

O/656/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
UK REGISTRATION NO. 3541138
IN THE NAME OF OPENWORK SERVICES LIMITED
IN RESPECT OF THE FOLLOWING SERIES OF 2 TRADE MARKS**



IN CLASSES 35 AND 36

AND

**AN APPLICATION FOR A DECLARATION OF
INVALIDITY THEREOF
UNDER NO. CA503876
BY BANK MILLENIUM S.A.**

BACKGROUND AND PLEADINGS

1. Trade mark No. 3541138, as a series of two trade marks as shown on the cover page of this decision, stands registered in the UK in the name of Openwork Services Limited (“the proprietor”). The application for registration was filed on 6 October 2020, and the trade mark was registered on 29 January 2021, in respect of the following services:

Class 35: *Advertising; publicity; business management consultancy; business consultancy; business advice; market research; marketing; business promotion; business management; business administration; accounting; business appraisals; business information; business organization consultancy; computerised file management; business document management services; sales promotion for others; organization of trade fairs for commercial or advertising purposes; arranging of displays, meetings, presentations, exhibitions and demonstrations for business purposes; personnel management and recruitment; preparation of business plans and business reports; business investigations; evaluation of business opportunities; market analysis; business development; collection, preparation and reporting of business and financial statistics; drawing up of statements of accounts; economic forecasting; tax preparations; business succession planning; sales management advice; information, advice and consultancy services relating to all of the aforesaid.*

Class 36: *Financial services, financial affairs, financial advice, financial analysis and consultancy; investment services; fund, asset, unit trust and investment management services; portfolio management; monetary affairs; mortgage services; pension services; financial management services; risk assessment, analysis and management; financial appraisal; brokerage services; financing; insurance, assurance and reinsurance; insurance brokerage; provision of funds; provision of financial information; economic financial research services; financial investment research services; financial research; financial evaluation;*

financial viability and monitoring exercises; financial modelling, administration of financial affairs; preparation of financial reports and analysis; investment research; investment manager research; advisory, consultancy and information services relating to all of the aforesaid.

2. On 25 May 2021, Bank Millennium S.A. (“the cancellation applicant”) filed an application to have this trade mark declared invalid under the provisions of section 47(2) of the Trade Marks Act 1994 (“the Act”). The application for invalidation was filed in respect of all of the services as registered and is based on section 5(2)(b) of the Act. The cancellation applicant relies upon the following UK comparable mark:



UK Trade Mark (“UKTM”) No. 915842354

Filing date: 20 September 2016

Registration date: 20 January 2017

Colour claimed: Navy blue; Dark pink

Registered in classes 9, 16, 35, 36, 38, 41 and 42

Relying on all services in Classes 35 and 36 only, namely:

Class 35: *Advertising, marketing and promotional services; Distribution of advertising, marketing and promotional material; Promoting the goods and services of others through the distribution of discount cards; Administration of a discount program for enabling participants to obtain discounts on goods and services through use of a discount membership card; Online advertisements; Sales promotion for others; Provision of space on web-sites for advertising goods and services.*

Class 36: *Financial and monetary services, and banking; Financial management relating to banking; Financial banking services for the withdrawal of money; Financial services related to the issuance of bank cards and debit cards.*

3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the applicant's mark was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

4. The cancellation applicant claims that the competing marks are visually, aurally and conceptually very similar, and that the services covered by the respective registrations are either identical or very similar, resulting in a likelihood of confusion. Consequently, it requests that the opposed registration be invalidated in full, and that an award of costs be made in favour of the cancellation applicant.

5. The proprietor filed a counterstatement denying the claims and submits that when factored into the global comparison, the differences in appearance of the marks and the services offered means that the marks are not sufficiently similar for there to be a likelihood of confusion. Accordingly, it submits that the application for invalidation should fail in its entirety, and an award of costs be made in favour of the proprietor.

6. Both parties filed written submissions which will not be summarised, but will be referred to as and where appropriate during this decision, and only the proprietor elected to file evidence. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

7. In these proceedings, the cancellation applicant is represented by Walker Morris LLP and the proprietor is represented by DAC Beachcroft LLP.

Evidence

8. The proprietor's evidence comprises a witness statement, dated 28 January 2022, by Michael David George Morrow of The Openwork Partnership, ("Openwork"), of which the proprietor is part. Mr Morrow is the Chief Commercial Officer of Openwork. The main purpose of the evidence is to give background to the proprietor's business and use of its trade mark.

