

O-477-17

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3170531
BY AXIS BANK LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 36:**



AND

OPPOSITION THERETO (NO. 407338) BY ALBINGIA, SOCIETE ANONYME

Background and pleadings

1. These opposition proceedings are brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on just one earlier mark ¹. Consequently, the dispute boils down to whether there is a likelihood of confusion between the following marks:

<p><u>The applicant’s (Axis Bank Limited) mark</u></p> <p>Application no. 3170531, which was filed on 20 June 2016 and published for opposition purposes on 8 July 2016.</p>	<p><u>The opponent’s (Albingia, societe anonyme) mark</u></p> <p>International Registration (“IR”) 1056950, which designated the EU for protection on 8 October 2010, with protection being granted on 4 October 2011.</p>
	
<p>Class 36: Financial services; banking services; financial and banking services provided via the Internet; monetary affairs; financial management; real estate affairs; capital investment; venture capital investment; investment of capital and funds; asset management investment; management of investment; acquisition for financial investment; administration of capital investments, fund investments and other financial investments; financial investment services; fund investment services;</p>	<p>Class 36: Insurance, consulting and information concerning insurance including risk analysis; financial affairs; banking, monetary affairs, real estate affairs.</p> <p>The colours black, red and pink are claimed as an element of the mark, with the register containing a further explanation about colour reading:</p> <p>“The word ALBINGIA is in black; the letter "A" and the words "VOUS</p>

¹ A further earlier mark was initially pleaded, but the opponent subsequently withdrew reliance on it.

<p>administration of funds and investments; hedge fund services; capital investments; capital fund management; financial analysis; financial consultancy; financial management; fund investments; financial investment fund services; international fund investment; financial fund management; mutual funds; mutual fund establishment; mutual fund investment; mutual fund management; stock exchange quotations; brokerage; stocks and bonds brokerage; surety services; corporate funds management; information, advisory and consultancy services relating to all the aforesaid; information, advisory, and consultancy services relating to all the aforesaid provided on-line from a computer database or the Internet.</p>	<p>"ASSURER AVEC TALENT" are written in shaded tones that go from red on the left to pink on the right."</p>
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2. The opponent considers that the applicant's mark is "clearly and readily identifiable" as a capital letter A and that it is essentially a mirror image of, and virtually identical to, the stylised letter A in its mark. It is stated that the letter A in the opponent's mark is a dominant element, is above average distinctiveness (in fact, it is stated that it is highly distinctive) and that it plays an independent distinctive role. It is stated that the services are identical or highly similar and there exists a likelihood of confusion. Various earlier cases are referred to involving conflicts between elements of composite marks with the composite whole². Given the date on which protection was granted to the earlier mark, the proof of use provisions are not applicable, with the consequence that the opponent is able to rely on all of its services.

² I do not summarise these as this case must be decided on its own merits - previous assessments made in relation to different marks is unlikely to be of assistance.

3. The applicant filed a counterstatement denying the ground of opposition. Neither side filed evidence, although both filed written submissions of which I take account, but will not separately summarise. A hearing took place before me on 15 September 2017 at which the applicant was represented by Mr Jaani Riordan, of counsel, instructed by Bristow's LLP and at which the opponent was represented by Mr Benjamin Longstaff, also of counsel, instructed by Barker Brettell LLP.

Section 5(2)(b)

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

“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.”

5. The following principles are gleaned from the judgments 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 greater 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

6. Identity can be held if one term falls within the ambit of another (or vice versa), as per the decision in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”):

“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 für 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”.

7. The applicant seeks registration for a range of services in class 36, as follows:

Financial services; banking services; financial and banking services provided via the Internet; monetary affairs; financial management; real estate affairs; capital investment; venture capital investment; investment of capital and funds; asset management investment; management of investment; acquisition for financial investment; administration of capital investments, fund investments and other financial investments; financial investment services; fund investment services; administration of funds and investments; hedge fund services; capital investments; capital fund management; financial analysis; financial consultancy; financial management; fund investments; financial investment fund services; international fund investment; financial fund management; mutual funds; mutual fund establishment; mutual fund investment; mutual fund management; stock exchange quotations; brokerage; stocks and bonds brokerage; surety services; corporate funds management; information, advisory and consultancy services relating to all the aforesaid; information,

advisory, and consultancy services relating to all the aforesaid provided on-line from a computer database or the Internet.

