

O-355-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2620971
BY GMPD LTD T/A MY MONEY PA
TO REGISTER:**



&



AS A SERIES OF TWO TRADE MARKS IN CLASSES 35, 36, 38 & 42

AND:

**OPPOSITION THERETO UNDER NO. 103899
BY FRIENDS LIFE MANAGEMENT SERVICES LTD**

BACKGROUND

1. On 15 May 2012, GMPD Ltd t/a MyMoneyPA (“the applicant”) applied to register the series of two trade marks shown on the cover page of this decision. The application was accepted and published for opposition purposes on 6 July 2012 for the following services:

Class 35 - Advertising; electronic data storage; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; data processing.

Class 36 - Financial services provided via the Internet; issuing of tokens of value in relation to bonus and loyalty schemes; provision of financial information.

Class 38 - Portal services; e-mail services; providing user access to the Internet.

Class 42 - Design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services.

2. On 3 October 2012, Friends Provident Management Services Ltd filed a notice of opposition directed against all of the services in the application. Following a change of name, the opposition now stands in the name of Friends Life Management Services Ltd (“the opponent”). The opposition is based upon grounds under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). For its opposition based upon section 5(2)(b) of the Act, the opponent relies upon the following goods and services in the following trade mark registrations:

UK no. 2555001 for the trade mark: **MY MONEY** (directed against all of the services in the application). The trade mark was applied for on 26 July 2010 and completed its registration procedure on 29 April 2011:

Class 9 - Computer software and hardware; computer programs; computer software and software upgrades supplied on-line from computer databases; computer software and telecommunications apparatus (including modems) to enable connection to databases and the Internet or intranets; downloadable electronic publications; compact discs; instructional materials and teaching materials provided on-line from computer databases; data protection apparatus.

Class 16 - Printed matter; printed publications; publicity and promotional material; books, picture books, magazines, periodicals and supplements; brochures and catalogues; fact sheets, pamphlets and leaflets; posters; booklets for use in conducting training workshops; instructional materials; bonds; paper and paper articles; cardboard and cardboard articles; stationery; pens; pencils; crayons; pencil cases; erasers; rulers; markers; pencil sharpeners; staplers;

staples; adhesives; adhesive tape; stickers; paperweights; diaries; calendars; office requisites (other than furniture).

Class 35 - Advertising services; advertising services relating to financial products, investments and services; promotional services; promotional services relating to financial products, investments and services; business advice services; business consultancy services; business management services; business information services; business research; accounting and auditing services; computerised database management services; electronic data storage; data processing; provision and compilation of business information; data searching and research; data modelling; computerised database management services; statistical information services; taxation advice; taxation planning; taxation consultancy; preparation and provision of statements of accounts; information, advisory, research, appraisal and consultancy services relating to all the aforesaid; information, advisory, research, appraisal and consultancy services relating to all the aforesaid provided on-line from a computer database or the Internet.

Class 38 - Telecommunication services; telecommunication access services; telecommunication of information including web pages, computer programs and other data; transmission of data via computer networks; provision of access to data banks containing information; provision of access to remote computers containing electronic publications; bulletin boards, databases and information accessible via computers; providing user access to the Internet or intranets; providing user access to computer networks including the Internet to facilitate electronic commerce and shopping; information provided on-line from a computer database or from the Internet or intranets; data transmission; providing access to on-line information (including websites) relating to insurance, financial advisory and brokerage services; providing access to fund management services; providing access to and leasing access to computer databases; leasing of access time to computer databases; information, advisory, consultancy and research services relating to all the aforesaid; information, advisory, consultancy and research services relating to all the aforesaid provided on-line from a computer database or the Internet.

Class 42 - Computer network services; hosting computer sites; rental of web-servers; computer programming; rental of computers, computer apparatus and computer equipment; advisory, information and consultancy services, all relating to the aforesaid; information, advisory, and consultancy services relating to all the aforesaid provided on-line from a computer database or the Internet.

UK no. 2526886 for a series of two trade marks i.e.