9. I note that Annex 1, filed with the submissions in defence of the application and witness statement, is partly written in English and partly written in a foreign language. The proprietor was advised by the Tribunal that only text in English would be assessed, and it was invited to file a certified translation of the Annex.¹ As no response was received and a translation was not filed by the given deadline, any evidence in a language other than English will not be considered as part of my decision. I have read and considered the witness statement, and I will refer to the relevant parts at the appropriate points in the decision, to the extent I consider necessary.

Statutory provision

10. The application to invalidate the proprietor's mark is based on section 5(2)(b), pursuant to section 47 of the Act. So far as is relevant, section 47 is as follows:

"(1) ...

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

...

¹ See official letter dated 16 February 2022.

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

...

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered -

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

...

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are –

(a) ...

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) ...

...

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

...

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

11. As the earlier mark is a comparable mark, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9.— (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union”.

12. The registration upon which the cancellation applicant relies qualifies as an earlier trade mark under the above provision.

13. As the earlier trade mark had not completed the registration procedure five years or more before the date on which the application for a declaration of invalidity was filed, it is not subject to the use conditions contained in section 47(2A) of the Act. The cancellation applicant is, therefore, entitled to rely upon it in relation to all of the services for which the mark stands registered without having to prove that genuine use has been made of them.

DECISION

14. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Section 5(2)(b) –

15. Section 5(2)(b) of the Act is as follows:

“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”.

16. In considering the application for invalidity under this section, I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“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 to mind the earlier mark, 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

17. Section 60A of the Act provides:

“(1) For the purposes of this Act goods and services —

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

18. I am therefore mindful of the fact that the appearance of respective services in the same class is not sufficient in itself to find similarity between those services, and that likewise, neither are services to be automatically found to be dissimilar simply because they fall in a different class.

19. The services to be compared are:

Cancellation applicant's services	Proprietor's services
<p><u>Class 35</u> <i>Advertising, marketing and promotional services; Distribution of advertising, marketing and promotional material; Promoting the goods and services of others through the distribution of discount cards; Administration of a discount program for enabling participants to obtain discounts on goods and services through use of a discount membership card; Online advertisements; Sales promotion for others; Provision of space on web-sites for advertising goods and services.</i></p>	<p><u>Class 35</u> <i>Advertising; publicity; business management consultancy; business consultancy; business advice; market research; marketing; business promotion; business management; business administration; accounting; business appraisals; business information; business organization consultancy; computerised file management; business document management services; sales promotion for others; organization of trade fairs for commercial or advertising purposes; arranging of displays, meetings, presentations, exhibitions and demonstrations for business purposes; personnel management and recruitment; preparation of business plans and business reports; business investigations; evaluation of business opportunities; market analysis; business development; collection, preparation and reporting of business and financial statistics; drawing up of statements of accounts; economic forecasting; tax preparations; business succession planning; sales management advice; information, advice and consultancy services relating to all of the aforesaid.</i></p>
<p><u>Class 36</u> <i>Financial and monetary services, and banking; Financial management relating to</i></p>	<p><u>Class 36</u> <i>Financial services, financial affairs, financial advice, financial analysis and</i></p>

<p><i>banking; Financial banking services for the withdrawal of money; Financial services related to the issuance of bank cards and debit cards.</i></p>	<p><i>consultancy; investment services; fund, asset, unit trust and investment management services; portfolio management; monetary affairs; mortgage services; pension services; financial management services; risk assessment, analysis and management; financial appraisal; brokerage services; financing; insurance, assurance and reinsurance; insurance brokerage; provision of funds; provision of financial information; economic financial research services; financial investment research services; financial research; financial evaluation; financial viability and monitoring exercises; financial modelling, administration of financial affairs; preparation of financial reports and analysis; investment research; investment manager research; advisory, consultancy and information services relating to all of the aforesaid.</i></p>
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20. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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”.²

² Paragraph 29

21. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.³

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

23. 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 goods. In *Boston Scientific Ltd v 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”.⁴

24. For the purposes of considering the issue of similarity of the services, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

³ Paragraph 23

⁴ Paragraph 82

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁵

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

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

26. In its written submissions, the proprietor has responded to the cancellation applicant’s comparison of the competing services⁶ and has set out its own summary in a comparison table⁷. The proprietor submits that the cancellation applicant has taken “a highly simplistic view of the complex, regulated nature of the financial services industry in the UK”.