8. The opponent's earlier mark is protected in respect of the following class 36 services:

Insurance, consulting and information concerning insurance including risk analysis; financial affairs; banking, monetary affairs, real estate affairs.

9. Whilst the opponent's specification covers specific terms such as insurance, it also covers some terms which, on the face of it, appear quite broad: financial affairs, monetary affairs, banking and real estate affairs. In order to understand what terms used in specifications mean/cover, the case-law informs me that "in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade"³ and I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁴. I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

"..... 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) (IPTRANSLATOR)* [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

³ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁴ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

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.”

10. Mr Riordan referred to the decision of Jacob J in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 where he stated:

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.”

11. Mr Riordan’s accompanying submission was that the terms in question should not be given a wide construction and must instead be construed as limited to their core meanings. Whilst I note the guidance, it is clear from *YouView* that the language should not be strained to produce an artificially narrow interpretation.

12. Mr Riordan also submitted that the terms should be given their literal meanings because even though the specification incorporated the class heading, no declaration had been made that the specification was intended to cover everything in the class. I do not consider it is necessary to deal with this submission in detail because there was nothing in Mr Longstaff’s submissions that indicated that he was relying on anything other than the literal meanings of the terms in the specification. His submissions were based on the applied for terms falling within the ambit of those of the opponent. He also referred to a decision of the EUIPO between the same parties involving the same applied for mark, but one which was opposed on the basis of a French registration comprising only the stylised letter A from the earlier mark. In that decision, the services were found to be identical on the inclusion basis.

13. Mr Riordan identified five categories in which he said the applicant’s services fell: i) specific investment services, ii) corporate and capital fund management, iii) services relating to stocks and bonds, iv) general banking services and v) online information and consultancy relating to the aforesaid. Whilst I do not necessarily disagree with his categorisation, it is important in a case such as this to not lose sight of the exact terms

under consideration. For this reason, I will look at each term in turn, albeit grouping them when it is reasonable to do so.

Financial services; banking services; financial and banking services provided via the Internet

14. The opponent's specification lists "banking", thus, there can be no doubt that the two references to banking services are identical. Further, there can be no doubt that banking is a financial service. The significance of this is that according to *Meric* the inclusion principle relates not just to the terms of the latter mark falling within the ambit of something in the earlier mark, but it also operates in reverse, thus, the applied for financial services may be considered identical to the earlier banking service.

15. In any event, the opponent's specification also lists "financial affairs". Financial affairs must be construed as services (of various types) relating to the financial affairs of individuals, business or organisations. Thus, in essence, the services are no different to the applied for "financial services" and I consider them to be identical.

16. All of the above terms are identical.

Monetary affairs

17. The opponent's specification lists "monetary affairs" so there can be no doubt that the services are identical.

Real estate affairs

18. The opponent's specification lists "real estate affairs" so there can be no doubt that the services are identical.

Financial management (listed twice); financial analysis; financial consultancy

19. At paragraph 15 I touched on the meaning of "financial affairs" covered by the opponent's specification. As I have said, it will cover various services relating to the

financial affairs of people, businesses and organisations. Such “affairs” would clearly include management of, and consultancy in relation to, their finances and would also include any analysis undertaken in support. I consider all of the above terms to fall within the ambit of financial affairs and that the terms are, therefore, identical. If they are not identical then they must be similar (given the nature, purpose and channels of trade) to financial affairs to a very high degree.

Stock exchange quotations; brokerage; stocks and bonds brokerage

20. These services are offered to both individuals and businesses for the purpose of investing in financial markets (specifically stocks and bonds) in order to make a financial gain. They clearly form part of the financial affairs of people who wish to engage in such activity and fall, in my view, within the ambit of the term “financial affairs”. They are also likely to fall within the ambit of “banking” which covers not just the traditional banking (holding) of money for an individual or business, but also services typically offered by a bank of which the above terms are some. I consider the above terms to be identical on these two bases alone. If they are not identical then they must be similar (given the nature, purpose and channels of trade) to financial affairs to a very high degree.

