

O-244-07

**TRADE MARKS ACT 1994  
IN THE MATTER OF AN APPLICATION  
BY S R MORRIS GROUP LIMITED  
TO REGISTER A TRADE MARK NO 2424048  
IN CLASSES 36 & 37**

**Decision and Grounds of Decision**

**Background**

1. On the 10 June 2006, S A Beaton of S R Morris Group Limited of Dunbar House, Sheepscar Court Leeds LS7 2BB, applied under the Trade Marks Act 1994 to register the following trade mark in Classes 36 and 37:



2. The goods in Classes 36 and 37 for which registration is sought are:

Class 36

“Real estate affairs, financial services, insurance”.


Class 37

“Building construction, refurbishment”.

3. No objection was raised against Class 37, however an objection was taken against the mark in Class 36 under Section 5(2) of the Act in respect of the following marks:

<b>Number</b>	<b>Mark</b>	<b>Specifications</b>	<b>Proprietor</b>
2211668	IF	<b>Class 36 Insurance; insurance brokerage; captive management; monetary affairs; bank affairs remote banking services which shall include telephone banking services, banking services provided online from a computer</b>	<b>If Skadeforsakring Holding Aktiebolag  Filing date: 18.10.1999</b>

		<p>database or capable of being accessed by mobile or wireless devices or by means of web pages being provided on the internet or through interactive television; trade in securities; real estate affairs; securities brokerage concerning stocks and other securities; real estate agencies; real estate management; surety services for charitable fundraising.</p>	
2212186	<i>if...</i>	<p><b>Class 36</b>  <b>Insurance; insurance brokerage; capital management; captive management; financial services; monetary services; bank services including remote banking services which shall include telephone banking services, banking services provided online from a computer database or capable of being accessed by mobile or wireless devices or by means of web pages being provided on the Internet or through interactive television; trade in securities; real estate affairs; securities brokerage concerning stocks and other securities; real estate agencies; real estate management; surety services for charitable fundraising.</b></p>	<p><b>If Skadeforsakring Holding Aktiebolag</b>   <b>Filing date: 22.10.1999</b></p>
2212819B	<b>IF</b>	<p><b>Class 36</b>  <b>Insurance; insurance brokerage; capital management; captive management; monetary affairs; bank affairs; trade in securities; securities brokerage concerning stocks and other securities; security services for charitable fund raising; financial services relating to real estate.</b></p>	<p><b>Halifax plc</b>   <b>Filing date: 29.10.1999</b></p>

E1356716		<p><b>Class 35</b>  Project management, accounting, business management, organisation consultancy, business consultancy, economic forecasting, management assistance, marketing consultancy, marketing assistance, statistical information.</p> <p><b>Class 36</b>  Banking services; telephone banking services, banking services provided online from a computer database or by means of web pages provided on the Internet or through interactive television; investment services; financial services; loan services; savings services; payment and credit services; credit card, debit card, charge card, cash card and bank card services; cash management; bankers' clearing services; financial advisory services; administration of financial affairs; computerised financial services; financial consultations; financial management; investment advice; account debiting services; monetary transfer, automated banking services, transfer of funds, electronic payment services; bill payment services; escrow services; currency exchange services; cheque encashment services; automatic cash dispensing services, automatic teller machine services; safe deposit services; financial guarantees (surety services); advice and enquiries</p>	<p><b>Halifax plc</b></p> <p><b>Filing date: 22.10.1999</b></p>
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		<p>regarding credit, services for the provision of credit information; mortgage services; mortgage banking, mortgage brokerage, mortgage introduction services; information, advisory and consultancy services relating to all the foregoing and insurance products linked to the provision of banking services and mortgage services.</p>	
E1584275	<i>if..</i>	<p><b>Class 36</b>  <b>Insurance; insurance brokerage; capital management; captive management; financial affairs; monetary affairs; bank affairs including remote banking services which shall include telephone banking services, banking services provided online from a computer database or capable of being accessed by mobile or wireless devices or by means of web pages being provided on the Internet or through interactive television; trade in securities; real estate affairs; securities brokerage concerning stocks and other securities; real estate agencies; real estate management; surety services for charitable fund raising.</b></p>	<p><b>If Skadeforsakring Holding Aktiebolag</b></p> <p><b>Filing date: 30.03.2000</b></p> <p><b>International priority date: 21.10.1999 (SE)</b></p>
E1584911	<b>IF</b>	<p><b>Class 36</b>  <b>Insurance; insurance brokerage; capital management; captive management; financial affairs; monetary affairs; bank affairs including remote banking services which shall include telephone banking services, banking services provided online from a computer database or</b></p>	<p><b>If Skadeforsakring Holding Aktiebolag</b></p> <p><b>Filing date: 30.03.2000</b></p> <p><b>International priority date: 18.10.1999 (SE)</b></p>

