

**O-395-16**


**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 3103432  
BY STEPHEN CLIVE UNDERWOOD  
TO REGISTER THE TRADE MARK  
CONTINUUM FINANCIAL  
IN CLASS 41  
AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER No. 404875 BY  
CONTINUUM (MARKETING) LIMITED**

## BACKGROUND

- 1) On 10 April 2015, Stephen Clive Underwood (hereinafter the applicant) applied to register the trade mark “continuum financial” in respect of the following services in Class 41: Writing services blog.
- 2) The application was examined and accepted, and subsequently published for opposition purposes on 15 May 2015 in Trade Marks Journal No.2015/020.
- 3) On 14 August 2015 Continuum (Marketing) Ltd (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
	3043565	21.02.14 06.06.14	36	Independent Financial Advice, online portal for life insurance, life assurance, pensions, investments, annuities, mortgages, online portal for money and financial aggregation.

- a) The opponent contends that its mark and the mark applied for are very similar and that the services in class 36 for which its mark is registered are very similar to those applied for by the applicant in class 41. It contends that the application offends against Section 5(2)(b) of the Act.
- 4) On 16 October 2015 the applicant filed a counterstatement, basically denying that the marks are similar. He states that he founded the opponent and as a partner was responsible for registering the opponent’s trade mark. He states that he intends to offer advice on all manner of subjects using the “Continuum” mark, starting with financial services as he has twenty-five years of experience in the industry. His blogs will, he claims, make consumers “better informed and enable them to make small adaptations to their lives in order to facilitate a better life”. He points out that the opponent has not and cannot trade as it is not approved by the Financial Conduct Authority (FCA). He contends that a number of companies in the financial sector use the word “Continuum”. The applicant requested proof of use, although this does not apply given the date that the opponent’s mark was registered.
  - 5) Both sides filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Only the opponent provided written submissions which I shall refer to as and when necessary in my decision.

## APPLICANT’S EVIDENCE

- 6) The applicant filed a witness statement, dated 27 February 2016, in which he states that he, along with Mr Martin Brown, founded the opponent, during 2013/2014 before Mr Underwood was fired in January 2015. He states that he has a “concurrent right” to use the term “continuum” and that he has tried to discuss the dispute with the opponent to no avail. He repeats many of the claims made in his counterstatement. He states that the opponent operates a blog under the name “Education Centre”.

At exhibit SCU9 he provides a print out, undated, from the FCA which shows eight companies with the word CONTINUUM as part of their name (including the opponent), although the report refers to eleven companies being found. Two of the companies have the word "cancelled" underneath their status, one has the sentence "previously IP registered" and another states "IVOP issued". Only two show the term "authorised", both of which trade under names which do not include the word "CONTINUUM".

## OPPONENT'S EVIDENCE IN REPLY

7) The opponent filed a witness statement, dated 18 April 2016, by Martin Anthony Brown a Director of the opponent company. He states that the opponent's mark is inherently highly distinctive for the financial services for which it is registered. He contends that it is normal for financial services companies to provide blogs.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## DECISION

9) The only ground of opposition is under section 5(2)(b) which reads:

"5.-(2) A trade mark shall not be registered if because -

(a) .....

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

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

10) An "earlier trade mark" is defined in section 6, the relevant part of which states:

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

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

11) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The applicant requested that the opponent provide proof of use, however, given the interplay between the date that the opponent's mark was registered (16 June 2014) and the date that the applicant's mark was published (15 May 2015), the proof of use requirement does not bite.

12) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

- (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.

### **The average consumer and the nature of the purchasing decision**

13) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. 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.”