27. I do not intend to reproduce the submissions of either party here, however, I have taken them into consideration in making my own comparisons, which I will now set as follows, grouping them together where this is appropriate, as per *Separode*:

Class 35

28. As admitted by the proprietor, its “*Advertising; marketing; sales promotion for others*” are self-evidently identical to the cancellation applicant’s “*Advertising, marketing and promotional services; Sales promotion for others*”:

⁵ Paragraph 5

⁶ See paragraphs 12 – 13 of the cancellation applicant’s submissions in support of the invalidation, dated 29 November 2021.

⁷ See paragraph 8 of the proprietor’s submissions in defence of the invalidation, dated 28 January 2022.

29. I consider the proprietor's "*business promotion*" services fall within the cancellation applicant's broader term "*Advertising, marketing and promotional services*", and as such they are identical as outlined in *Meric*. This is also admitted by the proprietor.

30. I am mindful of the guidance regarding the correct approach to scrutinising services as per *Avnet*, and to my understanding, "*publicity*" is different to "*marketing*" in that marketing is employed in the early stages of advertising and specifically targets a particular audience, while publicity is exposure to a wider audience, and may or may not have cost implications. However, the two are closely allied, and are similar in nature, purpose and channels of trade to the extent that it would be reasonable for the average consumer to believe that the responsibility for the services lie with the same or commercially linked undertakings. I therefore find "*publicity*" to be similar to "*marketing*" to at least a medium degree.

31. To my mind, the proprietor's "*organization of trade fairs for commercial or advertising purposes*" is similar in purpose to the cancellation applicant's "*Advertising, marketing and promotional services; Distribution of advertising, marketing and promotional material*" as both services serve to bring the products of an undertaking to the target audience for those products. As guided by *Avnet*, I remind myself that services should not be given a wide construction. I consider there to be an overlap in end users, and a complementary relationship between the services as without any advertising services, the need for the organization of trade fairs for advertising purposes would be redundant. I therefore consider the respective services to be similar to a medium degree.

32. To my mind, there is an overlap between the users of the proprietor's "*sales management advice*" and the users of the cancellation applicant's "*Sales promotion for others*". Although the exact purpose and method of employ differ between the two, they are likely to share similar channels of trade, and it would not be unreasonable for them to be provided by the same or commercially linked undertakings. I therefore consider the services to be similar to a medium degree.

33. In my view, there would be an overlap in users of the proprietor's "*market research*" services and the cancellation applicant's "*marketing*" services, with an overlap in channels of trade. I consider the services to differ in nature, with the former intended to provide insight into what may prove pertinent in the provision of the latter. I do not consider them to be complementary in a trade mark sense in that while market research may prove a useful tool prior to marketing, the two are not, as outlined in *Boston Scientific*, indispensable to each other. Consequently, I find there to be no more than a medium degree of similarity between "*market research*" and "*marketing*".

34. To my understanding, the core meaning of the contested "*business appraisals; collection, preparation and reporting of business and financial statistics; drawing up of statements of accounts; economic forecasting; tax preparations*" is with regard to financial evaluations and preparation of financial reports and information of businesses. In my view, there may be an overlap in the users of these various types of services and the "*Financial services, financial affairs, financial advice, financial analysis and consultancy*" services being provided under Class 36 of the earlier mark. However, the essential nature of the services is different, with the providers of the respective services likely to be specialists in their particular field. The purpose and method of use also differ, and the services are not complementary. To my mind, the average consumer would not automatically expect "*business appraisals; collection, preparation and reporting of business and financial statistics; drawing up of statements of accounts; economic forecasting; tax preparations; information, advice and consultancy services relating to all of the aforesaid*" to be provided by the same or economically linked undertakings as those providing "*Financial services, financial affairs, financial advice, financial analysis and consultancy*". I therefore find that if there is any similarity between the services, it is only to a low degree.

35. In my view, there is a connection between the proprietor's "*accounting*" services and the "*Financial and monetary services, and banking services*" being provided under Class 36 of the earlier mark as they both relate to money. However, accounting services are very specific, being the act of keeping detailed records of monetary transactions, and I do not consider the core meaning of the term to fall under the cancellation applicant's "*Financial and monetary services, and banking services*" at large. The purpose and method of use of the services also differ, and they are not

complementary, as per the criteria outlined in *Boston Scientific*. To my mind, the average consumer would not automatically expect that “*accounting*” be provided by the same or economically linked undertakings as those providing “*Financial and monetary services, and banking services*”. I therefore consider the respective services to be similar to only a very low degree.

