

**O-041-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3162004  
BY PROVIDENT FINANCIAL PLC  
TO REGISTER THE TRADE MARK**

**NORTH STAR**

**IN CLASSES 9, 16, 35 AND 36**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600000466  
BY HARVEY BAINBRIDGE**

## **Background and pleadings**

1. On 28 April 2016, Provident Financial plc (“the applicant”) applied to register the trade mark **NORTH STAR** for a range of goods and services in classes 9, 16, 35 and 36.
2. The application was published for opposition purposes on 27 May 2016. It is opposed by Harvey Bainbridge (“the opponent”) under the fast-track opposition procedure.
3. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). There is some inconsistency in the notice of opposition as to whether the opposition is directed against all of the goods and services in the application or only class 36. However, Mr Bainbridge states in his written submissions that “[the opposition] has been filed to protect against conflict that may arise from use in Class 36. No objection is being raised in respect of use elsewhere”.<sup>1</sup> Consequently, I proceed on the basis that the opposition is directed against the following services only:

Class 36      Financial services; banking services; loan and credit services; hire purchase and lease purchase finance; charge card and credit card services; debit card services; cash card services; debt collection and debt factoring services; instalment loan financing; electronic funds transfer and cash dispensing services; electronic payment services; electronic wallet services; processing of payments made through software applications; issuing statements of accounts; savings account and bank services; insurance services; debt management services; credit management services; bill payment services; tokenization; issuing of tokens of value in relation to customer loyalty schemes; information and advisory services relating to all the aforesaid.

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<sup>1</sup> Paragraph 1.

4. Mr Bainbridge relies upon his UK trade mark registration number 2531959 for the trade mark shown below, which was applied for on 17 November 2009 and for which the registration procedure was completed on 26 February 2010:



5. Mr Bainbridge relies upon all of the services for which the mark is registered, namely:

Class 36 The provision of independent financial advice and financial consultancy services.

6. In his notice of opposition, Mr Bainbridge states that he has used his mark in relation to all of the services relied upon. This statement is made because the earlier mark is subject to the proof of use provisions contained in section 6A of the Act. According to section 6A of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied-for mark. The relevant period is, therefore, 28 May 2011 to 27 May 2016.

7. The applicant filed a counterstatement denying the grounds of opposition.

8. Rules 20(1)-(3) of the Trade Marks Rules ("TMR") (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

9. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.

10. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Both parties filed written submissions, which I have read carefully and will refer to, as necessary, below.

11. The applicant has been professionally represented throughout by Walker Morris LLP; Mr Bainbridge represents himself.

### **Evidence**

12. This being a fast-track opposition, Mr Bainbridge’s evidence is not filed in the usual format of a witness statement with exhibits; rather, it consists of responses to a series of questions on the form TM7F, to which Mr Bainbridge has attached six exhibits. The evidence is verified by a statement of truth, signed by Mr Bainbridge, on the form itself.

13. Question 8 of the form asks the opponent to provide “details of the number of sales achieved under the mark in the UK during the relevant period”. In response, Mr Bainbridge states:

“TURNOVER FIGURES

07/8 £80,364

08/9 £58,113

09/10 £41,925  
10/11 £120,043  
12/13 £221,689  
13/14 £148,088  
14/15 £62,769”.

14. Exhibit 1 is a leaflet entitled “The benefits of diversification” and discusses building a financial portfolio. There are references to UK and US government bonds (p. 2), as well as to investors diversifying UK equities “by simply investing in foreign markets” (p. 4). The leaflet is not dated but refers to regulation by the Financial Conduct Authority (“FCA”) at p.4. A UK contact address is shown on the same page. The leaflet is said to be taken from [www.nsifa.co.uk](http://www.nsifa.co.uk), [www.nsifa.com](http://www.nsifa.com) and [northstarfinancialconsultants.co.uk](http://northstarfinancialconsultants.co.uk). The mark is shown at the top of each page in the following form:



15. Exhibit 2 is said to be headed paper “used on all official and client communications”. Again, it shows a UK address at the bottom of the page and refers to the FCA but it is not dated. The images are not particularly high quality but the mark is shown as follows:



16. Exhibit 3 is said to be a business card which is given to “all clients and contacts” but the evidence appears to be identical to exhibit 2.

