

O-396-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS 2600897 & 2600901
BY CHINA CONSTRUCTION BANK CORPORATION TO REGISTER THE
TRADE MARKS**



AND

CCB INTERNATIONAL

IN CLASSES 9, 16, 35, 36 & 41

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER NOS 102979 & 102980
BY GROUPEMENT DES CARTES BANCAIRES**


BACKGROUND AND PLEADINGS

1) On 10 November 2011, China Construction Bank Corporation (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the following two marks, both with an identical list of goods and services:

Relevant mark details	List of goods and services
<p>2600897</p>  <p>2600901</p> <p>CCB INTERNATIONAL</p>	<p>Class 9: <i>Computer software and programmes; computer hardware; computer software for trading of securities, options, foreign exchanges, futures, funds and commodities, investment management, investment research, investment advice, financial information services, financial analysis, market indices and financial projections; computer peripheral devices; magnetic disks; sockets, plugs and other contacts (electric connections); encoded cards; magnetic cards; mouse pads; memory devices; USB memory storage devices.</i></p> <p>Class 16: <i>Printed publications related to investment researches; magazines and newsletters containing financial and business information; published market indices; instructional, teaching and training materials in the field of financial services; documentation of computer software in the field of financial services; financial reports relating to merger, acquisition, restructuring and corporate finance affairs; paper and plastic materials for packaging (not included in other classes); paper; pamphlets; writing pads; memo pads; coasters of paper; note books; cards; envelopes; printed forms; printed matter; bookmarks; greeting cards; calendars; folders; stationery; pencil leads; writing materials; writing instruments; leaflets, promotional materials and other printed publications; boxes of cardboard or paper.</i></p> <p>Class 35: <i>Market analysis; business research; market research; economic forecasting; compilation and presentation of statistical information; business inquiries, appraisals, investigations and consultancy services; business information; computerized file management; compilation, classification and systemization of information into computer databases; data search in computer files [for others].</i></p> <p>Class 36: <i>Capital investment services; financial services relating to trading of securities, merger, acquisition, restructuring and corporate finance affairs, futures, currencies, options, foreign exchanges and commodities; shares and stocks brokerage; investment researches services; investment management and advisory services; installment loans; credit bureaux; debt collection agencies; banking; public funds investments; investments; fund investments; money exchanging; providing of loans; fiscal assessments and evaluation; financial evaluation (insurance, banking, real estate); financing services; financial management; mortgage banking; savings banks; hire-purchase financing; financial analysis and consultancy; credit card and debit card services; electronic funds transfer; financial information; issuance of tokens with value; issuance of credit cards; retirement payment services; financial sponsorship; home banking; financial clearing; safe deposit services; deposits of valuables; brokerage and agents for bonds and other securities; stock exchange quotations; futures brokerage; investigation about credit card; brokerage; guarantees and surety; trustee services; trust services; trusteeship services; insurance; investment advisory consultancy services; issuing of travelers' cheques.</i></p> <p>Class 41: <i>Education and training relating to finance, investment and business; providing educational information relating to finance and investment; organizing simulation and role-playing as part of training relating to finance, investment and business; arranging and conducting of seminars, conferences, training workshops and road shows.</i></p>

2) They were both subsequently published in the Trade Marks Journal on 9 December 2011 and on 8 February 2012, Groupement Des Cartes Bancaires (“the opponent”) filed notice of opposition to both applications. The grounds of the oppositions are in summary:

- The applications offend under Section 5(2)(b) of the Act because the marks are similar to two earlier marks in the name of the opponent, and are in respect of identical or similar goods and services. Both earlier marks are subject to the proof of use provisions and the opponent claims use of both marks in respect of the same list of Class 36 services only. The relevant details of the opponent's two earlier marks are:

Relevant details of marks	Services relied upon
Community Trade Mark ("CTM") 269290 CB Filing date: 25 September 1997 Date of entry in register: 29 September 2005	Class 36: <i>Insurance and finance, namely insurance underwriting, foreign exchange bureaux; issuing of travellers' cheques and letters of credit; financial affairs, monetary affairs, banking; savings banks; management of banking and monetary flow by electronic means; electronic purse services; issuing of and services relating to prepayment cards, debit cards, credit cards, cash withdrawal cards, chip (integrated circuit) cards, magnetic cards and smart cards; issuing of bank cards, non-electronic; cash withdrawal using chip (integrated circuit) cards, electronic funds transfer; electronic payment; card payment services; prepaid card services; financial transactions by card holders via automated teller machines; authentication and verification of parties involved; financial information via all means of telecommunication; authorisation and regulation of payments by card numbers; remote secure payment; financial information, namely remote collection of financial information and data.</i>
CTM 269415  Filing date: 25 September 1997 Date of entry in register: 12 November 1999	