36. “*Business management consultancy; business consultancy; business advice; business management; business administration; business information; business organization consultancy; preparation of business plans and business reports; business investigations; evaluation of business opportunities; business development; business succession planning.*”

While there may be an overlap in the end users of the above contested services and the users of the cancellation applicant’s “*Advertising, marketing and promotional services*”, I consider that the purpose of the respective services to be different, with the proprietor’s services relating to the structure of, and the day to day organisation of the business, and the provision of advice thereof. While advice on marketing may also be included as a part of such services, as per *Avnet*, I see no justification in giving the terms an unduly wide interpretation. In my view, it is unlikely that customers would believe that the responsibility for the services lie with the same undertaking. I therefore find the services to be dissimilar.

37. “*Computerised file management; business document management services.*”

I consider that the purpose and method of use to be different for the proprietor’s above services and the cancellation applicant’s “*Advertising, marketing and promotional services*”, with different channels of trade. Neither do I consider the opposing services to be complementary. Consequently, I find the services to be dissimilar.

38. “*Arranging of displays, meetings, presentations, exhibitions and demonstrations for business purposes*”.

I consider that the purpose of the above contested services and the cancellation applicant’s “*Advertising, marketing and promotional services*” to be different, although there may be an overlap in the end users of the services. The proprietor’s services are qualified as being for business purposes and while those services may also include meetings and presentations and the like in an advertising environment, in my

view, it is unlikely that customers would believe that the responsibility for the services lie with the same undertaking. I therefore find the services to be dissimilar.

39. In my view, “*personnel management and recruitment*” is a stand-alone service which has no direct connection with any of the services included in either class 35 or class 36 of the earlier mark. I do not consider that the average consumer would expect the providers of “*personnel management and recruitment*” to also provide, inter alia, “*Advertising, marketing and promotional services*” or “*Financial and monetary services, and banking*”. I therefore find the services to be dissimilar.

40. I consider the proprietor’s “*market analysis*” to be akin to a business management function which will assess the market in which an undertaking is operating. While there may be an overlap in users with the cancellation applicant’s “*Advertising, marketing and promotional services*”, the purpose, method of employ and channels of trade are different, and I do not consider them to be either complementary or in competition with one another. I therefore find these respective services to be dissimilar.

41. “*Information, advice and consultancy services relating to all of the aforesaid.*”

Although the methods of use and nature of providing information and advice about the respective services is different to the provision of the actual services, provision of a consultancy service has a clear complementary relationship with the provision of the aforementioned services themselves, with an overlap in end users and trade channels. I consider that the average consumer would expect the same undertaking to provide both services. I therefore find the term to be similar to the same degree for wherever I found similarity for the earlier services, as considered in the previous paragraphs.

Class 36

42. “*Financial services*” are self-evidently identical to the earlier mark’s “*Financial and monetary services, and banking*”.

43. “*Financial affairs, financial advice, financial analysis and consultancy; investment services; fund, asset, unit trust and investment management services; monetary affairs; financial management services; financial appraisal; financing; provision of funds; provision of financial information; economic financial research services; financial investment research services; financial research; financial evaluation; financial viability and monitoring exercises; financial modelling administration of financial affairs; preparation of financial reports and analysis; investment research; investment manager research*”.

Whilst I acknowledge the guidance from *Avnet* not to give services a wide construction covering a vast range of activities, I consider all of the above services included in the proprietor’s Class 36 specification to be of a financial nature and that they would all be encompassed within the broader term “*Financial and monetary services, and banking*” of the earlier mark. As such, I find the respective services identical as per the principle outlined in *Meric*.

44. My understanding of the term “*portfolio management*” is that it includes the management of portfolios in relation to investments in, amongst others, bonds, stocks and shares, in order to maximise those investments. To my mind, this would fall within the parameters of the cancellation applicant’s wider term “*Financial and monetary services, and banking*”, rendering the competing services *Meric* identical.

45. I consider “*mortgage services*” to be a financial service specifically relating to an arrangement for the loan of monies in order to purchase property. Once again, I find that the term would be encompassed within the cancellation applicant’s broader term “*Financial and monetary services, and banking*”, and as such, the competing services are identical as per *Meric*.

