

O-066-13

TRADE MARKS ACT 1994

APPLICATIONS 2527244, 2527247 & 2527248

BY HUNTSWORTH PLC

TO REGISTER THE TRADE MARKS

CITIGATE GROUP

CITIGATE COMUNICATIONS AND

CITIGATE DEWE ROGERSON

AS TRADE MARKS FOR SERVICES IN CLASSES 35, 41 & 42

AND

OPPOSITIONS 100063, 100064 & 100065

BY CITIBANK N.A. AND CITIGROUP INC.

BACKGROUND

1. On 24 September 2009, Huntsworth plc applied to register the following trade marks:

CITIGATE GROUP

CITIGATE COMMUNICATIONS

CITIGATE DEWE ROGERSON

2. The list of services for which registration was sought is the same for each mark. It is as follows:

Class 35:

Advertising services; marketing services; public relations services; market research, market analysis and strategic marketing services; preparation of publicity material and preparation of business reports; promotional services and public agency services; management consultancy services; consultancy services relating to business operations, consultancy services relating to brand development; information and advisory services relating to all the aforesaid services.

Class 41:

Event management services.

Class 42:

Design services, copywriting, art work design, graphic design services, illustrating services, web-site design services, computer programming services, information, advisory and consultancy services relating to all the aforesaid services.

3. The applications were accepted and published for opposition purposes on 27 November 2009. On 28 January 2010, Citibank N.A. and Citigroup Inc. opposed the applications. The grounds of opposition are, in summary, that:

- i) The opponents are the proprietors of the earlier marks set out in Annex A that consist of, or include, the word CITI. These marks include CITI, CITIBANK, CITIGROUP, CITICARD, CITICORP & CITIGOLD.
- ii) The opponents claim that they have used these marks and thereby established a „family’ of CITI- marks.
- iii) The opposed marks cover services that are identical or similar to the goods/services for which the earlier marks are protected.
- iv) There is a likelihood of confusion with the earlier marks and/or the opposed marks will be taken by the public to be a member of the opponents’ family of marks and there is therefore a likelihood of confusion through mistaken association.
- v) Registration of the opposed marks would therefore be contrary to s.5(2)(b) of the Act.

- vi) The opponents' CITI, CITIBANK (both with and without an arc device with which they are used), CITIGROUP, CITICARD & CITICORP marks have a reputation amongst the public.
- vii) Use of the opposed marks would take unfair advantage of the reputations of the earlier marks, because it would take advantage of the high level of investment in, and promotion of, those marks by the opponents.
- viii) Use of the opposed marks would also be detrimental to the distinctive character of the earlier marks because it would dilute the distinctiveness of the marks.
- ix) Registration of the opposed marks would therefore be contrary to s.5(3) of the Act.

4. There were originally further grounds of opposition based on the opponents' common law rights to marks including the word CITI. However, at the hearing mentioned below the opponents' counsel sensibly accepted that this ground added nothing to the other grounds of opposition. Consequently, I need say no more about that ground.

5. Both of the opponents are recorded as owning some of the earlier marks. However, their businesses are closely linked economically and it is obvious that each opponent has consented to any use made of the marks by the other. Consequently, from here on I will treat the opponents as one, without distinguishing between them, except where it is necessary to do so.

6. The applicant filed counterstatements denying the grounds of opposition and putting the opponents to proof of the various facts claimed in the notices of opposition. In particular, the applicant required proof of use of CITIBANK as registered under UK 1283067 and Community trade mark ("CTM") 179531 for certain goods and services in classes 9, 16 & 36, for CITIGROUP (CTM 867879) for goods and services falling in the same classes, for CITIBANK and arc device (CTM 2293405) for certain goods and services falling in classes 9, 16, 35, 36, 39 & 42, for CITICARD (CTM 179473) and CITIGOLD (CTM 179549), both for certain goods and services in classes 9 and 36.

7. Both sides seek an award of costs.

8. The oppositions were consolidated. This decision covers all three.

THE HEARING

9. The matter came to be heard on 18 October 2012 when the applicant was represented by Mr Michael Edenborough Q.C., instructed by Mewburn Ellis, and the opponents were represented by Mr James Mellor Q.C., instructed by Cleveland.

DECISION OF THE GENERAL COURT IN RELATED PROCEEDINGS

10. In 2001, the applicant applied to register CITIGATE as a CTM. The CTM application covered all the services listed in classes 35 and 42 of the opposed UK applications (but not the services listed in class 41 of the national applications).

11. The CTM application was opposed by the opponents on similar grounds to those raised in these proceedings. On 26 September 2012, the General Court (“GC”) issued a judgment¹ rejecting an appeal brought by the applicant against a decision by the First Board of Appeal at OHIM rejecting the application. The GC decided, *inter alia*, that:

i) The opponents had *“succeeded in establishing, as regards a significant part of the European Union, not only very widespread use of their CITIBANK mark, but also use of their CITICARD, THE CITI NEVER SLEEPS and CITIGOLD marks, as well as, to a lesser degree, use of their CITIEQUITY, CITIGARANT and CITIBOND marks.”*

ii) There was *“a low degree of similarity between the [applicant’s] market research, market analysis and strategic marketing services; preparation of business reports; public agency services; management consultancy services; [and] “consultancy services relating to business operations” in class 35 and the opponents’ “insurance, financial affairs, monetary affairs, real estate affairs services in Class 36.”* With regard to the applicant’s other services in classes 35 and 42 of the CTM, the GC held that *“they are neither identical nor similar to the [opponents’] services covered by classes 35, 36, 38 or 42 of the earlier marks.”*

iii) Having regard to the goods and services for which some similarity (or more) had been established, and having regard to the opponents’ family of CITI marks, there was a likelihood of confusion.

iv) *“Not only does the CITIBANK mark enjoy a reputation within the European Union but its distinctive character is further enhanced as a result of the fact that it belongs to a family of trade marks, the distinctive element of which is „citi’.”*

v) The applicant’s services which had survived the ground of opposition based on article 8(1) of the Regulation (equivalent to s.5(2)(b) of the national law), were *“services connected with the business sector, which itself necessarily has links with the banking and financial sector. They are services to which professionals will have recourse in the course of their business activities, in the same way as they will have recourse to the services in Class*

¹ Case T-301/09

36 in the course of those activities. There is therefore a degree of proximity between those different services.”

vi) The article 8(5) ground of opposition (equivalent to s.5(3) of the national law) succeeded because the relevant public would make a link between the marks and *“there is a risk that the mark applied for will take advantage of the aura attaching to the CITIBANK mark on account of its reputation and that, lastly, the relevant section of the public might decide to use the applicant’s services in the belief that the mark in question is linked to the well-known mark CITIBANK. That risk is, moreover, increased because there is a family of CITI trade marks.”*

vii) The applicant’s argument that *“the context has changed in so far as it is the [opponents’] services which, on account of the banking sector’s fall from grace, might take advantage of the positive image projected by its services cannot succeed because it is a vague, unsubstantiated claim, which does not, contrary to the applicant’s assertions, constitute a new fact or evidence to be taken into account by the Court.”*

viii) The applicant’s argument that the opponents had only established the reputation of CITIBANK and that the Board of Appeal had therefore been wrong to take the other earlier marks into account under article 8(5) was rejected because *“the existence of a family of trade marks may be regarded, for the purpose of the application of Article 8(5) of Regulation No 207/2009, as merely one of the factors to be taken into account in establishing whether there is connection between the mark applied for and one of the earlier marks forming part of that family, in so far as that earlier mark enjoys a reputation.”*

ix) The applicant’s argument that it had due cause to use the CITIGATE mark was rejected because *“the documents produced by the applicant simply show that there are various companies whose business name contains the word CITIGATE and a number of domain names which also contain that word. That evidence is not sufficient to establish due cause, because it does not demonstrate actual use of the CITIGATE mark.”*

x) Although it was possible that co-existence could reduce the likelihood of confusion or a connection being made between the parties’ marks, *“that possibility can be taken into consideration only if..... the applicant for the Community trade mark duly demonstrated that such coexistence was based upon the absence of any likelihood of confusion or the absence of any likelihood of a connection being made on the part of the relevant public between the earlier mark upon which it relies and the intervener’s earlier mark on which the opposition is based.”* The applicant had not established this.

12. There was some discussion at the hearing about the extent to which I was compelled to follow the findings of the GC. In the end I think it was accepted that, apart from point viii) above, all of the GC's findings were ones of mixed fact and law. Therefore only the finding at viii) above, which was on a point of Community law, was binding on me. Strictly speaking, as the GC's decision relates to the meaning of the Community Trade Mark Regulation rather than the Directive, I may not even be bound by GC's decision at point viii) above. However, as article 8(5) of the Regulation is effectively identical to article 5(2) of the Directive (which is the basis for s.5(3) of the national law), I will consider the GC's decision at point viii) above to be effectively binding on me. The GC's other findings are of merely persuasive value. Further, the UK application was filed 8 years after the CTM so the factual situation and the evidence may have changed by the date at which most of my findings must be made in these proceedings: 24 September 2009 ("the relevant date"). However, in the interest of consistency in legal decision making within the Community, I will keep the GC's other findings in mind.

THE FACTS

13. A list of the evidence is set out in Annex B. It would not be profitable to analyse each of the 29 statements and 226 exhibits. Rather, I will set out the relevant evidence and make the required findings of fact issue by issue.

The opponents' reputation and its 'family' of marks

14. The following trade mark ("citi and arc device") was rated as the 36th best global brand in 2009, the year that the opposed applications were filed².



15. The United States was recorded as the brand's country of origin. The brand had been rated even higher in earlier years, but the rating diminished following the financial crisis in 2008.

16. The opponents' business is divided into two areas. The biggest part is made up of what the opponents call their Institutional Clients Group ("ICG"). The ICG provides mainly business to business services. It is broken down into five sub-groups: Global Transaction Services ("GTS"), Global Banking, Global Markets, Citi Capital Advisors and Citi Private Bank. The other (smaller) part of the business consists of consumer banking services.

17. Mei-Li Tan is the Managing Director of the GTS division of the ICG and she gives evidence about the business and the marks used by GTS. She says that GTS provides a range of financial services to:

² See exhibit SMC3 to the statement of Sarah Connor, at page 43.

- i) Financial institutions, including insurance companies and banks, companies which manage assets and funds, and intermediaries including brokerage houses and broker-dealers;
- ii) Corporate organisations, including multi-national companies;
- iii) Public sector organisations, including Governments and Government Agencies and Departments, and also non-Governmental organisations.

18. Prior to 2003, the branding used in the UK emphasised the CITIBANK mark, although the CITIGROUP mark was also used. After 2003, GTS shifted the emphasis to the mark CITIGROUP with an umbrella device, although she says that CITIBANK continued to be used. In 2007, the citi and arc device replaced the CITIGROUP with umbrella device. In 2003, GTS started to use the marks CITIDIRECT and CITICONNECT in the UK in relation to the opponents' "web-based banking platform" and "on-line trade financing platform", respectively.

19. Ms Tan exhibits various brochures showing use of the CITI mark³ (as per paragraph 14 above) in 2008, CITIGROUP (plus umbrella device)⁴ from 2006, CITIBANK⁵ in 2000/2001, CITIDIRECT⁶ from 2003, and CITICONNECT from 2005⁷.

20. There is no doubt that CITIGROUP was used on a substantial scale up until early 2007. Exhibits MLT11-44 to Ms Tan's statement show numerous advertisements for business to business financial services between 2006 and 2009. These confirm that up until 2007 the CITIGROUP with umbrella device mark was very widely used. After that the citi and arc device mark was used, with CITIGROUP used mainly as part of the company name Citigroup Inc. The majority of these advertisements appeared in financial publications aimed at those in the financial services sector, such as senior bankers and finance executives. The most commonly used publications were Global Custodian, Global Finance, and Trade Finance, which had circulation figures in 2008 of around 20k, 50k and 8k, respectively. I note that some of these publications appear to be priced in sterling and others in dollars. Two of the three most commonly used publications are based in London.