- The application offends under Section 5(3) of the Act because the application is in respect of a mark that is similar to the same two earlier marks detailed above, in which the opponent claims have a reputation in respect to Class 36 services. The opponent claims that the necessary link exists and that, further, the use of the applicant's mark, without due cause, will derive an unfair advantage from the opponent's reputation in its marks by enabling the applicant to "parasitically" trade off the reputation. It is also claimed that such use would damage and tarnish the good repute of the earlier marks where the applicant's goods and services are of a lower standard than those of the opponent. Finally, it claims that use of the applicant's mark will reduce the distinctiveness of the earlier marks and diminish the ability of the opponent to distinguish its services from others in the financial, insurance and monetary fields. It is claimed that this would have the effect of blurring the distinctive character of the earlier marks.

3) The applicant subsequently filed a counterstatement denying the opponent's claims and putting it to proof of use.

4) The two oppositions were consolidated and a single set of evidence was submitted by both parties. The opponent also provided two sets of written submissions, the first a critique of the applicant's evidence, the second addressing the case as a whole. I will take these fully into account together with all other papers on file. Both sides ask for an award of costs. The matter came to be heard on 13 March 2013 when the opponent was represented by Mr Ian Bartlett of Beck Greener and the applicant represented by Ms Imogen Wiseman of Cleveland.

Opponent's Evidence

5) This takes the form of a witness statement by Martine Briat, Director of Legal and Banking Affairs with the opponent company. Ms Briat correctly directs herself to illustrating proof of use for the five year period ending with the date of publication of the alleged offending applications, namely, 10 December 2006 to 9 December 2011. It is stated that both of the earlier marks have been used extensively in respect of banking card services and related products and services within the European Union.

6) Ms Briat explains that the opponent is an open "Economic Interest Group" formed in 1984 to establish an inter-bank and universal card payment and cash withdrawal system. This system is branded "CB" and has been since it was founded. Ms Briat states that a quarter of card payments made in the EU are made via the CB system, including during the relevant period. The system connects ATMs of different member banks, and permits these ATMs to interact with the ATM cards of non-member banks. The system also permits cards issued by member banks to be used at point of sale.

7) The opponent's products and services that are offered by its member banks are branded using the "CB" marks with the marks being displayed on most ATMs and points of sale in France. Ms Briat also states that the earlier marks, particularly the "CB device" appear on a large number of debit cards in France and elsewhere across Europe, in the same way as other, well known marks such as *CIRRUS* or *LINK* do in the UK.

8) At Exhibit MB1, Ms Briat provides a list of the 131 financial institutions that are members of the CB system in 2011, 150 who were members in February 2008 and 149 in June 2007. This list includes banks such as *Barclays*, *Lloyds TSB*, *ING*, *Citibank*, *Coutts*, to name a few. Ms Briat states that all of these banks were licensed to use to use the CB marks in relation to their cards and ATMs.

9) Extracts from opponent's annual reports for the years 2010 and 2007 are provided at Exhibit MB2. These contain numerous references to both of the earlier marks and provide numerous statistics such as the transactions undertaken through the *CB* system in 2010 amounted to €451.2 billion with

143,000 remote sales points of acceptance, 56,243 ATMs, 1,150,000 face-to-face points of acceptance. A table on the first page of the exhibit shows a table of similarly impressive figures for the years 2003 to 2010. Ms Briat states that the “vast majority of the transactions took place in the EU”.

10) At Exhibit MB3, Ms Briat produces a print from the opponent’s management records demonstrating the number of transactions that took place in the years 2005 to 2010. This shows the “number of operations in the UK” rising from 143,639 in 2005 to 1,425,823 in 2010. Tables and graphs show that the vast majority of these were transactions recorded by *Easyjet*, but 14 other traders are also listed.

