

O/472/12

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2523820
BY CITY INDEX LIMITED IN RESPECT OF THE FOLLOWING SERIES OF
TWO TRADE MARKS IN CLASSES 9 & 41**



AND

OPPOSITION THERETO (NO 100334) BY CITIGROUP INC

The background and the pleadings

1) Application 2523820 was filed by City Index Limited (“Index”) on 13 August 2009 and was published in the Trade Marks Journal on 5 February 2010. The marks (it is a series application) and the goods and services for which registration is sought are:



Class 09: Computer software, computer programs, electronic publications; electronic publications and computer software and programs for use in the reporting of, or relating to, financial reporting, financial investment, financial exchange and financial trading, contracts for difference, spread betting, gaming and gambling; computer software and computer programs and electronic publications for use on mp3 players relating to financial and monetary trading, spread betting and contracts for difference trading, all the aforesaid goods relating to spread betting and contracts for differences (CFD's).

Class 41: Spread betting; gaming, betting, gambling, bookmaking and wagering services; on-line gaming, betting, gambling bookmaking and wagering services; provision of spread betting, gaming, betting, gambling, bookmaking and wagering services via the Internet, mp3 players, mobile telephones, or any other communication apparatus or networks; training and education; arranging of seminars, workshops, conferences and symposiums relating to spread betting, gaming, betting, gambling,

bookmaking and wagering; consultancy, information and advisory services relating to all the aforesaid.

2) Citigroup Inc (~~Group~~) opposes the registration of Index's mark. Its opposition was filed on 26 March 2010 and is based on a single ground under section 5(2)(b) of the Trade Marks Act 1994 (~~the Act~~), relying on a single earlier mark, namely: UK registration 2430546, the details of which are:



Class 36: Financial services; online financial trading; online trading brokerage; online dealing in stocks and shares; financial trading services; all delivered either through the Internet, wireless, by telecommunications or other electronic means

The mark was filed on 18 August 2006 and it completed its registration procedure on 19 February 2010.

3) Given its filing date, Group's mark constitutes an earlier mark as defined by section 6 of the Act. Further, when the applied for mark was published, Group's mark had not yet achieved registration, so, the use conditions set out in section 6A of the Act do not apply. The earlier mark may, therefore, be considered in these proceedings for the full scope of its services as registered; there is no dispute about this.

4) Index filed a counterstatement denying the grounds of opposition. It denies that the marks are similar. It refers to the use of the words CITY TRADING in its mark as referring to city trading activities and it argues that no trader can monopolize the use of the word CITY in relation to financial services. Index also denies that the goods and services are similar.

5) Both sides filed evidence. A hearing took place before me on 25 September 2012 at which Group was represented by Mr Jonathan Clegg of Cleveland LLP. Index did not attend the hearing, but instead provided written submissions.

Index's evidence

6) Index's evidence is given by Ms Rosemary Cardas, a partner in Keltie LLP, Index's representatives in this matter. Ms Cardas has conducted some Internet research in relation to the terms CITY TRADER and CITY TRADING from which she believes that:

—...~~to~~ term City Trader is a common generic use [sp] within the financial sector and by the media and general public as a reference to a trader who

works on the London Stock Exchange or on the financial markets. The term City Trader refers to a trader involved in financial trading, the word City having a direct reference to the financial district of London. This fact is supported by dictionary definitions including those found in the Oxford Dictionary, Websters Online Dictionary and the online reference tool —dictionary.com.”

7) Ms Cardas refers to Exhibit RAC1 as evidence of such definitions, which includes the following:

- CITY – —3(the City) the financial and commercial district of London, England.” – *Oxforddictionaries.com*;
- CITY – —2.The area of central London in which the United Kingdom’s major financial.....” – *dictionary.reference.com*;
- TRADER – —anember of a stock exchange trading privately and not on behalf of customers” – *dictionary.reference.com*;
- TRADER – —a person who buys and sells goods, currency, or stocks”. - *Oxforddictionaries.com*;
- An extract from *websters-online-dictionary.org* relating to the term STOCK BROKER which is one example of a —City Trader’s Job”.