		<p><b>capable of being accessed by mobile or wireless devices or by means of web pages being provided on the Internet or through interactive television; trade in securities; real estate affairs; securities brokerage concerning stocks and other securities; real estate agencies; real estate management; surety services for charitable fund raising.</b></p>	
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4. A period of six months was allowed for the applicant to respond under section 37(3) of the Act. No response had been received by 5 March 2007 and despite the fact that no objection had been taken against the Class 37 services, the application was refused as a whole under Section 37(4) of the Act. Following the request for a Statement of Grounds it was noted that the application had been refused in error in respect of the Class 37 services. Numerous attempts were made to contact the applicant by telephone however these attempts proved unsuccessful. The applicant was subsequently informed in writing that there is a way forward in respect of the Class 37 services however no response to the written correspondence was received. If the application is subsequently appealed, the refusal could be lifted against the Class 37 specification.

5. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of the decision and the materials used in arriving at it.

6. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

**The Law**

7. Section 5(2) of the Act reads as follows:

“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, or

(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.”

8. An earlier trade mark is defined in Section 6(1) which states:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, International trade mark (UK), Community trade mark or International trade mark (EC), which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

9. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG and Adidas Benelux BV.* [2000] E.T.M.R. 723.

10. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*; 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*

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

11. It is clear from the ECJ's judgment in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade marks have a highly distinctive character.

12. The six earlier trade marks are registered trade marks and are therefore deemed to be valid (Section 72 of the Act refers). The earlier trade marks do not consist solely of invented words so they cannot be accorded the very highest level of distinctive character. Three of the earlier marks are identical to one another and consist of the word only "IF". The remaining three marks consist of stylised versions of the word "if" followed by three dot characters.

13. I must of course, consider both marks in their entirety and, having done so, I have concluded that although these earlier marks do not possess the very highest level of distinctive character, they do possess a relatively high degree of distinctive character in relation to the services in Class 36.

### **Similarity of the goods**

14. The Class 36 specification in respect of UK Registration 2212186 includes "*insurance*", "*financial services*" and "*real estate affairs*" and Community Registrations E1584275 and E1584911 include "*insurance*", "*financial affairs*" and "*real estate affairs*". These are identical services to the applicant's Class 36 specification for "*real estate affairs, financial services and insurance*".

15. UK Registration number 2211668 includes "*insurance*" and "*real estate affairs*". These are identical services to "*insurance*" and "*real estate affairs*" in the applicant's Class 36 specification. In addition the earlier registration includes "*monetary services*" which are identical to "*financial services*" in the applicant's Class 36 specification.

16. Community Registration number E1356716 includes "*financial services*" which are identical to "*financial services*" in the applicant's Class 36 specification. The term "*financial services*" would also incorporate insurance services and would therefore be identical to "*insurance*" in the applicant's Class 36 specification. The Class 35 specification for the earlier registration includes "*business management*" and "*business consultancy*" services which are similar services to "*financial services*" in the applicant's Class 36 specification.

17. UK Registration number 2212819B includes "*insurance*", "*monetary affairs*" and "*financial services relating to real estate*" and these are all identical services to those

included in the applicant's Class 36 specification of "*real estate affairs, financial services and insurance*".

### **Similarity of the marks**

18. Since the mark is not identical to any of the earlier trade marks, the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question, therefore, is whether the mark in this application is so similar to the earlier trade marks that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

19. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks bearing in mind their distinctive and dominant components.

