

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION  
BY LAND SECURITIES PLC  
TO REGISTER TRADE MARK NO 2318368  
IN CLASS 36**

**BACKGROUND**


1. On the 12<sup>th</sup> December 2002 land securities Plc of 5 Strand, London WC2N 5AF applied under the Trade Marks Act 1994 for registration of the trade mark :

**CARDINAL PLACE**

in respect of :

Class 36 Property acquisition and sale; property management and administration; property portfolio management and administration; property and capital investment; property appraisals and valuations; property brokerage; estate management; advisory and information services all relating to the aforesaid; rental of property; rental of housing accommodation; rental of retail premises; rental of offices; rental of industrial premises; rental of retail warehouses; leasing of property; leasing of housing accommodation; leasing of retail premises; leasing of offices; leasing of industrial premises; leasing of retail warehouses; arranging leases for the aforesaid; rent collection services; provision of housing accommodation; provision of retail space; provision of office space; provision of industrial space; provision of retail warehouse space; billing services in relation to telecommunications service providers and meter reading.

2. An Examination Report was issued on 17<sup>th</sup> January 2003 in which an objection was taken under Section 5(2) of the Trade Marks Act 1994 in respect of the following earlier marks :

Number	Mark	Date	Services
2312780		10 <sup>th</sup> October 2002	Financial services; asset management; monetary and financial transactions; investment management; fund management;

financial evaluations;  
investment strategy and  
management; designing  
and structuring investment  
products; fiduciary  
services

E2901486\*  22<sup>nd</sup> October 2002

Financial services; asset  
management; monetary  
and financial transactions;  
investment management;  
fund management;  
financial evaluations;  
investment strategy and  
management; designing  
and structuring investment  
products; fiduciary  
services.

\* Community Trade Mark application claiming an International Priority date of 10<sup>th</sup> October 2002.

The Examination Report also raised a specification query in relation to the Class 36 specification.

3. The applicants representatives, Nabarro Nathanson, replied on the 20<sup>th</sup> February 2003. They suggested an amendment to the specification of services in order to overcome the objection raised on the specification. They also maintained that the objection raised under Section 5(2) should be waived as the marks were not identical or similar and the services were dissimilar.

4. An Official letter was issued on 27<sup>th</sup> March 2003, which contained a further suggestion to amend the specification and also maintaining the Section 5(2) objection.

5. On 10<sup>th</sup> April 2003 Nabarro Nathanson replied agreeing to the amended specification and also requesting a hearing on the Section 5(2) objection.

6. A hearing was held on 20<sup>th</sup> May 2003 at which the applicants were represented by Ms Schwartz. At the hearing the objection under Section 5(2) of the Act was maintained and the Notice of Final Refusal was issued on 21<sup>st</sup> July 2003.

7. On 24<sup>th</sup> July 2003 Nabarro Nathanson filed a TM5 and I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

## **DECISION AND GROUNDS OF DECISION**

8. Section 5(2) of the Act reads as follows :

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

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

9. An earlier trade mark is defined in Section 6(1) which states:

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

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

10. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

11. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, page 224;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, page 224, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, page 224;

(e) mere aural similarity between trade marks may create a likelihood of confusion; *Lloyd*, paragraph 29

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 132, paragraph 17;

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, page 224;

(h) account should be taken 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 was registered; *Lloyd*, paragraph 29.

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, page 224;

(j) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 333, paragraph 29.

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

12. It is clear from the ECJ's judgement in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade mark has a highly distinctive character.

13. The two earlier trade marks in question are identical, one being a UK application and the other being a Community application from the same owner. Indeed the Community trade mark application also claims priority from the UK application so the filing dates are

also identical. Whilst neither of the marks are registered at this time, both have been accepted by the respective examination divisions.

14. The word “Cardinal” is a dictionary word, which has a number of meanings, none of which have any connection with financial services of any kind. In addition to this the marks also have a device element on top of the letter “N”. In my view, therefore, the trade marks possess a high distinctive character per se.

#### **Similarity of the marks.**

15. Since the trade mark of this application is not identical to the earlier trade marks, the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question, therefore, is whether the mark of this application is so similar to the earlier trade mark that there exists a likelihood of confusion, which includes the likelihood of association on the part of the public.

16. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgement of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks, bearing in mind their distinctive and dominant components. For the sake of convenience the earlier mark(s) is reproduced below :

CARDINAL

17. The applicants have applied to register the words CARDINAL PLACE. It is evident that both marks incorporate the identical word which, in my view, forms the dominant and distinctive element of both marks.

#### **Similarity of the services.**

18. The two earlier marks have been applied for the following services :

*“Financial services; asset management; monetary and financial transactions; investment management; fund management; financial evaluations; investment strategy and management; designing and structuring investment products; fiduciary services.”*

19. This specification includes services such as “financial services” which is a very broad term that encompasses a large number of services including the services specified by the applicants.

20. At the hearing Ms Schwartz maintained that the marks were not similar and did not agree that all the marks would be referred to as “cardinal” marks. The analogy she gave was Canary Wharf, in that it is never referred to as “Canary”. The likelihood of confusion relies on the global assessment of the marks, and she maintained that the aural, visual and

conceptual differences were sufficiently different. She also drew my attention to the device element in the cited marks. On the question of conceptual similarity, Ms Schwartz argued that the cited marks brought to mind a member of the church, whereas the application gave the impression of a place or street name.

21. I agree that the average consumer is unlikely to directly confuse these two marks, but I maintained that they would be seen as identifying the services as coming from the same or economically linked undertaking. I agree that there is some degree of conceptual dissimilarity, as referred to by Ms Schwartz at the hearing and consequently there is some degree of distinction between the marks. However, the addition of the word “PLACE” to the applicant’s mark is, to my mind, allusive when used in relation to property, buildings etc and as the applicant’s services include property management and investment the word “PLACE” is not a particularly strong distinguishing feature.

22. The word “Cardinal” in my view is a strong trade mark for these services and the device element in the cited mark is not likely to result in consumers referring to the mark as anything other than a Cardinal mark.

23. The meaning of the word “cardinal” does not, in my view, change when used in the applicant’s mark.

#### **Likelihood of confusion.**

24. I must of course bear in mind that a mere possibility of confusion is not sufficient. (See eg *React Trade Mark* [2000] RPC 285 at page 290). The Act requires that there must be a likelihood of confusion. It is clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the services (and vice versa) – see *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* In this case I consider, that the marks are similar in their dominant and distinctive characteristics and that the similarities in the between the services are such, that it would be highly likely for a single service provider to be providing the services covered by both the earlier marks and the later filed application.

25. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the services in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion. In this case, I believe the identity of the services, coupled with the high distinctive character of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act, which includes the likelihood of association.

26. In reaching this conclusion, I bear in mind that it is sufficient if an average consumer encountering the respective marks would assume that the marks identify a single undertaking or undertakings with an economic connection.

**Conclusion.**

27. In this decision I have considered all of the documents filed by the applicants and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

**Dated this 26th day of September 2003**

**Mark Jefferiss  
For the Registrar  
The Comptroller General**