O-020-16

TRADE MARKS ACT 1994

TRADE MARK APPLICATION NO. 3057631
FOR THE TRADE MARK

PEAK CAPITAL

IN CLASSES 35 AND 36
BY PEAK CAPITAL ADVISORS LLP

AND

THE OPPOSITION THERETO
UNDER NO. 402956
BY PEAK ROCK CAPITAL, LLC

Background and pleadings

1. Peak Capital Advisors LLP ("the applicant") applied for the trade mark PEAK CAPITAL on 29 May 2014 for services in classes 35 and 36:

Class 35: *Business management; business administration; office functions; administration relating to business planning; advisory services relating to business management; analysis of business statistics; business efficiency expert services; business management assistance; business consultancy services relating to insolvency; business consultation services; business information and research services; business statistical analysis; business strategic planning; business strategy services; compilation of business statistics; conducting of business research; drawing up of statements of account; economic analysis for business purposes; expert evaluations and reports relating to business matters; strategic business planning; economic forecasting; information, advisory and consultancy services relating to the aforesaid services.*

Class 36: *Insurance; financial affairs; monetary affairs; arranging of investments; banking; brokerage; capital investments; capital investment advisory services; capital management; raising of capital; raising of capital by way of private equity and debt placements; debt advisory services; debt management services; fund investments; financial analysis; financial consultancy and advisory services; financial management; financial services, namely investment management services and investment advisory services; financial evaluation (insurance, banking, real estate); financial transactions; financial services relating to investment; financial services in the nature of an investment security; financial management, assistance, advice, consultancy, information and research services; investment services; investment services relating to mutual funds and debt instruments; financial valuation services; statistical information on financial transactions; loans [financing] ; mutual funds; securities brokerage / stocks and bonds brokerage; stock brokerage services; valuation of capital stock; venture capital services; venture capital fund management; financial services relating to business; information, advisory and consultancy services relating to the aforesaid services.*

2. The application was published on 27 June 2014 and was subsequently opposed by Peak Rock Capital, LLC ("the opponent"). Its opposition under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") is based upon the following earlier Community Trade Mark:

11282076

PEAK ROCK CAPITAL

Class 36: *Investment of funds for others*.

Filing date: 8 October 2012; date registration procedure completed: 1 February 2013.

3. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion because of the similarities between the marks and the identity or similarity between the parties' services. Under section 5(3), the opponent claims that the confusion caused would allow the applicant to take unfair advantage of the opponent's mark and that its brand image will be eroded and tarnished.

4. The opponent also opposes the application under section 5(4)(a) of the Act, based upon its use of the sign PEAK ROCK CAPITAL in the UK from July 2013, in relation to various financial services including investment advisory services, investment management, capita investments, capital management, financial management, financial transactions, venture capital services, and advisory services relating to the aforementioned services. The opponent claims that use of PEAK CAPITAL will lead to misrepresentation and damage the opponent's sign and business.

5. The applicant denies the grounds.

6. Both sides filed evidence. The matter came to be heard before me on 9 December 2015 by video conference. Mr Simon Malynicz, of Counsel, represented the opponent, instructed by Marks & Clerk LLP. Mr Julius Stobbs, of Stobbs, represented the applicant.

Opponent's evidence

7. Mr Jung Woo Choi has provided two witness statements. The first is dated 23 December 2014 and is partly confidential. Mr Choi is the opponent's Chief Financial Officer.

8. Mr Choi states that:

- The opponent makes equity and debt investments in the US and Europe, with over $700 million in committed capital from investors in the US and Europe.

- At the date of his statement, the opponent employed 23 staff in Texas and Brussels. Exhibit JWC1 comprises a screenshot of the European webpage from the opponent's website. This is undated, but bears a copyright date of 2014.

- About 60% of capital committed by European investors is from UK investors[1]. These include a private pension fund of a major UK-based bank, corporate trustees of pensions for government, and a fund of funds of a leading global asset manager. Mr Choi states that this means that there are a large number of indirect investors in the opponent (individuals, corporations and institutions).

[1] The actual figures are contained in the confidential evidence.

- Investors are given log-in access through a portal in the opponent's website, as shown in Exhibit JWC2, a screenshot which appears to date from October 2014.