46. “*Pension services*”. A pension would be widely understood to be a regular payment made to a retired person as the result of his or her contributions to a pension scheme of some description. As such, I consider it to be a monetary agreement which would be classed as a financial service. Therefore, I find that “*Pension services*” are covered by the broader term “*Financial and monetary services, and banking*”, making them identical as per *Meric*.

47. *“Risk assessment, analysis and management”*.

Risk can be construed in relation to various genres. However, I must consider the term in relation to the class in which it falls, and as such, in relation to the proprietor’s class 36, I perceive it to be directly relating to financial risk. Whilst I am mindful of the guidance from *Avnet*, I consider that in these proceedings, the term *“Risk assessment, analysis and management”* is covered by the wider term *“Financial and monetary services, and banking”*. Consequently, I find the respective services to be identical as per the principle outlined in *Meric*.

48. To my understanding, the core meaning of the term *“brokerage services”* is to act as an intermediary between two parties to arrange a variety of transactions, which could relate to a wide range of professional services, including those of a financial nature. I therefore consider that the term *“brokerage services”* as included in Class 36 of the proprietor’s registration to be *Meric* identical to the cancellation applicant’s broader term *“Financial and monetary services, and banking”*.

49. *“Insurance, assurance and reinsurance; insurance brokerage”*.

I am guided by the findings of Mr Justice Arnold in *Fil Investment Services Limited v Fidelis Underwriting Limited* [2018] EWHC 1097 (Pat)⁸ where it was found that insurance services are within the core of the ordinary meaning of "financial services". Consequently, I consider that the above services are *Meric* identical to the cancellation applicant’s *“Financial and monetary services, and banking”*.

50. I have found all of the proprietor’s aforementioned services in class 36 to be either self-evidently identical, or to be identical to the cancellation applicant’s services by dint of the principles outlined in *Meric*. If I am wrong in this, then I consider the respective services to be similar in nature, purpose and method of use, with an overlap in users and channels of trade. As such I consider them to be highly similar to one another.

51. *“Advisory, consultancy and information services relating to all of the aforesaid.”*

Although the methods of use and nature of providing information and advice about the respective services is different to the provision of the actual services, provision of

⁸ Paragraphs 89 – 90.

a consultancy service has a clear complementary relationship with the provision of the aforementioned services themselves, with an overlap in end users and trade channels. I consider that the average consumer would expect the same undertaking to provide both services. As I have found all of the proprietor's services in Class 36 to be identical to the cancellation applicant's services, I therefore find the "*Advisory, consultancy and information services relating to all of the aforesaid*" to be similar to the earlier services to a high degree.

52. A degree of similarity between the services is essential for there to be a finding of likelihood of confusion. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

53. I therefore find there to be no likelihood of confusion for those services in Class 35 which I found to be dissimilar.

The average consumer and the nature of the purchasing act

54. 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. (as he was then) described the average consumer in these terms:

"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 word

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.⁹

55. 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.

56. In its written submissions, the cancellation applicant submits that the contested services are directed towards the general public who have a need for general banking services, and as such, the average consumer is likely to pay an average degree of attention to the services which are being provided.

57. The proprietor submits that although the category of services may broadly be described as ‘financial services’, the nature of the specific services within that category can be diverse and differ substantially from one another. Consequently, it submits that the average consumer is likely to pay a high degree of attention to the services which are being provided.¹⁰

58. In my view, the average consumer for the competing services in Class 35 will most likely be professional users such as businesses seeking either business management services or advertising and such-like related services. I acknowledge that this could apply to a range of professional users, from large-scale organisations to small enterprises and sole traders. Such services will be purchased infrequently, although I recognise that the consumer may seek to revise or upgrade existing provisions from time to time, and that smaller businesses may elect to access the services more frequently, but on a smaller scale, particularly in relation to advertising services. The subsequent costs and level of attention of those consumers will be lower overall than those attached to bigger organisations who choose to undertake major campaigns. I consider that larger organisations will pay a high degree of attention to the selection of services, and while the reputation or commercial success of all businesses could

⁹ Paragraph 60.

¹⁰ See written submissions dated 31 January 2022, paragraphs 12 and 21 – 26.

be affected by the choices made, the level of attention paid by smaller businesses will be lower, but will still be to at least a medium degree.

59. Earlier in my decision, I found the financial services being provided in Class 36 of the respective registrations to be identical. To my mind, the average consumer for the competing services will be either a member of the general public or a business customer.