Capital investment; venture capital investment; investment of capital and funds; asset management investment; management of investment; acquisition for financial investment; administration of capital investments, fund investments and other financial investments; financial investment services; fund investment services; administration of funds and investments; hedge fund services; capital investments; capital fund management; fund investments; financial investment fund services; international fund investment; financial fund management; mutual funds; mutual fund establishment; mutual fund investment; mutual fund management; corporate funds management; surety services

21. These are the services categorised by Mr Riordan as various investment services and corporate/capital fund management services. Whilst I accept that such services are aimed more at businesses and other organisations as opposed to the general public, they are still clearly concerned with the financial affairs of such entities. They

are, thus, one of a range of services offered which relate to the financial affairs of a business and other organisations, and I consider that they fall within the term “financial affairs”. If they are not identical then they must be similar (given the nature, purpose and channels of trade) to financial affairs to a very high degree.

Information, advisory and consultancy services relating to all the aforesaid; information, advisory, and consultancy services relating to all the aforesaid provided on-line from a computer database or the Internet.

22. Although these terms relate to the “aforesaid” (the terms assessed already), there is no reason why they similarly cannot fall within the ambit of the terms on which I have based my findings. I consider that these information/advisory/consultancy services are to be found identical on the same basis as the relevant aforesaid services.

23. In reaching the above findings I have not ignored the submission made by Mr Riordan based upon the explanatory note given by the WIPO in the Nice Classification (11th Edition), which reads:

“Explanatory Note

Class 36 includes mainly services rendered in financial and monetary affairs and services rendered in relation to insurance contracts of all kinds.

This Class includes, in particular:

-services relating to financial or monetary affairs comprise the following:

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1. services of all the banking establishments, or institutions connected with them such as exchange brokers or clearing services;
 2. services of credit institutions other than banks such as co-operative credit associations, individual financial companies, lenders, etc.;
 3. services of "investment trusts," of holding companies;
 4. services of brokers dealing in shares and property;
 5. services connected with monetary affairs vouched for by trustees;

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6. services rendered in connection with the issue of travellers' cheques and letters of credit;
- hire- or lease-purchase financing;
- services of realty administrators of buildings, i.e., services of letting or valuation, or financing;
- services dealing with insurance such as services rendered by agents or brokers engaged in insurance, services rendered to insured, and insurance underwriting services.”

24. The point being made was that only certain services were listed as comprising financial and monetary affairs, services which did not necessarily include the applied for services, particularly the investment and corporate/capital management services. However, I must also take into account what WIPO says in relation to such indications, which read:

“The indications of goods or services appearing in the class headings are general indications relating to the fields to which, in principle, the goods or services belong”

25. Thus, I cannot take the indications given as being exhaustive of what the literal terms cover. It is up to the tribunal in this case to determine, based on the case-law referred to above, what said terms cover. In any event, and as Mr Longstaff submitted, those general indications do in fact cover services such as investment trusts. They also list services such as share brokerage, services of all the banking establishments and connected institutions and credit institutions.

Average consumer and the purchasing act

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

27. Given that the services are identical, this means that the same average consumer(s) is/are applicable to both parties. The average consumer for the majority of the services could, in my view, be a member of the public or a business. For some of the services, such as corporate/investment fund management and certain of the investment services, the business user is more applicable. There is no dispute that the degree of care and attention used by either average consumer is likely to be higher than the norm. This is understandable because the services all involve, generally speaking, people’s money/finances, so the choice of where to put it/invest it etc, is important.

28. Mr Longstaff put the degree of care and attention at quite high, borrowing a finding from the decision of the EUIPO as referred to earlier. Mr Riordan submitted that the degree of care and attention was higher than the norm, but, further, that some of the services in question were very specialised, purchased by sophisticated and institutional investors, with the result that such average consumers would exercise a “particularly high degree of care”. I accept Mr Riordan’s general point that some of the services will be selected with a greater degree of care than the others, albeit, they will all be selected with a degree of care higher than the norm. However, putting that at a “particularly high degree” may be overstating things, I would just say that for some of the investment/corporate fund management services, a high degree of care and consideration is likely to be in play.

