

Class 35

“Commercial affairs; business management advice, business economics advice, business administration advice; professional business consultancy; business consulting, [...]; outsourcing services [business assistance]; assistance and advice on management of commercial affairs; business advice; business advice on business ventures and business acquisitions, starting of companies and internal company investigations; advice and information relating to electronic commerce services; administrative services; provision of on-line information relating to commercial affairs and business management; business project management; corporate development services; business management planning and development, business risk management; business project management, management of business processes; tax preparation and filing services; payroll preparation; payroll services; book keeping and auditing; tax reporting services relating to accountancy, [...]; tax advice services relating to accountancy; accountancy; legal accountancy services; business research; internal and external verification of invoices, accounts, business research, supply of commercial and business information; fraud investigations in relation to accounts, finance and tax; business investigations and business advice on insolvent companies; auditing services; data analytics relating to commercial affairs and business; data analysis services relating to commercial affairs and business; data modelling services relating to business; market studies; cost analysis and related advice; [...] information, consulting advisory services relating to all the aforesaid services”

Class 36

“Financial and monetary affairs; actuarial services; fiscal valuation; financial analysis; financial research and information services; investment analysis; advice on creditor and debtor control investments, grants and financing of loans; financial affairs; consultancy and advice in relation to financial affairs and taxation; corporate

finance services including advising on financial affairs, financial evaluation and financial consultancy; fiscal assessment and evaluation; advisory services relating to credit and debt control; financial investigation; business appraisals for financial valuation; financial risk assessments; analysis of financial information; provision of online information relating to financial affairs; pension services; provision of pension information; pension advisory services; pension planning services; money saving advice; tax services (not accounting); financial tax reporting services; financial tax advice services; investment management services; investment asset management; arranging investments, in particular capital investments, financing services and insurance; investment services; financial investment services; investment, grants and financing of loans; [...] information, consulting advisory services relating to all the aforesaid services; all of the aforementioned services not related to employment agency services, outplacement services, personnel management consultation and evaluation services, personnel recruitment services, and personnel relocation and travel services”

Class 45

“Legal services; services pertaining to legal matters including [...] advocacy, litigation and handling of legal formalities; drafting of deeds, legal instruments and legal documents; [...] information, advisory and consulting relating to the aforesaid; none of the aforesaid relating to intellectual and industrial property”

36. Concerning the services that I did not find to be identical, I will proceed to assess their level of similarity under Section 5(2)(a) and the likelihood of confusion between the competing marks.

Section 5(2)(a)

Decision

The law

“5(2) A trade mark shall not be registered if because—

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, [...]

(b) [...]

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case law

37. The leading authorities which guide me are from the 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of trade marks

38. I found the respective marks to be identical as stated in paragraphs [12] – [13] of this decision.

Comparison of the services

39. When making the comparison, all relevant factors relating to the services in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“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”.

40. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

41. For the purposes of considering the issue of similarity of goods (or services), it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

Class 35

- “*business management advice, business economics advice, business administration advice; professional business consultancy; business consulting, [...]; outsourcing services [business assistance]; assistance and advice on management of commercial affairs; business advice; business advice on business ventures and business acquisitions, starting of companies and internal company investigations; advice and information relating to electronic commerce services; administrative services; provision of on-line information relating to commercial*

affairs and business management [...] information, consulting advisory services relating to all the aforesaid services”

42. As stated in paragraph [20], I found the terms above to be identical to some of the opponent’s services. However, if I am wrong in this assessment, I find, in alternative, that there is a high degree of similarity between the services, given they have the same nature, purpose, are provided through the same trade channels, by similar professionals, and may address the same users.

- *“business research; internal and external verification of invoices, accounts, business research, supply of commercial and business information; fraud investigations in relation to accounts, finance and tax; business investigations and business advice on insolvent companies; auditing services; data analytics relating to commercial affairs and business; data analysis services relating to commercial affairs and business; data modelling services relating to business; [...] information, consulting advisory services relating to all the aforesaid services”*

43. I found the services above to be identical to some of the opponent’s services as indicated at paragraph [26]. If I am wrong in this assessment, I find, in alternative, that there is a high degree of similarity between the services given that they have the same nature (i.e., business research and/or investigation), intended purpose, they are likely to share the same trade channels and overlap in their respective users.