20. The applicant's mark consists of the word "if" in a stylised font surrounded by a circular device followed by the slightly stylised words "initial finance". The word "initial" is presented in grey and the word "finance" is presented in blue. The left hand side of the circle which incorporates the lower case letter "i" has a grey background. The applicant has stated on the Form TM3 that the colour grey, Pantone reference Cool Grey 10 is used. The right hand side of the circle has a blue background. The applicant has stated on the Form TM3 that Pantone reference 323 is used. The stylised lower case letter "f" is presented at an angle sloping towards the right and forms a dividing diagonal line between the two colours blue and grey in the circle. Following the stylised word "if" in the circular device is the slightly stylised word "initial", presented in Pantone reference Cool Grey 10 and the slightly stylised word "finance" in blue, Pantone reference 328.

21. The dominant and distinctive element in the applicant's mark is the stylised word "if" presented in a circular device. The word "if" stands out as it is distinctive and appears at the beginning of the mark. It is followed by the words "initial finance"; "if" appears to be used as an acronym for the words "initial finance". These words are considered to be non distinctive in relation to the services as the term "initial finance" may be used for example to describe the provision of initial finance for starting up in business.

22. Taking account of the visual similarities, UK Registration number 2212186 and Community Registration numbers E1356716 and E1584275 all consist of stylised versions of the word "if" in lower case font followed by three dot characters. I consider these marks to be visually similar to the word "if" in the applicant's mark as they are all presented in lower case font. I consider this to be particularly so with regard to 2212186 and E1584275 as the letter "f" is presented as being almost identical and sloping to the right. The three dot characters included in the earlier marks give the impression that something more is to follow, however the distinctiveness lies in the word "if". UK Registrations 2211668 and 2212819B and Community Registration E1584911 all consist of the word only mark "IF". As such, these three marks could be used in any font and therefore if presented in lower case could be considered visually similar. Although the applicant's mark contains the additional words "initial finance" and there is a possibility



that the word “if” may be seen as an acronym for “initial finance” this does not help as the visual impact lies in the word “if”.

23. Aurally, although the marks are different in that the applicant’s mark includes the words “initial finance” after the word “if”, the words “initial finance” comprise the non distinctive element in the mark. The word “if” forms the distinctive part of the mark and this word is aurally identical to the earlier registrations.

24. Turning to the conceptual similarities, the dominant and distinctive element in all of the marks lies in the word “if”. Although it is possible that the addition of the non-distinctive words “initial finance” in the applicant’s mark could result in “if” being seen as an acronym for “initial finance”, it is equally possible that it could be seen as the word “if”. With this in mind the dominant and distinctive “if” element in each of the marks are conceptually similar.

25. I consider “if” to be a distinctive term in relation to the services in Class 36. All of the earlier marks consist of the word “if”, either as a word only, or with the addition of three non-distinctive dot characters. In addition, “if” is distinctive in the applicant’s mark, the term “initial finance” being non-distinctive. Bearing all of this in mind, I have concluded that there is a high degree of similarity when comparing the applicant’s mark to the earlier cited marks

### **Likelihood of confusion**

26. 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. I have already found the services for which the earlier trade marks are registered to be identical to the goods applied for. 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 goods (and vice versa) - see *Lloyd Schuhfabrik Meyer & CO GmbH v Klijsen Handel BV*.

27. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. In relation to the services in question I consider the average consumer of such services to be the general public. 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.

28. I must of course consider the likelihood of confusion by reference to the visual, aural and conceptual points of similarity. In my view the weight to be attached to all aspects of confusion is significant. The similarities between the marks and the identical services which are in conflict are likely to lead to both visual and aural confusion. I have found that all marks in conflict possess a relatively high degree of distinctive character and this

is a factor that I have borne in mind in concluding that there are also conceptual similarities between the marks.

29. In this case I believe the identical services that I have identified coupled with the relatively high degree of 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.

30. I therefore conclude that there is a likelihood of confusion which includes the likelihood of association. 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.

### **Conclusion**

31. In this decision I have considered all of the documents filed by the applicant in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

**Dated this 23rd day of August 2007**

**KAREN STEPHENS  
For the Registrar  
The Comptroller-General**