

O-339-04

TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATION No. 2318368

TO REGISTER A TRADE MARK IN CLASS 36

IN THE NAME OF

LAND SECURITIES PLC

DECISION

1. On 12th December 2002 Land Securities Plc ("*the Applicant*") applied to register the designation **CARDINAL PLACE** as a trade mark for use in relation to the following services in Class 36:

Property acquisition and sale; property management and administration; property portfolio management and administration; property and capital investment; property appraisals and valuations; property brokerage; estate management; advisory and information services all relating to the aforesaid; rental of property; rental of housing accommodation; rental of retail premises; rental of offices; rental of industrial premises; rental of retail warehouses; leasing of property; leasing of housing accommodation; leasing of retail premises; leasing of offices; leasing of industrial premises; leasing of retail warehouses; arranging leases for the aforesaid; rent collection services; provision of housing accommodation; provision of retail space; provision

of office space; provision of industrial space; provision of retail warehouse space; billing services in relation to telecommunications service providers and meter reading.

2. The Registrar objected to the application on the ground that it conflicted with 2 earlier applications which qualified for recognition as '*earlier trade marks*' in accordance with the provisions of Section 6(2) of the Trade Marks Act 1994 and Article 4(2)(c) of Council Directive 89/104/EEC of 21st December 1988.

3. The earlier applications were duplicative in the sense that the second application was a Community Trade Mark Application filed on 22nd October 2002 with a claim to priority from the first application, which was filed in the United Kingdom on 10th October 2002 with a request for registration of the same mark for the same specification of services in Class 36.

4. The mark covered by the earlier applications for registration is as follows:



CARDINAL

The services covered by the applications are:

Financial services; asset management; monetary and financial transactions; investment management; fund management; financial evaluations; investment strategy and management; designing and structuring investment products; fiduciary services.

5. The Registrar maintained that there were similarities (in terms of marks and services) that would combine to give rise to a likelihood of confusion within

the meaning of Section 5(2)(b) of the 1994 Act if the marks in question were used concurrently in the United Kingdom in relation to services of the kind for which they were each proposed to be registered.

6. A hearing took place on 20th May 2003 to consider representations on behalf of the Applicant in support of its application for registration. The hearing took place before Mr. Mark Jefferiss acting for the Registrar. He maintained the objection to registration for the reasons given a written decision issued on 26th September 2003 (SRIS O-293-03).

7. The hearing officer's findings, as summarised by me, were as follows:

- (1) the mark graphically represented in the earlier trade mark applications possesses a high degree of distinctive character per se;
- (2) the word **CARDINAL** is the dominant and distinctive element of both marks;
- (3) the earlier applications cover "*financial services*"; this is '*a very broad term that encompasses a large number of services including the services specified by the Applicant*' (paragraph 19);
- (4) the differences between the marks in issue result in a degree of conceptual dissimilarity; they are sufficient to make it unlikely that the average consumer of the services concerned would directly confuse the two marks;
- (5) however '*the word PLACE is not a particularly strong distinguishing feature*' (paragraph 21) and '*the meaning of the word CARDINAL does not, in my view, change when used in the Applicant's mark*' (paragraph 23).

8. He expressed his overall view of the objection in the following terms:

24. I must of course bear in mind that a mere possibility of confusion is not sufficient. (See e.g. *React* Trade Mark [2000] RPC 285 at page 290.) The Act requires that there must be a likelihood of confusion. It is clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the services (and vice versa) – see *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*. In this case I consider, that the marks are similar in their dominant and distinctive characteristics and that the similarities between the services are such, that it would be highly likely for a single service provider to be providing the services covered by both the earlier marks and the later filed application.

25. Furthermore, it is now well-established that the matter must be determined by reference to the likely reaction of an average consumer of the services in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion. In this case, I believe the identity of the services, coupled with the high distinctive character of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act, which includes the likelihood of association.

26. In reaching this conclusion, I bear in mind that it is sufficient if an average consumer encountering the respective marks would assume that the marks identify a single undertaking or undertakings with an economic connection.

9. The Applicant gave notice of appeal to an Appointed Person under Section 76 of the 1994 Act contending, in substance, that the hearing officer had erred by regarding the services in issue as identical or similar and also by giving insufficient weight to the differences between the marks in issue with the result

that the objection to registration had been maintained on the basis of a misapprehended likelihood of confusion. These points were developed in argument at the hearing before me.

10. With a view to reinforcing its position, the Applicant offered unconditionally to amend its specification of services under Section 39(1) of the Act by deleting the following references

- property and capital investment
- property appraisals and valuations
- property brokerage
- rent collection services
- billing services in relation to telecommunications
services providers and meter reading

and adding wording sufficient to restrict the references in the specification to '*property*' in the form of interests in land and buildings. It was accepted on behalf of the Registrar that so long as the application for registration remained pending, the Applicant could legitimately make such amendments by filing an appropriate request on Form TM21. I therefore consider that the appeal should be determined on the basis that the application for registration will be: (i) amended in the manner suggested if it is not refused; and (ii) refused if it would not be acceptable when amended in that manner.