17. Exhibit 4 is said to be a business card with a compliment slip. Neither document is dated. The mark is visible on both in the form shown at paragraph 14, above.

18. Exhibit 5 contains information about the “investment philosophy and investment process” of the company. The documents describe the considerations and tools the company uses in providing investment advice and is clearly aimed at potential clients. The mark as shown at paragraph 15, above, is visible at the top of pages 1 and 6. The documents are not dated but, at p. 2, the source of data is given as “Barclays Research 2013”. The exhibit refers to UK equities at pp. 2 and 10, gilts at p. 2 and Stocks and Shares ISAs at p. 11.

19. Exhibit 6 is a copy of the standard client agreement. It states at p. 1 that “North Star is a trading name of North Star Financial Consultants”. Although the representation is poor, the mark is visible at the top of the first page in the form shown at paragraph 15, above. The document refers to the company as offering independent investment advice as well as other financial products such as income protection insurance from a range of insurers. The agreement gives details of the set-up and ongoing charges for the investment services offered in pounds sterling. It also indicates that income from non-investment protection is by way of commission on products (p. 5). The document is not dated but refers at p. 1 to the FCA. The contact address is an address in Lancashire (p. 2).

### **Proof of use**

20. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

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

6A- (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, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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”.

21. Section 100 of the Act is also relevant, which reads:

“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”.

22. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (“*London Taxi*”), Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:



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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic

sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]”.

23. The correct approach to assessing the evidence is to view the picture as a whole, including whether individual exhibits corroborate each other.<sup>2</sup>

#### Sufficient use?

24. In *Awareness Limited v Plymouth City Council*, Case BL O/230/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

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<sup>2</sup> See the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Brandconcern BV v Scooters India Limited* (“*Lambretta*”) BL O/065/14.

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public”.

25. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that

person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use”.

26. The applicant submits that:

“13. [...] whilst the Opponent has provided turnover figures in the Notice of Opposition, no formal evidence of sales in the form of invoices or similar have been provided. Given that the Opponent claims to have had an average turnover of around £102,000, he should have been able to produce at least one invoice to prove the figures provided.

14. No other independent or dated evidence has been provided by the Opponent to prove that the mark [...] has been used by him, or with his consent, in relation to the services covered by the registration within the relevant period”.

27. The evidence filed by the opponent is thin. None of the exhibits provided by Mr Bainbridge is dated. The form TM7F contains a note at question 6 that “[i]f you cannot provide examples from the relevant period but provide more recent examples instead, you must state clearly whether the mark was used in the same form and in the same ways during the relevant period or in some part of that period”. No statement to that effect has been provided. However, I also take into account that Mr Bainbridge has expressly confirmed, at question 8 of the form TM7F, the turnover achieved under the mark in the relevant period and that he gives figures as far back as 2007/2008. He states that he is the director of the company and he ought, therefore, to be well placed to provide accurate information of this type. I acknowledge that that argument cuts both ways: the applicant’s criticisms regarding the lack of invoices or other hard evidence are not without foundation. However, the applicant has not challenged the evidence of turnover under the mark by way of its own evidence or with cross-examination. As is clear from the case law cited above, it is not fatal to Mr Bainbridge’s case that he has not provided a particular type of documentation to support his claim. It is a matter of fact that the FCA came into being on 1 April 2013. As exhibits 1, 2 and 6 all make reference to that body, they cannot be dated before 2013, though they may post-date the relevant period. The same inference can be made about the date of exhibit 5, which includes data said to be dated 2013.

28. Although I have no evidence or submissions regarding the size of the market for financial advice and services, it is likely to be vast. Having said that, it does not strike me as atypical of the market that independent financial advice is offered by sole traders or small businesses whose turnover is modest in comparison to the total worth of the sector.