11) Exhibit MB4 consists of Internet pages obtained in October 2011 taken from nine different websites of mainly French and Spanish banks. Whilst many of these are not clear, but all show a picture of bank cards with the opponents “CB” device mark appearing thereon. Exhibit MB5 has similar web pages, this time obtained from seventeen French traders’ websites. Where payment options are shown, the CB device appears alongside other payment methods such as *Mastercard*, *Visa* and *Paypal*. Exhibit MB6 consists of photographs showing the CB device mark appearing with marks representing other payment methods (such as *Maestro*, *Mastercard* and *Visa*) displayed on retailer’s doors and windows. It is not possible to ascertain where or when these photographs were taken. Exhibit MB7 consists of numerous archive printouts from the websites of EU based banks including *HSBC*, *Banque Populaire*, *BNP Paribas*, *Credit Agricole* and *BBVA*. They are dated variously between July 2007 and May 2010 and most feature bank cards where the “CB” device mark is visible appearing thereon.

12) Ms Briat states that all of the above demonstrates that “CB has come to be extremely well known as meaning the financial and monetary transactions system [the opponent] has operated for nearly 20 years”.

Applicant’s Evidence

13) This takes the form of a witness statement by Imogen Octavia Wiseman, Partner of fj Cleveland LLP, the applicant’s representative in these proceedings. Ms Wiseman states that she conducted searches using the IPO’s online database on 1 October 2012. These results found 32 “CB” marks in the classes covered by the contested application, including the two earlier marks relied upon by the opponent. A copy of these results is provided at Exhibit IOW1.

14) Ms Wiseman states that she then undertook Internet searches to establish whether the marks revealed by the search of the IPO database are in use. Sixteen of the marks are in use in respect of the parties’ goods and services in Classes 9, 16, 35, 36 and 41. At Exhibits IOW4 to IOW9 consists of Internet extracts showing various businesses, including a number of financial institutions

using the letters “CB” either as a stylised element of a composite mark or, in one case as part of the mark “CB1”. Where the marks are stylised, I note that such stylisation is significantly different to that of the opponent’s device mark. The sign “CB1” appears to be used to identify a specific property development in Cambridge.

15) Ms Wiseman also conducted a similar search for marks that contain the element “CB” as part of a more complex mark. A copy of the search results is provided at Exhibit IOW10 illustrating many hundreds of “hits”. At Exhibit IOW11, Ms Wiseman provides trade mark case details obtained from the IPO website for the thirty eight hits for marks consisting of the element “CB” plus one additional letter. Internet searches revealed that nine of these marks are in use and details are provided at Exhibits IOW12 to IOW20 for those in use in respect of goods and services in the classes of the contested application, namely classes 9, 16, 35, 36 and 41.

16) The first shows use of the mark “JCB CARD” and a device mark incorporating the letters “JCB” in respect of a credit card originating in Japan. A list of issuing banks is provided, none of which are in the EU.

17) The second relates to “London Commodity Brokers” being abbreviated to “LCB”. This describes itself as “an independent over-the-counter broking house specialising in physical and derivatives broking for coal, iron ore, freight and other commodity markets.”

18) The next relates to MCB Finance Group, a provider of consumer finance solutions to retail customers in Finland, Estonia, Latvia and Lithuania.

19) The fourth shows use of a mark “cbm” and device by Die Christoffel-Blindenmission, apparently translated from the German as “The Christian Blind Mission”, an international Christian development organisation.

20) The fifth of these exhibits is an extract from the website www.chrisbritton.co.uk that shows a single use of “CBC” as an abbreviation for Chris Britton Consultancy Ltd, a provider of “transport asset solutions”.

21) The sixth is an extract from the website of the CBI, that describes itself as “the UK’s top business lobbying organisation”.

22) The seventh of these exhibits is an extract from the website www.ftse.com describing the Industry Classification Benchmark, abbreviated to “ICB”, as “a definitive system categorising [...] companies and [...] securities worldwide”.

23) The next is an extract from the website www.ncbinsurance.com where use of a highly stylised “NCB” is shown as part of a composite mark. The company is in the business of insurance.

24) Finally, there is an extract from the website of Shanghai Commercial Bank Ltd, where a stylised “SCB” mark is used. The content refers to business activity only in Hong Kong.

DECISION

Proof of use

25) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services..."