- Emails are sent to investors informing them that specific information has been made available through the portal; an example from 16 December 2014 is shown in Exhibit JWC3 to a UK-based investors.

- Quarterly newsletters are sent, including to UK investors. An example from 31 October 2014 is shown in Exhibit JWC4. The update entirely refers to US-centric investments, although there is a reference to staffing in the European team.

- Investors to the opponent's funds are made aware of investment opportunities by promotional material, word of mouth from other investors, industry events and presentations, such as the example in Exhibit JWC5[2], and via third party investment advisors. Mr Choi states that this is typical of the industry.

9. Mr Choi gives some facts about the applicant's changes of name, which is it not necessary to detail here. Mr Choi also exhibits some pages from the applicant's website to show the services offered under the applicant's mark, e.g. working with smaller entrepreneurial companies, unfamiliar with raising capital, and more experienced companies[3]. Mr Choi states that this is the same area of trade as the applicant operates under its mark. Exhibits JWC10 and JWC11 are pages from the applicant's website which explain its various levels of investment advice. Exhibit JWC17 is a duplication of some of these pages, adduced to Mr Choi's second witness statement, dated 14 September 2015.

10. Mr Choi provides a summary of search results undertaken on the LexisNexis press search database for UK press sources which mentioned the opponent in 2014[4]. Mr Choi describes the results as showing that the opponent has been referred to numerous times in global publications which are directly accessible online and by subscription by UK readers and investors. These are dated after the date of application and appear to be US publications. Articles mentioning the opponent are shown in Exhibit JWC15; these are dated after the relevant date. Mr Choi refers to articles dated 24 September 2013 and 15 April 2014 in Private Debt Investor and Private Equity International[5] about the opponent (known as Peak Rock Capital). Mr Choi states that these publications are widely read by investors, and those interested in the market, both in the UK and globally.

11. Mr Choi states that the opponent's expansion into Europe is noted in the UK-based publication Private Equity News, as evidenced in Exhibit JWC16. An article dated 9 June 2014 is headed "U.S. Buyout Firm Plans European Office Opening" and continues:

[2] Confidential exhibit.
[3] Exhibit JWC9.
[4] Exhibits JWC12 and JWC13.
[5] Exhibit JWC14.

> "Peak Rock Capital, the Texas-based private equity and special situations investor that closed its debt fund oversubscribed at its $700 million hard cap last September is planning to open an office in Brussels this autumn...The firm expects most of the deal flow to come from France, Germany and the Benelux countries."

12. Mr Choi states that these press mentions have increased the opponent's reputation "in recent months". He states that the sourcing of many millions of pounds for the opponent's current fund from UK investors proves this reputation, although he does not state when the securing of this UK money occurred.

13. Apart from adducing pages from the applicant's website, Mr Choi's second witness statement simply serves to adduce prints from third party websites. These appear to have been filed to support a point about the identity of the average consumer.

Applicant's evidence

14. Mr Jonathan Laredo, a partner at the applicant, has filed a witness statement, dated 23 April 2015 and supporting exhibits. He states that the idea for the mark comes from the fact that the applicant's two founding partners are from the Peak District. He describes the applicant's current fund management business, and that the applicant has been based in London since it was founded in 2011. The majority of the applicant's sourcing of investment opportunities ('private placements business') has been the raising of capital for UK companies.

15. The applicant does not engage in the retail financial trade or trade to the general public. Its investors are either regulated institutions or classed as professional investors by the Financial Conduct Authority. Like the opponent, the applicant provides investor portal login facilities on its website.

16. Mr Laredo states that there are 47 funds on the London Stock Exchange which use the word Peak in their name (exhibit JL3). I note that these names, with one exception, include the word in the context of 'peak performance'. Mr Laredo states that it is his experience that peak is a word frequently used in names of financial services providers, along with summit, apex, pinnacle and mountain, because these words imply height and relative achievement. He attaches, at Exhibit JL1, the details of 26 financial company names which include the words Peak and Capital, along with prints indicating their use. The companies are mostly located in the US. Mr Laredo states that within half a mile from the applicant's London offices, there are two other finance companies with Peak in their name (New Peak Capital Partners) and One Peak Partners. He states that these exist without confusion. Mr Laredo also states that 'peak' is frequently used in finance; for example 'peak to trough', and when prices shares etc have reached their highest point, or peak.