29. The repeated references to the FCA suggest that the opponent is operating in the UK market, as do the references to UK-specific financial products (i.e. Gilts and UK equities) and the UK contact details. The types of product discussed in the material provided are consistent with the specification of the mark relied upon. Although I recognise the deficiencies in the evidence, taking matters in the round, I am satisfied

that the level of use shown is sufficient to constitute genuine use. I now turn to the issue of the form of the mark under which that use has been effected.

### Form of the mark

30. Under section 6A(4)(a), use of the mark in a variant form is permitted. In considering whether the use of the mark shown in the opponent's evidence is use of an acceptable variant, I note the comments of Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, in *Nirvana Trade Mark* (BL O/262/06) and in *REMUS Trade Mark* (BL O/061/08). He summarised the test under s. 46(2) of the Act as follows (the text is from *Nirvana* but it is also adopted in *REMUS*):

“33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period [...]

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all”.

31. The evidence shows that the mark has been used as follows:



32. In the mark as registered, the left-hand point of the star is surrounded by a faint blue circle. The effect is that of light shining from the point of the star. It is not clear from the evidence whether the form of the mark used includes this blue circle, though I note that the point of the star is less defined. I consider that the overall impression of the mark is dominated by the words “North Star” and the device of half a star. While the blue circle may be noticed, I consider that its role is of less importance and that its omission has no material effect on the distinctive character of the mark.

33. The only other difference is the diagonal line at the bottom right of the mark, which, the evidence shows, separates the mark from the writing space on the documents provided. The fact that the background is not rectangular has no effect on the distinctive character of the mark, given that the main function of the background is to provide a contrast for the white writing and device. I am of the view that the differences between the mark as registered and the mark as used do not alter the distinctive character of the registered mark and that the variant form of use may be relied upon.

34. The mark has also been used in the following form:



35. The words “financial consultants” are entirely descriptive of the services offered and are likely to be given no trade mark significance. The words will be perceived as a separate, descriptive element from the registered mark. I consider that the use shown is use of the mark as registered, upon which the holder may rely.

## Fair specification

36. The next step is to decide whether the opponent's use entitles it to rely on all of the services for which it is registered. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“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. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme



Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46".

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which

those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered”.

38. It is clear from the evidence that the opponent offers advice about a range of financial products and investment options. I consider that the specification on record is a fair reflection of the way in which the services would be described by the average consumer. The opponent may rely on the whole of its specification class 36, namely “the provision of independent financial advice and financial consultancy service”.

## **Section 5(2)(b)**

39. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

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

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

40. 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**

41. When making the comparison, all relevant factors relating to the services in the specification should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the 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”.

42. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- 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.

43. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if specifications are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

44. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] 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”.

45. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating 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”.

46. As far as complementarity is concerned, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC 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”.

47. In *Sanco SA v OHIM*, Case T-249/11, the GC 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 services is to assess whether the relevant public are liable to believe that responsibility for the 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.”

48. 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”.

49. In addition, I bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

50. For the purposes of considering the issue of similarity of the services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

51. Neither party has commented at any length on the similarity between the services at issue. Mr Bainbridge submits that the services offered under his mark “may include



investments but also insurance intermediation and debt counselling”.<sup>3</sup> The applicant, meanwhile, submits that:

“3. [...] an IFA must advise on all suitable products on the market, and give unbiased and unrestricted advice, i.e. they must be genuinely independent of any financial institution.

4. The Applicant holds a bank licence, and sells its own financial products and services. It provides information and advice in relation to its own products and services only”.

52. That may be the case. However, in order to be relevant, any distinctions between the services must be clear from the respective specifications. In the absence of any evidence to assist me in understanding the specifications, I must give the terms their ordinary and natural, or core, meaning.

#### *Financial services*

53. The applicant’s “financial services” includes the opponent’s “provision of independent financial advice and financial consultancy services”. The services are, on the principle outlined in *Meric*, identical.

