

O-065-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATIONS NOS. 3158844, 3157630, 3157623,
3157635, 3157619, 3159040, 3158863 AND 3157627**

BY ONESAVINGS BANK PLC

TO REGISTER VARIOUS TRADE MARKS IN CLASS 36

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS. 407495, 407496, 407498, 407500, 407501, 407502, 407504 AND
407508 BY ONEY BANK**

Background

1. OneSavings Bank Plc (“the applicant”) applied to register the following marks in the UK:

i) 3158844 (opposition number 407495)

Mark (series of 5):



Filing date: 11 April 2016

Date of publication: 24 June 2016

ii) 3157623 (opposition number 407498)

Mark (series of 3):



Filing date: 01 April 2016

Date of publication: 24 June 2016

iii) 3157630 (opposition number 407496)

Mark (series of 3):



Filing date: 01 April 2016

Date of publication: 24 June 2016

iv) 3157635 (opposition number 407500)

Mark (series of 2):



Filing date: 01 April 2016

Date of publication: 24 June 2016

v) 3159040 (opposition number 407502)

Mark (series of 3):



Filing date: 08 April 2016

Date of publication: 24 June 2016

vi) 3158863 (opposition number 407504)

Mark (series of 2):



Filing date: 11 April 2016

Date of publication: 24 June 2016

vii) 3157627 (opposition number 407508)

Mark (series of 2):



Filing date: 01 April 2016

Date of publication: 24 June 2016

viii) 3157619 (opposition number 407501):

Mark (series of 4)



Filing date: 01 April 2016

Date of publication: 24 June 2016

2. They were accepted and published in the Trade Marks Journal in respect of the following identical list of services:

Class 36: *Insurance; financial affairs; monetary affairs; real estate affairs; banking; building society services; provident society services; bank account and savings account services; credit services; financial and money lending services; services for valuation of real estate; stock-broking services; financial services provided via the Internet; online banking services; credit card services; debit card services; provision of secured and unsecured loans; provision of overdraft facilities; provision of loans secured by mortgage; mortgage services; mortgage brokerage services; investment portfolio management services; payment processing services; banking and financial services provided via*

telecommunications networks, mobile phone networks, satellite networks, wireless networks, cable networks, the Internet and global computer networks; currency exchange services; issuing of travellers' cheques; information, advice and consultancy in relation to all the aforesaid services.

3. Oney Bank (“the opponent”) opposes the applications in full. The oppositions are based upon Section 5(2)(b) of the Trade Marks Act (“the Act”), with the opponent relying upon the International Registration (“IR”) shown below:

Mark: IR no. 1171086



Trade mark type: Mark consists of colour or colours per se

In relation to the above wording, I should mention here that there is an issue as to whether this is a faithful reproduction of a statement in the International Register. I will return to this point later.

Date of Designation of the EU: 03 May 2013

Date protection granted in EU: 20 June 2014

Priority date: 02 May 2013 (France)

4. The opponent relies on the following services:

Class 36: *Insurance underwriting; general insurance services; banking, financial and monetary affairs; financing and lending services; electronic payment services; services involving bank, credit, debit, payment and other cards or checks providing financial advantages; online banking services accessible via the Internet or any telecommunication network, including via mobile telephone; issuance of gift cards for payment and gift checks for payment; issuance of discount coupons; issuing of travelers' checks;*

consultancy in the field of finance and insurance; financial sponsorship; organization of payment for the supply of gifts and any goods or services by the issuance, distribution, clearing of purchase vouchers, tickets, checks, coupons, tokens, prepaid cards or credit cards or any other means of payment particularly via computer networks or by telephone; provision of payment facilities and financing whether via a telephone or a computer terminal; financial services in connection with holding loyalty cards; services involving payment by loyalty cards; financial services in connection with holding promotional loyalty coupons; services involving payment by promotional loyalty coupons; issuance and financial management of payment facilities, particularly purchase vouchers; sales promotion for others by issuing loyalty cards enabling the accumulation of purchasing points and the award of purchase vouchers, promotional offers and gifts.

5. The oppositions were all defended by the applicant who filed counterstatements denying the claims made.

6. All eight oppositions were consolidated. Both sides filed evidence and written submissions. The opponent also filed written submissions in reply. This will be summarised to the extent that is considered appropriate.

