

O-366-13
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2615400
BY EQI INDEPENDENT LIMITED AND MY MONEY MANAGEMENT LTD
TO REGISTER



&



AS A SERIES OF TWO TRADE MARKS IN CLASSES 35 and 36

AND:

OPPOSITION THERETO UNDER NO. 103653
BY FRIENDS LIFE MANAGEMENT SERVICES LTD

BACKGROUND

1. On 19 March 2012, EQI Independent Limited and My Money Management Ltd (the applicant) applied to register the series of two trade marks shown on the cover page of this decision in classes 35 and 36 of the Nice Classification system, as follows:¹

Class 35

Business management; business administration; business advisory services; business advisory services in relation to debts and debt management and solutions; business advisory services in relation to accountancy, finance, auditing and tax; business advice relating to accounting; business advice relating to financial re-organisation; tax advisory services; tax and taxation planning services; tax and tax return preparation services; accounting services; accountancy services; business auditing; tax return advisory services; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.

Class 36

Financial affairs; monetary affairs; financial solution services; debt management services; debt management consultation; debt solution services; debt restructuring services; debt settlement negotiation services; debt settlement services; financial services; financial services, namely debt management services; financial services, namely debt settlement services; financial services, namely debt restructuring and resolution services; tax advice services; audit and accounts services; bankruptcy services; preparation of accounts; tax consultation and tax return preparation services; accountancy reporting services; advisory services relating to taxation; taxation planning services; tax return advisory services; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.

2. Following publication of the application on 4 May 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 by the company, 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:

3. **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 registered on 29 April 2011; the opponent relies on:

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

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

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.

4. **UK no. 2526886** for a series of two trade marks:



(directed against all of the services in the application). The trade mark was applied for on 24 September 2009 and registered on 29 January 2010 for:

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.

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

6. On 15 October 2012, the applicant filed a counterstatement in which the opponent’s claims are denied.

7. The opponent’s marks are earlier marks not subject to proof of use because, at the date of publication of the application, they had not been registered for five years.²

8. 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

9. The opponent’s evidence 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).”

10. 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.”

11. 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

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

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.”

- By the relevant date (19 March 2012), schemes using the MY MONEY Platform had been introduced to the workplaces of at least the following employers: *National Australia Bank, Tesco Plc, Marsh Services Limited, Mercer Limited, Nera UK, Oliver Wyman* and *Herman Miller Limited*.
- Pages 11 to 12 of exhibit DM1 show the locations, dates and attendee numbers of presentations given on behalf of four of the above employers. Mr Millar states:

“These show that over 500 employees of these four employers alone attended presentations about the MY MONEY Platform by the relevant date.”

- By the date of the application for registration the MY MONEY platform had been promoted on a range of promotional products, including hoardings, golf umbrellas, memory sticks, gift bags, pens and truffles. Mr Millar states:

“By the relevant date (19 March 2012) over £12,000 had been spent in this regard.”

- An example of promotional material is provided at pages 16 to 18 of Exhibit DM1, in the form of an advert. It shows a ballet dancer within the words “FRIENDS LIFE”. The second page states:

“Badged ‘My Money’ to employees, it makes workplace savings more relevant...”

- The cost of producing the promotional material until 19 March 2012 was nearly £60,000.
- By the date of the application for registration the MY MONEY platform had also been promoted at the Professional Pensions Communications Forum (February 2012).
- A variety of brochures have been circulated amongst employers and their employees about the MY MONEY platform. Pages 20 to 133 of exhibit DM1 consist of brochures: those dated December 2011 are entitled: “Flexible Retirement Account Product guide” and “Innovative solutions for workplace benefits Corporate Platform”; those dated January 2012 are 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 those dated March 2012 are entitled “Flexible Retirement Account Investment brochure Helping you to understand your investment choices.” All but one of these brochures contain the words “my money” on their cover pages and include numerous references to “My Money” and “mymoney”;

- Pages 134 to 136 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 are provided as pages 137 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 144 to 145 of exhibit DM1 which have been obtained from the Internet archive waybackmachine show the pages in question and are dated 11 February 2012. Pages 146 – 155 consist of a report showing “page views” to this website in 2012. The page was first viewed on 30 January 2012 and by 19 March 2012 had been viewed nearly 2,500 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 156 to 157 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 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...”