21. The following table shows the considerable extent to which GTS promoted its services in the UK by reference to the marks shown above. Ms Tan says that all figures are estimated and shown in US dollars (thousands).

	Media/Print Advertising	Industry Events	Client Events	"Premiums"	Sponsorship/Awards	Brochures/Client communications	Total

³ See exhibit MLT4

⁴ See exhibit MLT1,5,6,8,12,17,22,31,59,63

⁵ See exhibit MLT6

⁶ See exhibit MLT7

⁷ See exhibit MLT8

2004	57.09	455.22	44.12	9.66	310.45	134.67	1,011
2005	136.22	389.91	140.16	-	124.27	136.20	926
2006	142.93	135.58	131.92	-	-	254.36	664
2007	376.00	1277.60	-	48.00	-	378.40	2,080
2008	712.32	915.20	380.48	32.00	-	360.00	2,400
2009	720.00	676.00	228.00	-	-	312.00	1,936

22. GTS also promotes its services via its website, which according to Ms Tan, received 1.83m unique visits in 2009. The marks used on the website appear to be CITI and the citi and arc device.

23. Ms Tan exhibits some third party press reports from the period 2004/2005⁸. It appears that the part of the business now known as GTS was most commonly referred to as „Citigroup’.

24. The following table shows the global and UK revenues of GTS for the period 2004-2009.

	Global (US\$ Thousands)	UK (US\$ Thousands)
2004	4,078,000	599,481
2005	4,914,000	616,104
2006	6,117,000	740,487
2007	8,098,000	1,192,604,
2008	9,946,000	1,341,248
2009	9,789,000	1,280,201

25. Money Kanagasabapathy is the Managing Director of Citi Private Bank and he gives evidence about the activities of the other parts of the ICG, i.e. Global Banking, Global Markets, Citi Capital Advisors and Citi Private Bank. All the businesses are international.

26. The Global Banking business consists of investment banking, including financial and strategic advice on mergers, acquisitions etc., underwriting and distributing equity, and derivative securities. The customers are large corporations, financial institutions and governments. The Global Corporate Bank provides a full range of

⁸ See exhibits MLT58-63.

corporate banking services to multi-national companies and financial institutions. These include cash management, foreign exchange, trade finance, loans, capital markets, and investment banking. The Global Commercial Bank provides financial services to SMEs, as well as to large businesses. The services include market-linked investments.

27. The Global Markets group provides underwriting, research, sales and trading to a wide range of business and institutional customers.

28. The Citi Private Bank provides global investing, banking, lending and trust services to high-net-worth individuals and families.

29. The Citi Capital Advisors group offers financial services to “*ultra-high-net-worth*” investors in the fields of infrastructure, private equity and “*market strategies*”.

30. Mr Kanagasabapathy gives similar (although not quite identical) evidence to that of Ms Tan as to the marks used by ICG in the UK. He says that the CITI trade mark was first used in the UK in 2007 and CITIGROUP was first used in 1998 and has been used continuously since then.

31. Mr Kanagasabapathy provides evidence about the annual UK revenue figures for the ICG, excluding the GTS, in the period 2004-2009. These range from around \$2.5 billion to around \$7 billion. He also provides figures for the amounts spent annually during this period on advertising and promotion. These range from under \$1m to almost \$10m. Mr Kanagasabapathy exhibits⁹ a booklet produced in 2006 showing details of ICG’s “*extraordinary*” advertising campaign at that time. It shows the CITIGROUP with umbrella device mark used in relation to a wide range of business-to-business financial services, and private banking services.

32. Mr Kanagasabapathy also exhibits¹⁰ what he claims to be a representative sample of press coverage of the ICG’s business in the UK in the period 2004-2006. This consists of 26 articles from financial publications or the financial and business pages of newspapers, such as The Financial Times, Sunday Times, Sunday Telegraph and The Times. The opponents are consistently referred to as „Citigroup’, although these appear to be mainly references to its corporate name.

33. Mr Kanagasabapathy provides some representative advertising by Citi Private Bank from the period 2007/8¹¹. These are from The Economist, Spears Wealth Management Magazine and The Lawyer. The first advertisement from February 2007 shows private banking services being offered under the CITIGROUP with umbrella device mark. The later advertisements, from 2008, show similar services being promoted by reference to the marks Citi Private Bank and citi and arc device. Mr Kanagasabapathy says that that Citi Private bank holds events for prospective

⁹ See exhibit MK2

¹⁰ See exhibit MK3

¹¹ See exhibits MK7-9

clients with a minimum of \$10m to deposit. These events are held in and around London. He exhibits invitations from the period 2004 to 2009. I note that the branding for events held up until March 2007 features the CITIGROUP with umbrella device mark. The branding for events held from September 2007 onwards feature the mark „Citi Private Bank’.

34. Christopher Dyas is the Global Head of Distribution for another part of the ICG known as Citi Investment Research & Analysis group. Mr Dyas’s evidence is that his business undertakes assessments of the viability, stability and profitability of businesses for clients who wish to make informed investment decisions. In 2010, the business had 33k clients worldwide, of which Mr Dyas estimates about 12% are based in the UK. The position was similar in 2008 and 2009. The investment analysis is delivered to clients via *“multiple distribution channels including automated email based client subscription, Citi websites and preferred third party research aggregation vendors such as Thomson Reuters, Bloomberg, Capital IQ, Factset and Markit”*. Examples of printed report are provided¹² which show that the CITIGROUP with umbrella device mark was in use in July 2007, but had been replaced by the citi and arc device mark by June 2009.

35. Jane Griffiths is the Managing Director of Citibank N.A. She gives the principal evidence on which the opponents rely to show the use made of CITI- marks by Citibank in relation to consumer banking. Ms Griffith explains that the opponents opened the first branch of CITIBANK in the UK in 1995. Prior to that, the opponents had provided a range of financial services in the UK, starting in 1976 with what Ms Griffiths describes as „core banking services’. On-line banking was introduced in 1997 under the marks Citibank Direct Access and Citibank PC Banking. Some examples of promotional material from the time are in evidence¹³. They show the former mark used in relation to a typical range of on-line banking services. I note that one of the leaflets includes the question *“Have you applied for your free Citibank Direct access software yet?”*

36. Ms Griffiths states that the main consumer banking brands are CITIBANK and CITI alone. However, she claims that other marks have also been used, such as CITINSURANCE, CITISOLUTIONS, CITICAPITAL and CITIGOLD. She exhibits a range of historical promotional material from 1997, which she says shows the services offered. These include:

- i) A telephone banking service under the marks CITIBANK and CitiPhone Banking;
- ii) A bank card promoted under the marks CITIBANK and CITICARD;
- iii) Foreign currency services promoted under the mark CITIBANK;

¹² See exhibit CD1 and CD2

¹³ See exhibit JG19

- iv) Travel insurance promoted under the same mark;
- v) Share dealing services offered under the same mark;
- vi) Mortgages offered under the same mark.

37. At the time of Ms Griffiths' first statement in May 2011, the opponents had five UK branches of CITIBANK. At one time the opponents also operated a personal loan business under the mark CITIFINANCIAL, but this was closed in 2008. The opponents launched a range of CITI branded credit cards in 2004. Some examples of the card from comparison websites are in evidence¹⁴, which are said to date from 2006. They show a card bearing the citi and arc device mark. Some examples of co-branded credit cards are also in evidence¹⁵. Ms Griffiths says that the debit card currently called CITIBANK BANKING CARD was previously called CITICARD. She exhibits some historical brochures from 1995/1997 showing this to be the case¹⁶. It appears from exhibits JG15 and JG22 that CITIGOLD is, or was up until 2005, a premier bank account scheme, which at one time entitled those account holders to a CITICARD Gold bank card. There are also some examples in evidence of the use of CITI, citi and arc device and CITI CARDS in relation to credit cards and credit card insurance services¹⁷, which appear to date from late 2004 and 2005. Some of the co-branded credit cards in evidence from 2005 to 2007 show use of CITI, citi and arc device, and in one case, CITIBANK and device¹⁸, in relation to credit card loyalty/incentive schemes¹⁹. The customer rewards were linked to the partner organisations. For example, the co-branded CITI/American Airlines card offered discounts off American Airlines flights. The extent of such use of the opponents' marks in relation to loyalty/incentive schemes is not clear. No further information is provided about the claimed use of CITINSURANCE, CITISOLUTIONS or CITICAPITAL.

38. The opponents' revenue from its consumer banking business in the UK in the period 2004-2009 was as follows:

	Revenue £millions
2004	398
2005	335

¹⁴ See exhibit JG16

¹⁵ See exhibits JG16, 17 & 28

¹⁶ See exhibit JG21 and JG22

¹⁷ See exhibits JG28 and 30

¹⁸ As per CTM 2293405

¹⁹ See exhibits JG16,17 & 28

2006	341
2007	558
2008	546
2009	526

39. During 2008, nearly half a million new credit card accounts were opened under the CITI brand.

40. Between 2004 and 2009, the opponents spent between £11m and £25m per annum promoting the consumer banking side of the business in the UK.

41. Ms Griffiths says that the opponents' marks have been promoted in national and London newspapers. Many of the examples she provides date from 1997/1998. However, there are also examples of promotions from 2006-2008²⁰ in which the marks CITIBANK and citi and arc device are used. They show that the opponents also use the strapline „CITI NEVER SLEEPS'. The opponents' website during this period used similar branding²¹. Ms Griffiths says that the opponents are often referred to as just „CITI'. She exhibits²² some press reports to make good the point. These date from 2004 and „CITI' is generally used as a shortened form of the company names Citibank or Citigroup.

Findings of fact

42. I find that the opponents have established:

- i) Substantial use of the mark CITIBANK since 1976 in relation to financial services;
- ii) Use from late 2004/2005 of CITI, citi and arc device, CITI CARDS and CITIBANK and arc device in relation to credit card, credit card insurance services and co-branded credit card loyalty schemes;
- iii) Use of CITIGOLD at least up until 2005 in relation to consumer banking services;
- iv) Use of the citi and arc device in relation to financial services aimed at both businesses and consumers from 2007 onwards;

²⁰ See exhibits JG43- JG53

²¹ See exhibit JG55

²² See exhibit JG56

- v) Substantial use, particularly up until 2007, of CITIGROUP, often (but not always) with a small umbrella device, in relation to the opponents' business-to-business financial services;
- vi) Use of CITI as part of Citi Private Banking since 2007 in relation to high end personal banking services;
- vii) Use of CITI as part of the strapline „Citi never sleeps' in relation to financial services;
- viii) Use of other CITI- marks not relied upon in these proceedings, mostly prior to 2003, but more recently in the case of CITIDIRECT, CITICONNECT and CITIFINANCIAL.

Proof of use of earlier marks

43. In accordance with s.6A of the Act, a number of the earlier marks on which the opponents rely are subject to proof of use. This is because the registration procedures for those marks were completed five years or more before the date of publication of the opposed marks. The relevant 5 year period for this purpose is therefore 28 November 2004 to 27 November 2009.

44. The requirements for genuine use were conveniently summarised by Ms Anna Carboni as The Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (Sant Ambroeus Trade Mark)²³. The summary, which I gratefully adopt and re-produce below, is drawn from the judgments of the Court of Justice of the European Union (CJEU) in Case C-40/01, *Ansul BV v Ajax Brandbeveiliging BV*, Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar*, and Case C-495/07, *Silberquelle GmbH v Maselli-Strickmode GmbH*.

“(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

²³ [2010] RPC 28

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].


(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

45. The marks in question and the use claimed in the relevant period are shown below. Taking account of the above guidance, I have also indicated whether the evidence shows genuine use of the mark in the relevant period.