7. Fieldfisher LLP represent the applicant in these proceedings; Trade Mark Consultants Co. represent the opponent. A hearing took place before me on 18 October 2017 at which the applicant was represented by Hasting Guise from Fieldfisher LLP, and the opponent was represented by Andrew Norris of Counsel, instructed by Trade Mark Consultants Co.

The opponent's evidence

8. This takes the form of a witness statement from Oliver Oguz, together with four exhibits. Mr Oguz is a chartered trade mark attorney with the firm representing the opponent in these proceedings. He states that the opponent was founded in 1983 and provides various banking products and services in a number of EU countries, but the

UK is not identified as one. He also provides financial reports from 2013, 2014 and 2015 outlining the company's activities and income.

The applicant's evidence

9. This comes from Hastings Guise and is accompanied by eight exhibits. Mr Guise explains that he is a trade mark attorney and partner in the firm of Fieldfisher LLP, the applicant's professional representatives in these proceedings. Mr Guise states that the applicant began trading under the name OneSavings Bank Plc on 1 February 2011, was listed on the London Stock Exchange in June 2014 and joined the FTSE 250 index in June 2015. Exhibit HG1 consists of an extract from the applicant's website; this refers to both OneSavings Bank Plc and the abbreviation OSB. It is stated that the applicant operates a number of specialist financial services brands. The main consumer brand under which the applicant trades is Kent Reliance, which is a successor of Kent Reliance Building Society and has a history of 150 years (HG2).

10. Mr Guise says that the applicant has traded under the mark OneSavings Bank, OSB and ONE since its inception and that it has become "a prominent financial business in the UK with approximately £6bn of assets on its balance sheet". He states that despite the applicant's prominent use of the mark ONE during the last six years in relation to financial services, to the best of the applicant's knowledge "no instances of confusion with the opponent, whether on the part of consumers, savers or investors, have arisen" and "no complaint [...] has been raised by the opponent [...] until the filing of the present opposition". He also refers to the fact that the applicant is the owner of other earlier registrations for related marks which have not been opposed or challenged by the opponent (HG3).

11. Mr Guise states that the earlier right is pronounced as ON-AAY by the opponent in its own marketing material. In this connection, he states that he has reviewed YouTube videos¹. Extracts from those videos are exhibited at HG4. This consists of a flash drive that has TV adverts in French promoting the mark ONEY; the pronunciation shown in those adverts is ON-E ('ey' seems to be pronounced like 'ai' in 'fair').

¹ At www.youtube.com/watch?v=2JQ_GIVp_3o and www.youtube.com/watch?v=BRF7xjagKwc

Preliminary issues

12. At the hearing Mr Guise submitted that the opposition number 407495 should be struck out because the opponent had quoted an incorrect number in respect of its earlier trade mark registration. In particular, he argued that the last digit of the number entered on the Form TM7 appears to be an 8 rather than a 6.

13. Leaving aside the question of why the objection was first raised at such a late stage in the proceedings, I consider that even if an error has been made, that was immaterial. This is because the applicant itself understood the opposition no. 407495 as being based on the opponent's IR 1171086 as confirmed by the applicant's own counter-statement, which expressly refers to it. Further, the Form TM7 was accompanied by a copy of a document² quoting the correct IR number, which would have left no doubt as to what the mark relied upon by the opponent was. I therefore dismiss Mr Guise's request.

DECISION

14. Section 5(2)(b) of the Act reads:

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

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

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

15. An earlier trade mark is defined in Section 6 of the Act, which states:

“6.-(1) In this Act an “earlier trade mark” means –

² Copy of a form requesting the change of the opponent's name from Banque Accord to Oney Bank

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.

16. The opponent's mark is an earlier mark, which is not subject to proof of use because, at the date of publication of the applications, it had not been protected in the EU for five years. The opponent can, as a consequence, rely upon all of the services it has identified.

Section 5(2)(b) - case-law

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

18. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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

20. I also bear in mind the decision in *Boston Scientific Ltd v OHIM*, Case T-325/06, where the General Court (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”.

21. 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.”

22. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

23. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

24. The competing services are as follows:

Applied for services	Opponent's services
<p>Class 36: <i>Insurance; financial affairs; monetary affairs; real estate affairs; banking; building society services; provident society services; bank account and savings account services; credit services; financial and money lending services; services for valuation of real estate; stock-broking services; financial services provided via the Internet; online banking services; credit card services; debit card services; provision of secured and unsecured loans; provision of overdraft facilities; provision of loans secured by mortgage; mortgage services; mortgage brokerage services; investment portfolio management services; payment processing services; banking and financial services provided via telecommunications networks, mobile phone networks, satellite networks, wireless networks, cable networks, the Internet and global computer networks; currency exchange services; issuing of travellers' cheques;</i></p>	<p>Class 36: <i>Insurance underwriting; general insurance services; banking, financial and monetary affairs; financing and lending services; electronic payment services; services involving bank, credit, debit, payment and other cards or checks providing financial advantages; online banking services accessible via the Internet or any telecommunication network, including via mobile telephone; issuance of gift cards for payment and gift checks for payment; issuance of discount coupons; issuing of travelers' checks; consultancy in the field of finance and insurance; financial sponsorship; organization of payment for the supply of gifts and any goods or services by the issuance, distribution, clearing of purchase vouchers, tickets, checks, coupons, tokens, prepaid cards or credit cards or any other means of payment particularly via computer networks or by telephone; provision of payment facilities and financing whether via a telephone or a computer terminal;</i></p>

<p><i>information, advice and consultancy in relation to all the aforesaid services.</i></p>	<p><i>financial services in connection with holding loyalty cards; services involving payment by loyalty cards; financial services in connection with holding promotional loyalty coupons; services involving payment by promotional loyalty coupons; issuance and financial management of payment facilities, particularly purchase vouchers; sales promotion for others by issuing loyalty cards enabling the accumulation of purchasing points and the award of purchase vouchers, promotional offers and gifts.</i></p>
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25. The opponent contends that the respective services are identical save for the applicant's *real estate affairs* and *services for valuation of real estate*, which, it claims, are highly similar to the opponent's services. Having initially denied, in its counterstatement, any similarity between the contested services and the services covered by the earlier mark, the applicant subsequently conceded, in its submissions, that the respective "specifications are identical or similar except for "real estate services" which [it stated] "are dissimilar". However, as noted by the opponent, the applicant did not set out in more detail exactly what services it would count as identical or similar. I will therefore proceed to my own assessment.

26. The contested *insurance* is encompassed by the term *general insurance services* covered by the earlier mark. These services are identical on the principle outlined in *Meric*.

27. The contested *financial affairs; monetary affairs; banking; building society services; provident society services; bank account and savings account services; credit services; financial and money lending services; stock-broking services; financial services provided via the Internet; online banking services; credit card services; debit card services; provision of secured and unsecured loans; provision of overdraft*

facilities; provision of loans secured by mortgage; mortgage services; mortgage brokerage services; investment portfolio management services; payment processing services; banking and financial services provided via telecommunications networks, mobile phone networks, satellite networks, wireless networks, cable networks, the Internet and global computer networks; currency exchange services; issuing of travellers' cheques either encompass or are encompassed by the opponent's *banking, financial and monetary affairs; financing and lending services; electronic payment services; services involving bank, credit, debit, payment and other cards or checks providing financial advantages; online banking services accessible via the Internet or any telecommunication network, including via mobile telephone*. These services are also identical on the *Meric* principle.

28. Given the relationship between the contested *information, advice and consultancy in relation to all the aforesaid services* and the services to which they relate, which I found to be identical to the opponent's services, I find that there is a high degree of similarity between these services and the services covered by the earlier mark.

29. This leaves the contested *real estate affairs and services for valuation of real estate*. The opponent referred me to a decision of a fellow Hearing Officer, BL-O-477/17. However, in that decision, the two competing specifications contained the identical term *real estate affairs* so I cannot see how that decision might assist here.