11. I do not think that the amendments unconditionally offered by the Applicant are sufficient to segregate the services specified in the notionally

revised application from those specified in the earlier trade mark applications. In particular, it appears to me that ‘*asset management*’ and ‘*investment management*’ services in Class 36 may well involve the management of interests in land and buildings and thus extend to activities within the scope of the application for registration as notionally revised. However, the broader proposition that activities of the kind specified in the notionally revised application are or include ‘*financial services*’ does not appear to me to be sustainable on a conventional ‘money flavoured’ interpretation of the word ‘*financial*’.

12. The marks in issue are not identical. In order to resolve the objection to registration it was necessary to assess the net effect of the differences and similarities between them from the perspective of the average consumer of the services concerned. Each mark had to be considered without excision or dismemberment. The differences and similarities had to be given as much or as little significance as the average consumer would have attached to them at the date of the application for registration.

13. I agree with the hearing officer in thinking that the mark graphically represented in the earlier trade mark applications possesses a high degree of distinctive character per se and that the word **CARDINAL** is the dominant and distinctive feature of it from a visual, aural and conceptual point of view.

14. However, I am not comfortable with his finding that the word **CARDINAL** operates with no change of meaning as the dominant and distinctive element of the Applicant’s mark.

15. The perceptions and recollections triggered by the earlier mark are likely to have been ecclesiastical whereas the perceptions and recollections triggered by the Applicant's mark are likely to have been locational as a result of the qualifying effect of the word **PLACE** upon the word **CARDINAL**. A qualifying effect of that kind can be quite powerful as indicated by the examples cited in argument on behalf of the Applicant: **SOMERSET** as compared with **SOMERSET HOUSE**; **COUNTY** as compared with **COUNTY HALL**; **CANARY** as compared with **CANARY WHARF**.

16. This accounts for the hearing officer's finding that there is a degree of conceptual dissimilarity between the marks. His finding that the marks were unlikely to be directly confused also appears to recognise (and I would agree) that the conceptual dissimilarity is sufficient to render the visual and aural differences significant from the perspective of the average consumer.

17. So why should it be thought that the visual, aural and conceptual differences are sufficiently significant to render the marks distinguishable, but not sufficiently significant to enable them to be used concurrently without giving rise to a likelihood of confusion? This, to my mind, is the critical question. The answer to it depends upon how much or how little the word **PLACE** would be likely to contribute to the distinctive character of the mark **CARDINAL PLACE** taken as a whole.

18. As I have already indicated, the hearing officer addressed this point to the following effect:

“... the addition of the word **PLACE** to the applicant’s mark is, to my mind, allusive when used in relation to property, buildings etc. and as the applicant’s services include property management and investment the word **PLACE** is not a particularly strong distinguishing feature. The word **CARDINAL** in my view is a strong trade mark for these services ... The meaning of the word **CARDINAL** does not, in my view, change when used in the applicant’s mark.”

However, his characterisation of the Applicant’s mark as the allusive word **PLACE** added to the strong trade mark **CARDINAL** appears to me to be open to the objection that it effectively ignores the blend of meaning and significance produced by combining the word **CARDINAL** with the word **PLACE** in the designation **CARDINAL PLACE**.

19. Having held that the visual, aural and conceptual differences were sufficient to render the marks distinguishable, the hearing officer ought to have recognised that the underlying reason for that conclusion (i.e. the perceptions and recollections triggered by the designation **CARDINAL** were essentially ecclesiastical whereas those triggered by the designation **CARDINAL PLACE** were essentially locational) pointed to the further conclusion that the marks could be used concurrently without giving rise to a likelihood of confusion.

20. I am left with the clear impression that he did not do so. I believe that if he had done so, he would have concluded that conflict with the rights conferred by the earlier trade mark applications was not evident upon the basis of the unelaborated information and materials then available to the Registrar. Since the Registrar acts as a watchdog not a bloodhound when raising ex officio objections to registration on relative grounds, I would expect him to have allowed the

application to proceed in the usual way i.e. without prejudice to any objection that the proprietor of any earlier trade mark right might wish to raise on relative grounds with evidence directed to the points at issue in any subsequent opposition or invalidity proceedings.

21. For these reasons I consider that the hearing officer's decision to refuse registration on ex officio examination under Section 5(2)(b) of the 1994 Act should be set aside. The application for registration will be remitted to the Registrar for further processing in accordance with the provisions of the Act and the Rules. The Applicant is directed to file a Form TM 21 requesting amendment of the specification of services within 21 days of the date of this decision. The request for amendment will cover the points identified in paragraph 10 above.

22. In keeping with the usual practice on appeals to this tribunal in ex parte proceedings, I make no order for costs.

Geoffrey Hobbs Q.C.

28th October 2004

Ms. Eesheta Shah of Messrs Nabarro Nathanson appeared on behalf of the Applicant.

Mr. John MacGillivray appears on behalf of the Registrar.