O-332-03

IN THE MATTER OF APPLICATION NUMBER 2191353
IN THE NAME OF LOMBARD NORTH CENTRAL PLC
TO REGISTER A TRADE MARK IN CLASSES 9, 35, 36, 37, 38 & 42

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 50256
BY LOMBARD RISK SYSTEMS LIMITED &
LOMBARD RISK CONSULTANTS LIMITED

IN THE MATTER OF application number 2191353
in the name of Lombard North Central Plc
to register a trade mark in Classes 9, 35, 36, 37, 38 & 42

And

IN THE MATTER OF opposition thereto under number 50256
by Lombard Risk Systems Limited & Lombard Risk Consultants Limited

Background

1. On 10 March 1999, Lombard North Central Plc filed an application to register the trade mark LOMBARD NETWORK SERVICES in Classes 9, 35, 36, 37, 38 & 42 in respect of the following goods and services:

Class 9	Computers and data processing apparatus and instruments, visual display units and printers for use with the aforesaid goods; modems; parts and fittings for all the aforesaid goods; computer programs and computer software; all included in Class 9.
Class 35	Provision of business and commercial information services, advisory services relating thereto; provision of management information and data by means of printed matter and by computer and other electronic means.
Class 36	Banking services; credit services; charge, credit and debit card services; financing services; securing funds for others; insurance services; credit protection insurance services; but not including institutional and private investment management and investment services; all included in class 36
Class 37	Installation, maintenance and repairs services; advisory services relating thereto; all the aforesaid services being provided in connection with the hire, leasing, rental and sales of computer equipment, all included in Class 37.
Class 38	Telecommunications and other data transmission systems; advisory services relating thereto; all the aforesaid services being provided in connection with the hire, leasing, rental and sales of computer equipment, all included in Class 38.
Class 42	Hire, leasing and rental of computers, data processing installations and ancillary equipment and of installations and apparatus for use therewith; all included in Class 42**.**

2. On 7 October 1999, Lombard Risk Systems Limited and Lombard Risk Consultants Limited as joint opponents filed notice of opposition in which they say that they are the proprietors of a number of trade marks, details of which can be found as an annex to this decision. The ground on which the opposition is based is in summary:

Under Section 5(2)(b)	because the opponents' earlier trade marks and the application in suit include the distinctive element LOMBARD and the application is sought to be registered for goods identical or similar to those covered by these earlier trade marks, as a result there exists a likelihood of confusion on the part of the public.

3. The applicants filed a counterstatement in which they deny the ground on which the opposition is based. Both sides request that an award of costs be made in their favour.

4. On 16 August 2002 I issued my decision in respect of the above proceedings. In paragraph 37, I directed that as none of four "earlier marks" relied upon by the opponents in the grounds of opposition had yet achieved registration, under the terms of the proviso contained in subsection (2) of Section 6, my decision was not to take effect until the outcome of these marks had been determined.

5. The position with regard to all four marks has now been decided. The two United Kingdom trade marks, numbered 2100513 and 2100514 have been refused. The two Community Trade Marks, numbered 272302 and 265199, have been accepted but subject to a revision to the specification of the services that they cover. In a letter dated 25 November 2002, I set out my decision based on the facts before me, and giving the parties one month in which to make any submissions. Submissions were received from the opponents' representatives, and taking these into account my decision is as follows.

6. Before going to my substantive decision I must address some issues raised by Ms Nicholls' submissions. The first relates to an amendment to the specification of Class 36 of the application. Ms Nicholls submits that if this request had been made after the filing of the Form TM7, it should be ignored and the issue determined on the basis of the original specification of goods. In fact the form TM33 requesting the amendment to the services was made before the opposition had been filed, but even if it had not, Ms Nicholls' assertion that it should have no bearing is clearly wrong. The provisions of Section 39 of the 1994 Trade Marks Act state that the applicant "may at any time, withdraw his application or restrict the goods or services covered by the application." subject only to the proviso that if the application has been published, then the revision must also be published. This was done in Journal 6305. It is then a matter for the opponents to consider whether they wish to oppose the amendment; none was filed; or whether the revision disposed of their objection to the application, which self-evidently it did not.

7. With her submissions Ms Nicholls enclosed details that she had extracted from a number of web sites. This is, in effect, new evidence although not presented in the

form required by the Act. It was also obtained some three and a half years after the relevant date in these proceedings. Having reviewed its contents I take the view that insofar as it may be relevant to the position that I am now considering, it would have been just as relevant for the case originally made out, and if available, should properly have been submitted as part of the opponents' case, or in the case of an appeal, leave requested to have it admitted at the appeal. Notwithstanding this, for completeness I will consider the extracts as part of this supplementary decision.