Mark	Class	Use claimed - Goods/services	Genuine use shown
UK 1283067 CITIBANK	36	Banking services (financial)	Yes
CTM 867879 CITIGROUP	9	Computer programmes and computer software relating to, and for use with applications in the field of, financial services	No
	16	Printer matter relating to financial services.	No
	36	A full range of insurance services	No

	36	Banking and financial services	Yes
CTM 179531 CITIBANK	9	Computer hardware and software used in connection with financial, banking, credit card investment and insurance services.	No
	16	Printed matter relating to financial services	No
	36	Insurance	Credit card insurance
	36	Financial affairs and monetary affairs	Yes
	36	Real estate affairs	No
 CTM 2293405	9	Computer hardware and software used in connection with financial, banking, credit card investment and insurance services.	No
	16	Printed matter and publications on the subjects of finance, banking, credit cards, investing and insurance.	No
	35	Credit card customer loyalty and incentive programs	Yes
	36	Financial services, namely, Banking, credit card services; consumer lending and financing; commercial lending and financing; mortgage brokerage; investment and investment advisory and consulting.	Yes
	36	Real estate brokerage; trust, estate, and fiduciary management, planning and consulting.	No
	38	Providing access to financial services and financial	No

		information via remote computer and global computer network.	
CTM 179473 CITICARD	9	Debit cards and credit cards.	Use of CITI CARDS for credit cards
	36	Insurance: financial affairs; monetary affairs.	Use of CITI CARDS in relation to credit card services and credit card insurance services.
CTM 179549 CITIGOLD	9	Debit cards	No
	36	financial affairs; monetary affairs.	Yes
	36	Insurance	No

46. In reaching these conclusions I have taken the use shown of CITI CARDS as use of CITICARD in a form which does not alter the distinctive character of the mark as registered. This use therefore qualifies as use of the registered mark by virtue of s.6A(4)(a) of the Act.

47. Counsel for the opponents provided references in the evidence which he submitted supported the uses that I have rejected as unproven. I have been through each of these references but find that they do not show the additional uses claimed. For example, counsel relied on paragraph 19.2 of Ms Tan's statement and exhibit MLT5 as showing use of the mark CITIGROUP in relation to computer programmes and software. However, Ms Tan makes no claim that the mark has been used in relation to these goods. Indeed she refers only to the "services" offered by GTS²⁴. Although exhibit MLT5 shows use of CITIGROUP in relation to financial services, it shows no use of that mark in relation to the marketing of software. Exhibit MLT 6 describes an internet based billing service called Citibank e-Billing B2B Solution, which appears to have been introduced in 2000. Ms Tan provides no further information about the nature of the „solution' or whether it involved the sale of software. The copyright dates on the brochures are 2000 and 2001 (i.e. before the relevant period for establishing use of the CITIGROUP mark in relation to software).

²⁴ See paragraph 20 of her second statement

48. Ms Tan states that the mark CITICONNECT was first used in the UK “*at least as early as 2005*” in relation to the opponents’ on-line trading financing platform. She draws attention to a brochure with a copyright date of 2005, which supports this claim. Counsel for the opponents also relied on this brochure to show use of CTITGROUP (which also appears on the document) in relation to a trade in financial software. However, it only shows use of the marks in relation to the services described by Ms Tan. The same applies to the third party material exhibited as MLT59 and 63, which counsel for the opponents also contended showed use of the CITIGROUP mark in relation to software.

50. As noted above, there is some evidence of software being offered to customers under the mark CITIBANK, but this was in 1997 (long before the relevant five year period) and the software was offered free of charge, apparently to encourage take up of the opponents’ on-line financial services rather than to create a market for software.

51. Counsel for the opponents contended that Exhibit MLT8 showed use of CITIGROUP in relation to a trade in printed matter, but all it actually shows is use of the mark on promotional printed matter in relation to a trade in financial services. Ms Tan claims no more.

52. Mr Dyas gives evidence of research reports being provided to UK clients under the marks CITIGROUP with umbrella device and more recently the citi and arc device, but he says that these were provided by electronic means or via third party publications. So this does not show how the opponents used these marks in relation to printed matter.

53. Ms Griffiths provides evidence that the opponents offered travel insurance in 1997, but this is long before the start of the relevant five year period.

54. Ms Griffiths also gives evidence²⁵ showing use of the CITIBANK and arc device mark registered as CTM 2293405 in relation to the opponents’ website in 2005/6. The website includes a link to „Citibank Online’. Ms Griffiths herself says nothing to explain this reference, but counsel for the opponents relied on it to show use of the CTM in relation to services in class 38 for „*Providing access to financial services and financial information via remote computer and global computer network*’. The services covered by class 38 of CTM 2293405 are telecommunications services, i.e. the technical means of accessing networks. They are the sort of services provided by an internet service provider. Merely operating an on-line website is not therefore a service „*providing access*’ [to financial services/information] when covered by a registration in class 38.

²⁵ See paragraphs 28 and 38 of her second statement and exhibits JG28 and JG55

The applicant's concurrent use

55. The applicant's evidence about the use made of CITIGATE marks comes from Laura Bessell-Martin, who has been the Finance Director of Citigate Dewe Rogerson Limited ("CDR") only since August 2011. CDR is a subsidiary of the applicant company. Ms Martin-Bessell's evidence comes from the company and other records.

56. According to Ms Martin-Bessell, CITIGATE was first used by CDR in 1988. At that time the company was called Citigate Communications Limited. She exhibits a brochure from 1990²⁶ showing use of CITIGATE in relation to PR communications services aimed particularly at the financial and manufacturing sectors. In 1998 the company merged with another PR agency called Dewe Rogerson to form Citigate Dewe Rogerson Limited. Ms Martin-Bessell says that the company has expanded since then and spans "*all public relations disciplines*". She says that it is also ranked by the Financial Times Merger Market as one of the leading mergers and acquisitions advisors. According to Ms Martin-Bessell, CDR "*continues to be the advisor of choice for UK transactions and recent work includes the \$4.2 billion of Baldor Electric by ABB, the £223 million takeover of Scott Wilson by URS and the \$25 billion exchange offer by Vinplecom*". CDR offers a "*full range of communications services*" to companies and is the "*retained advisor*" of the London Stock Exchange. The company's annual turnover between 2005 and 2010 ranged from £18m to £26m. However, as counsel for the opponents pointed out at the hearing, the applicant conducts a proportion of its business outside the UK. About 60-70% of the turnover cited by Ms Martin-Bessell is as a result of trade in the UK²⁷.

57. Over the same period, the company spent between £82k and £262k per annum promoting its services in the UK. This included the money spent producing promotional publications such as „The Persuader’, „The Power of Persuasion’, „Investor Relations Survey’ and „CEO Brand Value Report’, which covers the success of the FTSE 100 CEOs in their communications with the media²⁸. CDR also advertises in third party PR publications such as PR Week, PR News and Public Affairs News.

58. Ms Martin-Bessell says that CDR also produces some publications in collaboration with others. She exhibits a report from 2007 entitled „Joining AIM, a professional handbook’ which was produced with the London Stock Exchange and others. The publication includes a section on „The Role of the PR/IR company’, that was written by officers of CDR. The following extract gives a flavour of the sort of advice provided by CDR.

“A proven track record advising on IPOs should be the first pre-requisite when choosing a PR agency. A company intending to join AIM should look for a PR

²⁶ See exhibit LB1

²⁷ See exhibit LB21, page 165.

²⁸ See exhibits LB23, LB24 & LB26

firm that has advised not only domestic companies on the IPOs, but also international companies on successful primary, secondary or dual listings in London and on a wide number of flotations on both AIM and the Main Market. The PR agency should also be able to demonstrate a solid understanding of the sector within which the company operates. This knowledge should extend not only to the technical and operational aspects of the industry, but also to the challenges and intricacies of communicating the business model and strategy to the investment community.”

59. I note that the handbook includes an advertisement for CDR which also uses the CITIGATE brand alone²⁹. The same sort of dual use is apparent in the advertisements CDR placed in The Persuader between 2004 and 2006³⁰.

60. CDR also organises events to publicise the business, including dinners, lectures and corporate hospitality. Ms Martin-Bessell provides information³¹ about the prestigious Aldwych Dinners which CDR organised between 2001 and 2008. Counsel for the applicant drew my attention to the fact that:

- i) The attendance lists for these dinners regularly included officers from the opponents' companies;
- ii) The branding used at these events on hoardings etc. included CITIGATE and CITIGATE DEWE ROGERSON.

61. CDR has also won numerous awards as a PR agency, including in 2003 the Association of British Insurers award for „Best Financial Services Agency’.

62. At various times the applicant traded via other economically related companies with Citigate in their names. Citigate Advertising Limited was created in 1987 and changed its name to Citigate Advertising & Marketing Limited in 1993 and then in 1996 to Citigate Albert Frank Limited. The company traded as an advertising agency, but it is not clear what trading name was used. The company was sold to a third party in 2005. Another company changed its name to Citigate Communications Limited in 2002. It was a successful public relations firm. Ms Martin-Bessell says that it traded under the CITIGATE brand, and she exhibits³² pages from the company's website which show this. The company was sold to a third party in 2005. Citigate DVL Smith Limited came into existence in 2000, but was only a parent company for DVL Smith Limited. It is not clear whether the latter company used CITIGATE as a trading name. The parent company was sold to a third party in 2005, so any use of Citigate would have ceased at that time. Another company changed its name to Citigate Design Limited in 1987 before becoming Lloyd Northover Citigate Limited in

²⁹ See exhibit LB27, page 165

³⁰ See exhibit LB23

³¹ See exhibit LB28

³² See exhibit LB5

1994 and then, in 1999, Citigate Lloyd Northover Limited. The company was a design consultancy. The extent to which it used CITIGATE in its trading style is not clear. The company was sold to a third party in 2005.

63. Citigate Marchcom Limited came into existence in 2000 and traded as a corporate communications consultancy specialising in on-line communications. Ms Martin-Bessell exhibits pages from the company's website in 2003 which show that it traded under the company name. The company ceased trading in 2004. Citigate Northern Ireland Limited was also a communications company. Ms Martin-Bessell says it traded under the Citigate name between 1999 and 2006 when it was sold to a third party. Pages from the company's website are evidence³³, which bear out Ms Martin-Bessell's statement.

64. Citigate Smarts Limited adopted that company name in 2000, having previously been Dunsheath Citigate Limited and Citigate Scotland Limited. The Company was a PR business. Ms Martin-Bessell says that it used CITIGATE branding and she exhibits pages from the company's website in 2003 which show the company trading as CITIGATE SMARTS. The company was sold to a third party in 2005.

65. Other companies called Citigate Northern Ireland Public Affairs Limited, Citigate Public Affairs Limited, Citigate Publishing Limited and Citigate Sponsorship Limited are all said to have traded under CITIGATE branding at various times between 2000 and 2006 and, in the case of Citigate Public Affairs Limited, until 2009. However, as Ms Martin-Bessell did not join the company until 2011, it is not clear how she knows this. The only documentary evidence about these companies comes from the registration records obtained from Companies House.

66. Roger Grimshaw is a trade mark attorney at Mewburn Ellis, which acts for the applicant in these proceedings. Mr Grimshaw made three witness statements, the first and second statements include the results of some searches he conducted on the website of PR Week³⁴. The first search was on the name CITIGATE DEWE ROGERSON. That search revealed numerous uses of that name (and a couple of uses of CITIGATE COMMUNICATIONS) between 1999 and 2008. The second search was on the name CITIGATE alone. That search revealed numerous uses of CITIGATE and CITIGATE COMMUNICATIONS between 1995 and 1998, and use of CITIGATE DEWE ROGERSON in 2009/2010.

Findings of fact

67. I find that the applicant has established:

- i) Substantial use of CITIGATE DEWE ROGERSON since 1998 in relation to a financial public relations business with a particular focus on corporate finances and the financial services sector;

³³ See exhibit LB8

³⁴ See exhibit RSG1 and RSG5

- ii) Use of CITIGATE COMMUNICATIONS between 1995 - 2005, CITIGATE MARCHCOM between 2000-2004, Citigate Northern Ireland Limited between 1999-2006 and CITIGATE SMARTS between 2000-2005, all in relation to PR and/or corporate communications;
- iii) Use of CITIGATE alone prior to 1998, and limited use of that mark in conjunction with uses of CITIGATE DEWE ROGERSON in more recent advertisements for CDR's PR services, and at CDR's promotional events.