- *“data collection, compilation and systemisation services; compilation of computer data-bases; computer data services, namely computerised data verification, computerised data management, computerised data processing, computer data entry services, and collating of data in computer database; data management services; media monitoring services; computer software verification services”*

44. In its counterstatement, the applicant submitted that the terms above differ from those of the opponent. The opponent submitted evidence (**Exhibit LP2** and **Exhibit LP3** pages 12-16) showing that two major business management consultancy companies offer services involving the use of data (including collection processing and management of data). The opponent did not provide further evidence or submissions on the similarity of the competing services. Whilst I appreciate that the opponent’s evidence seems to suggest that business

management companies offer services that encompass the use of data, from the evidence before me I cannot derive any further element to assess the level of similarity between the competing services.

45. Data collection, compilation and verification can be carried out when offering business management consultancy. Therefore, whilst the services do not have the same nature, they could be aimed at the same purpose (i.e., collect, rationalise, and use data to direct the company's organisation) and may be offered through the same trade channels. These services are not strictly complementary, but data-related services can be functional to the delivery of business management consultancy. Therefore, I find that there is at least a medium degree of similarity between the terms above and the opponent's "*business management consultancy*".

Class 36

- "*real estate advice and management; [...] information, consulting advisory services relating to all the aforesaid services; all of the aforementioned services not related to employment agency services, outplacement services, personnel management consultation and evaluation services, personnel recruitment services, and personnel relocation and travel services*"

46. The core meaning of management of property/real estate is the administration of such assets. I accept that property may be seen as a type of investment. However, the management of property is typically a service which is provided by estate and leasing agents, rather than by financial advisors or providers of financial investment services. I accept that there may be some limited overlap in nature, method of use and purpose, as both parties' services involve the management of different types of assets. However, in my view, any such overlap is very high level. I do not consider these services to be in competition and I do not consider them to be complementary. Taking all of this into account, I find these services to be similar to a low degree.

Class 45

- "*services pertaining to legal matters including consultancy, [...]; tax law consultancy; advisory services relating to legal matters; legal tax advice services;*

[...] information, advisory and consulting relating to the aforesaid; none of the aforesaid relating to intellectual and industrial property”

47. I find the terms above to be highly similar to the opponent’s “*litigation services*”. The respective services have the same nature (legal services), intended purpose (provide legal support), and share the same trade channels since exclusively professionals in the legal profession can offer these services. Law firms usually provide a wide range of legal services encompassing different areas of the law; therefore, I also find these services can be in competition between them.

- *training on legal systems; [...] information, advisory and consulting relating to the aforesaid; none of the aforesaid relating to intellectual and industrial property”*

48. I appreciate that companies (e.g., law firms) that offer legal services generally are involved in the training of new professionals (e.g., training contract schemes); thus, the services could address the same end users. However, such companies or businesses do not generally offer legal training as a service *per se* and legal training is offered by other institutions such as, for example, universities. Thus, I find that “*training on legal systems*” has a different nature, intended purpose, channels of trade, and is not in competition with any of the opponent’s services. Thus, I find the competing services to have a low degree of similarity.

Distinctive character of the Earlier Mark

49. 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).”

50. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor to consider in my assessment.
51. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the opponent has filed no evidence of use of its mark. Accordingly, I have only the inherent position to consider.
52. Neither party indicated any potential meaning for the words ‘Moores Rowland’. It is my view that the Earlier Mark may represent the combination of two English surnames and the average consumer is likely to understand the Earlier Mark with such meaning. The Earlier Mark does not seem to convey any other message or have additional meanings that could affect the Earlier Mark’s distinctiveness. Combinations of surnames are quite commonly used as firms’ names; thus, I find the Earlier Mark’s structure not to be particularly unusual and, thus, I believe it possesses a medium level of distinctive character.

Likelihood of confusion

53. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

54. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 as follows:

“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”.

55. I have found the degree of similarity of the respective services ranges from low to high. The relevant consumer is likely to pay an above medium degree of attention in their selection. The distinctiveness of the Earlier Mark is medium. The marks are identical. In the purchase of the contested services both visual and aural considerations are deemed to be relevant.

56. Weighing all these factors, I find that the average consumer is likely to mistake the Earlier Mark for the Contested Mark. Thus, there is a likelihood of direct confusion.

Conclusion

57. The opposition under Section 5(1) and Section 5(2)(a) succeeds and the application will be refused.

Costs

58. The opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice (“TPN”) 2/2016. Bearing that scale in mind, I award costs to the opponent as follows:

Official fee	£100
Preparing the notice of opposition and considering the counterstatement	£200
Preparing and submitting evidence	£500
Total:	£800

59. I order PT MRI Indonesia to pay Dr. Curtis N. Rhodes, Jr. the sum of **£800**. 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 23 day of September 2024

Andrea Rossi

For the Registrar