#### *Banking services; bank services*

54. Banking is the business or services offered by a bank, which is defined in the *Oxford Dictionary of English* as “a financial establishment that uses money deposited by customers for investment, pays it out when required, makes loans at interest, and exchanges currency”.<sup>4</sup> The term is, however, very wide. It would, in my view, include the assessment of the suitability of a range of financial products, such as mortgages, for a

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<sup>3</sup> Submissions, paragraph 5.

<sup>4</sup> <[http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m\\_en\\_gb0059620?rskey=xX8sMB&result=2](http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0059620?rskey=xX8sMB&result=2)> [accessed 18 January 2017].

customer, as well as the provision of information and advice to customers about the variety of financial products offered by the bank. I do, however, take the applicant's point that a bank would ordinarily sell only its own financial products, whereas an independent financial adviser (or consultant) would deal with products offered by third parties.<sup>5</sup>

55. Consultancy" is defined as "a professional practice that gives expert advice within a particular field: [as *modifier*]: a *management consultancy firm*".<sup>6</sup> I have some evidence from Mr Bainbridge which indicates that his firm also offers a range of financial management services but I have no other evidence before me and I cannot say whether those activities are typical of a financial advisory or consultancy business. The core meaning of the opponent's "provision of independent financial advice and financial consultancy services" is that it provides information about a range of financial products, such as stocks and shares, investments and mortgages, and advises on the most appropriate for the customer's requirements. The different financial options discussed may concern the same type of product, or indeed the actual products, offered by a bank. I am not persuaded that the natural meaning of the terms in the opponent's specification includes the management of client funds.

56. There is, therefore, a good degree of overlap in the nature and intended purpose of the services. The users of the respective services are likely to be the same, as will the channels through which the services reach the market. The services are not complementary as defined in the case law; there may be a degree of competition, as the advice of an independent financial adviser may be sought instead of the advisory services of a bank. Overall, I find that there is a high degree of similarity between the applicant's "banking services; bank services" and the services of the earlier mark.

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<sup>5</sup> Submissions, paragraphs 3-4.

<sup>6</sup>[http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m\\_en\\_gb0174330?rskey=Xi33PO&result=1](http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0174330?rskey=Xi33PO&result=1) [accessed 20 January 2017].

### *Insurance services*

57. Insurance services is a very broad term. It would include the provision of appraisal services for assessing the suitability of insurance products, as well as the provision of insurance policies (such as mortgage repayment insurance). As far as the opponent's services are concerned, it would be usual for financial advice to involve consideration of and recommendations about appropriate insurance policies. The services share similarity of purpose and nature, although the opponent's services are necessarily independent of a particular provider. The customers will be the same and the method of use will be identical. The services are not complementary as defined in the case law but they may be competitive. The services are similar to a reasonably high degree.

### *Debt management services; credit management services*

58. Both credit and debt management services involve assessment of an individual's finances and advice as to how best to arrange one's finances. The opponent's services are concerned with providing advice about the management of one's finances, including advice about the management of debt and credit. I consider that the services are identical on the principle outlined in *Meric*.

### *Hire purchase and lease purchase finance*

59. I can see no meaningful similarity between these services and those of the opponent. Although the respective services could be described as financial services, this is a relatively superficial level of similarity. The intended purpose of the services applied for is to provide goods, such as a vehicle, which is hired or leased, with the consumer being given the option to purchase at the end of a fixed period. Their purpose is, therefore, different from that of the opponent's services. The channels of trade and the method of use will differ. The users may be the same, though only superficially, in that they may be members of the public. I acknowledge that the services of the opponent could, in theory, be called upon for advice on the merits of particular schemes

but I do not consider that this would fairly represent the core meaning of the terms in the specification. The services are neither in competition nor complementary. The services are not similar.