(directed against the services in classes 35, 36 and 38 of the application). The trade mark was applied for on 24 September 2009 and completed its registration procedure on 29 January 2010:

Class 36 - Insurance and insurance services; financial and monetary services; financial brokerage services; financial management services; investment management services; mortgage services; mortgage financing services; mortgage brokerage services; monetary affairs and credit card services; unit trust and investment trust services; capital investment and investment advice; credit arrangement services; credit management services; reinsurance services; arranging of loans; savings services; financial and insurance services relating to the acquisition and sale of property; debit and charge card services; travel insurance services; pension services; pension fund administration services; personal pension services; fund management services; advisory services relating to taxation; financial advice and planning of finances relating to taxation; financial advice relating to wills; information, advisory, consultancy and research services relating to all the aforesaid provided on-line from a computer database or the Internet; information, advisory, consultancy and research services relating to all the aforesaid.

Class 38 - Telecommunication services; telecommunication of information including web pages, computer programs and other data; provision of access to remote computers containing electronic publications; bulletin boards, databases and information accessible via computers; providing user access to computer networks including the Internet to facilitate electronic commerce and shopping; data transmission; providing access to on-line information (including websites) relating to insurance, financial advisory, brokerage, monetary and credit and debit card services; providing access to fund management services; providing access to and leasing access to computer databases; information, advisory, consultancy and research services relating to all the aforesaid.

3. In relation to its opposition based upon section 5(4)(a) of the Act, the opponent relies upon use of the signs **MY MONEY** which it says has been used throughout the UK “from around January 2012” in relation to financial services and **MY MONEY AND ME**, which it says has been used throughout the UK “from around March 2011” also in relation to financial services.

4. On 8 December 2012, the applicant filed a counterstatement in which the opponent's claims are denied. As the comments contained in the counterstatement are the only submissions I have from the applicant, they are reproduced here in full:

"In defending our application MyMoneyPA states that the market is awash with MyMoney products and services. When you put mymoney into Google the following appears (by ranking): No 1. MyMoneyWeek – personal finance education group, 2. MyMoneySteps – dealing with debts, 5. Where does my money go – Open Knowledge Foundation, 8. Where has my money been – Dosh Tracker, 9. Ambit MyMoney – Sungard's banking application, 10. MyMoney – Department for Education, 11. MyMoney24 – personal finance news and 14. My Money Child Account – HSBC

The gaps in the above numbers are typically filled with news articles on "my money."

In looking at the two Friends Provident marks and comparing both to MyMoneyPA there are many significant differences that will prevent confusion in the mind of consumers.

Taking "Friends my money and me" it is over three lines has full capitalisation and full lower case, has numerous fonts and is displayed with numerous colours namely blues, green and orange.

The "my money" logo is totally lower case has a space between "my" and "money" and is blue.

The MyMoneyPA logo is made up of words which are all joined up with capitalisation of My and Money and PA; the term PA is well known as an acronym for personal assistant or personal aide i.e. someone who assists in daily business or personal tasks. The logo is differentiated too with a graphic which takes up 12% of the total logo. This is very distinctive with a bow tie on a finger and it also has ".com" included. This is in green to match the corporate colours of black and green.

The services provided by MyMoneyPA are very different to Friends Provident which is a manufacturer of financial services products whilst MyMoneyPA is a "lifestyle personal assistant". There are no grounds for stating that the services are in competition with one another.

The supply channels are similar in as much as they are internet based however that is the predominant channel for most companies now and those noted above are all internet based."

5. Only the opponent filed evidence. Whilst neither party asked to be heard, the opponent filed submissions in lieu of attendance at a hearing. I will refer to these submissions as necessary below.

The opponent's evidence

6. This consists of a witness statement from David Millar accompanied by exhibit DM1. Mr Millar is the opponent's Marketing Communications Manager; he explains that:

"3. In January 2012, the opponent launched a corporate online savings platform under the mark MY MONEY (and the sub brand MY MONEY AND ME) (the MY MONEY platform)."

Mr Millar adds that:

"4. The MY MONEY platform enables employers to offer its employees a range of flexible savings products (pension and non-pension products) that they can apply for, contribute to and otherwise manage in one online environment."