26) Consideration has to be taken, also, of section 100 of the Act which states:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

Consequent upon section 100 the onus is upon the registered proprietor to prove that it has made use of the trade mark in suit, or that there are proper reasons for non-use.

27) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch), Arnold J commented on the case law of the Court of Justice of the European Union ("CJEU") in relation to genuine use of a trade mark:

"In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

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

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

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

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

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

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

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

52. In Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV (ONEL)* [2012] ECR I-0000, [2013] ETMR 16 the CJEU ruled that Article 15(1) of the Regulation must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to "genuine use in the Community", but that the territorial extent of the use was one of the relevant factors in that assessment.”

28) The applications being challenged were both published on 9 December 2011, consequently the five year period when the opponent is required to demonstrate use is between 10 December 2006 and 9 December 2011. Taking account of this guidance from the courts it is necessary to assess all surrounding circumstances.

29) The evidence provided by Ms Briat on behalf of the opponent only demonstrates use of its unstylised “CB” mark in the body of its 2007 and 2010 annual reports. Such use is not use in the course of trade and is not use in respect to goods and services. Consequently, it fails to support the claim that this mark has been used during the relevant period and the opponent cannot, therefore, rely upon this mark.

30) The evidence is significantly more persuasive regarding the use of its “CB” device mark. There are numerous examples of this mark appearing on bank cards issued by numerous banks around the EU and in France in particular. I do not understand the applicant to be challenging that use exists. However, it does contend that it fails to demonstrate use in respect of any financial services proper to Class 36, but rather it merely demonstrates use in respect of a technical service linking banking systems rather than the provision of financial services *per se*. It supports this by drawing attention to Ms Briat’s own comments in her witness statement, namely, that the main activities of the opponent are “to support inter-bank cooperation, to ensure security for its CB card system, and to be responsible for connecting authorization for payments made via CB cards”.

31) I reject the applicant’s submission. Whilst the opponent may be responsible for developing and operating the technical means for delivering its services, this is not the only service provided. It may also include services clearly proper to Class 36, such as the *management of banking and monetary flow by electronic means* (listed in its Class 36 specification). Further, the consumers of these services are also the customers of member banks and these consumers access the service of cash withdrawals and point of sale payments through their bank cards. It is my view that the opponent has correctly characterized these services as a type of financial service proper to Class 36. It is possible that such technical services are procured by the members of the opponent’s organization, but this would be an additional service provided to its trade consumers and would be additional to the services provided to the member bank’s customers. It is not merely a technical service linking banking systems even though the services of cash withdrawals and point of sale payments is dependent upon the existence of such a technical function.

32) It is also argued on behalf of the applicant that use is not shown in the UK, but of course the earlier mark is a CTM and, as such, use across the EU is relevant for assessing if there has been genuine use in the relevant period. In this respect, the evidence demonstrates that the mark is used extensively, accounting for a quarter of all card payments in the EU with the opponent having about one hundred and thirty banking members and with the “CB branding” appearing on

consumers' payment cards and on ATMs. Whilst the evidence is somewhat unhelpful in identifying specific use outside of France, it is also clear from the size of this use, that use extends to other territories in the EU. In my mind, there can be no doubt that the use is sufficient to overcome the hurdle defined by the CJEU in *ONEL* for demonstrating genuine use of the opponent's stylized CTM 269415.

33) In light of this finding, it is necessary that I consider what is a fair specification to reflect the use demonstrated in the opponent's evidence. In doing so, I keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

"29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it

appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

34) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pedantic way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

35) I am also mindful of the guidance provided by the General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (ALADIN)* Case T-126/03:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark

protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON) [2004] ECR II-0000, paragraph 32, and Case T-203/02 Sunrider v OHIM – Espadafor Caba (VITAFRUIT) [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an

arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

...

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

36) Finally, I also take account of the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"... I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

37) When considering how it is likely that the "average, reasonably informed consumer" would, when asked to describe the opponent's services, I note that the applicant has, as a fall back to its primary case (that there is no genuine use), suggested that the opponent's specification should be restricted as follows:

Electronic payment; card payment services; prepaid card services; financial transactions by card holders via automated teller machines

38) I agree with the applicant, in presenting its fall back position insofar that the use shown does not justify the retention of the broad specification listed in CTM 269415. There is no indication that the opponent provides any insurance services, and insofar as it provides financial services, these are limited in scope so that it would not be appropriate to permit it to retain the broad references to *finance, financial affairs, monetary affairs, banking, savings banks*, all of which include many other services that the applicant is not involved. However, as it is

made clear by Mr Hobbs QC in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* above, it is not necessary that I restrict the opponent's specification to the particular examples for which there has been genuine use. Consequently, I reject the applicant's suggested specification as it does just that. Rather, I must consider what category of services such use is realistically taken to exemplify.