Evidence going to confusion/likelihood of confusion

68. Jeffrey French is the Head of External Relations for, inter alia, the European division of Citigroup Global Markets Limited, which as noted above, is another part of the opponents' ICG. Mr French says his department operates, effectively, as a full service communications consultancy serving all the opponents' businesses. He explains that it is normal for large financial institutions to have their own public relations or corporate communications departments. Sometimes, where a particular project warrants it, his department brings in external PR agencies to assist.

69. Mr French says that financial PR is a subset of PR generally, and its existence can be attributed to two things. Firstly, the provision of financial services is complex. Secondly, the specialist financial press tend to have a higher degree of knowledge about the financial sector than their colleagues in other sectors. This has resulted in PR agencies that specialise in financial PR. Their clients are financial institutions and other types of businesses who want PR communications about their financial affairs.

70. Press releases issued by Mr French's department between 2007 and 2009 carry the citi and arc device. Mr French says that when an external PR agency is engaged and issues statements in e-mail form on behalf of the opponents it is always clear that these "*relate*" to the opponents. This is because the CITI trade mark is included in the statements, either at the top or in the body. He exhibits³⁵ four examples of such e-mails. One includes the citi and arc device, which is clearly used as branding. The others just mention „Citi' in the text. All four originate from New York, but Mr French says that similar e-mails were issued in 2007/8 by PR agencies engaged in the UK. The purpose of this evidence appears to be show that relevant consumers in the UK are accustomed to seeing press releases issued by e-mail from external PR agencies on behalf of the opponents, some of which carry branding in the form of the citi and arc device.

71. Supporting evidence to the same effect comes from Peter Hewer who works for a financial PR agency called Tulchan Communications LLP, which issued e-mailed statements on behalf of the opponents, and Jill Hulme, who has worked for a number of PR agencies and occupied equivalent in-house roles.

³⁵ See exhibit JF3

72. Kathryn Keneally is a partner in a law firm called Fulbright & Jaworski LLP, which is based in New York. She previously worked for Owen and Davis, which is another law firm that represented Citibank N.A. She recalls that in 2002 she received a letter from an organisation called Citigate Global Intelligence and Security³⁶. The letter announced the creation of a new business providing „global intelligence’. Ms Keneally says she recalls thinking “*what is Citibank doing here?*” She thought that this was an odd business for the opponents to be in, but believed the letter must have emanated from the opponents because of the CITI- element in the branding and because Citibank was using the word „Global’ as part of some of its branding at the time. Further, the high standing of some of the people involved reinforced her belief that there was likely to be some connection with the opponents. As she acted for Citibank she forwarded the letter to her client with a summary of the legal issues that she thought it might present. After speaking to Citibank and reading the letter again, she realised that there was no connection. Mr Keneally acknowledges that her role as Citibank’s legal advisor means that she is not comparable to an average user of its services.

73. Lora Moffatt is also a lawyer working in New York. She regards herself as a trade mark attorney. She received the same letter as Kathryn Keneally in 2002 and was initially confused. She showed it to one of the in-house attorneys at Citigroup.

74. Jonathan Clegg is a UK trade mark attorney working for Cleveland, which represents the opponents in this matter. He provides³⁷ a copy of an article which appeared in the Money section of the Telegraph in 2003. The article covers the success of the applicant’s business and includes the following paragraph:

“So how come the shares have halved in the past six months? Talk of a „Citi’ downturn has alarmed investors. There is also the little matter of £100m in outstanding payments owed to agencies bought by [a company in the applicant’s group] in the past year.”

75. Mr Clegg offers no further explanation of the significance of this evidence. The inference is that the reference to „Citi’ showed that the writer mistakenly believed that the applicant was linked to the opponents. However, as counsel for the applicant pointed out at the hearing, this is no more than speculation. This is not evidence of confusion.

76. Andrew James Clemson is also a trade mark attorney working for Cleveland. He exhibits the results of some internet searches he conducted which showed that CITIGATE DEWE ROGERSON had issued some press releases between 2004 and 2010 about developments in the opponents’ businesses, identified as CITIGROUP, CITI or CITI CARDS.

³⁶ A copy of the letter is exhibited as KK2

³⁷ As exhibit JMC2

77. Mr Clemson also provides evidence about an article in the financial pages of the Guardian in 2002 in which the title of the article wrongly stated Citigate when it should have been Citigroup. A correction was published the next day³⁸.

78. The applicant provided seven witness statements from people who know of the applicant and the opponents' businesses and say that they have not been confused. Joanne Hart is a financial journalist. She has been the Investments Editor for the Mail on Sunday since 2006. She also operates her own company specialising in financial journalism and media training. Ms Hart has trained senior bankers, corporate financiers and PR professionals, including some of the applicant's people. Ms Hart says that she never thought that the parties were connected. In her view, the activities of a PR agency are discrete from those of a financial services provider.

79. Sue Cox is a retired investment analyst. During her working career she saw Citigroup as a competitor. Ms Cox says that she often received communications from CDR but she was never confused because of the different branding and because of the nature of the communications. According to Ms Cox, Citigroup and CDR are communicating to different audiences and the nature of their activities is fundamentally different.

80. Neil Gillis has been the Chief Executive of three large companies. He was therefore a regular user of financial public relations services. At one stage he was a client of the opponents and of the applicant. He says that Citigroup acted as an investment bank and provided financial advice. CDR provided financial public relations services and dealt with the media. From time to time the parties worked in conjunction with one another. Mr Gillis says there was never any confusion. He saw the parties as providing two very distinct services. He regarded the common element „citi' as referring to the fact that the parties had their roots in the cities of London (in the case of CDR) and New York (in the case of Citigroup).

81. Andrew Brough is a Fund Manager who works for Schrodgers. He receives communications from the applicant and from the opponents. He says that the communications he receives from Citigroup generally provide commentary from analysts on companies' financial results or are concerned with buying and selling shares. By contrast, the communications received from public relations companies are usually press releases issued on behalf of third parties that offer no opinion or analysis from the PR agency. Mr Brough has never been confused by the marks at issue.

82. Stephen Pearce is the co-owner of Kennedy.Pearce Consultancy, a financial recruitment agency based in the City of London. He says that when he was first asked to recruit staff for CDR it did not occur to him that they could be associated with Citigroup. This is because the services provided by CDR are very distinct from the services provided by Citigroup. Mr Pearce would not expect similar candidates

³⁸ See exhibits AJC2 and AJC4

for the two firms. Further, the difference between the marks used by CDR and the opponents is sufficient, in his view, to avoid any confusion.

83. Joshua Critchley worked as a senior banker at Goldman Sachs and is currently working at RBC Capital Markets where he is Co-Head of European Investment Banking. Mr Critchley says that he has worked with CDR throughout his career. He regards CDR and the opponents as working in completely separate fields. CDR provides activities within the PR sector, whereas the opponents provide financial advice “*completely different in nature*”. He associates the opponents with the “*Citi logo*” and doesn’t link this to CDR’s mark.

84. Rosalyn Schofield is a solicitor working for Associated British Foods plc. Her firm is a client of CDR and she has worked with them since 2000. CDR deals with her firm’s investor relations, the media and corporate reputation. Mr Schofield is aware of Citigroup, mainly through dealings with Citibank. She never thought they were connected and regards their marks as “*very different*”.

85. Finally, the opponents filed a witness statement from Anne Moses, who is an Associate General Counsel within the opponents’ business. She offers various familiar reasons why confusion between the parties would not have come to the attention of the legal department.

Findings of fact

86. I find that there is no evidence of actual and relevant confusion. The evidence of actual confusion boils down to the interpretation placed on the spelling of the word „Citi’ in an article in the Telegraph, which I have already dismissed as speculation, an error in the Guardian, and two trade mark lawyers in New York who say they were initially confused when coming across one of the applicant’s marks (although not one of the marks applied for). The error in the Guardian was made 10 years ago by a Journalist, not by someone during the course of trade in financial services or financial PR services etc. By itself it proves nothing. The New York trade mark lawyers were obviously very familiar with the opponents’ brands and are therefore not necessarily a good guide to the likely reaction of an average UK consumer. Further, the confusion happened in New York where the opponents are based and therefore where their reputation and brands are strongest.

87. I attach no weight to the applicant’s evidence of non-confusion either. I accept that the witnesses who have given evidence were not confused. However, there is no evidence as to how these witnesses were selected, or whether other witnesses were approached but rejected. Other than witnesses identified through a valid representative survey, evidence from individual consumers cannot be approximated to the likely reaction of the notional average consumer³⁹.

³⁹ See the judgment of Lewinson L.J. in *Marks and Spencer plc v Interflora plc* [2012] EWCA Civ 1501

88. The opponents have established use of the citi and arc device on some press releases issued by e-mail by external PR agencies on their behalf. And some of the applicant's witnesses give evidence going to the market relationship between financial services and financial PR services. I will take this evidence into account when I come to assess the likelihood of confusion, unfair advantage and detriment.

Third Party uses of Citi- marks

89. Roger Grimshaw gives evidence⁴⁰ of numerous other companies on the UK companies register with names with the prefix Citi-. However, it is well established that the mere registration of companies (or trade marks for that matter) tells one nothing about the signs that are actually used in the marketplace. Of more potential relevance are the results of two searches of the internet that Mr Grimshaw conducted in 2012 to see which of the companies identified in his searches were active. He presents pages from 55 of their websites⁴¹. Counsel for the applicant drew my attention to some of the more relevant examples. The most relevant of these, in my view, are:

- i) A company called Citicourt & Co has a website with a copyright date of 2006, which says that it is based in London and provides a broad range of financial advisory services;
- ii) A business trading in the UK under the name Citimark claims to have provided asset management services for 25 years;
- iii) A business called Citisoft, with an office in London, offers global investment management services and claims to have been trading for 25 years;
- iv) A business trading as CitiFocus claims to have offered financial recruitment services in London since 1991.

90. Other examples relied on by counsel for the applicant showed use of CITI- marks only after the relevant date and/or use of the mark in relation to services outside the financial sector, such as I.T., real estate and travel.

91. The opponents provided (further) witness statements from Jonathan Clegg and Andrew Clemson, both attorneys at Cleveland, and Dr Verena Von Bomhard, who is an attorney at Hogan Lovells LLP, which represents the opponents in OHIM proceedings. These statements relate primarily to the 55 companies identified in MrGrimshaw's evidence and indicate that:

- i) Investigations had revealed that Citicourt & Co Limited appeared to be a small company with assets in 2010 of only £74k;

⁴⁰ See RSG1

⁴¹ See exhibits RSG2 and RSG3

- ii) The opponents were aware of a company called Citi Limited, which provides project and programme management services within the public sector and had addressed “*relevant issues*”;
- iii) A company called Citidirect.co.uk. Limited, which provides online directory services, had agreed to change its name as part of an agreement with the opponents;
- iv) A company called Citi Money Exchange Limited was incorporated in 2003 and provides Bureau de Change services in London;
- v) The latest accounts for Citi Mark Partnership indicate that it is a small business;
- vi) The opponents’ enforcement strategy was based on watching for conflicts on the trade mark registers;
- vii) Businesses without registered marks, such as those listed above, would not come on the opponents’ radar;
- viii) The opponents had successfully opposed (mostly by achieving restrictions or withdrawals) 13 applications by other third parties to register marks with the prefix CITI- (including, rather surprisingly in my view, one by British Airways to register the mark British Airways Citiexpress for airline and travel services), and 34 further such applications to register CTMs including the word „City’ (including one by E-City Technologies to register the mark E-CITY for telecommunications and other technological services).