*Loan and credit services; instalment loan financing*

60. The intended purpose of these services is to lend money which will be repaid at a later date, usually with interest. That purpose is different from the purpose of financial advice and consultancy services. Although all financial, any similarity in nature between the services is at a high level of generality. The respective services are unlikely to share channels of trade with the services of the earlier mark and their method of use will be different. While the services of an independent financial advisor could, in theory, extend to assessment of loans, the opponent's services are by definition independent of a particular institution and the average consumer is unlikely to think that responsibility for the services lies with the same undertaking: the services are not complementary. There is no meaningful similarity between the services.

*Charge card and credit card services; debit card services; cash card services; cash dispensing services*

61. These services concern the making available of funds to customers enabling the customer to make payments directly from an account, on a credit basis, or to obtain cash. The nature and intended purpose of the services are different from those of the opponent's services and they do not share channels of trade. The users may overlap, at a high level of generality, but that alone is not sufficient for a finding of overall similarity. The method of use of the respective services differs and they are neither in competition nor complementary. The services are not similar.

*Electronic funds transfer; electronic payment services; electronic wallet services; processing of payments made through software applications; bill payment services; tokenization*

62. I have no submissions from the parties on the meaning of “tokenization”. I understand it to be a process related to data security in which sensitive data, such as credit card information, is converted into non-sensitive data or “tokens”. Similarly, I have no submissions to explain “electronic wallet services”. Again, I understand these to relate to software which enables electronic payment, potentially but not necessarily by using specific connected hardware. All of these services are concerned with facilitating the electronic movement of money. I can see no meaningful similarity with the opponent’s services. The purpose, as well as the method of use and channels of trade of the services, all differ. There is neither a competitive nor a complementary relationship. The services are not similar.

*Debt collection and debt factoring services*

63. These services are concerned with the recovery of debt, including for profit following the purchase of debt. Their purpose is different from the purpose of the opponent’s services and there is no similarity between the respective services’ channels of trade or method of use. The users are likely to be different and there is neither competition nor complementarity between the services. The services are not similar.

*Issuing statements of accounts; savings account services*

64. These services involve the provision of accounts and the process of producing statements for customers. As I indicated, above, I have no evidence to support the contention that the opponent’s services ordinarily involve the management of funds, as distinct from the provision of advice and information about financial matters. That being the case, the purpose of the opponent’s services differs from that of the services applied for. The channels of trade are not the same, nor are the methods of use. While the

users may coincide, the services are not in competition, nor are they complementary. The services are not similar.

*Issuing of tokens of value in relation to customer loyalty schemes*

65. I can see no meaningful similarity between these services and those of the opponent. The nature, purpose, method of use and channels of trade are all different. Although the users may coincide at a high level of generality, that is insufficient to establish overall similarity. There is no competition and no complementarity between the services. The services are not similar.

*Information and advisory services relating to all the aforesaid.*

66. I have found that “financial services; banking services; bank services; insurance services; debt management services; credit management services” are identical or similar to the services in the earlier specification. “Information and advisory services relating to all the aforesaid” are similar to these services, insofar as they relate to the services I have found to be identical or similar.

67. I have found that “hire purchase and lease purchase finance; loan and credit services; instalment loan financing; charge card and credit card services; debit card services; cash card services; cash dispensing services; electronic funds transfer; electronic payment services; electronic wallet services; processing of payments made through software applications; bill payment services; tokenization; debt collection and debt factoring services; issuing statements of accounts; savings account services; issuing of tokens of value in relation to customer loyalty schemes” in the application are not similar to the services in the earlier mark. It follows that the information and advisory services related to these activities, whatever their method of delivery, are a step further removed from the opponent’s services. There is no similarity between these services and those of the opponent.

68. In view of my findings regarding the similarity of the parties' services, the opposition against "hire purchase and lease purchase finance; loan and credit services; instalment loan financing; charge card and credit card services; debit card services; cash card services; cash dispensing services; electronic funds transfer; electronic payment services; electronic wallet services; processing of payments made through software applications; bill payment services; tokenization; debt collection and debt factoring services; issuing statements of accounts; issuing of tokens of value in relation to customer loyalty schemes; information and advisory services relating to all the aforesaid" is hereby dismissed.<sup>7</sup>

69. In relation to the applied-for "banking services; bank services; debt management services; credit management services; insurance services; information and advisory services relating to all the aforesaid", I note that the applicant's specification is very wide and could, in theory, include services which are not similar to the services covered by the earlier specification. I will return to this point when I consider the likelihood of confusion.