60. The selection of the Class 36 services will be relatively important to the relevant public, with the act of selecting these services likely to follow a measured thought process. These services are unlikely to be purchased casually or as a matter of routine and are likely to be selected based on reviews and the reputation of the provider, cost and suitability of the product. The purchasing process would be a combination of visual and aural. Some consumers would be aware of the services through television and newspaper advertisements or may seek information from brochures or the internet or by visiting 'bricks and mortar' premises. Other consumers would pursue word of mouth recommendations or receive verbal advice, including via telephone enquiries, from a range of providers, before making the final selection. The cost of the services will vary according to the exact nature, specification and the level of service selected, however, the initial outlay could be substantial. In my view, the general public and smaller enterprises will pay a higher than medium degree of attention to the selection process, with the large-scale business customer paying a high degree of attention.

Comparison of marks



61. 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 in *Bimbo SA v OHIM* Case C-591/12P, 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.”¹¹

62. 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.

63. The respective trade marks are shown below:

Cancellation applicant’s trade mark	Proprietor’s trade marks
	<p data-bbox="810 927 986 965">Series of 2:</p> 

64. The proprietor’s mark has been accepted and registered as a series of two marks under section 41(2) of the Act. As shown above, the first mark in the series is presented in colour, while the second mark of the series is presented in greyscale. I note that registration of a mark in black and white covers use of the mark in colour.¹² For convenience, I will from this point refer to the series in the singular, though my

¹¹ Paragraph 34

¹² See paragraph 5, *Specsavers* [2014] EWCA Civ 1294.

comments should be taken as referring equally to both marks in the series, unless expressed otherwise.

65. The cancellation applicant submits that the earlier registration is for a navy and pink logo on a white background in the form of a stylised lower case 'double-storey' letter "g".¹³ It further submits that the distinctive and dominant elements of the proprietor's mark coincide with the earlier registration in that they both contain the same colours and the same basic geometric shapes, and that the marks are overall visually, aurally and conceptually very similar.

66. In its counterstatement, the proprietor submits that its mark is unmistakably a stylised letter "O" with a semi-circle directly below, which it states "is stylised in such a way to indicate a partial reflection of the letter "O" or a head on shoulders", and which it states looks nothing like a letter "g".¹⁴ It further submits that the use of colour is different, and that beyond the basic common shape element of a circle and a curved line, the overall impression of its mark is visually, aurally and conceptually different to the earlier mark.¹⁵

Overall impression

67. The cancellation applicant's mark consists of a solid, double outlined circular shape, infilled in blue, with a short straight line emanating out of the circle in a north-easterly direction. It is positioned directly above a solid, double outlined arc shape, infilled in pink, which curves upwards. The colours Navy blue; Dark pink are claimed as a feature of the mark. The overall impression of the mark rests in the combination of symbols which together form a single unit.

68. The proprietor's mark consists of a solid, infilled double outlined full circle positioned directly above a solid, infilled double outlined semi-circle which curves downwards. There is a clear distinction in colour between the circle and the semi-

¹³ As referred to in paragraph 4 of the cancellation applicant's statement of grounds, and as entered in the 'Mark Text' field of the registration details.

¹⁴ See paragraphs 4 – 5 and 12 of the counterstatement.

¹⁵ See paragraph 16 of the proprietor's submissions dated 31 January 2022.

circle in both the colour and the greyscale marks, the whole of which is positioned in the centre of a darker square shaped background. I consider the background to be a purely decorative element designed to contrast the circle and semi-circle symbols and which does not add to the trade mark message conveyed by the symbols. As such, the background does little to contribute to the overall impression of the mark, which rests in the combination of the circle and semi-circular symbols.

Visual comparison

69. While both marks comprise a combination of two separate shapes, as previously described, the additional line coming out of the circle in the cancellation applicant's mark, and the opposing curve and size of the arc/semicircle in each mark creates a visual difference between the marks. Considering the marks as a whole, I find there to be no more than a medium degree of visual similarity between them.

Aural comparison

70. I do not consider the cancellation applicant's mark to be sufficiently similar as to be recognised as a stylised letter 'g', as submitted by the cancellation applicant in its statement of grounds. Neither do I consider that the applicant's mark would be recognised as the letter "O", as in my view it would be viewed in conjunction with the semi-circle as a single unit, the whole of which detracts from the circle element being perceived as a letter or numeral. To my mind, each of the marks would be perceived by the average consumer as an abstract image. Neither mark contains any words or other components which would be articulated by the consumer. In *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T- 424/10, the GC stated:

"45 The fact none the less remains that, contrary to what the applicant submits, a phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHMI — Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 67).