39) When taking this consideration into account, together with the specification for which the opponent's mark is registered, it is my view that the genuine use shown by the opponent is sufficient to justify the retention of the following specification of services:

...; management of banking and monetary flow by electronic means; electronic purse services; issuing of and services relating to prepayment cards, debit cards, credit cards, cash withdrawal cards, chip (integrated circuit) cards, magnetic cards and smart cards; issuing of bank cards, non-electronic; cash withdrawal using chip (integrated circuit) cards, electronic funds transfer; electronic payment; card payment services; prepaid card services; financial transactions by card holders via automated teller machines; authentication and verification of parties involved; ...; authorisation and regulation of payments by card numbers; remote secure payment; ...

40) My considerations of the ground based upon Section 5(2)(b) will be based on this specification of services.

Section 5(2)(b)

41) Section 5(2)(b) reads:

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

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

42) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *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] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v.*

Thomson Multimedia Sales Germany & Austria GmbH C-120/04 and Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P. It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

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

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

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

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

(g) in determining whether similarity between the goods or services covered by two marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

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

(k) 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; 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; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

Comparison of goods

43) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

44) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

45) I also bear in mind the following guidance of the GC in *Gérard Meric v OHIM*, T-133/05:

“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 Vedral 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).”

46) Finally, in terms of understanding what a "complementary" relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 where it was stated:

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Segio Rossi v OHIM - Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseño original Juan Bolanos) [2007] ECR I-0000, paragraph 48)."

Class 9

47) The opponent's services supplied to its member banks rather than the consumer of banking services, such as *management of banking and monetary flow by electronic means* are such services where the purchaser may also expect that the necessary equipment may also be supplied by the opponent. Consequently, there is an overlap of trade channels in respect of goods covered by the applicant's Class 9 specification where those goods may be provided as part of an overall package of products supplied to the bank as part of the managing banking and monetary flow. To this extent, the applicant's *computer software and programmes* have trade channels that overlap with the opponent's services, and can include goods that are used in the delivery of the opponent's services and therefore there is also some overlap of intended purpose. However, these goods differ in their nature and methods of use. Taking all of this into account, I conclude that they share a moderate level of similarity to the opponent's services.

48) In respect of the applicant's *computer hardware; computer software for trading of securities, options, foreign exchanges, futures, funds and commodities [and] investment management and computer software for [...] investment research, investment advice, financial information services, financial analysis, market indices and financial projections*, these are also goods specifically adapted for use in the field of finance, but do not relate to the management of banking and monetary flow. Consequently, whilst there is still some similarity with the opponent's services, this is no more than low.

49) In respect of the remaining of the applicant's class 9 goods, namely *computer peripheral devices; magnetic disks; sockets, plugs and other contacts (electric connections); encoded cards; magnetic cards; mouse pads; memory devices; USB memory storage devices*, it is not clear to me that there is any similarity with the opponent's services. Whilst it is possible that magnetic discs and magnetic cards for example, could carry information relating to the same or similar services to that of the opponent, this is a tenuous link and there is nothing before me to suggest that trade channels may overlap even if such goods did carry this information. Consequently, I conclude that the goods share no similarity with the opponent's services.

Class 16

50) In respect of the applicant's *instructional, teaching and training materials in the field of financial services*, these are all goods that could be sold with the services of the opponent, or separately but still relating to these services and, consequently, may share trade channels and may have the intended purpose of assisting consumers of such services. Therefore, I find that there is a reasonably high level of similarity.

51) In respect of *documentation of computer software in the field of financial services* such a direct link is not obvious but, nevertheless, insofar as the opponent's services require computer software in order to be delivered to its customers and the consumer might expect it to supply such software, then it follows that documentation relating to this software may also be supplied by the same provider. Therefore, there is some similarity but it is no more than low.