7. The main points emerging from Mr Millar's statement are, in my view, as follows:

- a number of online and hard copy magazine articles have been published between January 2012 and May 2012 that refer to the MY MONEY platform. Pages 1-10 of exhibit DM1 consist of examples of such articles from: the online financial guide www.citywire.co.uk (dated 31 January 2012 and 20 & 21 February 2012), www.professionalpensions.com (dated 31 January 2012), Professional Pensions Magazine (dated 2 February 2012), Pensions Week magazine (dated 6 February 2012), www.pensionsweek.com (dated 5 February 2012), Pensions Insight magazine (dated 1 March 2012) and Corporate Advisor magazine (dated 1 March 2012). The articles refer to the service as "My Money" and it is described in the Citywire article of 31 January 2012 in the following terms: "The online workplace savings platform offers a pension, cash and stocks and shares ISAs, and an investment account.";
- Page 11 of exhibit DM1 indicates, inter alia, that by the date of the application for registration 12 undertakings had introduced schemes using the MY MONEY platform and there were 924 members of such schemes;
- By the date of the application for registration the MY MONEY platform had been promoted at the Professional Pensions Communications Forum (February 2012), at the Westminster and City Conference (March 2012), in *Professional Pensions* (a weekly trade publication with a circulation of approximately 15,000) and in a number of its monthly supplements and in *Pension Insight* magazine. The costs of these activities amounted to some £72k. Once again the service is referred to in pages 16 and 17 of exhibit DM1 as "My Money";

- A variety of brochures have been circulated amongst employers and their employees about the MY MONEY platform. Pages 19 to 132 of exhibit DM1 consist of: brochures dated December 2011 entitled: “Flexible Retirement Account Product guide” and “Innovative solutions for workplace benefits Corporate Platform”; January 2012 entitled: “Making the most of saving online with...Introducing My Money” (which appears to be a draft brochure), “Flexible Retirement Account Terms and conditions”, “Flexible Retirement Account Key features document”, “Make the most of saving online with your employer Introducing My Money” and; March 2012 “Flexible Retirement Account Investment brochure Helping you to understand your investment choices.” All but one of these brochures contains the words “my money” on the cover page and includes numerous references to “My Money” and “mymoney”;
- Pages 133 to 135 are dated 31 January 2012 and relate to the launch of the MY MONEY platform to the opponent’s own employees on its internal intranet. The article refers to screen shots of the MY MONEY platform in operation which were available to the opponent’s employees and the general public on the photo/image sharing website www.flickr.com from 31 January 2012; these screen shots are provided as pages 136 to 142 of exhibit DM1 and once again refer to “My Money”, “my money” and “My money”;
- The opponent has registered a number of domain names from which it operates websites associated with the MY MONEY platform including: www.friendsmymoney.co.uk and www.friendslifemymoney.co.uk. These domain names were registered in 2010 and 2011 respectively, although they did not go live until the MY MONEY platform was launched in January 2012;
- The webpage www.friendslife.co.uk/corporateplatform has also provided details about the MY MONEY platform since its launch in January 2012 and has provided access to a brochure featuring the MY MONEY trade mark. Pages 143 to 144 of exhibit DM1, which have been obtained from the Internet archive [waybackmachine](http://waybackmachine.org), show the pages in question and are dated 11 February 2012. Pages 145 – 154 consist of a report showing “page views” to this website in 2012. The page was first viewed on 30 January 2012 and by 14 May 2012 had been viewed nearly 3,000 times;
- Since its launch, employers adopting the MY MONEY platform have had the option of using a bespoke URL such as bbc.friendslifemymoney.co.uk to link to the usual MY MONEY log in page;
- Since its launch, employee members of the MY MONEY platform have been able to contact the opponent using the e-mail address mymoney@friendslife.co.uk and mymoney.questions@friendslife.co.uk, a response to which would be sent from either the address above or from mymoneynoreply@friendslife.co.uk – an example is provided at pages 155 to 156 of exhibit DM1. Although dated 17 January 2013, Mr Millar states that an e-mail in this format would have been sent

since the service was launched in January 2012. The words “My Money” feature prominently in the example provided;

- Finally, since its launch, the telephone helpline for the MY MONEY platform which can be used by employers, employees and advisors, has had an automated message which says: “Thank you for calling the My Money helpline...”.

8. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

9. I shall deal first with the objection based upon section 5(2)(b) of the Act. This reads as follows:

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

(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, or

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

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

11. In these proceedings the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which constitute earlier trade marks under the above provisions. Given the interplay between the date on which the application was published and the date on which the opponent’s registrations completed their registration

procedure, the earlier trade marks are not subject to proof of use, as per section 6A of the Act.

Section 5(2)(b) – case law

12. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU 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;

(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 of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks 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.”

The average consumer and the nature of the purchasing process

13. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services and then to determine the manner in which these goods and services will be selected by the average consumer in the course of trade. In its submissions the opponent states:

“6. The notional average consumer in this case is most likely to be a business consumer and the general public...