14) The applicant’s services are for an informative blog, initially on financial issues, which would be found on the internet and thus the visual aspect will be the most important element in selection although I must also consider aural issues as the blog maybe recommended during a conversation. When seeking information regarding financial matters the average consumer is likely to take some care as to where and from whom this information is provided even when the service is free. The opponent offers financial advice and services which cover, inter alia, insurance, pensions, investments and mortgages. I believe that most consumers seeking such services will initially use the internet to search for providers, or they may encounter an advertisement in a printed publication or on-line so again, the visual aspects will be the most important. However, I must also take into account the possibility of word of mouth recommendations and so aural considerations must be considered. In selecting a provider of financial information or taking out a pension or mortgage the average consumer would, in my opinion, take considerable care as potentially large sums of money are involved.

### **Comparison of services**

15) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

16) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

18) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

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

19) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

20) The services of the two parties are:

Applicant's services	Opponent's services
Class 41: Writing services blog.	Class 36: Independent Financial Advice, online portal for life insurance, life assurance, pensions, investments, annuities, mortgages, online portal for money and financial aggregation.



21) The applicant has stated that his blog will initially focus upon financial information as this is his area of expertise. I accept the contention of the opponent that providers of financial advice, insurance, pensions, mortgages and investments also tend to provide information free to the general public in addition to their own customers, and it is commonly known that this may be done through e.g. a blog or a newsletter. It is a form of advertising in that by providing general information under a topic they can then state that should you wish to avail yourself of a pension/mortgage etc. they have the expertise to provide you with the service best suited to your needs. **To my mind, the services are complementary to at least a low degree.**

## Comparison of trade marks

22) 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 them, bearing in mind their distinctive and dominant components. The CJEU 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.”

23) It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
	

24) The word CONTINUUM has a standard meaning of “A continuous series or whole, no part of which is perceptively different from the adjacent parts”. This does not appear to have any meaning for the services offered by either party. The applicant contends that the opponent uses a word with three letter “U”s and so this is not a dictionary word. He contrasts this with his use of the dictionary word and states that the marks are different. I do not accept this contention. The opponent’s mark uses a device of a different colour letter “U” which is “behind” and overlapping the two letter “U”s in the word. In joining the letter “U”s it forms a continuous series or whole, thus emphasising the word. To my mind, both marks have as their main dominant element the word “CONTINUUM”. Whilst the opponent’s mark has a strapline underneath of five words “YOUR FINANCIAL FUTURE MADE REAL” in much smaller case, this merely alludes to the services provided. Similarly, the word “FINANCIAL” in the applicant’s mark alludes to the subject matter of his blog. The whole of the applicant’s mark appear in the opponent’s mark. In my opinion there is at least a medium degree of similarity.

## Distinctive character of the earlier trade mark

25) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 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 *Windsurfing Chiemsee 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).”

26) The opponent’s mark consists of the first and most obvious word “CONTINUUM” (albeit slightly stylised) and a strapline. Whilst the strapline alludes to the services for which the mark is registered the dominant and distinctive element “CONTINUUM” has no meaning in respect of the services for which it is registered. The mark is inherently distinctive to a medium to high degree. The opponent has not shown use of its mark and so cannot benefit from enhanced distinctiveness.

### **Likelihood of confusion**

27) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the services by predominantly visual means, although not discounting aural considerations and that they will pay a medium to high degree of attention to the selection of such items.
- the services of the two parties are complementary to at least a low degree.
- the marks of the two parties are similar to at least a medium degree.
- the opponent’s mark has a medium to high degree of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.

28) It is easy to envisage a situation whereby an average consumer needing financial advice whilst contemplating a mortgage, pension or insurance would initially seek general information, knowing that most providers offer broad information with the caveat that they will provide specific advice tailored to the individuals needs and situation. In view of this and the above, and allowing for the concept of



imperfect recollection, there is a likelihood of consumers being confused into believing that the services applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in full.**

## **CONCLUSION**

29) As the opposition has been completely successful the application will be refused.

## **COSTS**

30) As the opponent has been successful it is entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering the other side's evidence	£500
Preparing submissions	£200
<b>TOTAL</b>	<b>£1200</b>

31) I order Stephen Clive Underwood to pay Continuum (Marketing) Ltd the sum of £1200. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16th day of August 2016**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**