52) In respect of *printed publications related to investment researches; magazines and newsletters containing financial and business information; published market indices; financial reports relating to merger, acquisition, restructuring and corporate finance affairs*, these are all relating to financial matters and these may be provided as supplementary products to financial services. Consequently, there is some overlap of trade channels, but as all but the second of these terms relates to financial areas not covered by the opponent's services, any similarity will be reasonably low. The second term relates to publications containing financial information more broadly and, consequently, there is an increased likelihood that the consumer will expect such printed matter to share trade channels with the supplier of services such as those of the opponent. Here the level of similarity will be higher.

53) Finally, in respect of the remaining goods in Class 9, it is not obvious to me that there is any similarity to the opponent's services.

Class 35

54) All of the applicant's Class 35 services are either economic or business services and are distinctly different to the services of the opponent. They will not share trade channels and their purpose and methods of use are all different. Consequently, I conclude there is no similarity.

Class 36

55) At the hearing, on behalf of the applicant, Ms Wiseman conceded that some of the respective Class 36 goods are identical. I concur that this is the case in respect of the applicant's *credit card and debit card services, electronic funds transfer and issuance of credit cards* and also its broad term *banking*.

56) Further, the applicant's services *financial management, savings banks, issuance of tokens with value, home banking and financial clearing* are all services that may include card services of the sort listed in the opponent's specification (as identified at paragraph 39 above). Therefore, these services are also considered to be identical in line with the guidance of the GC in *Gérard Meric*.

57) The applicant's *investigation about credit card, providing of loans and issuing of travelers' cheques* are services that may complement or be auxiliary to the opponent's card services and whilst not identical, will share a good deal of similarity.

58) All of the applicant's remaining Class 36 services are services that it would be expected to be provided by a bank or similar institution, consequently, they may share the same trade channels as the opponent's services. However, there are differences in the nature, intended purpose and in the way the services are used. Consequently, while they may all be covered by the broad umbrella of financial and banking services, the level of similarity is still only moderate.

Class 41

59) Whilst many of the applicant's services in this class relate to finance and investment, this is not, in itself, sufficient reason to find similarity. The providers of education and training services are not normally the same providers as those who provide the services in which the education and training relates. Certainly, there is no evidence before me to suggest that a provider of services such as those of the opponent would also normally provide education and training in the field of finance. Taking account of this, I conclude that if there is any similarity it is on the low side.

The average consumer


60) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

61) As I have identified above, some of the services of the respective parties are notionally identical, being a sub-set of broader banking services provided to consumers. The consumer generally selects such services with care and is likely to compare the merits of various different providers before selecting. Consequently, the purchasing act entails a higher degree of care and attention than with regard to more everyday goods and services. Nevertheless, the level of care and attention is not of the highest level. I also recognise that in respect of services such as cash withdrawal services, where the consumer may be exposed to the parties' marks, the level of care and attention will be only low, with consumers rarely considering whether an ATM machine, for example, is part of its bank's network or whether part of some rival ATM network.

Comparison of marks

62) Following my finding regarding genuine use, the opponent is able only to rely upon its device mark. The opponent relies upon the alleged conflict resulting from the applicant's use of the "CCB" element in its marks. This element is more prominent in the applicant's 2600901 application. Consequently, the opponent's best case lies with its attack upon this mark. Therefore, I will limit my considerations regarding similarity of marks to an analysis of the opponent's earlier CTM 269415 and the applicant's 2600901 mark. If the opponent cannot succeed in respect of its case based upon this, neither will it be able to succeed against the other of the applicant's marks.

63) In light of the above, my considerations are in respect of the following two marks:

Opponent's mark	Applicant's mark
	CCB International

64) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions

created by the marks, bearing in mind their distinctive and dominant components; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

“27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

65) There cannot be an artificial dissection of the marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of the them and is deemed to be reasonably well informed and reasonably circumspect and observant. The assessment of the similarity of the marks must be made by reference to the perception of the relevant public.

66) In the applicant’s mark, the word “International” indicates geographical scope and as such will not be perceived by the relevant public as adding, to any great extent, to the distinctive character of the mark. Rather, the dominant and distinctive element is the letters “CCB”. The Opponent’s mark consists of two, side-by-side devices that are perceived as indicating the letters “CB”. They create a distinctive whole and the distinctive character is not readily broken down and the distinctive character resides in its totality rather than in any one element.