29. The marks will be encountered visually on brochures, websites, visual media advertisements and signage etc. However, the aural impact should not be ignored because, as Mr Riordan submitted, the services could be accessed over the telephone as well. I note two further points submitted by Mr Riordan. First, he stated that the level of care being exercised meant that the potential customer would seek out detailed information about the provider of the services before purchasing them which would mitigate against confusion. Whilst I understand the point, but this may be taking things too far. As Mr Longstaff submitted, there is no evidence showing that the services in question are typically subject to lengthy due diligence checks relating to the exact identity of the service provider. Second, Mr Riordan submitted that when encountering the marks, the average consumer would always do so in context, namely, that other signs would no doubt be used in conjunction with the contested mark. In his skeleton argument he even depicted the contested mark along with the words AXIS BANK (the applicant's trading name) to illustrate how this may avoid confusion. I indicated at the hearing that it was the notional use of the mark applied for that must be considered and that it should not be a factor in the applicant's favour that they actually use the contested mark in a manner which may (and I stress the word "may") reduce the likelihood of confusion.

Comparison of marks

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

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



32. In terms of overall impression, the applicant’s mark has just one element, so that is the only thing which contributes to its overall impression. On the other hand, the opponent’s mark has a number of elements. It is a true composite mark. Mr Longstaff submitted that the stylised A element was the dominant element on account of it being positioned at the top of the mark and comprising large, bold shapes, in contrast to the lowercase and “lightweight” word albingia; the French strapline, it was submitted, has even less weight. He submitted that it was the stylised A that strikes the eye and would be retained in the memory. Mr Riordan submitted that the word albingia was the dominant element. It was submitted that this word was the central and most distinctive element, presented in large clear letters. He also focused on the relative distinctiveness of this element compared to the stylised A, arguing that it was the word albingia that, as put in his skeleton:

“performed substantially all the work in discharging the essential origin function of the Earlier mark; it is the clear focus of attention, which overwhelms the abstract graphical representation of the letter A”.

33. Beyond the two elements focused on above, there is one further element, the words “vous assurer avec talent”. This element is significantly smaller and has much

less impact than the other two elements. Some consumers will barely notice it all. Although I would not go so far to say that it is completely negligible, the contribution it makes to the overall impression of the mark is limited. That then leaves the two elements about which most discussion was made. In terms of the relative distinctiveness point, whilst I would not go so far as to say that relative distinctiveness could never be an issue in a case such as this, one must be careful not to overplay its significance. I say this because in the opponent's mark, both the word albingia and the stylised letter A are, in my view, elements which both have at least an average level of distinctiveness (even if the A is seen as the initial letter of the word). Even if albingia may be more distinctive, it does not follow that the word will overwhelm the other element(s) of the mark. One needs to consider the matters in the round, including the visual impact the elements make. Notwithstanding the submissions made, it is difficult to draw much of a line, if any, between the two elements on this basis. Of course, it is not necessary to find in every case that a particular element dominates a mark. One is simply looking at the overall impression of the mark and the relative weight that components have within it. It seems to me that the two main elements make a roughly equal contribution to the overall impression of the mark. Both are dominant (and distinctive) elements, but neither materially dominates the other.

34. In terms of the visual comparison, Mr Longstaff focused on the similarities between the applicant's mark and the stylised letter A in the opponent's marks. He said that whilst there may be slight differences between them, they were barely noticeable. He felt that this equated to a high degree of visual similarity between the marks. Mr Riordan submitted that Mr Longstaff was guilty of not comparing the marks in their totalities. He submitted that as the word albingia was absent, coupled with the difference between the stylised letter A and the applicant's mark (and that the latter would not even be seen as an A) meant that the overall visual impressions were substantially different. In my view, there is a clear point of similarity and a clear point of difference, for what are very obvious reasons (the presence of a highly similar stylised component/the absence of the word albingia). The additional absence of the French strapline does little to further distance the marks. Furthermore, the differences in the exact geometric configuration of the stylised A and the applicant's mark, whilst accepting that there are differences, do not in my view stand out significantly. Weighing all of this, I conclude that there is a medium degree of visual similarity

between the marks. That I have found some visual similarity on the basis explained does not mean that I have ignored the whole mark comparison. It is simply the case that the similarity that exists between the applicant's mark and the component of the opponent's mark will clearly strike the eye, particularly bearing in mind my assessment of the overall impression of the mark.