Findings of Fact

92. There is evidence of a small number of third parties trading under names with the prefix Citi- in the financial sector prior to the relevant date. The extent of such concurrent use is not clear, but it is not likely to have been very substantial. There is also some evidence of third parties trading under names including the word CITI outside the financial sector, although the extent of such use prior to the relevant date appears to have been fairly limited.

THE SECTION 5(2)(b) GROUND

93. Section 5(2)(b) is as follows:

- “5 (2) A trade mark shall not be registered if because -
- (a) -
 - (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

94. The opponents' primary case appears to be that there is a likelihood of confusion with its „family' of CITI- trade marks. I will therefore examine this claim first and then consider whether the opponents have any better case based on a conventional comparison of the opposed marks with the opponents' individual earlier trade marks as set out in annex A.

95. In deciding whether the opponents have established a „family' of marks I take account of the case law of the CJEU in this regard, which is set out in the judgment of the court in *Il Ponte Finanziaria SpA v OHIM*⁴². The relevant part of the judgment is as follows.

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family or series' of marks.

63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family or series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64. As the Advocate General stated in point 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family or series', the earlier trade marks which are part of that 'family' or series' must be present on the market.”

96. I find that the opponents have established the existence of a family of marks at the relevant date. The family at that date was composed most notably of the marks, CITIBANK, citi and arc device, CITI and, although the use of the mark diminished after 2007, CITIGROUP. The scale of use of the CITIGROUP mark prior up until 2007 and the extensive third party references to it after that (including some by the applicant's witnesses in this case) mean that it was still „present on the market' at the

⁴² Case 234/06P, paragraphs 62-64, reported at [2008] ETMR 13.

relevant date. The extensive use of these core marks was supplemented by lower level use of supporting marks, such as CITIGOLD and CITI CARDS. The uses covered a wide range of financial services, including credit card insurance services. There was also some use of two of the marks – UK 2383246 CITI CARDS and CTM 2293405 CITIBANK and device - that are registered for *„credit card customer loyalty and incentive programs’* in relation to such services. The family relationship between the marks is recognisable from the prominence given to the word CITI either alone or in combination with a second word usually describing or alluding to financial services. The exception to this general characterisation of the *„family’* is CITIGROUP, which was likely to be perceived as a mark identifying the collective sum of the opponents’ various businesses.

Similarity between the marks

97. Taking the opposed marks in turn, I find that there is reasonable degree of visual and aural similarity between the opponents’ family of marks, particularly between CITIGROUP, and CITIGATE GROUP. This is because the applicant’s mark includes the distinctive prefix CITI- and (in the case of CITIGROUP) also the word GROUP. I accept that the visual and aural similarities are not of the very highest level because of the inclusion of the additional suffix –GATE in the first word of the applicant’s mark. However, in my judgment this difference reduces rather than eliminates the visual and aural similarities.

98. Counsel for the applicant submitted that the inclusion of the suffix –GATE in the applicant’s mark jarred with the characteristics that identified the opponents’ family of marks. This point goes partly to the conceptual similarity or dissimilarity of the marks. I accept that the word GATE has no reference to financial services, unlike most of the suffixes in the marks in the opponents’ family. Further, the applicant’s mark could also be seen as a misspelling of *„city gate’*, but that is not a term of any relevance to consumers in modern times and they are therefore unlikely to see that meaning in CITIGATE. Consequently, although the meanings of GATE and GROUP are clear enough, I find that the majority of relevant consumers will not attach any clear conceptual meaning to CITIGATE GROUP as a whole, or to the word CITIGATE alone.

99. Further, I think it is overstating the matter to say that the –GATE suffix positively jars with the family relationship between the opponents’ family of marks. It doesn’t fit 100%, but it doesn’t jar either, particularly in relation to communications services where it hints at *„access’*. The meanings of recognisable elements of the applicant’s mark, CITI- and GROUP, create some conceptual similarity with CITIGROUP, but not much conceptual similarity with the other members of the opponents’ family of marks. I therefore conclude that the applicant’s CITIGATE GROUP mark is moderately similar to the marks in the opponents’ family, mainly because of the visual and aural similarities described above, but is highly similar to CITIGROUP.

100. Turning to the CITIGATE COMMUNICATIONS mark, I find that the dominant and distinctive element of this mark is CITIGATE. This is because the word COMMUNICATIONS is self evidently a word with very little distinctive character, particularly for PR type services. In these circumstances the common word/prefix CITI is sufficient to create a reasonable degree of visual and aural similarity to the opponents' CITI mark, and a moderate degree of similar to the citi and arc device, CITIGROUP and CITIGOLD marks.

101. The opponents' CITI, CITIGROUP and CITIGOLD marks appear to represent their best case against the applicant's third mark - CITIGATE DEWE ROGERSON. In this case CITIGATE is no more dominant or distinctive than DEWE or ROGERSON. Therefore, overall, this mark looks and sounds quite different to any of the members of the opponents' family of marks. Further, as the second and third words, DEWE ROGERSON, are recognisably names, their meaning does jar with the characteristics of the opponents' family of marks and creates some conceptual distinction. Therefore, although the first word of this mark also starts with the letters C.I.T.I., I find that there is very little similarity between CITIGATE DEWE ROGERSON and the opponents' family of marks, either individually or collectively.

Distinctive character of the earlier marks

102. The CITIBANK, citi and arc device, CITI and CITIGROUP marks had acquired a highly distinctive character in the financial services sector at the relevant date. This is despite the fact that the CITIGROUP mark was often used with an umbrella device. Where it was used as part of a composite mark, CITIGROUP was the dominant and most distinctive element of that mark, and it is well established that a mark can acquire an enhanced distinctive character as a result of use in combination with other signs⁴³. Other members of the opponents' family of marks, such as CITIGOLD and CITICARDS, would also have been highly distinctive for financial services, partly because of the association with the opponents' well known core marks.

Relevant consumer

103. The average consumer of the applicant's services is likely to be a business seeking professional services, which would include businesses in the financial field. Such a consumer is likely to pay an above average level of attention when selecting a service provider.

Similarity of goods/services

104. As this part of the opponents' case is partly based on its 'family' of marks argument, it is first necessary to determine the similarity between the goods/services for which these marks were 'present on the market' and the services covered by the opposed applications.

⁴³ See Case C-488/06, *L & D SA v OHIM*, at paragraphs 74-76.

105. I have found that the opponents' family of marks were present on the market for a wide range of financial services, including credit card insurance services and that there was also some use of two of the marks that were registered for credit card customer loyalty and incentive programs.

106. In comparing the respective services, I take account of the judgment of the CJEU in *Canon* where the court stated at paragraph 23 of its judgment that:

“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”.

107. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*⁴⁴, the General Court restated that “complementary” means:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

108. As I noted earlier, in the earlier OHIM proceedings the General Court upheld the Board of Appeal's decision that there was “*a low degree of similarity between the [applicant's] market research, market analysis and strategic marketing services; preparation of business reports; public agency services; management consultancy services; [and] “consultancy services relating to business operations”* in class 35 and the opponents' “*insurance, financial affairs, monetary affairs, real estate affairs services in Class 36.*”

109. The opposed UK applications cover the same services in class 35 and the opponents' family of marks were present on the market for essentially the same services as those at issue before the GC, other than “*real estate affairs services*”, which does not appear to have played any part in the court's reasoning. At paragraph 49 of its judgment the court stated that:

“.....the Board of Appeal pointed out, at paragraphs 26 to 28 of the contested decision, that “market research, market analysis and strategic marketing services” could be concerned with the financial markets'. Furthermore, it stated that “management consultancy services” and “consultancy services relating to business operations” are vague expressions that denote a general link to the world of business and commerce’ (paragraph 26 of the contested decision). “[Public agency] services could be provided in the area of banking and finance [and] are therefore similar to the services for which the [interveners'] mark CITIBANK has a reputation’ (paragraph 27 of the contested decision). Lastly, “preparation of business reports” is a service that

⁴⁴ Case T- 325/06

presents obvious links to the world of finance' (paragraph 28 of the contested decision).

110. The court concluded⁴⁵ that:

"...while the services referred to above covered by the mark applied for are different, on account of their nature and intended use, from the services in Class 36 covered by the earlier marks, there is nevertheless a connection between them. The services in Class 35 identified at paragraph 49 above are mainly directed, having regard to their nature, at professional circles, in particular undertakings which, after having recourse to the services in Class 35, may need the services in Class 36. For example, if the market analysis is positive, the undertaking may wish to put its plan into practice, and, to that end, will need to have recourse to investment services. That connection is sufficiently close that it cannot be ruled out that consumers may think that the services are provided by one and the same undertaking. There is therefore a low degree of similarity between those services."

111. The court appears to have accepted that there was, to some degree, a complementary relationship between the some of the applicant's services in class 35 and the opponents' financial services in class 36 because they might be used in connection with the same business venture and consumers might believe that they were offered by the same undertaking, by which I assume they meant to include economically connected undertakings.

112. The evidence before me does not cause me to reach a different conclusion. Indeed most of the parties' evidence is directed at a comparison of the applicant's role as a PR /corporate communications agency and the opponents' role as a financial services provider, which the GC accepted were not similar services. With one exception (see below) I have reached the same conclusion as the GC - that there is a low level of similarity between the respective services described in paragraph 108 above.

113. In one respect the GC's conclusions about the similarity between, on the one hand, "*financial services, including investment services*" and, on the other hand, "*strategic marketing services*" and "*marketing services*" are not logical or consistent. This is because the GC upheld the Board of Appeal's findings that "*strategic marketing services*" are similar to a low degree to financial services, but held that "*marketing services*" are not similar. However, as the former description of services is clearly a subcategory of the latter description of services, it cannot be the case that "*strategic marketing services*" are similar to "*financial services, including investment services*", but "*marketing services*" at large are not.

114. I agree with the GC that market research and analysis services are complementary, to some degree, to financial services, because the former could be offered as preparatory services linked to loans or investments. However, I do not understand why that link extends to "*strategic marketing services*", the purpose of

⁴⁵ At paragraph 59 of the judgment.

which is to sell third party goods or services. I do not accept that a relevant average consumer's normal expectation would be that an undertaking offering marketing services to others (strategic or otherwise), would also provide financial services, or vice versa. As the GC noted, the respective services are different in nature and purpose, and they are not in competition. Therefore, I find that „*strategic marketing services*’ (like „*marketing services*’) are not similar to financial services in class 35. I therefore agree with the OHIM Board of Appeal and the GC’s findings as regards the similarity (or not) between the applicant’s services in classes 35 and 42 and the opponents’ financial services, except that I find that there is no similarity between the opponents’ financial services and the applicant’s „*strategic marketing services*’ in class 35.

115. With regard to the applicant’s other services in classes 35 and 42 of the CTM, the Board of Appeal and the GC found that “*they are neither identical nor similar to the [opponents’] services covered by classes 35, 36 [38 or 42] of the earlier marks.*” Thus the GC affirmed that “*advertising services; marketing services; public relations services; preparation of publicity material; promotional services; consultancy services relating to brand development; information and advisory services relating to all the aforesaid services*”, were not similar to any of the opponents’ financial services in class 36. The same conclusion was reached with regard to similarity between financial services and those services covered by class 42 of the applicant’s CTM application, which covered the same services that I am considering in class 42 of the opposed UK applications. On these matters, I have come to the same conclusions as the GC, for the same reasons.

116. The opponents’ earlier CITI CARDS and CITIBANK and device marks are also registered, and were present on the market to some extent, for “*credit card customer loyalty and reward programs.*” The GC did not appear to consider whether these services were similar to any of the applicant’s services in class 35 and I have not heard arguments on this matter. There is no apparent similarity between “*Credit card customer loyalty and reward programs*” and the services in the opposed applications. In particular, the respective services are not in competition, are not complementary, and the purposes of the services appears to be different. Further, the opponents’ services are aimed at credit card holders, who are usually (although not always) members of the public, whereas the services covered by the opposed applications are aimed at other businesses, so although there is some overlap between the respective users, it is limited to business users of credit cards. For these reasons I find that these services are not similar.