67) From a visual perspective, Ms Wiseman submitted that the word “International” plays an important role in the applicant’s mark. I concur insofar that it is an element absent in the opponent’s mark and it creates a mark which is noticeably longer than the opponent’s mark. The applicant’s mark also consists of the letters “CCB”. Whilst the opponent’s mark creates the illusion of the letters “CB”, it in fact, consists of two side-by-side device elements. These devices create a visual distinction between the marks, but as they still creating the impression of the letters “cb”, two letters that are also present in the applicant’s marks, there is some visual similarity, but I would put in no more than low.

68) Similarly to the above, Ms Wiseman submitted that the word “International” plays an important aural role in the applicant’s mark. Again, I agree insofar as it adds an additional aural element, extending its pronunciation to eight syllables compared to the opponent’s two syllable mark. The opponent’s mark will be expressed as “CB”. The applicant’s mark will be expressed as the letters “CCB” and the word “International”. However, both marks share the same sound “CB”, albeit in the applicants mark as part of the “CCB” element. Taking all of this into account, I conclude that the respective marks share a moderately low level of aural similarity.

69) From a conceptual perspective, the opponent's mark is not endowed with any concept beyond that of the two letter acronym "CB". The applicant's mark consists of the three letter acronym "CCB" and the word "International" that will be perceived as a reference to geographical scope. The two and three letter acronyms have no obvious meaning and, consequently, these elements of the respective marks are conceptually neutral. The latter element of the applicant's mark is absent in the opponent's mark and this results in one mark having an element that has a meaning and that is missing in the other mark. Taking all of this into account, I conclude that the respective marks are neither conceptually similar or dissimilar.

Distinctive character of the earlier trade mark

70) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). Regarding the inherent distinctive character, the opponent's mark consists of two devices reminiscent of the letters "CB". These device elements enhance the level of distinctive character over and above the mere letters alone. Taking this into account, I conclude that the opponent's mark is endowed with a moderately high level of distinctive character.

71) In respect to the services for which I found genuine use (see paragraph 39 above) it is clear that there is significant use in continental Europe. However, the case is less convincing in respect to the UK. In the evidence, a number of UK banks are referred to as customers of the opponent. However, at no point is it explained whether this relates to its services in continental Europe where, of course, UK banks may also conduct business in the local markets. There is also evidence of about 1.425 million transactions being conducted in the UK in 2010, the vast majority of which were recorded by one trader, namely *Easyjet*. There is no evidence of how the mark was used in respect of these transactions and further, whilst superficially impressive, this volume of transactions is very low when considering the self-evidently enormous volume of transactions that must take place every year in the UK. Taking all of this into account, I am unable to conclude that the opponent's mark benefits from any enhanced distinctive character in the UK.

Likelihood of confusion

72) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik*

Meyer & Co. GmbH v. Klijsen Handel B.V paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

73) Mr Bartlett submitted that short marks are granted a relatively narrow scope of protection, citing the finding of the GC in Case T-185/02 *Ruiz-Picasso and Others v OHIM – DaimlerChrysler (PICARO)*, paragraph 54 and Case T-112/06 *Inter-Ikea Systems BV v OHIM*, paragraph 54. I note the criticisms of the *PICARO* case by Iain Purvis QC, sitting as the Appointed Person in *Elle Trade Mark*, BL O/277/12, paragraphs 15 – 18, where he dismissed the GC's application, in *Inter-Ikea*, of its guidance in *PICARO* as erroneous and stating that the correct approach was to consider each case on its own merits regarding the level of visual similarity. I also observe that visual similarity is but one of a number of factors that I must consider when considering the likelihood of confusion. The interdependency principle referred to above must be kept in mind. Therefore, whilst noting the comments of the GC, I reject Mr Bartlett's broad application of its comments.

74) Ms Wiseman submitted that the "CB" element plays no independent distinctive role in the applicant's marks but rather it is subsumed in the acronym "CCB". Whilst I do not disagree with this submission, it is my view that this is not the point in my considerations, but rather whether the "CCB" element leads the consumer to believe that, when considering the respective marks as a whole, to believe that the respective goods and services originate from the same or linked undertaking. Whilst Ms Wiseman submitted that there is no evidence that the word "International" is non-distinctive, I take judicial notice of its meaning conveying geographical scope. Consequently, any conceptual value is in indicating that the mark identifies an entity that operates across certain territorial borders.