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

70. 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 services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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

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<sup>7</sup> If the goods/services are not similar, there can be no likelihood of confusion. See, for example, *Waterford Wedgwood plc v OHIM*, C-398/07 P (CJEU).

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”.

71. There is no need for me to consider the average consumer for the services which I have found to be dissimilar. The average consumer will be either a business professional or a member of the general public. Both groups of average consumer will take care in selecting the services, though the process is likely to be more complex and involved for the business professional. The services associated with large amounts of money or long-term business and financial decisions will be chosen with a high amount of care, whilst the level of attention will be lower for transactions with less financial or long-term impact. Overall, the average consumer is likely to pay a reasonably high degree of attention in selecting the services.

72. The purchasing process is likely to be primarily visual, with the parties’ services being purchased after the marks are seen on websites, in advertisements, in newspaper and journal articles and reports, and on the signage of premises. However, I also recognise that there is the potential for the marks to be encountered aurally, through use over the telephone or in oral recommendations.

### **Comparison of trade marks**


73. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, 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”.

74. 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 the marks.

75. The trade marks to be compared are as follows:

<b>Opponent’s trade mark</b>	<b>Applicant’s trade mark</b>
	<b>NORTH STAR</b>

76. Neither party has made specific submissions regarding the similarity between the marks. The earlier figurative mark consists of the words “North Star” in title case, in white on a black background. To the left of the word is the outline, in white, of half of a five-pointed star. The left-hand tip of the star is emphasised in white and is surrounded by a blue circle, giving the impression that light is emanating from the tip of the star. The

words “North Star” form a unit which will be seen as one element of the mark. I consider that the words and the star device make a roughly equal contribution to the mark. The blue colour and the white-on-black presentation play weaker roles.

77. The applicant’s mark is a word-only mark consisting of the words “NORTH STAR” in capital letters. Neither word dominates; as they readily form a phrase, the words will be read as a unit. There are no other elements to contribute to the overall impression.

78. Both marks share the same words “North Star”/“NORTH STAR”, though there is a clear visual difference between the marks because of the device in the earlier mark. Bearing in mind my assessment of the overall impression, I find that there is a medium degree of visual similarity.

79. The device in the earlier mark will not be articulated. Both words will be pronounced in the usual way, in both marks. The marks are, as a consequence, aurally identical.

80. The average consumer may know as a fact that there is a star named the North Star. Alternatively, the average consumer may assume that is the case, without any specific knowledge to that effect, or s/he may surmise that the star in question has something to do with the north. Whichever concept is attributed to the words “North Star”/ “NORTH STAR” is as likely to be given to the same words in the other mark. The device in the earlier mark reinforces the concept of a star but does not add or alter that meaning. The marks are conceptually identical.

### **Distinctive character of the earlier trade mark**

81. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment

of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *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-2779, 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)”.

82. Invented words usually have the highest degree of inherent distinctive character; words which are descriptive of the services relied upon normally have the lowest. The earlier mark consists of two dictionary words and a device. It is neither descriptive nor

allusive of the opponent's services. I consider that the earlier mark has an average degree of inherent distinctive character, no higher or lower than the norm.

83. Mr Bainbridge has not made the specific claim that his mark has an enhanced level of distinctive character. Whilst some evidence of turnover has been provided, I have no figures to show the size of the market in the services at issue or the market share enjoyed by the services sold under the earlier mark. On the basis of the evidence provided, I am not in a position to determine that the earlier mark has an enhanced distinctive character in relation to services in class 36.

### **Likelihood of confusion**

84. 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 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 bear 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, relying instead upon the imperfect picture of them he has retained in his mind.

85. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related. In terms of the former, although both marks contain the words "North Star"/"NORTH STAR", the device of a star in the opponent's mark is an element that will be recalled or remembered by the consumer. I consider that the difference created by the

device is sufficient that the consumer will not simply mistake one mark for the other and, consequently, that there is no risk of direct confusion.

86. Indirect confusion was described in the following terms by Iain Purvis, Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example”).

87. I note that the categories identified by Mr Purvis are not exhaustive.<sup>8</sup> Undoubtedly, there are difference between the marks. However, the words “North Star”/ “NORTH STAR”, present in both marks, will convey an identical conceptual message. That message is not altered by the presence of a device, nor by the presentational differences between the marks. I find that, notwithstanding the other elements in the earlier mark, the words “North Star”/ “NORTH STAR” are likely to fix themselves in the average consumer’s mind and will act as an important hook in prompting the average consumer’s recall of the competing trade marks. Even when considering the applied-for services which are similar to no more than a reasonably high degree to the opponent’s services, and in circumstances where a reasonably high degree of attention is paid to the purchase, this conceptual hook is likely to lead the average consumer to assume that the undertakings are the same or economically linked. I consider that there will be an expectation on the part of the average consumer that all of the services at issue come from the same or economically linked undertakings. There is a likelihood of indirect confusion.

## **Conclusion**

88. The opposition has succeeded in respect of the following services, for which the application is refused:

Class 36      Financial services; banking services; bank services; insurance services; debt management services; credit management services; information and advisory services relating to all the aforesaid.

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<sup>8</sup> *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at [29]

89. The application will proceed to registration for the following services:

Class 36      Loan and credit services; hire purchase and lease purchase finance; charge card and credit card services; debit card services; cash card services; debt collection and debt factoring services; instalment loan financing; electronic funds transfer and cash dispensing services; electronic payment services; electronic wallet services; processing of payments made through software applications; issuing statements of accounts; savings account services; bill payment services; tokenization; issuing of tokens of value in relation to customer loyalty schemes; information and advisory services relating to all the aforesaid.

90. I indicated at paragraph 69 that the specification applied for covers a wide range of services, some of which are likely to be dissimilar to the services covered by the earlier mark. Given that the application is to be refused in part, paragraph 3.2.2 of Tribunal Practice Notice ("TPN") 1/2011 applies. It states:

"In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing

Officer will take that rewording into account and the proposed wording being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer will indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services".

91. This practice reflects the comments of Mann J in *Giorgio Armani SpA v Sunrich Clothing Ltd* [2010] EWHC 2939 (Ch) in relation to partial refusals of registration. He stated that:

"[...] the proper scope of registration [...] is the [potential area of dispute]. In some cases it will not be a real area of dispute because the answer is obvious - it might be possible to isolate the permissible part by blue pencilling



that which is not admissible, or it might be obvious that a plain express qualification ("save for [the goods in respect of which the opposition succeeded]") will do the trick, in which case there is no real area of dispute there either. On the other hand, it might be that the answer to that part of the case is more disputed - particular formulations might be objected to as falling on one side of the line or the other. Procedures ought to allow for all these possibilities".

92. The tribunal wrote to the parties on 3 November 2016 and advised the applicant that a fall-back specification would be considered if it were provided. The applicant's email dated 5 December 2016 indicated the services which it wished to be considered as part of a fall-back specification. However, while some terms have been removed, the list of services specified reiterates the services in the original specification. I have already considered the similarity of those services and made my findings in relation to the likelihood of confusion. As far as the services which I have found to be similar or identical are concerned, there is nothing in the parties' submissions to suggest that the applicant's interest lies in services which are materially different from the services covered by the earlier mark. In such circumstances, I do not consider it appropriate to provide the applicant with a further opportunity to consider the position.

### **Costs**

93. The applicant has retained a number of terms in its specification but Mr Bainbridge has succeeded in relation to the broadest terms. Both parties having achieved a roughly equal measure of success, I direct that the parties bear their own costs.

**Dated this 1<sup>st</sup> day of February 2017**



**Heather Harrison  
For the Registrar**

## **The Comptroller-General**