Decision

17. Section 5(2)(b) of the Act states that:

"(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."

18. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

19. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*. where the Court of Justice of the European Union ("CJEU") stated, at paragraph 23 of its judgment:

> "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."

20. 'Complementary' was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

> "82 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…".

21. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* ("Treat") [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

22. In *Avnet Incorporated v Isoact Limited,* [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "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."

23. 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."

24. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T-33/05, the General Court ("GC") stated that:

> "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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

25. The earlier mark is not subject to proof of its use, which means that it must be considered across the notional breadth of the services relied upon, *investment of funds for others*[6].

26. On the *Meric* principle, the applicant's terms *financial affairs; monetary affairs; arranging of investments; banking; brokerage; capital investments; capital management; fund investments; financial services, namely investment management services and investment advisory services; financial services relating to investment; financial services in the nature of an investment security; investment services; investment services relating to mutual funds and debt instruments; mutual funds; securities brokerage/stocks and bonds brokerage; stock brokerage services; venture capital services; venture capital fund management; financial services relating to business* either encompass or are encompassed by the opponent's services and are, therefore, identical.

27. The opponent claims (in its notice of opposition) that *raising of capital; capital investment advisory services* are highly similar, but not identical, to its services, but

[6] *Roger Maier and Another v ASOS* [2015] EWCA Civ 220, paragraphs 78 and 84.

that *raising of capital by way of private equity and debt placements* is complementary (it does not claim this is highly similar).

28. *Raising of capital; capital investment advisory services; financial analysis; financial consultancy and advisory services; financial management; financial evaluation (insurance, banking, real estate); financial transactions; financial management, assistance, advice, consultancy, information and research services; financial valuation services; statistical information on financial transactions;* are all services which one would expect to be provided by an undertaking providing investment of funds services. The nature of the services are financial, the purpose is to make the investment, the methods of use will be investment following consultation (including management, statistics, analysis and research) with the provider; channels of trade will be identical and the services are highly complementary. These services are highly similar. It is curious that the applicant does not claim that *raising of capital by way of private equity and debt placements* is highly similar, although it claims that *raising of capital* is highly similar. Without making a better case for the opponent than it makes itself, *raising of capital by way of private equity and debt placements* must be similar at least to a good degree. *Information, advisory and consultancy services relating to the aforesaid services* are similar to the opponent's services, insofar as they relate to the services I have found to be identical, highly similar, or similar to a good degree.

29. The applicant's *insurance; debt advisory services; debt management services; loans [financing]; valuation of capital stock; information, advisory and consultancy services relating to the aforesaid services* are all financial services. As the opponent's services are to be considered on a notional basis (not what has actually been provided to date), this includes investment services to individuals who may not be of high net worth; members of the general public and small businesses make investments. The opponent's evidence includes prints from third party websites (Exhibit JWC18) which shows this to be the case. The parties' services, although not for the same purpose, not complementary and not in competition, may share channels of trade. Mr Malynicz referred me to the decision of Arnold J in *Stichting BDO v BDO Unibank, Inc.,* [2013] EWHC 418, in which it was found that the defendants' remittance services and the claimants' financial and tax consultation services lay in the broad field of financial services, although the judge said that the most that can be said is that they were similar to a low degree. I find that the services listed at the beginning of this paragraph are similar to a low degree with the opponent's services.

30. Mr Stobbs referred me to an OHIM opposition decision, B1939654, *Cathay United Bank Co., Ltd v Cathay Capital Europe s.a.r.l.*, in which the Opposition Division said this about comparing the applicant's class 35 services with the opponent's broad range of financial services, including investment services, in class 36:

> "The contested *business management consultancy; efficiency experts; business information; business management and organisation consultancy; business management; auditing; business consultancy* are usually rendered by companies specialised in this specific field such as business consultants.