75) I take all of the above into account, and also that I have concluded that the marks share a low level of visual similarity, a moderately low level of aural similarity and are conceptually neutral (but I also have due regard for the role the word "International" plays in indicating geographical scope), that the earlier mark is endowed with a moderately high level of distinctive character and that the purchasing process involves a greater than normal level of attention, but not the highest level. With all this in mind, I conclude that there is no direct confusion where one mark will be confused with the other.

76) Further, even where the respective services are identical, I find that neither is there is no likelihood of indirect confusion (where the consumer will believe that the goods and services for which the respective marks are used will originate from the same or linked undertaking). The consumer is likely to identify the word "International" nature of the business. Consequently, the consumer is likely to focus upon the "CCB" element of the mark. However, even then, the presence of

the additional letter “C” together with the highly stylised nature of the letters that comprise the opponent’s mark lead me to conclude that there is no likelihood of confusion. The opposition based upon Section 5(2) of the Act, therefore, fails against this application.

77) In respect to the applicant’s word and device mark, the addition of the device element and the addition of the Chinese characters introduces a further number of differences and creates an overall impression that sufficiently distant from the opponent’s mark for there not to be a likelihood of confusion. The prominent device element at the start of the mark is distinctly different in character to that of the applicant’s devices. Taking all of this into account, I find that, in respect of this application, the opposition based upon Section 5(2) also fails.

78) In summary, the both the oppositions, insofar as they are based upon Section 5(2)(b) of the Act fail in their entirety.

79) I also comment briefly on the impact upon this outcome of the OHIM’s opposition decision No B1883241, brought to my attention by the opponent in Beck Greener’s letter of 8 April 2013. The opponent submitted that my decision should follow that of the OHIM and reject the applications in their entirety. My decision has not followed that of the OHIM and I observe that there are a number of different circumstances when comparing the respective proceedings. The OHIM proceedings were against a different mark, namely “CCB” and not “CCB International” as in these proceedings. Further, I note that the OHIM concluded that the opponent’s mark benefitted from a “highly enhanced degree of distinctiveness” based upon its “intensive use”. In the current proceedings, when I have been required to consider the position in the UK, I have not found such enhanced distinctive character. Consequently, there are different circumstances in the two cases that have required different considerations, and it is my view that it is not necessary or desirable for me to follow the findings of the OHIM.

Section 5(3)

80) I turn to consider the ground for opposition under Section 5(3) of the Act which reads as follows:

“5.-(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

81) 'Reputation' for the purposes of Section 5(3) means that the earlier mark is known by a significant part of the public concerned with the products or services covered by that mark (paragraph 26 of the CJEU's judgment in *General Motors Corp v Yplon SA (CHEVY)* [1999] ETMR 122 and [2000] RPC 572).

82) As I have already noted earlier in this decision, whilst it is not disputed that the opponent's customers include banks based in the UK, I have been unable to conclude that this translates into use in the UK by those banks rather, than use in continental Europe. In addition, I have found that the evidence showing 1.425 million UK transactions in 2010 (and lower volumes in previous years back to 2005), was insufficient to demonstrate an enhanced distinctive character. Similarly, the lack of more detailed information of how the mark was used in respect of these transactions and also taking into account that such a number of transactions is, self-evidently only a tiny proportion of all UK transactions, I conclude that the evidence does not illustrate that a significant part of the public concerned knows of the mark.

83) It follows that I am unable to conclude that, for the purposes of Section 5(3), that the opponent has the necessary reputation amongst the consumer of banking goods and services in the UK.

84) Consequently, the oppositions, insofar as they are based upon Section 5(3) of the Act both fail in their entirety.

COSTS

85) The oppositions having failed, the applicant is entitled to a contribution towards its costs. I take account of the fact that the two sets of proceedings were consolidated, that a hearing has taken place and that both sides filed evidence. I award costs on the following basis:

Considering Notice of Oppositions and preparing statements in reply	£600
Considering & preparing evidence	£900
Preparing for & attending hearing	£800
TOTAL	£2,300

86) I order Groupement Des Cartes Bancaires to pay China Construction Bank Corporation the sum of £2,300. 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 3rd day of October 2013

**Mark Bryant
For the Registrar,
the Comptroller-General**