7...The level of attention paid by the average consumer to the purchase act of the goods/services in suit will (generally speaking) not be particularly high.

8. The average consumer is likely to pay more attention to the visual aspects of the purchase although aural aspects cannot be ignored.

43. Again, although the average consumer might pay a higher level of attention to the purchase of the respective services than, say, a supermarket item...”

14. Whilst I agree with the opponent that the average consumer for the goods and services at issue in these proceedings will be a “business consumer and the general public”, some of the services at issue are, in my view, far more likely to be targeted at businesses than a member of the general public. In relation to the application, such

services would include advertising and data processing services in class 35 and all of the services in class 42, and, insofar as the opponent's earlier trade mark no. 2555001 is concerned, with the exception of services such as accounting and auditing services, electronic data storage and taxation advice, planning and consultancy (which would be provided to both groups of average consumers), all of the services in classes 35 and 42 of the registration.

15. As the goods and services at issue are wide ranging and disparate, the manner in which they will be selected and the degree of care that will be taken by the average consumer during their selection is also likely to vary widely. For example, a member of the general public is likely to select a pencil sharpener by primarily visual means from a range of retail outlets both in the real and virtual worlds and, given the low cost of such an item, is likely to pay very little attention when doing so. Contrast this with a business user commissioning an undertaking to provide it with advertising services. As the process is likely to include an initial review of potential candidates (using specialist publications and websites) and as the selection process may include, inter alia, a range of meetings with various undertakings to discuss which is considered most suitable, a mixture of both visual and aural considerations are likely to come into play and a high degree of attention is likely to be paid to the selection of such services. Given the breadth of the goods and services at issue and the varying nature of the selection process, I will return to the issue of the average consumer when I consider the likelihood of confusion later in this decision.

Comparison of goods and services

16. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. In reaching a conclusion, I will also keep in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

18. Finally, the comments of Jacob J in *Avnet Incorporated v Isoact Limited* [1998] FSR 16 are also relevant:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

19. I have reproduced the competing specifications above. Whilst I note that in its counterstatement the applicant states that its services are very different to those of the opponent, as the opponent points out in its submissions, the comparison to be made is not between what the parties might actually do, but between the specifications as applied for and registered. Proceeding on that basis, my analysis, by class, is as follows:

Class 35

All of the applicant’s services in this class are identical to services in class 35 of no. 2555001 either on the basis that they are identically worded or are self evidently the same services i.e. “Advertising” and “advertising services provided via the Internet”, “electronic data storage” and “data processing”, or because the term in question i.e. “organisation, operation and supervision of loyalty and incentive schemes” is included in a more general term in the earlier trade mark i.e. “promotional services.”

Class 36

All of the services in this class i.e. “Financial services provided via the internet; issuing of tokens of value in relation to bonus and loyalty schemes; provision of financial information”, are identical on the basis that they are included in more general terms in class 36 of no. 2526886 i.e. “financial and monetary affairs” and “information, advisory, consultancy and research services relating to all the aforesaid provided on-line from a computer database or the Internet; information, advisory, consultancy and research services relating to all the aforesaid”.

Class 38

All of the services in this class i.e. “Portal services; e-mail services; providing user access to the Internet” are identical on the basis that they are included in the general term: “telecommunication services” in class 38 of both earlier trade marks.

Class 42

“Design and development of computer... software; computer programming; design, drawing and commissioned writing for the compilation of web sites” and “creating, maintaining and hosting the web sites of others” are identical on the basis that they are included in “computer programming; hosting computer sites” included in class 42 of no. 2555001 and “installation, maintenance and repair of computer software” is identical on the basis that it is included in “computer network services” also in class 42 of no. 2555001. Although not identical in my view, given the obvious similarities in the intended purpose, method of use and trade channels, the “design and development of computer hardware” in the application is highly complementary/similar (at least) to “computer hardware” in class 9 of no. 2555001. That leaves “design services”. This is a broad term which would include a wide range of design services including those relating to, for example, bathrooms, vehicles, creative works etc. as well as to a range of IT related design. When considered in the context of the applicant’s other services and the comments contained in its counterstatement as to the nature of its services, it is, I think, reasonable for me to infer that the design services of interest to the applicant will most likely be those closely related to those other services for which registration has been sought. Proceeding on that basis, I think that the design services of interest to the applicant are all likely to be in the IT related field, and, at the very least, are likely to be similar to the opponent’s goods and services in classes 9 and 42 to at least a reasonable degree.