117. The UK applications, unlike the applicant’s earlier CTM application, also cover “*event management services*” in class 41. However, I see no similarity between these services and any of the goods or services for which the opponents’ family of marks were present on the market at the relevant date.

Likelihood of Confusion between the Applicant's Marks and the Opponents' Family of Marks

118. As some degree of similarity between the applicant's services and the goods/services for which the opponents' mark were registered and present on the market is an essential requirement for a successful s.5(2) objection⁴⁶, to the extent that it is based on the family of marks argument, this ground fails for "*marketing services; strategic marketing services; advertising services; public relations services; preparation of publicity material; promotional services; consultancy services relating to brand development; information and advisory services relating to all the aforesaid services*" in class 35 and for all the services covered by classes 41 and 42 of the opposed applications.

119. It is therefore only necessary to consider the objection linked of the family of marks argument in relation to the following of the applicant's services in class 35:

Market research, market analysis; preparation of business reports; public agency services; management consultancy services; consultancy services relating to business operations.

120. In considering the likelihood of confusion I take account of the principles established by the Court of Justice of the European Union (CJEU) in cases *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] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

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;

⁴⁶ See the judgment of the CJEU in *Waterford Wedgwood plc v OHIM*, Case C-398/07

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in 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 causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

121. In my judgment, the low level of similarity between the applicant's services and the services and the above average level of attention likely to be paid by the relevant average consumer when selecting the services, are outweighed by the highly distinctive character of the opponents' CITI (UK 2350326A), citi and arc device (CTM 5170170), CITIBANK (CTM 179531) and CITIGROUP (CTM 867879) marks in relation to a wide range of financial services, including business-to-business financial services, and the existence of a family of CITI marks, which also included CTM 179549, CITIGOLD and UK 2383246, CITI CARDS. Assessing the position at the relevant date, I find that CITIGATE GROUP and CITIGATE COMMUNICATIONS were liable to be taken as members of the opponents' family.

122. In reaching this conclusion I have taken into account that:

- i) There is, at least to some degree, a complementary relationship between the applicant's services under consideration in class 35 and the services in class 36 for which the opponents' family of marks were registered and present on the market at the relevant date:
- ii) There is a high degree of similarity between CITIGATE GROUP and CITIGROUP and a reasonable degree of similarity between CITIGATE COMMUNICATIONS and CITI, and a moderate degree of similarity between CITIGATE COMMUNICATIONS and the citi and arc device, CITIGROUP and CITIGOLD.

123. In these circumstances there is a likelihood that the relevant average consumer will believe that the applicant's services are offered by the same undertaking that offers financial services under the marks CITI, citi and arc device, CITIBANK, CITIGROUP and CITIGOLD, or by an economically connected undertaking.

124. The s.5(2)(b) ground of opposition based on the family of marks case therefore succeeds against the marks CITIGATE GROUP and CITIGATE COMMUNICATIONS in relation to the services listed at paragraph 119 above.

125. I find that the s.5(2)(b) ground based on the family of marks argument fails in relation to all the services covered by the application to register CITIGATE DEWE ROGERSON. The mere fact that a distinctive feature of one mark is included as a part of another mark does not mean that the marks are similar enough to create a likelihood of confusion⁴⁷. In my judgment, the most distinctive element in the opponents' marks - CITI – is subsumed within the mark CITIGATE DEWE ROGERSON, so much so that it makes only a negligible contribution to the overall impression created by that mark on consumers⁴⁸. Consequently, I do not consider it to be a dominant and distinctive element of the applicant's mark, or that it retains an independent distinctive role in that mark. When coupled with the low degree of similarity between the respective services, I find that the relevant average consumer would not be likely to confuse the marks or to expect the user of CITIGATE DEWE ROGERSON to be (or to be economically connected to) the undertaking that uses the marks CITI, citi and arc device, CITIBANK, CITIGROUP, CITI CARDS and CITIGOLD in relation to financial services.

Likelihood of confusion between the applicant's marks and the opponents' individual marks

126. The opponents have a number of earlier marks that are not subject to the proof of use requirements because they had been registered for less than 5 years at the date of publication of the applicant's marks. Some of them are therefore entitled to

⁴⁷ See, for example, *Vedial v OHIM, France Distribution*, Case C-106/03P [2005] ETMR 23

⁴⁸ See, by analogy, paragraphs 57 and 58 of Case C-254/09P, *Calvin Klein Trade Mark Trust v OHIM*

protection for a wider range of goods/services than those shown in the evidence and considered above. I must therefore consider whether any of these marks present a stronger case than the one I have already considered under the „family of marks’ part of the opponents’ case. As these marks have not been shown to have been present on the market at the relevant date for the goods/services in question, it is necessary to consider each of them separately.

127. The opponents UK trade mark 2350326B for the mark CITI is registered in class 38 for *„providing access to financial services and financial information via remote computer and global networks’*. The closest of the applicant’s marks is, in my view, CITIGATE COMMUNICATIONS. The closest services covered by the application to register that mark are, in my view, *„website design services’* in class 42, which are quite different but potentially complementary services. The level of similarity between the respective services is nevertheless quite low. As there is no evidence that the earlier mark has been used for the services for which it is protected, the distinctive character of the mark depends upon its inherent distinctiveness, which I assess as average. There is a reasonable degree of similarity between the marks as wholes. The visual, aural and conceptual similarities arise because the opponents’ mark makes up the prefix of the first word of the applicant’s mark – CITIGATE, which is the dominant and distinctive element of that mark. The average consumer of the applicant’s services is likely to be a business person, who is likely to pay at least an average level of attention when selecting such services. Considered globally, I find that the similarities between the marks and services are not sufficient in these circumstances to create a likelihood of confusion, including the likelihood of association. I therefore reject the ground of opposition based on this mark.

128. CTM 5170170 is the citi and arc device. It is protected for, inter alia, *„internet services and providing information on global computer networks’* in class 42. Internet services in class 42 would appear to include *„website design services’* (and, by extension, *„design services’*) covered by class 42 of the opposed applications. These services are therefore identical.

129. The closest of the applicant’s marks is again CITIGATE COMMUNICATIONS. There is a moderate degree of overall similarity between the marks (slightly more aural and then visual similarity because the device in the opponents’ mark will not play a part when the mark is spoken). The average consumer is again likely to be a business person paying at least an average level of attention to the selection of a service provider. The CTM has an average level of inherent distinctiveness. Although the evidence shows that the opponents provide financial services over the internet, there is no evidence that the distinctiveness of the mark has been enhanced for internet services as such. Considering all the relevant factors, I find that the respective marks look and sound sufficiently different so that there is no likelihood of confusion, including the likelihood of association. The s.5(2)(b) opposition based on this mark therefore also fails.

130. The opponents other marks include UK mark CITICORP, 2508214, which is registered in class 35 for inter alia, *„advertising; business management; business administration’* in class 35. The applicant’s marks also cover advertising services and these services are therefore identical. Further, *„business management’* is a broad term which appears to cover all the services in class 35 directed at assisting a third party with the management of its business. This would appear to include *„consultancy services relating to brand development’*, which is covered by the opposed applications. CTM 4523866, CITI ULTIMA, is registered in class 35 for the same services and also for the very vague description *„business and personal assistance services’*. It is registered in class 41 for *„ticket and booking services for entertainment, sports and cultural events’*, which are similar, but only to a low degree, to the applicant’s *„event management services’* (the first being an event booking service and the second being an event management service).

131. I consider that the differences between these individual marks and the opposed marks is so substantial that the identity or similarity between the respective services is outweighed by the differences between the marks. There is no likelihood of confusion. Consequently, the s.5(2) grounds based on these marks also fail.

132. Finally, I have considered all the opponents other pleaded marks, such as CTM 179431 CITICARD and CTM 1343441, CITIFOCUS, but I find that they present no stronger case than the ones I have already considered (in the case of CITICARD) or the differences between the respective marks is so great that there is no likelihood of confusion (in the case of CITIFOCUS).

133. I therefore find that the opponents grounds under s.5(2) are no stronger when considered in relation to any of individual marks as compared to the case considered above based on the opponents’ family of marks.

THE SECTION 5(3) GROUND

134. Section 5(3) is as follows:

5(3) A trade mark which -
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

135. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55. The law appears to be as follows.

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks, the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.
- (h) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image; *L'Oreal v Bellure, Court's answer to question 1*.

The Reputation of the Earlier Marks

136. I find that the opponents' CITI (UK 2350326A), citi and arc device (CTM 5170170), CITIBANK (CTM 179531) and CITIGROUP (CTM 867879) marks had a substantial reputation amongst both business and individual consumers of financial services at the relevant date. Given the extent of the use made of the CITIGROUP mark up until 2007, and the continued references to that mark by third parties in financial and other publications after that date, I do not think the diminished use of CITIGROUP after 2007 affects this conclusion. It has not been shown that CITIGOLD (CTM 179549) or CITI CARDS (UK 2383246) marks had reputations amongst a significant proportion of consumers for financial services, but they were present on the market and therefore a factor to be taken into account when assessing whether the use of the applicant's marks would create the necessary link to any of the opponents' family of marks with reputations⁴⁹.

Will the CITIGATE DEWE ROGERSON mark be linked to the opponents' Marks?

137. I first consider the s.5(3) ground against the mark CITIGATE DEWE ROGERSON. I accept that CITI is a highly distinctive feature of the opponents' marks, but I do not accept that this means that the opponents are automatically entitled to object to any mark starting with those letters for any goods or services. Even in the case of a family of marks, where attention is necessarily focused on the element(s) in the earlier marks which identifies them as a family, it is still necessary to make an assessment of the overall impressions created by the respective marks.

138. The fact that CITIGATE DEWE ROGERSON (like the opponents' marks) begins with the letters C.I.T.I. will make only a negligible contribution to the overall impression created by that mark on consumers. This is because that element of the applicant's mark is rather subsumed within the mark as a whole (even though it appears at the start of the first word in the mark). Consequently, I do not consider the prefix of CITIGATE, to be a dominant and distinctive element of the applicant's mark, or to retain an independent distinctive role in the applicant's mark as a whole. Further, the additional words DEWE ROGERSON introduce a strong dissimilarity between the marks⁵⁰. When coupled with my finding that the respective services are, at most, only similar to a low degree, I do not believe that consumers of the parties' services will call the opponents' marks to mind when they encounter the applicant's mark. This is despite the strength of the reputations of the opponents' marks, the fact they form a family of marks, and that there is some overlap between consumers of financial services and those listed in the relevant application. In the absence of the

⁴⁹ As per the judgment of the General Court in case T-301/09 described in paragraph 11(viii) above.

⁵⁰ See, by analogy, paragraph 68 of Case C-254/09P, Calvin Klein Trade Mark Trust v OHIM

required mental link with all or any of the opponents' marks, the opposition under s.5(3) fails against the CITIGATE DEWE ROGERSON mark.

Due cause to use CITIGATE DEWE ROGERSON?

139. In *Premier Brands v Typhoon Europe Limited and Another*⁵¹ Neuberger J. (as he then was) held that “without due cause” required more than the innocent adoption of the junior mark and he approved the approach taken by the Benelux court in *Luca Bols* [1976] IIC 420 at 425 in relation to a similar provision of Benelux law. This is set out below:

“What this requires, as a rule, is that the user (of the mark) is under such a compulsion to use this very mark that he cannot honestly be asked to refrain from doing so regardless of the damages the owner of the mark would suffer from such use, or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark...”.

140. Further, in the more recent case of *Marks and Spencer v Interflora*⁵² the CJEU appears to have equated “due cause” with use that amounts to “fair competition”. Thus in a case such as the present one, where the applicant has demonstrated that it provided services under the opposed mark for 11 years prior to the relevant date and established its own valuable goodwill under the contested sign, it is arguable that the applicant had due cause to continue to use it, and therefore to apply to register it.