> These companies gather information and provide tools and expertise to enable their customers to carry out their business or provide businesses with the necessary support to acquire, develop and expand market share. The services involve activities such as business research and appraisals, cost price analysis and organisation consultancy. These services also include any 'consultancy', 'advisory' and 'assistance' activity that may be useful in the 'management of a business', such as how to efficiently allocate financial and human resources, how to improve productivity, how to increase market share, how to deal with competitors, how to reduce tax bills, how to develop new products, how to communicate with the public, how to do marketing, how to research consumer trends, how to launch new products, how to create a corporate identity, etc. The above-mentioned contested services have nothing in common with the opponent's services which are basically financial and real estate services, which are normally provided by financial institutions and real estate agencies. It is very unlikely that financial institutions and real estate agencies render *business management, business administration services* at the same time. Even though some elements of managing and administrating of financial business can be applied, it is insufficient to find similarity. Neither the purpose nor the nature of the services in dispute are similar. Therefore, these services are considered to be dissimilar."

31. This decision is not binding upon me, nor does it have persuasive value. Nevertheless, I find that I agree with OHIM's analysis that, broadly speaking, services such as business management, office functions and business consultancy and advice are not similar to financial services and, *a fortiori*, not similar to *investment of funds for others*. Bearing in mind the core meanings, they share neither nature nor purpose, are not in competition, are not complementary, and do not share trade channels. I find that there is no similarity between the opponent's *investment of funds for others* and the following Class 35 services of the application:

Business management; business administration; office functions; administration relating to business planning; advisory services relating to business management; business efficiency expert services; business management assistance; business consultancy services relating to insolvency; business consultation services; business strategic planning; business strategy services; drawing up of statements of account; strategic business planning; information, advisory and consultancy services relating to the aforesaid services.

32. I also find that there is no similarity between the following services of the application which the opponent submits are highly similar: *analysis of business statistics; business information and research services; business statistical analysis; compilation of business statistics; conducting of business research; economic analysis for business purposes; expert evaluations and reports relating to business matters; economic forecasting; information, advisory and consultancy services relating to the aforesaid services.* This is because although an undertaking providing investment services for others will conduct financial analysis of the entities in which an investment may potentially be made, this is part of its own research, or its own internal business, prior to carrying out the investment service, rather than services provided for others, separately to the investment itself. To take another example, a

clothing manufacturer may research their market before selling a new line of suits, but market research is not similar to suits; it is part of the clothing manufacturer's own business.

Average consumer

33. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

34. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

35. The matter is to be approached on a notional basis, not on the basis of the parties' current customer base. There is no need for me to consider the average consumer for the class 35 services as I have found that they are not similar, in which case there can be no likelihood of confusion (Canon, paragraph 23). In the case of the class 36 services, some consumers may be high-net-worth, experienced investors; others may be members of the general public, investing savings. Either will take care in deciding upon financial investments but, for the former type of consumer, the selection process is likely to be more complex and involved. For all investors and those procuring a financial service, an above average level of attention will be paid to the service provider owing to the importance of ensuring that one's money is safe, has a good level of return, and so on. Primarily, the average consumer's encounter with the parties' marks will be on a visual level, such as signage on premises, newspapers, journal advertisements and reports, and website use. However, the potential for oral use must also be recognised for various types of financial services, such as oral recommendation and use over the telephone.

Comparison of marks

36. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant

components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

37. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

38. The respective marks are:

Earlier mark	Application
PEAK ROCK CAPITAL	PEAK CAPITAL

39. Although it clearly is not negligible, CAPITAL carries less distinctive weight in the overall impression of the marks because it is descriptive in the context of financial services. PEAK is the most dominant element owing to its position at the start of each mark. The difference between the marks is the additional word ROCK, in the earlier mark, sandwiched between the PEAK and CAPITAL, which are the only components of the application. The presence of identical words at the beginning and end of both marks creates a high degree of visual and aural similarity between the marks.

40. Despite being a tautology, PEAK and ROCK reinforce each other conceptually, creating the impression of a mountain peak. This concept is also brought to mind by the application, although given the financial meaning of peak, it may, alternatively, be interpreted as meaning capital valued at its highest point. There is either conceptual identity or a difference, therefore, depending upon which conceptual impression the applicant's mark makes upon the average consumer.

Distinctive character of the earlier marks

41. In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV*[7] the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular

[7] Case C-342/97.

undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

42. Mr Malynicz submitted that the opponent does not rely upon enhanced distinctive character; in any event, I do not consider that it would be entitled to claim an enhanced distinctive character through use. There is a distinct lack of evidence in the UK before or at the material date; it all points towards the setting up of European operations after the material date. Inherently, capital is non-distinctive/descriptive, and although peak and rock are common words, the tautology gives the mark as a whole an average degree of distinctive character for investment services.