8) Exhibit RAC2 of Ms Cardas’ evidence is a search results page from the Google search engine conducted on the term —City trader”. The print is of the first 100 hits out of 520,000. The underpinning websites are not provided. The vast majority relate to articles about people who carry out the job of a city trader. Beyond this, the hits include links to websites with references to:

- —City trader jobs”;
- a —City Trader Mobile App” of cityindex.co.uk (and other similar apps);
- a —City Trader – PC games”;
- a company called CITY TRADING SECURITES LIMITED;
- a range (of what I assume to be lingerie) called CITY TRADER on the website londoncallinglingerie.com;
- a —cheap PC City Trader”;
- a —Windy City Trader Trade Tip Natural Gas”;

- –The Windy City Trader”;
- –City Trader Cartoons and Comics”;
- a –Free city trader wall street trader game download”;
- –City Trader – Mr Monkey”;
- a –Herefordshire Hereford City traders token 1662”;
- a City Trader (video game);
- a ”City Trader – PC (1 of 2)”;
- a –City Trader Program”;
- a spread betting application called CityTrader (this appears to be from Index);
- further references to City Trader PC games;
- a company called CITY TRADER LIMITED;
- –City Trader Gifts”;
- –City trader training”.

9) Exhibit RAC2 of Ms Cardas’ evidence is a search results page from the Google search engine conducted on the term –City trading”. The print is of the first 100 hits out of 6,340,000. The underpinning websites are not provided. Many relate to the act of city trading – i.e. the act of trading (in financial stocks and other commodities) in a financial centre. Beyond this, the hits include links to websites with references to:

- Index’s –City Trading” application which is a spread betting platform;
- Business names which include the words CITY TRADING;
- City Trading jobs;
- Some out of context references e.g. –Derby City Trading standards” and –city trading estates”;
- Unclear references including –City Trading Post”;

- A reference to “City Trading/finance games”.

10) Exhibit RAC4 contains an article from the Financial Times dated 14 October 2011 about city traders. Exhibit RAC5 contains an article from the BBC News 24 website dated January 2008 entitled “What is a City trading job like?”.

11) At the same time as filing its evidence, written submissions were also provided. I will not make a detailed summary of the submissions here but, in essence, they focus on the lack of distinctiveness of the terms CITY TRADER/CITY TRADING; Index considers that in consequence of this, these words do not form the dominant and distinctive components of the marks and that they cannot be used to prevent the registration of other marks which include similar words. Provided is an examination report relating to the mark City Trading for the same goods and services Index have applied for here; the application was objected to by the IPO.

Group’s evidence in response

12) Group’s evidence is given by Mr Andrew Clemson, a trade mark attorney at Cleveland LLP, Group’s representatives in this matter. Mr Clemson has conducted some Internet research in relation to the meaning of the term “financial services”. Various exhibits are produced as follows:

- AJC1 – A print of a webpage entitled “Financial services” from the website Wikipedia.org. It lists a large range of financial services.
- AJC2 – A print of a webpage entitled “What we do” from the website of the Financial Services Authority (“FSA”). It lists the various roles the FSA provide including who it regulates, its approach and guidance, and other financial responsibilities. It has a wide range of rule-making, investigatory and enforcement powers.
- AJ3/4 – Further prints from the FSA website showing the range of services it regulates including firms who deal with investments, insurance, banking, credit unions.
- AJC5 – A print from the website of Companies House which shows various business activities that a company can nominate. Amongst a very large list, various financial services are listed.

Section 5(2)(b)

13) Section 5(2)(b) of the Act reads:

—5(2) A trade mark shall not be registered if because –

(a)

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

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

14) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

15) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

16) The goods and services Index has applied for are varied. In class 9 there are goods (such as software and electronic publications) which may be consumed by both the general public and by businesses. This is so even from the perspectives of those terms in class 9 which are qualified as being for some form of financial or spread betting purpose. In terms of the degree of care and attention, less attention may be adopted by the purchaser of an electronic publication than by a

purchaser of a computer programme, but in neither case do I consider that the purchasing process is materially higher or lower than the norm. This is in contrast to the services of the earlier mark (various financial services) which, generally speaking, may be subject to a more considered purchasing process than the norm, depending, of course, on exactly what is involved; both members of the public or businesses may, again, avail themselves of such things.

17) In class 41 there are, again, various things to consider. In relation to most of the services put forward I consider that the average consumer will adopt an average level of care and attention, but no higher than that. I will discuss this in more detail if it becomes necessary to do so. In relation to spread-betting, and as I will come on to, this may be something where a slightly more considered approach will be displayed as the service is one more akin to a financial service and could be used by both members of the general public and by businesses; the service may be used as an alternative to traditional investment services or to act as an hedge to other investments.