35. Aurally, Mr Riordan submitted that there was no aural similarity. He argued that the opponent's mark would be articulated only on the basis of the word albingia, whereas the applicant's mark would not be articulated at all, as it would not, in his submission, even be seen as a letter A. In his skeleton Mr Longstaff submitted that there is aural similarity on the basis that the opponent's mark may be articulated (at least in part) on the basis of the A, particularly bearing in mind the earlier submission that this was the dominant element. He also submitted that the applicant's mark may be articulated as an A even without a cue for it to be perceived in such a way, he argued that it was still discernable.

36. I agree with Mr Riordan that the opponent's mark will most probably be articulated solely upon the basis of the word albingia. If this is so, this results in there being no aural similarity with the applicant's mark which will be articulated as the letter A, or, not at all if the letter A is not even discerned, as will be the case with a large proportion of consumers. Of course, the relevant public does not always perceive a mark in a single way as noted in *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290 where Floyd L.J. summed up the Court of Appeal's earlier judgment in *Interflora Inc. and another v Marks and Spencer plc* [2014] EWCA Civ 1403 as follows:

"37. In relation to what the court described as the crucial question, namely whether the average consumer, as a hypothetical person, necessarily has a single reaction and so precludes a consideration of the perceptions of a proportion of the relevant public the court in *Interflora* identified the following propositions:

- i) the average consumer test provides the court with a perspective from which to assess the particular question it has to decide, for example whether a statement is liable to mislead purchasers.

ii) a national court may be able to assess this question without the benefit of a survey or expert evidence.

iii) a national court may nevertheless decide, in accordance with its own national law, that it is necessary to have recourse to an expert's opinion or a survey for the purpose of assisting it to decide whether the statement is misleading or not.

iv) absent any provision of EU law dealing with the issue, it is then for the national court to determine, in accordance with its own national law, the percentage of consumers misled by the statement that, in its view, is sufficiently significant in order to justify banning its use.”

37. The impact of the above judgment is that the ground of opposition may succeed if a sufficiently significant percentage of relevant consumers are confused, but it is not necessary that the majority of consumers are misled. Of course, I am not yet considering confusion, but merely making an aural comparison. However, if the propensity to see (or more accurately hear) any aural similarity is with such a small group, a group which does not represent a sufficiently significant percentage of the relevant public, then it is immaterial. I take the view that the likelihood of an average consumer discerning and then articulating the applicant's mark as an A is fairly low (but not insignificant), but there is only a very slim likelihood of the A in the opponent's mark being articulated at all, thus the propensity for any aural similarity to exist is slimmer again. Given all this, my finding is that the marks are not aurally similar.

38. That then leaves the conceptual meanings of the marks. In terms of the opponent's mark the average consumer will pack away an unknown fancy word (albingia) but this has no concept per se. They will also pack away the letter A. In terms of the applicant's mark, some will conceptualise it on the basis of the letter A (if it is discerned), whereas others will see no concept at all. I think there will be sufficient numbers in the former camp for me to say that there is a sufficiently significant percentage of the relevant public that will perceive a medium level of conceptual similarity, but for everyone else there is none.

39. Mr Riordan submitted that whilst there is no threshold for a finding of similarity, he felt that the opponent had failed to establish that there was overall similarity between the marks at issue. He relied on the decision in *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290 which stated, after assessing the law on threshold similarity (and that there is no minimum threshold):

“59. On the other hand the cases do show that the General Court has said that where there is (a) average visual and phonetic similarity, but no conceptual similarity (*Wesergold*), or (b) a number of visual and phonetic features which precluded the signs from being perceived as similar (*Ferrero*), or (c) no visual or phonetic similarity but a low degree of conceptual similarity (*Lufthansa*), or (d) a common suffix (*Kaul*), there may yet be no similarity overall between mark and sign. I have no difficulty with these conclusions: it is only overall similarity which counts.