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

DECISION

13. I shall deal first with the objection based upon section 5(2)(b) of the Act, which states:

“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.”

Section 5(2)(b) – case law

14. 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

15. In accordance with case law I must determine who the average consumer is for the respective parties' services and then determine the manner in which these 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.”

16. I agree with the opponent that the average consumer for the services at issue in these proceedings will be a “business consumer and the general public”, however, some of the services at issue are far more likely to be targeted at businesses than at a member of the general public. In the application, such services would include business management, business administration and business advisory services in

class 35. In the specification of the opponent's earlier trade mark (no. 2555001) the same can be said of most of the services in class 35 of the registration, 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).

17. The services in the respective parties' specifications are wide ranging and disparate. Consequently, 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 accordingly. A member of the general public accessing an online bulletin board is likely to do so visually and is likely to pay very little attention when doing so. A business user commissioning an undertaking to provide it with business management services, on the other hand, is likely to pay considerable attention to what is likely to be an expensive purchase. The process is likely to include an initial review of potential candidates (using specialist publications and websites) and may include a range of meetings with various undertakings to discuss which is considered most suitable. Consequently, a mixture of both visual and aural considerations is likely to come into play and a high degree of attention is likely to be paid to the selection of such services. Due to the wide ranging nature of the respective parties' services I will return to the issue of the average consumer when I consider the likelihood of confusion later in this decision.

Comparison of services

18. The services to be compared are as follows:

The opponent's services	The applicant's services
<p>Class 35 – TM2555001 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</p>	<p>Class 35 Business management; business administration; business advisory services; business advisory services in relation to debts and debt management and solutions; business advisory services in relation to accountancy, finance, auditing and tax; business advice relating to accounting; business advice relating to financial re-organisation; tax advisory services; tax and taxation planning services; tax and tax return preparation services; accounting services; accountancy services; business auditing; tax return advisory services; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.</p>

<p>to all the aforesaid provided on-line from a computer database or the Internet.</p>	
<p>Class 36 – TM2526886 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.</p>	<p>Class 36 Financial affairs; monetary affairs; financial solution services; debt management services; debt management consultation; debt solution services; debt restructuring services; debt settlement negotiation services; debt settlement services; financial services; financial services, namely debt management services; financial services, namely debt settlement services; financial services, namely debt restructuring and resolution services; tax advice services; audit and accounts services; bankruptcy services; preparation of accounts; tax consultation and tax return preparation services; accountancy reporting services; advisory services relating to taxation; taxation planning services; tax return advisory services; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.</p>
<p>Class 38 (TM 2555001) 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</p>	

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 38 (TM2506886)

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.

19. In making a comparison between the parties' services I must consider the opponent's specification as registered, since it is not subject to proof of use. This must be compared with the applicant's specification as published.

20. In comparing the services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM)*, Case T-133/05, which, while referring to goods, is equally applicable in principle when considering the parties' respective services:

"29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

21. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (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 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, taking into account how goods/services are classified in trade.

22. I also bear in mind the decision in *El Corte Inglés v OHIM* Case T-420/03, in which the court commented:

“96...goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi [2005] ECR II-685).”

23. I also take note of the case of *Les Éditions Albert René V OHIM* T-336/03, where it was held:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

24. Additionally, there is the guidance provided in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (HC):

“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.”

25. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

26. Where appropriate I will, for the purposes of comparison, group related services together in accordance with the decision in *Separode Trade Mark* BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

Class 35



27. All of the applicant’s services in this class are identical to services in class 35 of TM no. 2555001 either on the basis that they are identically worded i.e. ‘Business management’ or because the term in question is included in a more general term in the earlier trade mark. The opponent’s ‘business advice services’ is a broad term which covers ‘business advisory services; business advisory services in relation to debts and debt management and solutions; business advisory services in relation to accountancy, finance, auditing and tax; business advice relating to accounting; business advice relating to financial re-organisation’. The opponent’s specification also includes ‘accounting and auditing services’, ‘tax advice’, ‘tax planning’ and ‘taxation consultancy’ which includes all of the applicant’s ‘tax advisory services; tax and taxation planning services; tax and tax return preparation services; accounting services; accountancy services; business auditing and tax return advisory services.’ Both parties’ specifications include ‘consultancy services relating to all of the aforesaid’.

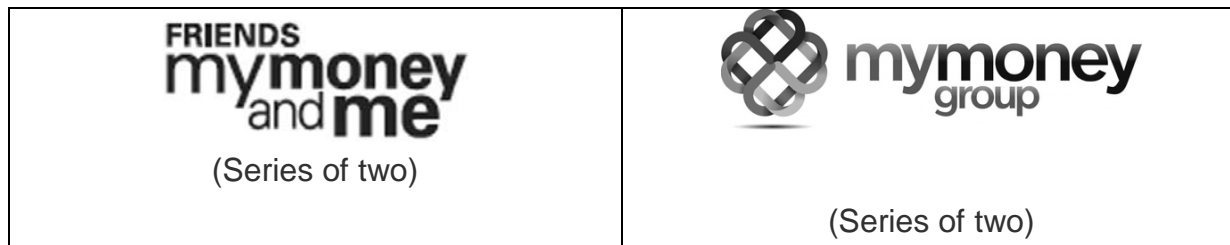
Class 36

28. All of the applicant’s services in this class i.e. ‘Financial affairs, monetary affairs, financial solution services’ and all of the specific types of financial services including taxation, debt management and accounts services are included within the broad terms, ‘financial and monetary services’, ‘financial brokerage services’, ‘financial management services’ and the general terms ‘information, advisory, consultancy and research services relating to all the aforesaid provided on-line from a computer database or the Internet’ and ‘ information, advisory, consultancy and research services relating to all the aforesaid’ in class 36 of no. 2526886.

Comparison of trade marks

29. The competing trade marks are as follows:

The opponent’s trade marks	The applicant’s trade marks
<p style="text-align: center;">MY MONEY</p> 	



30. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes 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.

31. The first of the opponent's earlier trade marks consists exclusively of the words MY MONEY presented in upper case as two separate words. The words "hang together", the distinctiveness lying in the trade mark as a whole rather than in its individual elements.

32. The opponent's second earlier trade mark consists of a series of two, the first of which contains the words "FRIENDS", presented in upper case above the words "my" and "money" in lower case, which are in turn presented above the words "and" and "me" presented in lower case. (The words 'FRIENDS', 'money' and 'and' are shown in three shades of blue while the words "my" and "me" are presented in green and orange). The second trade mark in the series is presented in black and white and it is this trade mark which I shall consider for the purposes of this comparison as it offers the opponent the best prospect of success.

33. The first element in the trade mark is the word FRIENDS presented in upper case, which the opponent describes in its submissions as, 'a well known trading name of the opponent'. Below the word FRIENDS are the words "my money" above the words "and me", all of which are presented in lower case in sizes which vary slightly. There is nothing to suggest that the FRIENDS element of the trade mark is anything other than distinctive. However, despite its positioning as the first element of the trade mark, its size in relation to other elements of the trade mark results in its not being a dominant element. Much like the words MY MONEY, the words which remain i.e. "my money and me" hang together with the distinctiveness once again lying in the totality 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.

34. As to the distinctiveness of the words My Money, whilst I accept that the word MONEY will be meaningful in relation to a number of the services at issue in these proceedings, when it is accompanied by the words "My" or "My" "and me" and considered in relation to the services relied upon by the opponent, the combinations which result cannot be said, in the absence of evidence to the contrary, to be devoid of any distinctive character. That said, as the resulting combinations are still, in my view, highly allusive, the distinctive character of the earlier trade marks,

notwithstanding the presence of the distinctive element FRIENDS in the second trade mark, must be considered relatively low.