18) In relation to all of the goods and services then it seems to me that visual characteristics are likely to be important as the goods and services are likely to be selected after perusal of websites, brochures, prospectuses etc. Aural similarity will not, however, be ignored. In relation to traditional forms of betting, bets may sometimes be placed over the phone so in this case visual and aural similarity have an equal role to play.

Comparison of goods/services

19) When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

20) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

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

21) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

—It's true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

22) In relation to understanding 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”¹ and that 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 meaning². However, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (*Avnet*) Jacob J stated:

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

—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.”

23) The services covered by Group’s earlier mark are:

Class 36: Financial services; online financial trading; online trading brokerage; online dealing in stocks and shares; financial trading services; all delivered either through the Internet, wireless, by telecommunications or other electronic means

24) I will make my assessment on the basis of the following break-down of the applied for goods and services:

Class 37

Spread betting

25) Mr Clegg submitted that spread betting was very similar to various financial services in class 36, particularly those that involve investment and stock trading. However, neither party has provided evidence directed at the similarity, or lack of, between spread betting and financial services. That being said, spread betting is commonly known as a form of betting which can take place against the movement of the financial market. One does not “invest” as such because one is making a bet rather than putting capital into a company directly, but nevertheless, the user of the service is putting capital forward which may or may not be realised. As such, it has a degree of similarity with investment services or stocks and shares trading. The point of similarity is furthered by the fact that the betting is taking place within the confines of the financial market, a point that will not be lost on the average consumer. There would appear to be a fairly obvious competitive relationship as one may use spread betting as an alternative to traditional investment services, or by those looking to hedge their investments. Taking all this into account I consider that:

- i) Spread betting is similar to a reasonably high degree to financial services such as investment services and stocks and shares trading.
- ii) But spread betting is not similar to financial services outside of the above context (e.g. is not similar to mortgage/loan services).

Gaming, betting, gambling, bookmaking and wagering services

26) Mr Clegg considered that the above terms would include spread betting within their ambit. He also argued that any form of betting/wagering/gambling etc

would in any event be similar to financial services due to the putting forward of a stake for possible financial gain.

27) In terms of the ambit point, I must bear in mind the *Avnet* principle meaning that the terms should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase". The most likely term to include spread betting within its ambit is, for obvious reasons – "betting". I agree with Mr Clegg here in that spread betting is simply a sub-category of betting. However, I do not consider that this naturally extends to gaming or gambling services which conjure up other services such as casino, bingo etc and, perhaps, traditional forms of bookmaking. The same applies, in my view, to bookmaking and wagering services – the core of these terms are traditional forms of bookmaking such as betting on horses or other sporting events. I come to the conclusion that spread betting is a discrete service falling within its own category. In terms of the second point, that any form of betting, gambling etc is similar to financial services, I reject this argument. The inherent nature of such services are quite different as is the method of use etc, the purpose points appears to me to be a very superficial argument and, also, missing from traditional betting etc is the link with the financial market. Taking all this into account I consider that:

- iii) Betting is similar to a reasonably high degree to financial services such as investment services and stocks and shares trading due to spread betting falling within the ambit of betting.
- iv) Betting other than spread betting is not similar to any financial service, thus, the similarity in the term betting may be overcome by excluding spread betting.
- v) Gaming, gambling, bookmaking and wagering services are not similar to financial services.

On-line gaming, betting, gambling bookmaking and wagering services

28) This term simply indicates one of the forms in which the already considered services are rendered. The form of service, in these circumstances, has no material effect. By parity of reasoning with my earlier findings I consider that:

- vi) On-line betting is similar to a reasonably high degree to financial services such as investment services and stocks and shares trading due to online spread betting falling within the ambit of online betting.
- vii) Online betting other than online spread betting is not similar to any financial service thus, the similarity in the term online betting may be overcome by excluding online spread betting.

viii) Online gaming, gambling, bookmaking and wagering services are not similar to financial services.