141. Counsel for the opponent relied upon a number of cases before the GC, CJEU and the OHIM Boards of Appeal⁵³ which he submitted showed that co-existence could only be taken into account where:

- i) The likelihood of confusion (or other damage) may be inferred from the peaceful co-existence of the marks on the market;
- ii) The mark applied for is identical to the mark used.

142. The parties to these opposition proceedings have been locked in similar proceedings for years, first at OHIM and then before the European courts. So the co-existence on the UK market has not been “peaceful”.

⁵¹ [2000] F.S.R. 767

⁵² Case C-323/09, at paragraph 91 of the judgment

⁵³ The main case is C-498/07P, *Aceites del Sur-Coosur S.A. v Koipe Corporation SL*: see paragraphs 81-84

However, in its more recent judgment in *Budějovický Budvar, národní podnik, v Anheuser-Busch Inc.*⁵⁴ the CJEU held that:

“Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of an earlier trade mark cannot obtain the cancellation of an identical later trade mark designating identical goods where there has been a long period of honest concurrent use of those two trade marks where, in circumstances such as those in the main proceedings, that use neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services.”

143. This judgment also appears to be applicable to proceedings under s.5(3) of the national law (Article 4(4)(a) of the Directive). It is true that *Budweiser* related to a different situation where the marks and goods were identical. However, if co-existence is relevant there it must also be relevant where the conflict between the marks is less extreme. The marks at issue in the *Budweiser* litigation had been subject to virtually constant litigation in the UK and elsewhere over a period of 30 years and, therefore, co-existence had been anything other than “peaceful”. The CJEU’s judgment in that case therefore appears to have broadened the scope for long established co-existence to be taken into account as a factor to be taken into account when deciding whether the functions of the earlier mark are likely to be damaged by an application to register a *prima facie* conflicting junior mark. That is certainly how the English Court of Appeal seems to have understood the judgment⁵⁵.

144. Counsel for the opponents submitted that *Budweiser* was an exceptional case that turned on its own facts. Amongst those facts were that the marks had co-existed for decades, had been allowed to co-exist as a result of previous court decisions, and that the use of the junior mark had started before the use of the mark with the earliest filing date. Further, the GC had continued to apply the test cited at paragraph 141 above after the judgment of the CJEU in *Budweiser*, including in the judgment given in the related CTM proceedings in this case. It is true that the judgment of the CJEU in *Budweiser* is limited to “*circumstances such as those in the main proceedings*”, but I consider that it modifies the strict requirement stated in the earlier case law that the co-existence of two marks on the market must have been “peaceful” before it can be taken into account.

145. I am aware that a national court of another member state has asked the CJEU to rule on whether there is “due cause” within the meaning of article 5(2) of the Directive where the junior mark was used in good faith before the filing date of a mark with a reputation⁵⁶. That would apply to some, but not all, of the earlier marks

⁵⁴ Case C-482/09

⁵⁵ See paragraphs 17, 21-23 and 42 of the judgment at [2012] EWCA Civ 880.

⁵⁶ See Case C-65/12, *Leidseplein Beheer B.V. and Hendrikus Jacobus Marinus De Vries v Red Bull GmbH and Red Bull Nederland B.V.*

in these oppositions. On the case law as it currently stands, and if it had been necessary, I would have found that the applicant's established honest concurrent use of the CITIGATE DEWE ROGERSON mark from 1998-2009 was sufficient to constitute "due cause" to continue to use that mark at the relevant date in 2009.

146. However, if I am right in finding that use of the mark in question in 2009 did not mean that there was a likelihood of confusion, and that consumers wouldn't make the necessary link between CITIGATE DEWE ROGERSON and the opponents' marks, it should not matter whether the applicant had "due cause" to use its mark.

Will the CITIGATE GROUP and CITIGATE COMMUNICATIONS marks be linked to the opponents' marks?

147. Having already found that the applicant's marks CITIGATE GROUP and CITIGATE COMMUNICATIONS must be refused under s.5(2) for certain of the services listed in class 35 of those applications, it is only necessary to consider the s.5(3) ground in relation to those marks for the services that have survived the s.5(2) opposition. These are shown below.

Class 35:

Advertising services; marketing services; public relations services; strategic marketing services: preparation of publicity material; promotional services; consultancy services relating to brand development; information and advisory services relating to all the aforesaid services.

Class 41:

Event management services.

Class 42:

Design services, copywriting, art work design, graphic design services, illustrating services, web-site design services, computer programming services, information, advisory and consultancy services relating to all the aforesaid services.

148. As the GC accepted in the CTM proceedings, the applicant's services listed in class 35 could be used by businesses in the financial sector or businesses that also use financial services. This is true of all the services listed above. There is therefore a degree of overlap between the consumers of the services listed above and consumers of financial services, although the services themselves are not similar.

149. The degree of similarity between CITIGATE GROUP and the opponents' reputed CITIGROUP mark, in particular, is clearly much greater compared to that between the mark CITIGATE DEWE ROGERSON and any of the opponents' marks. In the case of CITIGATE GROUP and CITIGROUP, the similarity created by the common CITI prefix is not counteracted or overwhelmed by the presence of strong distinguishing elements in the junior mark. Consequently, the CITI element is much more prominent in that mark. Further, the second word in the applicant's mark - GROUP - adds a second element of similarity between the marks. In these

circumstances my global assessment is that consumers of the services listed above, and consumers of financial services, are likely to make a link between the marks in the sense that the CITIGATE GROUP mark will bring the earlier mark CITIGROUP to mind, even where there is no specific connection between the applicant's services and financial services.

150. The position is more finely balanced where the mark CITIGATE COMMUNICATIONS is concerned. Here the second word – COMMUNICATIONS – is more or less descriptive for the services covered by the applications and therefore does little to counter the impression created by the prefix CITI in the word CITIGATE, which is the dominant and distinctive feature of the applicant's mark. Taking account of the strength of the reputations of the earlier marks, I find that the respective consumer groups will bring the opponents' CITI, citi and arc device, CITIBANK and CITIGROUP marks to mind when they encounter CITIGATE COMMUNICATIONS, but only when the applicant's mark is used in relation to services with a recognisable connection to financial services.

151. The evidence shows the applicant's business has such a connection with financial services. This is because financial public relations agency services are a recognised subcategory of public relations services. The use of CITIGATE COMMUNICATIONS in relation to the services provided by a financial PR agency is therefore likely to create the necessary mental link with the opponents' marks.

152. The services in question are covered by the terms *„public relations services; preparation of publicity material; promotional services [of which PR is a subcategory]; consultancy services relating to brand development'* [which is a subcategory of PR services] in class 35. The required link between the marks is therefore established in relation to these services, albeit that it will not be as strong as the link created between CITIGATE GROUP and CITIGROUP.

153. There is no evidence that there is a recognised financial subcategory of any of the other services listed in the application. Without such a recognisable financial connection, I find that the degree of similarity between the respective marks alone is insufficient to cause consumers to make a link between the marks when CITIGATE COMMUNICATIONS is used in relation to the other services listed at paragraph 147.

CITIGATE GROUP - Unfair advantage/detrimental to reputation or distinctive character of CITIGROUP?

154. There is some debate as to whether the judgment of the CJEU in *L'Oreal v Bellure*⁵⁷ means that an advantage gained by the user of a junior mark is only unfair if there was an intention to take advantage of the senior mark, or some other factor is

⁵⁷ Summarised at paragraph 135(h) above.

present which makes the advantage unfair. The English Court of Appeal has considered this matter three times. Firstly, in *L’Oreal v Bellure* when that case returned to the national court for determination. Secondly, in *Whirlpool v Kenwood*⁵⁸. And thirdly and most recently, in *Specsavers v Asda Stores Limited*⁵⁹. On each occasion the court appears to have interpreted *L’Oreal v Bellure* as meaning that unfair advantage requires something more than an advantage gained without due cause.

155. The learned authors of Kerly’s Law of Trade Marks and Trade Names, 15th edition (of which counsel for the opponents is one), cast doubt on whether the Court of Appeal has correctly interpreted *L’Oreal v Bellure*. Indeed, the relatively broad meaning attributed by the CJEU to the words “without due cause” in *Marks and Spencer v Interflora* may provide reason to doubt whether the requirement for “unfairness” adds anything to the requirement that an advantage is gained without due cause. If that is right, it is possible that the CJEU’s reference in *L’Oreal v Bellure* to the relevant provision applying where the proprietor of the junior mark “seeks to ride on the coat tails” of the senior mark (emphasis added) was nothing more than a reflection of the terms of the questions posed by the referring court. However, I do not consider that the CJEU’s judgment in *Marks and Spencer v Interflora* completely resolves the uncertainty. This is because it relates to another case where the selection and use of a sign corresponding to a reputed mark (as an adword for internet searches) was clearly intentional. Consequently, the CJEU had no need to say anything about the position where the user of the junior mark had inadvertently gained an advantage of some sort. I therefore consider that I am bound to follow the English court’s interpretation of *L’Oreal v Bellure*. There is no evidence in this case of any intention on the applicant’s part to take advantage of the reputations of the opponents’ marks, or to “live dangerously”, or any other positive factor that adds unfairness to advantage. The opponents’ unfair advantage case therefore faces an obvious difficulty.

156. In my view, the similarity between CITIGATE GROUP and CITIGROUP, and the strength of the reputation of the latter mark is so high that consumers normal expectations, that marks used for dissimilar services are not related, would not apply here. In my view, the CITIGATE GROUP mark would not only bring the CITIGROUP mark to mind, it would also cause relevant consumers (including customers of CITIGROUP’s financial services) to wonder whether there might be an economic connection between the user of that mark and the undertaking responsible for CITIGATE GROUP. This is despite the absence of any recognisable connection between financial services and the applicant’s services, and the likely presence of some third party CITI marks in the market.

⁵⁸ Reported at [2010] RPC 2: see paragraph 136

⁵⁹ [2012] EWCA Civ 24: see paragraph 127.

157. In addition to the high level of similarity between the marks in question, and the very high degree of distinctiveness of the CITIGROUP mark amongst consumers for financial services, consumers will be caused to wonder whether there might be an economic connection between the users of these marks because:

- i) Consumers of financial services, particularly business users, are likely to overlap to a significant degree with consumers of the services under consideration;
- ii) Although the opponents' marks were not the only marks on the market with the prefix/first word CITI, the level of use of such marks by third parties was likely to have been so low as to sail under the radar of most consumers, and;
- ii) Amongst those consumers who notice that the CITIGATE GROUP and CITIGROUP marks are not the same, the association between the latter mark and a family of other CITI- marks will increase the likelihood that the applicant's mark will be taken as a modification of the CITIGROUP mark, or as another member of the same family of marks.

158. In its judgment in *Marks and Spencer v Interflora* the CJEU explained the circumstances in which the proprietor of a reputed mark may prevent uses „detrimental to distinctive character' of the mark like this.

“76. As the Advocate General states at paragraph 80 of his Opinion, detriment is caused to the distinctive character of a trade mark with a reputation when the use of a sign identical with or similar to that mark reduces the ability of the mark to distinguish the goods or services of its proprietor from those which have a different origin. At the end of the process of dilution, the trade mark is no longer capable of creating an immediate association, in the minds of consumers, with a specific commercial origin.

77. For the proprietor of a trade mark with a reputation to be effectively protected against that type of injury, Article 5(2) of Directive 89/104 and Article 9(1)(c) of Regulation No 40/94 must be interpreted as entitling the proprietor to prevent all use of a sign identical with or similar to that trade mark which reduces the distinctiveness of the mark, without it being required to wait for the end of the process of dilution, that is to say, the total loss of the trade mark's distinctive character.”