35. The applicant's mark also consists of a series of two trade marks. Other than the circular device which is presented in a range of colours in the first trade mark in the series, both trade marks are presented in black and white. As with the opponent's series, the black and white version of the mark will be used for comparison as it represents the applicant's best case. The mark comprises a circular device, which makes up approximately the first quarter of the mark, followed by the words 'mymoney' presented in lower case above the word 'group'. The words mymoney will have the same meaning mentioned above, even though they are joined, as there is a natural break in the combination which will not go unnoticed by the average consumer, particularly as the word 'money' is emboldened. The word 'group' is subservient in size and positioning within the mark as a whole and, in the context of the services at issue, is non distinctive. Given its size and positioning, the circular device element and the words 'mymoney' are the distinctive and dominant elements of the trade mark.

36. Having reached these conclusions I now move on to consider the degree of visual, aural and conceptual similarity between the competing trade marks.

The opponent's 'MY MONEY' mark

Visual similarities

37. I will deal first with the opponent's MY MONEY mark. In its submissions the opponent states:

"13. Visually the figurative element to the Applicant's mark is of low distinctive character, particularly when assessed in relation to the Class 35 and Class 36 services in the Applicant's specification since it depicts stylised interlocking money clips or would otherwise be regarded as purely decorative".

38. In the absence of evidence to the contrary I do not accept that the average consumer of the services at issue would consider the device element of the applicant's mark to consist of stylised interlocking money clips. As I have concluded above, it will be seen as a device which has a distinctive and dominant role within the mark as a whole. Both parties' marks share the common words 'my money'. The applicant's mark also includes a circular device and the word 'group'. The presence in both parties' trade marks of the words My Money results in a reasonable degree of visual similarity between them.

Aural similarities

39. As to aural similarity, is well established that where a trade mark consists of a combination of words and devices it is the word element(s) that the average consumer will turn to when referring to the trade mark. The applicant's trade mark will be articulated as either, MY-MONEY-GROUP or 'MY-MONEY', since the 'GROUP' element of the mark is non-distinctive and may not be pronounced at all. The opponent's mark will be pronounced MY-MONEY. In the first instance, the first two words of the applicant's three word mark represent the entirety of the opponent's mark. Consequently, I find there to be a high degree of aural similarity between the

marks. Should the average consumer not pronounce the word 'GROUP' at all, the mark are aurally identical.

Conceptual similarities

40. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.³ The assessment must be made from the point of view of the average consumer.

41. The opponent submits:

"The figurative element does not alter the conceptual meaning of the Applicant's mark in any significant way. The word "group" plainly indicates to the average consumer that the services provided under the Applicant's mark originate from an undertaking economically linked with the Opponent or vice versa. Therefore, conceptually the marks are virtually identical."

42. In respect of any conceptual similarity, both parties' trade marks will create in the average consumer's mind the concept of their own financial circumstances. They are, therefore, conceptually similar to a high degree.

The opponent's 'FRIENDS my money and me' mark

43. 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 word 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

44. 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 services for which it has been registered as coming from a particular undertaking and thus to distinguish those 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:

"27. 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..."

³ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

45. 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 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 34 above, the opponent's earlier trade marks are, absent use, possessed of only a low degree of inherent distinctive character.

Likelihood of confusion

46. 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.

47. Earlier in this decision I concluded that the services at issue are identical, that the competing trade marks are visually similar to a reasonable degree, aurally similar to a high degree (or identical) 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 also 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."

48. Notwithstanding that the words "MY MONEY" and "my money and me" are of low distinctive character, the fact that the competing trade marks either consist of or include these words as all or part of their dominant elements is, in my view, sufficient to result in a likelihood of (at least) 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

49. The opposition under section 5(2)(b) of the Act against all of the services in the application succeeds.

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

50. 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

51. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place and make the award 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

52. I order EQI Independent Limited and My Money Management Ltd 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 11th day of September 2013

**Ms Al Skilton
For the Registrar,
The Comptroller General**