Provision of spread betting, gaming, betting, gambling, bookmaking and wagering services via the Internet, mp3 players, mobile telephones, or any other communication apparatus or networks

29) Again, this term simply adds further ways in which the services already assessed may be rendered. Consistent with the above findings, I consider that:

- ix) Provision of spread betting and betting services via the Internet, mp3 players, mobile telephones, or any other communication apparatus or networks is similar to a reasonably high degree to financial services such as investment services and stocks and shares trading.
- x) Provision of betting services other than spread betting via the Internet, mp3 players, mobile telephones, or any other communication apparatus or networks is not similar to any financial service thus, the similarity in the term may be overcome by excluding spread betting.
- xi) Provision of gaming, gambling, bookmaking and wagering services via the Internet, mp3 players, mobile telephones, or any other communication apparatus or networks is not similar to financial services.

Arranging of seminars, workshops, conferences and symposiums relating to spread betting, gaming, betting, gambling, bookmaking and wagering

30) Although these services are not the same things as the services already assessed, the subject matter is the same, albeit this is providing a seminar etc about the service. A seminar about spread betting is a step removed from spread betting per se, as is the degree of similarity with financial services such as investment services. Nevertheless, the services will provide information and advice about a service which is reasonable high in similarity to a financial service. All things considered, I consider there still to be a moderate degree of similarity and I find, consistent with my earlier findings, as follows:

- xii) Arranging of seminars, workshops, conferences and symposiums relating to spread betting and betting is moderately similar to financial services such as investment services and stocks and shares trading.
- xiii) Arranging of seminars, workshops, conferences and symposiums relating to betting other than spread betting is not similar to any financial services thus, the similarity in the term may be overcome by excluding spread betting

- xiv) Arranging of seminars, workshops, conferences and symposiums relating to gaming, gambling, bookmaking and wagering is not similar to financial services.

Training and education

31) Training and education covers a multitude of disciplines. If the training and education relates to the financial field then training is being provided the subject matter of which relates to the services of the earlier mark. The services of the earlier mark will include the giving of advice and information. Whilst not identical, I consider the services to be moderately similar. A fall-back specification has not been provided, but for the sake of completeness, the same would apply to training and education relating to spread betting in comparison to financial services which would include advice and information relating to investments and stocks and shares. On the other hand, training and education relating to gaming, gambling, bookmaking and wagering would not be similar to financial services. Depending on the outcome, I will return to the question of fall back specifications.

Consultancy, information and advisory services relating to all the aforesaid

32) I consider that these services rest or fall with the aforesaid terms with the same degree of similarity.

Class 9

Electronic publications and computer software and programs for use in the reporting of, or relating to, financial reporting, financial investment, financial exchange and financial trading, contracts for difference, spread betting, gaming and gambling

33) Consistent with the findings already made, there is no similarity between financial services and these services to the extent that they are for use in the reporting of, of relating to, gaming and gambling.

34) That leaves the above goods which are for the reporting of, or relating to:

- a) Financial reporting,
- b) Financial investment,
- c) Financial exchange and financial trading,
- d) Contracts for difference,
- e) Spread betting.

35) In the cases of a) to d), the subject matters are particular financial services which are all covered by the financial services of the earlier mark. As such, electronic publications or programs relating to the same will either facilitate the operation of those services, or provide information, or the status of, the services.

There could be some competitive relationships (e.g. a person may choose an electronic publication on financial reporting or may opt instead for a financial reporting service) or a complementary relationship (e.g. software used to monitor investments and financial trading may complement the service itself). Either way, the subject matter is similar and the same provider may supply them to the same end users. I consider there to be a reasonable degree of similarity between these goods and financial services. In terms of e), goods for the reporting of, or relating to, spread betting, these are a step removed because the subject matter is not a financial service covered by the earlier mark. Nevertheless, as previously expressed, there is a key link between spread betting and financial services such as investment and stocks and shares trading which means that on a similar basis there is still a degree of similarity, albeit on a more modest level.

Computer software and computer programs and electronic publications for use on mp3 players relating to financial and monetary trading, spread betting and contracts for difference trading, all the aforesaid goods relating to spread betting and contracts for differences (CFD's)

36) All of the aforesaid relates to spread betting and contracts of difference. Consistent with my previous findings, there is a reasonable degree of similarity in relation to such goods relating to contracts of difference and a moderate degree of similarity in relation to such goods relating to spread betting.

Computer software, computer programs, electronic publications

37) To the extent that such goods could relate to financial matters then, consistent with the above, there is a reasonable degree of similarity. Depending on the outcome, I will return to the question of fall back specifications.