Comparison of trade marks

20. The competing trade marks are as follows:

The opponent's trade marks	The applicant's trade marks
<p>MY MONEY</p> 	

21. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the distinctive and dominant elements of the respective trade marks.

22. The first of the opponent's earlier trade marks consists exclusively of the words "MY MONEY", presented in upper case as two separate words. As, in my view, the words refer to the reader and his/her financial affairs, they "hang together", with the distinctiveness lying in the trade mark as a whole rather than in its individual elements.

23. The second of the opponent's earlier trade marks consists of a series of two. They each contain the words "FRIENDS", "money" and "and". In the first trade mark in the series these three words are presented in three different shades of blue with the words "my" and "me" presented in green and orange. As the second trade mark in the series, however, is presented in black and white, it is this trade mark on which I shall make the comparison as it offers the opponent its best prospect of success. The first element in the trade mark is the word "FRIENDS" presented in upper case (which, in its submissions, the opponent describes as "a well known trading name of the opponent"). The second element in the trade mark consists, in my view, of the words "my money and me", presented in lower case and in which each of the words is presented in a slightly different size. While there is nothing to suggest that the "FRIENDS" element of the trade mark is anything other than distinctive, despite its positioning as the first element of the trade mark, it is not, given its size in relation to the other element of the trade mark, a dominant element. Much like the words "MY MONEY", the words which remain i.e. "my money and me" hang together with any distinctiveness once again lying in the combination of words rather than the component parts. Given the size of this combination of words in relation to the word "FRIENDS", this combination constitutes the dominant element of the trade mark.

24. As to the distinctiveness of the words “MY MONEY”, in its counterstatement the applicant argues that: “the market is awash with MyMoney products and services”. As the opponent points out, however, whilst there are references in its counterstatement to a Google search no evidence has been filed by the applicant in support of this assertion. Whilst it is obvious that the word MONEY will be meaningful in relation to many of the goods and services at issue in these proceedings, when it is accompanied by the word “MY” or the words “my and me”, the combinations which result cannot, in the absence of cogent evidence to the contrary, in my view, be said to be devoid of any distinctive character for the specific goods and services relied upon by the opponent. That said, when considered in relation to any goods and services which relate to financial matters, the resulting combinations are, in my view, highly allusive and, as a consequence, the distinctive character of the earlier trade marks in those circumstances (and notwithstanding the presence of the distinctive element FRIENDS in the second earlier trade mark), must be considered to be relatively low.

25. Turning now to the application, this also consists of a series of two trade marks. Other than the symbol and word “.com” which is presented in green in the first trade mark in the series, both trade marks are presented in black and white. Using the second trade mark in the series as the basis for comparison, it consists of the words “MyMoney” presented in title case accompanied by the letters “PA”, the symbol and word “.com” and the stylised device of a hand with a bow tied on the index finger. The words “My Money” will have the same meaning as mentioned above and, given their well known meaning as an abbreviation, the letters “PA” will, as the applicant suggests, indicate a personal assistant; the symbol and word “.com” will indicate part of an Internet domain name for a commercial company. Given its size and positioning, the words and letters “MyMoneyPA” are the dominant element of the trade mark. Whilst the “.com” element is de minimis and will be accorded no trade mark significance, the device of a hand with a bow tied on the index figure is a distinctive element of the trade mark (although given its positioning it is not the dominant element of the trade mark). Given my conclusions above on the distinctiveness of the words “MY MONEY” and “my money and me”, the words and letters “MyMoneyPA” (which are likely to suggest a personal assistant that will assist with one’s financial matters) are a distinctive element of the applicant’s trade mark, although distinctive only to a relatively low degree.

26. Having reached those conclusions I now move on to consider the degree of visual, aural and conceptual similarity between the competing trade marks. Turning first to compare the applicant’s trade mark with the opponent’s “MY MONEY” trade mark, while the letters “PA”, the symbol and word “.com” and the device of a hand are alien to the opponent’s trade mark, the presence in both parties’ trade marks of the words MY MONEY (albeit in different formats) results in a reasonable degree of visual similarity between them. As to aural similarity, it is well established that where a trade mark consists of a combination of words and devices, it is the word elements that the average consumer will turn to when referring to the trade mark. Regardless of whether the applicant’s trade mark is referred to as My-Money-PA or My-Money-PA-dot-com, the presence in both parties’ trade marks of the words “MY MONEY” will result in a

reasonable degree of aural similarity between them. Finally, insofar as conceptual similarity is concerned, whilst the applicant's trade mark may also evoke the concept of a personal assistant, as both parties' trade marks will create in the average consumer's mind the concept of their own financial circumstances, they are, in my view, conceptually similar to a high degree.