46 A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.

47 In those circumstances, and given that the contested mark is a figurative mark lacking word elements, it cannot be concluded there is either a phonetic similarity or a phonetic dissimilarity between that mark and the earlier marks.”

71. Consequently, I make no aural comparison of the competing marks.

Conceptual comparison

72. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006]¹⁶.

73. I acknowledge the parties’ submissions that the marks represent the letters “g” and “O” respectively, or in the case of the proprietor’s mark, that it indicates a head on shoulders. I consider it unlikely that either mark would instantly convey any such message and, as I have already considered, it is my view that each of the marks comprise abstract shapes and as such they have no concept. Therefore I make no conceptual comparison of the marks.

Distinctive character of the earlier marks

74. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to

¹⁶ Paragraph 56.

the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

75. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

76. Registered trade marks can possess varying degrees of inherent distinctive character, being low where they are allusive or suggestive of a character of the goods and services, whereas invented words usually have the highest degree of distinctive character. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The cancellation applicant submits that the earlier mark has a normal level of distinctiveness as it does not describe any of the characteristics for which the mark is registered. It has not claimed that its mark has enhanced distinctiveness and no evidence demonstrating the extent of the use or promotion of the mark in the UK has

been provided. Therefore, I only have the inherent characteristics of the mark to consider.

77. As described previously, I consider the cancellation applicant's mark to comprise an abstract image made up of two relatively simple shapes which together form a single unit. The device as a whole is not strikingly distinctive, neither is it particularly weak. Overall, I consider the earlier mark to be inherently distinctive to a medium degree.

Likelihood of confusion

78. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind.

79. It is clear then that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

80. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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).”

81. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

82. In its written submissions, the proprietor submits that the average consumer for the cancellation applicant's services is likely to be entirely different to the average consumers of its own services in terms of services sought and by means by which they are prepared to access the services. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

83. Earlier in this decision, I found the competing trade marks to be visually similar to no more than a medium degree, however neither an aural nor a conceptual comparison could be made. I considered the earlier mark to be inherently distinctive to a medium degree. I found the contested services in Class 35, except for those identified under paragraphs 36 – 40 of this decision, to be either identical or similar to the cancellation applicant's goods. I considered the Class 36 services to be identical, with the contingent that if I am wrong in this finding, then the competing services are similar to a high degree.

84. The act of selecting the services at issue is likely to follow a measured thought process, with larger businesses paying a high degree of attention to the selection of services in both classes, and smaller enterprises paying at least a medium degree of attention to the purchasing act for services in Class 35. Meanwhile, the general public and smaller enterprises will pay a higher than medium degree of attention to the process of selecting the services in Class 36.

85. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. Given the degree of consideration paid to the purchasing act, it follows that the relevant consumers will have a greater ability to discern between the trade marks and the

undertakings providing the respective services, when compared with, for example, the purchasing act involved in the trade of a common consumer item. I do not consider there is any likelihood of direct confusion as in my view, the visual differences between the marks will be noticed and recalled by the average consumer. I find those differences to be sufficient for confusion not to arise, even where the respective services are held to be identical.

86. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

87. Keeping in mind the global assessment of the competing factors in my decision, it is my view that it is unlikely that the average consumer would assume that there is a connection between the parties. I do not consider that the contested mark displays characteristics akin to the earlier mark which would lead the average consumer into believing that there is an economic connection between the undertakings. I therefore find no likelihood of indirect confusion.

88. The application for invalidation under section 5(2)(b) fails.

Conclusion

89. The application for a declaration of invalidity has failed. Subject to any successful appeal, the registration under No. 3541138 will remain on the register in respect of all the services in its specification.

Costs

90. The proprietor has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN")

2/2016. Applying the guidance in that TPN, I award the proprietor the sum of £600, which is calculated as follows:

Considering the application for invalidation and preparing and filing a counterstatement	£300
Filing written submissions:	£300
Total:	£600

91. I therefore order Bank Millennium S.A. to pay Openwork Services Limited the sum of £600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 3rd day of August 2021

Suzanne Hitchings
For the Registrar,
the Comptroller-General