8. Quite clearly, having been refused, the two UK trade marks cannot qualify as "earlier marks" and have no part to play in these proceedings. The two CTM 's proceeded to acceptance on the basis of a revision to the specifications as follows:

Number	**Mark**	**Specification**
265199	LOMBARD RISK GROUP OF COMPANIES	Provision of training, seminars and conferences in areas of derivatives, risk management, financial markets, systems integration; provision of training, seminars and conferences relating to technology used in financial markets.
272302	LOMBARD RISK	Provision of training, seminars and conferences in areas of derivatives, risk management, financial markets, systems integration; provision of training, seminars and conferences relating to technology used in financial markets.

9. In her written submissions, Ms Nicholls refers to my comments in paragraph 34 of the decision, in which I state that neither the opponents' earlier mark nor the specifications of the application is limited in any way, saying that this is contradicted by the official letter of 29 October 1999. This advised that the specification of Class 36 of the application had been amended, the amendment being that referred to in paragraph 6 above. There is no contradiction. In citing only part of what was said Ms Nicholls has taken the paragraph out of context. It continued "…so notionally at least I have to proceed on the basis that there is commonality in the channels and means by which the respective goods and services reach and appear in the market, and also in the relevant consumer.". The amendment excluded certain services from Class 36 of the application, but did not limit what was there to being of a particular nature or type. However, that is not the position that exists following the acceptance of the opponents' earlier marks which are now limited to services for the provision of

training, seminars and conferences, but specifically in the area of derivatives, risk management, financial markets, systems integration and to technology used in financial markets.

10. As in my decision of 16 August 2002, I will determine the likelihood of confusion or deception by application of the "global" approach advocated in the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

11. In my decision I conducted an analysis of the respective marks. Nothing has changed in that respect and I see no reason to reconsider that question.

12. In determining whether the goods and services covered by the application and those of the opponents' earlier mark are similar, I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 and the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, which indicated the question of similarity should be determined by a consideration of the following factors:

(a) the nature of the goods or services;

(b) the end-users of the goods or services;

(c) the way in which the goods or services are used;

(d) whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

13. Turning first to Class 9 of the application. Ms Nicholls focused her arguments specifically towards the computer programs and computer software within the application and I take this to be where the objection subsists. She says that unqualified this would include software relating to the provision of training in the areas of derivatives, risk management, financial markets, systems integration and technology used in financial markets, or in other words, the services covered by the opponents' earlier mark. Ms Nicholls is correct in her assessment, but that does not necessarily mean such goods should be considered as similar to the services.

14. Insofar as computer software is an item of goods, and training is the provision of a service, they must be quite different in nature. Even though the services covered by the opponents' earlier marks are directed at the financial markets, the specification of the application is not limited in any way and I therefore see no reason why the end users should, or at least could not be the same.

15. Ms Nicholls submits that generally, businesses that train others in specialist business skills, and financial operations in particular, often provide computer programs and software products to their customers as part of their training package. It is in support of this that Ms Nicholls provided the web pages I have referred to above.

16. The pages relating to the Harvard Business School and Dearborn Financial Services (who use a US telephone number for course registration) appear to be use outside, or are not clearly use within this jurisdiction, although in the latter case the training is provided in conjunction with a company operating within the United Kingdom. The details from Dearborn indicate that software, primarily CD-ROMs and on-line information technology are used in training in conjunction with instructor support. However, none of the pages can be dated, and do not cast any light back to a time at, or prior to the relevant date.

17. Ms Nicholls has also provided details on a Continuing Professional Development programme, described as an "ongoing resource designed to help financial advisers fulfil their sales, business and regulatory CPD obligations" that can be used as distance learning, in house training or as a combination of both. The learning resource is available in a CD-ROM version or can be accessed on line. Participation requires the completion of a registration process. It is not entirely clear whether this training is provided to companies for use by their own employees, or to persons employed in the financial sector. The only information by which to date this material is a copyright claim "1999-2001" which does not establish that this training was being provided prior to the relevant date in these proceedings.

18. The information relating to Bridge Learning refers to the formation of the company in January 1996 (prior to the relevant date) to provide multimedia training. The company is described as a consultancy and distributor of technology based learning materials, seemingly for use by others in the delivery of their own training. There is nothing to indicate that Bridge Learning provide training themselves.

19. On the basis of the information provided by Ms Nicholls, it would seem that the training industry in the UK is segregated into distinct areas; the provision of software for others to use as part of their own training programme, and those who provide software as part of their own training package. There is no evidence that software is provided as a separate, stand-alone entity to deliver the whole training package. This being the case, software could be considered to be complementary to, but not an alternative or in competition with the provision of training services. I have no evidence as to how the industry classifies software for use in the provision of training and the actual service, but being that they are quite different and distinct, I would assume that they would not be placed in the same category.