Summary of findings in relation to goods/services similarity

38) The following goods and services of the applied for mark are not similar to the services of the earlier mark:

Class 09: Electronic publications and computer software and programs for use in the reporting of, or relating to, gaming and gambling

Class 41: Gaming, gambling, bookmaking and wagering services; on-line gaming, gambling bookmaking and wagering services; provision of gaming, gambling, bookmaking and wagering services via the Internet, mp3 players, mobile telephones, or any other communication apparatus or networks; arranging of seminars, workshops, conferences and symposiums relating to gaming, gambling, bookmaking and wagering; consultancy, information and advisory services relating to all the aforesaid.

39) The following goods and services of the applied for mark are similar (to the various degrees previously indicated) to the services of the earlier mark:

Class 09: Computer software, computer programs, electronic publications; electronic publications and computer software and programs for use in the reporting of, or relating to, financial reporting, financial investment, financial exchange and financial trading, contracts for difference, spread betting; computer software and computer programs and electronic publications for use on mp3 players relating to financial and monetary trading, spread betting and contracts for difference trading, all the aforesaid goods relating to spread betting and contracts for differences (CFD's).

Class 41: Spread betting; betting services; on-line betting services; provision of spread betting, betting services via the Internet, mp3 players, mobile telephones, or any other communication apparatus or networks; training and education; arranging of seminars, workshops, conferences and symposiums relating to spread betting and betting; consultancy, information and advisory services relating to all the aforesaid.

40) Certain of the goods and services which are similar are only similar to the extent that the goods and services notionally relate to financial services and/or spread betting. Depending on the outcome, the scope of these findings may necessitate the need for submissions on fall-back specifications.

The distinctiveness 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). The earlier mark consists of the following composite mark:



42) The question relates to the distinctiveness of the mark as a whole, but in forming that view one must consider the components of which the mark comprises. Such an exercise will also be instructive in terms of assessing whether the point of similarity between the marks CITY TRADER/CITY TRADING will lead to a likelihood of confusion once, of course, all other factors are borne in mind.

43) Mr Clegg accepted that for certain types of financial services the words CITY TRADER were not the strongest. However, he suggested that there was a range

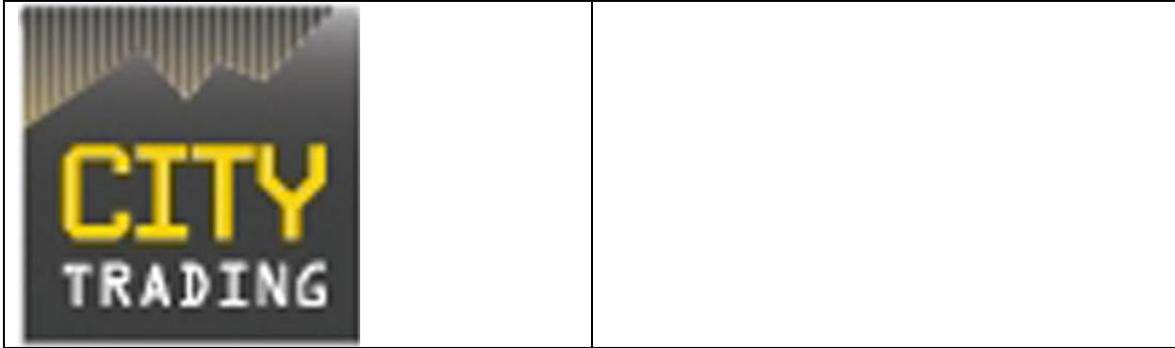
of distinctiveness depending on exactly what financial services were in issue; for example, the words had more distinctiveness in relation to mortgage services than in relation to financial trading services. However, he argued that at no point did the words lack distinctiveness altogether.

44) The one thing that clearly comes out of the evidence is that the words CITY TRADER mean a person who works in a financial centre whose job it is to trade in stocks and shares etc. Thus, in relation to a service which may be performed by a city trader, the words CITY TRADER must be extremely limited in distinctiveness. In relation to other financial services, I still consider any distinctiveness that the words possess to be low because the consumer is still likely to perceive some form of relationship with services performed by a city trader given the commonness of this term. In terms of the arrows, again, these seem to me, when seen in context with the words CITY TRADER and the services in question, to suggest the rise and fall of stocks and shares or the financial market so, again, any distinctiveness is at best low. The words CITY CREDIT CAPITAL will be seen as a combination of words which, although they have some individual suggestive qualities, the combination is somewhat meaningless. I come to the view that the earlier mark, as a whole, has a moderate degree of distinctiveness due to the combination of two elements with weak/low distinctiveness and one element (the less dominant element) with no more than an average level of distinctiveness.