159. Use of a mark that causes consumers to wonder whether the provider of the services in question might be economically connected to an undertaking that is well known to provide financial services under a similar mark appears to me to present a likelihood of dilution. This is not the same as a likelihood of confusion because being caused to wonder whether there might be an economic connection does not mean

that consumers will positively believe that there is such a connection⁶⁰. Whether or not consumers later realise that there is no connection between the users of the marks, the initial doubt means that the senior mark's continued ability to create an immediate association with services from a specific commercial origin is likely to be loosened and weakened. Over a period of time such uses are likely to erode the distinctive character of the senior mark. That is likely to affect the functions of the senior mark, including the origin and advertising functions, which enable it to attract and retain customers. This is seriously likely to result in an eventual change in the economic behaviour of the opponents' customers and potential customers, i.e. with less distinctive brands the opponents' financial services will stand out less from the crowd and consumers will therefore be less likely to select those financial services compared to those of the opponents' competitors.

160. In this connection I note that in his judgment in *Och-Ziff and Another v Och Capital and Others*⁶¹, Arnold J. appears to have accepted that a change in the economic behaviour of consumers could be inferred in appropriate circumstances. I respectfully agree with that analysis. Direct evidence of actual changes in economic behaviour will usually only be possible to produce after dilution has already caused significant damage, which would be inconsistent with the passage cited above from the judgment of the CJEU from *v Marks and Spencer v Interflora*.

161 The applicant does not appear to have used the mark CITIGATE GROUP and there are no other apparent reasons why it has due cause to use this particular mark. I therefore find that the registration of this mark for all the services covered by the application is contrary to s.5(3) of the Act. This is because use of CITIGATE GROUP for the services listed at paragraph 147 above would be detrimental to the distinctive character of the opponents' CITIGROUP mark.

162. In the light of that finding there is no need for me to make a finding as to whether the mark also takes unfair advantage of the earlier reputed marks.

CITIGATE COMMUNICATIONS - Unfair advantage/detrimental to reputation or distinctive character of CITI, citi and arc device, CITIBANK and CITIGROUP?

163. I have already held that the use of CITIGATE COMMUNICATIONS in relation to *„public relations services; preparation of publicity material; promotional services; consultancy services relating to brand development'* in class 35, will create the necessary mental link in consumers' minds with the CITI, citi and arc device, CITIBANK and CITIGROUP marks.

⁶⁰ For an historical example of the difference in the context of transishing, see *“Black Magic”* 1940 RPC 58.

⁶¹ See paragraph 137 of the judgment of Arnold J. at [2010] EWHC 2599 (Ch)

164 The evidence indicates that PR and corporate communications agencies sometimes issue public statements on behalf of large financial companies, such as the opponents, and that, on other occasions, PR type statements are issued by the companies themselves. The evidence also establishes that statements issued via PR agencies on behalf of financial companies sometimes carry the brand of the undertaking on whose behalf the agency is acting.

165. It is clearly important that financial services providers can make public statements promoting their financial services without the recipients having difficulty working out whether they come from, or are made on behalf of, the financial services provider itself, or from a PR agency making an independent assessment of the financial services market.

166. In my view, the use of the CITIGATE COMMUNICATIONS mark in relation to the services listed above will cause the relevant public for financial services to wonder whether the undertaking responsible for those services might have an economic connection with the undertaking strongly identified by the CITI, citi and arc device, CITIBANK and CITIGROUP marks. Whether or that gives the user of the CITIGATE COMMUNICATIONS mark an advantage or not, it is likely to reduce the immediate association which the relevant public has between the opponents' highly distinctive marks for financial services and a specific commercial origin.

167. This is an example of how the distinctiveness of the earlier marks for financial services is liable to be eroded by the use of CITIGATE COMMUNICATIONS for the services listed in paragraph 163.

168. The applicant appears to have used the mark CITIGATE COMMUNICATIONS at certain times in the past, but the extent of such is not clear and there does not appear to have been any use of that mark for 4 years prior to the relevant date in these proceedings. The applicant has also used the mark CITIGATE alone in the distant past and more recently from time to time, but the extent of use of that mark after 1998 seems limited, and it has usually been used in conjunction with CITIGATE DEWE ROGERSON. In these circumstances, I find that the applicant did not have due cause to use the CITIGATE COMMUNICATIONS mark at the relevant date.

169. For the reasons given above, I find that the use of CITIGATE COMMUNICATIONS would be detrimental to the distinctive character of the opponents' earlier marks and registration is therefore refused for *„public relations services; preparation of publicity material; promotional services; consultancy services relating to brand development'* in class 35.

170. The opposition fails in respect of the remaining services because absent a recognisable connection between the applicant's services and financial services, the public will not link the applicant's mark with the opponents' marks. There cannot

therefore be either an unfair advantage to the applicant, or detriment to the distinctive character of those marks, when CITIGATE COMMUNICATIONS is used in relation to:

Class 35:

Advertising services; marketing services; strategic marketing services; information and advisory services relating to all the aforesaid services.

Class 41:

Event management services.

Class 42:

Design services, copywriting, art work design, graphic design services, illustrating services, web-site design services, computer programming services, information, advisory and consultancy services relating to all the aforesaid services.

OVERALL OUTCOME

171. The opposition to CITIGATE DEWE ROGERSON fails in its entirety.

172. The opposition to CITIGATE GROUP succeeds in its entirety.

173. The opposition to CITIGATE COMMUNICATIONS succeeds, except for the services listed at paragraph 170 above.

COSTS



174. The parties were content for costs to be assessed in the usual way. As one opposition has succeeded, one has failed, and one has partly succeeded, I direct that each side should bear its own costs.


Dated this 12th Day of February 2013

**Allan James
For the Registrar**

Annex A

Mark	Type	Filing date	Goods/Services	Owner	Number
CITI	UK	2/12/03	Class 36:Financial services; banking services; credit and debit card services and credit and debit card customer loyalty and incentive programs; commercial and consumer lending and financing; real estate and mortgage brokerage; trust, estate, and fiduciary management, planning and consulting; investment and investment advisory and consulting; securities brokerage and trading services; facilitating secure financial transactions; insurance services; underwriting and sales of property, casualty and life insurance policies and annuity contracts.	Citigroup Inc.	2350326A
CITI	UK	2/12/03	Class 38:Providing access to financial services and financial information via remote computer and global computer networks.	As above	2350326B
CITI CARDS	UK	31/1/05	Class 35: Credit card customer loyalty and reward programs. Class 36:Credit card services and servicing credit card accounts.	As above	2383246
CITIBANK	UK	1/10/86	Class 36: Banking services (financial) included in Class 36.	As above	1283067
CITICORP	UK	9/2/09	Class 35: Advertising; business management; business administration; office functions. Class 36: Insurance; financial affairs; monetary affairs; real estate affairs.	As above	2508214
CITIGROUP	CTM	6/7/88	Class 36: A full range of insurance and financial services; banking services; credit card services; securities trading, consulting and underwriting services; investment services.	As above	867879

	CTM	27/9/04	Application withdrawn after opposition filed	As above	4046397
	CTM	23/2/99	<p>Class 09: Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, fire-extinguishing apparatus .</p> <p>Class 16: Paper, cardboard and goods made from these materials (included in class 16); printed matter; bookbinding material, photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (included in class 16); playing cards; printers' type; printing blocks; publications.</p> <p>Class 36: Insurance; financial affairs; monetary affairs; financial and insurance services; banking, investment and credit card services.</p> <p>Class 42: Internet services and providing of information on global computer networks.</p>	As above	5170170
CITI ULTIMA	CTM	1/8/05	Class 35: Advertising; business management; business administration; office functions; provision of credit card customer loyalty and reward programs;	As above	4523866

			<p>directory services to help locate professionals, shops and shopping facilities, medical and wellness facilities, family, childcare and home assistance services and craftspeople; business and personal assistance services.</p> <p>Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; credit card services; redemption of credit card loyalty and reward programs.</p> <p>Class 39: Travel and transport information and reservation services.</p> <p>Class 41: Ticket reservation and booking services for entertainment, sports and cultural events.</p>		
CITIFIRST	CTM	27/4/07	Class 36: Insurance; financial affairs; monetary affairs; real estate affairs.	As above	5864202
CITIINTER NATIONAL	CTM	11/11/99	Class 36: Insurance; financial affairs; monetary affairs; real estate affairs, in particular banking, investment consultation and asset management services.	As above	1380203
CITIBANK	CTM	1/4/96	Class 36: Insurance; financial affairs; monetary affairs; real estate affairs.	Citibank N.A.	179531
	CTM	9/7/01	<p>Class 09: Computer hardware and software used in connection with financial, banking, credit card investment and insurance services.</p> <p>Class 16: Printed matter and publications on the subjects of finance, banking, credit cards, investing and insurance.</p> <p>Class 35: Credit card customer loyalty and incentive programs; providing online retail shopping services.</p> <p>Class 36: Financial services, namely, banking; credit card services; commercial and consumer lending and financing; real estate and</p>	As above	2293405

		<p>mortgage brokerage; trust, estate, and fiduciary management, planning and consulting; investment and investment advisory and consulting; securities brokerage and trading services; facilitating secure financial transactions; and insurance services; namely underwriting, and sales of property, casualty and life insurance policies and annuity contracts.</p> <p>Class 38: Providing access to financial services and financial information via remote computer and global computer network.</p> <p>Class 42: Online and interactive news and information services provided via global computer network relating to financial news and information as well as general news and information regarding current events.</p>		
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CITICARD	CTM	1/4/96	<p>Class 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving, teaching apparatus and instruments, electric and electronic apparatus and instruments (included in class 9); apparatus for recording, transmission or reproduction of sounds or images; magnetic data carriers, recording discs; recorded computer programs and software; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.</p> <p>Class 16: Paper, cardboard and goods made from these materials (included in class 16); printed matter; bookbinding material, photographs; stationery; adhesives for stationery or household purposes; artists' materials, paint brushes; typewriters and office requisites (except furniture), instructional and teaching material (except apparatus); plastic materials for packaging (included in class 16); playing cards; printers' type; printing blocks.</p> <p>Class 36: Insurance; financial affairs; monetary affairs; real estate affairs.</p>	As above	179473
CITIGOLD	CTM	1/4/96	As per 179473 above	As above	179549

Annex B

OPPONENTS EVIDENCE
Witness statement by Sarah May Cannon - Exhibits SMC1-SMC4
Witness statement by Jane Griffiths - Exhibits JG1-JG14
Witness statement by Dr Verena von Bomhard - Exhibit VB1
Witness statement by Jonathan Michael Clegg - Exhibit JMC1
Witness statement by Jeffrey French - Exhibits JF1-JF3
Witness statement by Christopher Dyas - Exhibits CD1-CD3
Witness statement by Peter Hewer - Exhibit PH1
Witness statement by Jill Hulme
Witness statement by Kathryn Keneally - Exhibits KK1-KK3
Witness statement by Lora Moffatt – Exhibits LAM1-LAM3
Second witness statement by Jonathan Michael Clegg – Exhibit JMC2
Witness statement by Andrew James Clemson - Exhibits AJC1-AJC4
Witness statement by Anne Elaine Moses
Witness statement by Money Kanagasabapathy - Exhibits MK1-MK33
Second witness statement by Jane Griffiths - Exhibits JG15-JG56
Witness statement by Mei-Li Tan - Exhibits MLT1-MLT69
Third witness statement by Jonathan Michael Clegg
Second witness statement by Andrew James Clemson - ExhibitsAJC5-AJC6

APPLICANTS EVIDENCE
Witness statement by Laura Bessell-Martin - Exhibits LB1-LB34
Witness statement by Roger Grimshaw - Exhibit RSG1
Second witness statement by Roger Grimshaw - Exhibits RSG2-RSG7
Third witness statement by Roger Grimshaw - Exhibits RSG8-RSG9

Witness statement by Joanne Hart
Witness statement by Sue Cox
Witness statement by Neil Gillis
Witness statement by Andrew Brough
Witness statement by Stephen Pearce
Witness statement by Joshua Charles Macdonald Critchley
Witness statement by Rosalyn Schofield