60. Thus I would summarise the position in the following way:

- i) The court should assess the phonetic, visual and conceptual similarity of mark and sign and decide whether, overall, mark and sign would be perceived as having any similarity by the average consumer.
- ii) If no overall similarity at all would be perceived, the court would be justified in declining to go on and consider the likelihood of confusion applying the global appreciation test, as Article 9(1)(b) is conditional on the existence of some similarity. Such situations are not likely to occur often in contested litigation, but where they do occur, it is not legitimate to take account of any enhanced reputation or recognition of the mark.
- iii) Where the average consumer would perceive some overall similarity, however faint, the court must go on to conduct the global appreciation test for the likelihood of confusion, taking account where appropriate of any enhanced reputation or recognition of the mark.

iv) In conducting the global appreciation test the court must take forward its assessment of the degree of similarity perceived by the average consumer between mark and sign”.

40. There can be no set formula based on degrees of similarity under the visual/aural/conceptual heads for deciding whether there is overall similarity between two trade marks. Each case must be considered on its own merits. Thus, whilst there may be circumstances where there is no overall similarity despite two marks having some visual and aural similarity (as per *Wasergold* referred to above), it does not follow that I must find that there is no overall similarity here. Mr Riordan submitted that the position in the subject proceedings was even worse than the examples given above. However, whilst I note the above guidance, I come to the view that the level of similarity I have found is easily sufficient for the marks to be considered similar overall and I should go on with the assessment as to the likelihood of confusion.

Distinctive character of the earlier mark

41. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

42. No evidence having been filed, I have only the inherent characteristics of the earlier mark to consider. The opponent stated in its statement of case that the stylised A that appears in its mark has an above average degree of distinctive character. Making reference to the distinctive character of the stylised A component, as opposed to the mark as a whole, is a sensible approach. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. (sitting as the Appointed Person) pointed out that the level of “distinctive character” of a mark is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

43. In my view, the stylised A will be seen as a reference to the initial letter of the word “albingia”. Letters per se are not, generally speaking, the most distinctive of marks (or components of marks). However, there is no evidence to suggest that it has any

particular resonance in relation to the services at issue. Furthermore, it has a reasonable degree of stylisation giving it a reasonable visual impact. Mr Riordan stressed that the component was less distinctive than the albingia element and in a subsequent submission (albeit in relation to confusion) he referred to the decision in *Supreme Petfoods*⁵ suggesting that the A logo was on a par with the circumstances in that case which related to the word SUPREME as the point of similarity, and its low level of distinctiveness. I disagree with any suggestion that the stylised A is low in distinctiveness, and in doing so I concur with Mr Longstaff who submitted that the component enjoys a normal degree of inherent distinctive character.

Likelihood of confusion

44. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“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

⁵ *Supreme Petfoods Limited v Henry Bell & Co (Grantham) Limited*. EWHC [2015] 256 (Ch)

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).”

45. Mr Longstaff’s submissions were focused more upon indirect as opposed to direct confusion. This is a sensible approach as it would be unlikely for the average consumer not to appreciate and recall to some extent the presence in the opponent’s mark of the word albingia. Mr Riordan put forward a number of reasons as to why confusion would not arise. I think it worthwhile rehearing those points here. His submissions were based on the following propositions:

- i) If, despite his earlier submission, there was similarity between the marks, it was only of a low level; further, the applicant’s mark is purely figurative and does not include the key distinctive element of the opponent’s mark; and that there is no conceptual and aural similarity. Whilst all this is noted, I have

found a medium (not low) degree of visual similarity and that albingia is not the key (or dominant) component, as the stylised A plays a roughly equal role.