Comparison of the marks

45) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components

Index's trade mark	Group's trade mark
	



46) Index argues that the words CITY TRADER/CITY TRADING in the respective marks do not form the dominant part of the mark, it argues that this role will be played by the respective device elements. However, despite the words CITY TRADER (and by analogy CITY TRADING) being extremely limited, or at best low, in distinctiveness, the words are nevertheless the most dominant part of the mark. In *L'Oreal SA v OHIM (Trade Marks and Designs)* [2006] the CJEU stated in case C-235/05, [2006] ECR I-57 *FLEXIAIR*:

—The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

47) In *Shaker di Laudato v. OHIM* T-7/04 [2009] ETMR 16 the GC, on a case remitted from the CJEU, stated:

—39. The Board of Appeal held that the word 'limoncello' was the dominant component of the trade mark applied for and that, therefore, the marks at issue were visually and phonetically practically identical, while Shaker claims, in essence, that as the word 'limoncello' does not have distinctive character, since it describes lemon-based liqueurs, it cannot be the dominant component of that mark for the purposes of the comparison of the marks at issue.

40. It should be borne in mind that, according to the case-law, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components. It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element. That could be the case, in particular, where that component is capable alone of dominating the image of that mark which members of the relevant public keep in their minds, such that all the other components are negligible in the overall impression created by that mark (*OHIM v Shaker*, paragraphs 41 and 42, and Case C-193/06 P *Nestlé v OHIM* [2007] ECR I-114, paragraphs 42 and 43)."

and

43 In those circumstances, it must be held that the word "rhoncello" is likely to dominate the overall impression created by the trade mark applied for in the minds of the relevant public.

44 That finding cannot be called into question by Shaker's argument that the word "rhoncello" does not have distinctive character because it is descriptive. Without examining the issue of whether the word "rhoncello" is descriptive for the relevant public, it should be borne in mind that, in any event, the possibly weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since—because, in particular, of its position in the sign or its size—it may make an impression on consumers and be remembered by them (*Inex SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Wiseman—Representation of a cowhide)* (T-153/03) [2006] E.C.R. II-1677 at [32], and *PAGESJAUNES.COM* at [54]; see also, to that effect, *Avex Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Ahlers (a))* (T-115/02) [2004] E.C.R. II-2907 at [20])."

48) In terms of visual similarity, the fact that the marks are dominated by the words CITY TRADER/CITY TRADING, words which are, in themselves, very similar from a visual perspective, creates an inevitable degree of similarity. However, the other elements in the mark are not to be ignored. The respective graphical elements give the marks a very different look and feel. Furthermore, Group's trade mark has additional wording CITY CREDIT CAPITAL. In relation to colour, Group's earlier mark is depicted in red and green whereas Index's second mark is depicted in yellow – whilst this is noted, I do not consider this is particularly significant either way. Weighing the similarities and the differences, I

consider there to be a reasonable degree, neither high nor low, of visual similarity.

49) In terms of aural similarity, the figurative aspects of the respective marks do not form a difference as they will not be articulated. Mr Clegg submitted that the verbal element CITY CREDIT CAPITAL will, likewise, not be articulated because it is the less dominant element. However, I consider this element to be slightly more distinctive so it is likely that some average consumers will articulate this. For those that do there will be a reasonable (neither high nor low) degree of aural similarity, but for those that do not, there will be a high degree of aural similarity.

50) There is a degree of conceptual similarity due to the words CITY TRADING/CITY TRADER both having a meaning relating to the trading of stocks and shares in a financial centre, be it a reference to the act itself or to a person whose job it is.

Likelihood of confusion

51) 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.

52) I will consider the position firstly in respect of the services sought to be registered in class 41. In relation to:

Spread betting; betting services; on-line betting services; provision of spread betting, betting services via the Internet, mp3 players, mobile telephones, or any other communication apparatus or networks.