27. Turning now to the second of the opponent's earlier trade marks, many of the same conclusions apply. Whilst the inclusion of the word "FRIENDS" and "and me" in the opponent's trade mark creates further points of differentiation between the competing trade marks, once again the presence in both parties' trade marks of the words "MY MONEY" will result in a degree of visual, aural and conceptual similarity between them, albeit, in my view, a lower degree of similarity than in relation to the words "MY MONEY" alone.

Distinctive character of the opponent's earlier trade marks

28. I must now assess the distinctive character of the opponent's earlier trade marks. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In relation to registration no. 2555001 MY MONEY the opponent states:

"24. The opponent's earlier mark possesses a normal level of distinctive character. The opponent's earlier trade mark must be presumed in these proceedings to be validly registered and as such has some degree of distinctiveness..."

29. In its submissions, the opponent makes no claim that either of its earlier trade marks has acquired an enhanced distinctive character through the use made of them. Although the opponent has filed evidence of the use it says it has made of the signs "MY MONEY" and "MY MONEY AND ME" in relation to financial services (for the purposes of its objection based upon section 5(4)(a) of the Act), as its MY MONEY trade mark is not registered for financial services in class 36 and as there is, as far as I can tell, no use shown of trade mark no. 2526886 (or insofar as the 5(4)(a) claim is concerned the words MY MONEY AND ME), I have only the inherent characteristics of the trade marks to consider. Given my conclusions in paragraph 24 above, the opponent's earlier trade marks are, absent use, possessed of only a low degree of inherent distinctive character.

Likelihood of confusion

30. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the opponent's earlier trade marks as the more distinctive these trade marks are the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has retained in his/her mind.

31. Earlier in this decision I concluded that, inter alia, the goods and services at issue are either identical or similar to at least a reasonable degree, that the competing trade marks are visually and aurally similar to a reasonable degree and conceptually similar to a high degree, and that the opponent's earlier trade marks are possessed of only a low degree of inherent distinctive character. In reaching a conclusion on the likelihood of confusion, I note the following comments of the CJEU in *L'Oréal SA v OHIM* – Case - C-235/05 P:

“42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

43. It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

44. In the second place, as was pointed out at paragraphs 35 and 36 of this judgment, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.

45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark,

one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

32. In its submissions the opponent states:

“59(2) It is irrelevant that there may be other signs similar to the opponent’s earlier trade mark being used in the market place as trade marks – *Nude Brands Limited v Stella McCartney and Ors* [2009] EWHC 2154 (Ch).”

33. As the opponent points out, the fact other parties may be using the words MY MONEY as a brand name does not, for the reasons mentioned by Floyd J in *Nude Brands*, assist the applicant. In *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, the CJEU said:

“29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.

34. Notwithstanding that the words “MY MONEY” and the element “my money and me” are of low distinctive character, the fact that the competing trade marks either consist exclusively of, or include these words as all or a significant part of their distinctive and dominant elements, whilst bearing in mind that in the opponent’s second earlier trade mark the words “my money and me” play an independent distinctive role, is, in my view, sufficient to result in a likelihood of (most likely) indirect confusion i.e. where the average consumer assumes that the goods and services at issue in these proceedings come from undertakings which are economically linked. Given the overall degree of similarity in the competing trade marks and the identity/similarity in the goods and services at issue, this conclusion applies to both members of the general public and to business users irrespective of how the goods and services are selected or the degree of care that is paid to their selection.

Conclusion under section 5(2)(b) of the Act

35. The opposition under section 5(2)(b) of the Act succeeds in relation to all of the services of the application.

The objection based upon section 5(4)(a) of the Act

36. As the opponent has been wholly successful under section 5(2)(b) of the Act, and as its objection under this ground places it, in my view, in no better position, I see no reason to consider this ground and decline to do so.

Costs

37. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£300
Preparing evidence:	£500
Opposition fee:	£200
Written submissions:	£300
Total:	£1300

38. I order GMPD Ltd T/A MY MONEY PA to pay Friends Life Management Services Ltd the sum of **£1300**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of September 2013

C J BOWEN
For the Registrar
The Comptroller-General