- ii) The opponent's mark has no reputation and a normal level of distinctiveness as whole. I do not necessarily disagree with these observations.
- iii) That the stylised A is the least distinctive part of the mark and a parallel is drawn, as mentioned earlier, with the *Supreme Petfoods* case. Whilst I do not necessarily disagree with the assessment that the stylised A is less inherently distinctive than the word albingia, I am doubtful as to how telling this is, given that the component still has a normal degree of distinctiveness and still makes a roughly equal contribution to the overall impression of the mark. Further, I note from the *Supreme Petfoods* case, as Mr Longstaff did, that the distinctiveness of the word SUPREME is a very different matter to that of the stylised A. In fact, it was referred to in the decision as a "common non-distinctive element".
- iv) That the similarity between the services is low. For reasons already given, my finding is that all of the services are identical, or if not, similar to a very high degree.
- v) That there is no evidence of confusion. Mr Riordan accepted that this was not decisive but was a factor nonetheless. I agree, though, with Mr Longstaff who highlighted that there was no evidence of parallel trade, so nothing can be read into an absence of confusion.
- vi) That the standard of circumspection and attention is particularly high. I agree to some extent, but as stated earlier, I would pitch this as above average for some of the services and simply high for others.
- vii) That various forms of contextualised use (including envisaging the applicant's mark alongside the words AXIS BANK), and use taking place in a regulated way (in a branch for example), would also assist the distinguishing process. As stated earlier, it is a notional assessment that must

be made in these opposition proceedings and extraneous matter cannot be taken as something which avoids confusion.

- viii) In relation to the opponent's claim that if the applicant's mark were to be used in red/pink then confusion would be even more likely with the opponent's red/pink coloured mark, it was submitted that this does not help because there is no evidence that the colour red/pink adds to the distinctiveness of the earlier mark. I agree with Mr Riordan on this.

46. Mr Longstaff's submissions on indirect confusion were based principally on the average consumer recognising the high degree of similarity between the applied for mark and the corresponding component in the opponent's mark, which, he said, would be assumed to be the same visual logo and thus indicate the same or economically linked undertaking. He highlighted, again, the identity of the services, and whilst accepting the higher than usual level of care and attention, he submitted that indirect confusion was still likely. Mr Longstaff noted that in the opponent's earlier written submissions there was information about the nature of branding in the banking and insurance sectors, including information about the use of visual logos on, for example, the high street. Whilst I feel that the material in those written submissions crosses the line between submission and evidence (and thus will be ignored), Mr Longstaff's general point that the common element will be seen as a (common) corporate visual logo may still be considered.

47. I come to the view, notwithstanding the level of care and attention that will be exercised by the average consumer, that there is a likelihood of indirect confusion if these marks were to be used in respect of the identical (or highly similar) services at issue. Whilst recognising the whole mark comparison that is to be made, I nevertheless conclude that the average consumer will notice what I consider to be a remarkable degree of similarity between the applicant's mark and the stylised A component of the opponent's mark. I say "remarkable degree of similarity" because, although there are differences, they are such that they could easily be lost through imperfect recollection. The common component plays a roughly equal role in the overall impression of the opponent's mark and has a normal level of distinctiveness. I agree with Mr Longstaff that the average consumer will see this as some form of

corporate visual logo sending a message of trade origin. If the average consumer were then to encounter the applied for mark, that recognition will still exist and an assumption of same stable services reached. I come to this view whether or not the applicant's mark, in abstract, would be perceived as a letter A. **The opposition succeeds.**

Conclusion

48. Subject to appeal, the applicant's mark is to be refused registration.

Costs

49. The opponent has been successful, so it is entitled to a contribution towards its costs. Both counsel accepted that scale costs were applicable. My assessment is set out below:

Official fee - £100⁶

Preparing a statement of case and considering the counterstatement - £300

Filing and considering written submissions - £400

Preparation for and attending the hearing - £600

Total - £1400

50. I order Axis Bank Limited to pay Albingia, societ e anonyme, the sum of £1400 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.

⁶ Although the opponent submitted a fee of £200, only £100 should have been paid for this opposition under section 5(2)(b) only. The applicant should not have to make up for this.

Dated this 04th day of October 2017

Oliver Morris

For the Registrar,

The Comptroller-General