Likelihood of confusion

43. The parties' evidence includes detail about the use of their marks with 'peak' devices. In *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, Floyd L.J. considered the CJEU's judgment in *Specsavers*, Case C-252/12, establishing that matter used with, but extraneous to, the earlier mark should not be taken into account in assessing the likelihood of confusion with a later mark. Consequently, this evidence has no bearing upon the matters before me.

44. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). There is no likelihood of confusion where there is no similarity of goods and services. Consequently, this opposition fails under section 5(2)(b) against the applicant's services in class 35.

45. I have found that the parties' services in class 36 range from being identical to similar to a low degree. The marks are highly similar visually and aurally. There may be conceptual identity or a difference depending on whether PEAK in the applicant's mark is interpreted as meaning a financial high point or a mountain peak. If the conceptual significance of the applicant's mark is perceived as a mountain peak, this brings the marks very close together indeed. If the alternative concept is

perceived, there is a conceptual difference. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

> "20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

46. However, conceptual differences between marks do not necessarily counteract visual and aural similarities sufficiently to avoid a likelihood of confusion[8]. It depends upon how strong the visual and aural similarities are, and the degree of difference between the concepts. In the present case, the marks are highly similar visually and aurally, the beginnings and ends are the same, and the only difference between them is a short word sandwiched between the identical elements, more easily overlooked than if it appeared elsewhere in the mark. The fact that CAPITAL is non-distinctive for many of the services does not reduce the similar visual and aural impact of the marks. Although there are conceptual differences, they are not that strong: share a general meaning of a high point. For conceptual counteraction to work in this case, the average consumer would have to engage in an analysis of the marks which goes beyond the perception of marks as wholes and which would require their artificial dissection.

47. The applicant argues that there will be a very high degree of attention paid by the average consumer for investment services. As said earlier, the matter must be approached notionally, including the general public as well as the particularly circumspect investor; in which case the matter must be viewed from the perspective of the general public, having the lower level of attention[9]. However, even where 'expert' consumers are involved, confusion can still occur. A specialist consumer's circumspection does not automatically obviate confusion[10], especially where the marks are so close visually and aurally. Nor does the evidence of consumers being used to other entities using the word PEAK help: they are almost exclusively to be found in the US.

48. The marks could be seen as conceptually identical but, even if not, the strength of the conceptual difference is insufficient to counteract the high levels of visual and aural similarity. There is a likelihood that the marks will be imperfectly recalled and will be confused. I find a likelihood of confusion in relation to all of the applied for services, including those for which there is a low degree of similarity (*insurance; debt advisory services; debt management services; loans [financing]; valuation of capital stock; information, advisory and consultancy services relating to the aforesaid services*), which are services for which, notionally, the average consumer is as likely to be the general public as it is specialists.

---

[8] See the GC in *Nokia Oyj v* OHIM, Case T-460/07 and *Adelphoi Limited v DC Comics (a general partnership)* BL O/440/13, Professor Ruth Annand, sitting as the Appointed Person.
[9] *Adelphoi Limited v DC Comics*.
[10] *Honda Motor Europe Ltd v OHIM*, Case T- 363/06, GC.

49. The ground under section 5(2)(b) succeeds against class 36 but fails against class 35.

Other grounds

50. Although they were not formally abandoned, Mr Malynicz submitted that the section 5(3) and section 5(4)(a) grounds stood or fell with confusion. There is no need to consider the other grounds against class 36, as the opponent has succeeded here under section 5(2)(b). As I have found no likelihood of confusion in relation to class 35, these grounds also fail against the class 35 services of the application.

Outcome

51. The opposition succeeds under section 5(2)(b) against class 36 but fails against class 35. The application is refused for class 36 but may proceed to registration for the class 35 services.

Costs

52. Both sides have been successful in equal measure. Each side would normally bear its own costs in such circumstances. Mr Stobbs mentioned as a "slight point" that he had had to deal with the section 5(3) and 5(4)(a) grounds, even though the opponent did not press them. As they were not formally abandoned and dealing with them was not onerous, I have decided not to vary my initial view. Accordingly, each side should bear its own costs.

Dated this 15th day of January 2016

Judi Pike
For the Registrar,
the Comptroller-General