20. The services covered by the opponents' earlier mark are specialised and likely to be provided to well informed and knowledgeable consumers. I have no evidence as to how the services come to the attention of the consumers, but it seems to me that being specialised they would either be marketed specifically to the financial services sector, or be sought out by operators within that field. Software can reach the consumer in the same way, but is also capable and likely to be stocked by software retailers for self-selection, or by enquiry.

21. In her Declaration of 30 April 2001, Ms Nicholls submitted that LOMBARD is non-distinctive for financial services, and provided evidence to show that the word has relevance within the financial sector. In my decision I took the view that this connection may well be known to those engaged in the financial services sector, but that this would not be so in respect of the average consumer. The opponents' "revised" statement of services are all to be provided to persons engaged within the financial markets, who are likely to be well informed of the corporate names and trade marks in use in this field, and on the opponents' own evidence, aware of the generic use of the word LOMBARD. It seems that in relation to their own consumers, the opponents' mark will have a low threshold of distinctiveness, and not having provided any details of the use that they may have made of the mark, I cannot say that it has become any more distinctive through use, or that the opponents have established a reputation.

22. I believe it follows that computer software related to financial markets is likely to be aimed at the same consumer group, and accordingly, LOMBARD when used in relation to the financial markets should be considered to have a similar low level of distinctiveness.

23. In relation to Class 35 of the application, I stated in my decision that this class contained services Awhich, given the synergy between the business and financial aspects of the management of a commercial undertaking would, in my view be considered capable of being provided by one and the same undertaking, and therefore, are similar services@. I subsequently took the view that following the amendment of the specifications of the opponents' earlier marks, they had been focussed away from business and towards the financial markets and should no longer be considered as being similar. Ms Nicholls submits that this synergy exists in respect of training services even when related to specialised financial operations because they are still connected with the operation of a business. I do not agree. There are financial services such as auditing and accountancy that are closely allied to the operation of most, if not all businesses. But in my view the same cannot be said in relation to trading on the financial markets which is a specialised and distinct activity. Taking all of the surrounding circumstances into account I remain of the view that the services covered by Class 35 of the application are neither the same, nor similar to those covered by the opponents' earlier mark.

24. Class 36 of the application covers a broad range of financial services, but qualified as Anot including institutional and private investment management and investment services.@. In my decision I took the view that the application covered financial services that were capable of involving consultancy, and where not, were closely allied to such services, and consequently, that identical and similar services were involved.

25. The applicants' specification relates to the provision of insurance services per se. Ms Nicholls' refers to risk management as being the key to the operation of insurance markets. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16 it was stated:

> "*.... definitions of services.... are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as "boots and shoes". In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.*"

26. I am not aware of Ms Nicholls' credentials in the world of finance, but apart from this bald statement I have no evidence to support her assertion. To me the term "risk management" conveys the idea of reducing potential liability or risk to the insurer, rather than the insured, and therefore not a service provided to the consumer, and without evidence I would be reluctant to infer that the provision of insurance services would include the provision of the service of risk management. The revised specifications of the opponents' earlier marks no longer contain consultancy per se, but have been limited to a specialised and specificarea, and for similar reasons to those that I have set out above I consider such services to be different to those covered by Class 36 of the application, and particularly so given the exclusion.

27. In my decision I did not find there to be any similarity in the services covered by Classes 37 and 38 of the application, and the revision to the specifications of the opponents' earlier trade marks moves the gap even wider.

28. Although I found there to be similarity in respect of the services covered by Class 42 of the application, it was brought to my notice that the opposition had not been directed against that class of the application, and should not, therefore, have been the subject of my decision. For the record, I consider the revision to the specification of the opponents' earlier mark removes the similarity in the respective services.

29. Taking all of the factors and circumstances into account, I take the view that the consumer familiar with the opponents' use of their mark, in relation to the services for which it has been accepted, is unlikely to be deceived or confused into believing that use of the mark in suit in relation to the goods and services for which registration is sought, is use by the opponents or a trader linked with the opponents. Consequently, the objection under Section 5(2) fails, and the application is free to proceed for the specifications as advertised, or in respect of Class 36, as amended during the proceedings.

30. The opposition having failed, the applicants are entitled to an award of costs. I order that the opponents pay the applicants the sum of ,635 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of November 2003

Mike Foley
for the Registrar
The Comptroller

Annex

Number	Mark	Class	Specification
272302 (CTM)	LOMBARD RISK	9	Computer software.
		36	Financial training and financial consultancy services.
265199 (CTM)	LOMBARD RISK GROUP OF COMPANIES	9	Computer software.
		36	Financial training and financial consultancy services.
2100513	LOMBARD RISK	9	Computer software.
		36	Financial consultancy services.
		41	Financial training services.
2100514	LOMBARD RISK GROUP OF COMPANIES	9	Computer software.
		36	Financial consultancy services.
		41	Financial training services.