I found such services to be similar to a reasonably high degree to financial services such as investment services and stocks and share trading etc. The point of similarity between the marks is the most dominant aspect of both marks, which, when balanced with the other aspects of the marks, leaves a reasonable degree of visual and aural similarity (a higher degree of aural similarity remains for those consumers who would not pronounce the additional verbal element of the earlier mark). However, the words which constitute the point of similarity are, at the very least, highly allusive of the services in question. Whilst I must bear in mind the potential for imperfect recollection, I come to the view that the differences between the marks are sufficient to rule out a likelihood of direct confusion (mistaking, effectively, one mark for the other). The different look and feel of the marks and the additional verbal element are likely to be noticed and remembered. That said, I must still consider indirect confusion, whereby the

average consumer believes, due to the point(s) of similarity between the marks, that the goods or services provided under them are the responsibility of the same or an economically related undertaking. I have carefully considered this issue. I have also borne in mind my earlier finding that in relation to these services a slightly higher than the normal level of care and attention will be displayed by the average consumer. Whilst this does not equate to the highest degree of care and attention, it is still something to throw into the mix. The various factors push and pull against each other. I come to the view that the average consumer will simply assume that the trade marks in question have both used a similar but highly allusive element – the points of difference assist to inform the average consumer not only that the marks are different, but that the services are the responsibility of different undertakings. The point of similarity will, in my view, be perceived by the average consumer as coincidence and not indicative of economic connection. **There is no likelihood of confusion.** Consistent with this finding, I come to the same view in relation to:

–arranging of seminars, workshops, conferences and symposiums relating to spread betting and betting; consultancy, information and advisory services relating to all the aforesaid”

53) I next consider:

–training and education”

54) Such services will be selected with a reasonable degree of care and consideration. In terms of the similarity of services then I have found them to be moderately similar to financial services but only on the basis that the training and education may relate to financial matters and/or spread betting. In relation to training/education relating to spread betting, my findings above apply here also. In relation to training and education relating to financial matters then the position is slightly different due to my earlier finding that there may be slightly more distinctiveness in the CITY TRADER element of the earlier mark, particularly for financial services that do not directly relate to investment or the trading in stocks and shares. However, I have still found that this element will nevertheless be low in distinctiveness. Having made another multi-factorial assessment, I come to the view that the average consumer will be able to distinguish between the marks (so there is no direct confusion) and that they will not put the similarity between the words CITY TRADER and CITY TRADING, when the rest of the marks are borne in mind, together with the degree of similarity between the services, down to the same or an economically related undertaking being responsible for the services. **There is no likelihood of confusion.**

55) I next consider the applied for goods in class 9. In relation to:

–computer software and computer programs and electronic publications for use on mp3 players relating to financial and monetary trading, spread betting and contracts for difference trading, all the aforesaid goods relating to spread betting and contracts for differences (CFD's).”

all of the above goods relate to spread betting and contracts for difference. In view of this my earlier finding in respect of services relating to spread betting is adopted by analogy. I have fully considered the factors in play but can see no material difference in assessment. **There is no likelihood of confusion.**

56) In relation to:

–electronic publications and computer software and programs for use in the reporting of, or relating to, financial reporting, financial investment, financial exchange and financial trading, contracts for difference, spread betting”

57) With the exception of “financial reporting” the goods relate to the type of things already discussed under the preceding finding. Consistent with those findings, and for similar reasons, **there is no likelihood of confusion.** In relation to electronic publications and computer software for financial reporting, which must be reasonably similar to financial reporting services, then, again, I come to the view that the average consumer will see the words CITY TRADER in the earlier mark as highly allusive and the same in relation to the use of CITY TRADING in the applied for mark. For similar reasons to those expressed already **there is no likelihood of confusion.**

58) That leaves:

–Computer software, computer programs, electronic publications”

59) The above goods are only similar to the services of the earlier mark on the basis that they could relate to financial matters. These services appear to me to be on a par with the assessment made in relation to the unqualified education and training services. I have, of course, borne in mind the different nature of the goods being assessed here, but I come to the same view having made the appropriate multi-factorial assessment. **There is no likelihood of confusion.**

In view of the above findings, there is no likelihood of confusion with respect to the goods and services I have found to be similar. The opposition is hereby dismissed.

Costs

60) Index has been successful and is entitled to a contribution towards its costs. I hereby order Citigroup Inc to pay City Index Limited the sum of £1500. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£300

Filing evidence and considering Group's evidence
£700

Filing submissions
£500

61) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 27th day of November 2012

**Oliver Morris
For the Registrar,
The Comptroller-General**