30. At the hearing Mr Norris submitted on behalf of the opponent that *real estate affairs* are broad services which include real estate investment and real estate funds and that the evaluation of real estate funds depends upon "the evaluation of the underlying real estate". Mr Norris's argument was, as I understood it, that the contested *real estate affairs* encompass real estate investment and that real estate investment is "very similar" to the opponent's *financial (management) affairs*, because investors in real estate properties trade in much the same way as investors in other asset classes. I disagree. Mr Norris' construction is, in my view, a stretching of the words beyond their core meaning. *Real estate affairs* is not the most natural description for a fund that invests in real estate: the ordinary description of it would, in my opinion, be of *investment fund*. In Case T-514/13 *AgriCapital Corp. v OHIM* the GC found that real estate related services are services connected with a property including the lease,

purchase, sale or management of a property and that *real estate affairs* are not similar to *financial services*. It stated:

“35. The Board of Appeal concluded that the services of ‘real estate management and brokerage, rental and leasing of real estate (facility management); real estate affairs; leasing of farms; the aforesaid services not in connection with publishing and/or published products’ covered by the mark sought were dissimilar to ‘financial services’ covered by the applicant’s earlier marks.

36. The applicant complains that the Board of Appeal of OHIM concentrated on the fact that real estate management and brokerage services and financial services cannot be substituted for one another, without examining whether they are complementary. In that regard, it argues that the Board of Appeal of OHIM’s definition of financial services is too narrow. It contends, in particular, that it is common practice for banks and financial institutions to offer real estate for sale, either themselves or via a subsidiary. Evidence of this is the joint advertising of both types of services. It follows that, contrary to what the Board of Appeal held, ‘real estate management and brokerage services’ are closely linked to ‘financial services’ and, hence, complementary.

37. OHIM contests the applicant’s arguments.

38. In that regard, first, it has already been held, as regards the nature, intended purpose and method of use of the services at issue, that financial services do not have the same nature, the same intended purpose or the same method of use as real estate services. Whereas financial services are provided by financial institutions for the purposes of the management of their clients’ funds and consist of, inter alia, the holding of deposited funds, the remittance of funds, the granting of loans or of various financial operations, real estate services are services connected with a property, namely, in particular, the lease, the purchase, the sale or the management of a property (judgment of 11 July 2013 in *Metropolis Inmobiliarias y Restauraciones v OHIM — MIP Metro (METRO)*, T-197/12, EU:T:2013:375, paragraph 42).

39. It follows that, contrary to the applicant's submissions, the Board of Appeal of OHIM did not define the 'financial services' covered by the earlier mark too narrowly.

40. Second, it must be observed that, as has been held in paragraph 34 above, the Board of Appeal of OHIM did not merely examine whether the services of 'real estate affairs' and 'financial services' are substitutable for one another, but in fact proceeded to examine their complementarity.

41. Furthermore, it should be noted that, in support of its argument as to the complementarity of the services at issue, the applicant alleges merely that the sale of real estate is a service which is often offered by financial institutions.

42. However, as has also already been held, as regards the fact that the services covered might be found in the same distribution channels, it must be held that real estate services are not, in principle, provided on the same premises as financial services (judgment in *METRO*, paragraph 38 above, EU:T:2013:375, paragraph 43).

43. The documents produced by the applicant in the course of the administrative proceedings (annex A5 to the application) do not disprove that finding, since real estate services carried out by financial institutions are provided by separate branches, so that the financial services are separate from any real estate services (judgment in *METRO*, paragraph 38 above, EU:T:2013:375, paragraph 45).

44. It follows that the Board of Appeal of OHIM did not err in law in finding that the services of 'real estate management and brokerage, rental and leasing of real estate (facility management); real estate affairs; leasing of farms; the aforesaid services not in connection with publishing and/or published products' covered by the mark sought were dissimilar to the 'financial services' covered by the applicant's earlier marks."

31. Even if one were to approach the comparison the other way around, on the assumption that real estate funds fall within the opponent's *financial affairs* and that the day-to-day management of the properties and facilities in which the fund invests

might involve activities such as maintenance and rent collection (which qualify as *real estate affairs*), it could not assist the opponent. This is because, in my view, the management of real estate funds (as an investment service) is limited to investment advice and investment management and it is separate from (and does not include) the management of the properties which create the portfolio of assets. Proceeding on that basis, the nature, purpose and users of the respective services would be different, one being concerned with the purchase, sale and rental of a property (*real estate affairs*) and the other one with an investment product (real estate fund as a service falling within the meaning of *financial affairs*). The services would be provided by different trade channels, namely an estate agent and a financial institution and there would be no competition. Insofar as complementarity is concerned, there is no evidence that providers of real estate investment services also offer real estate affairs services or vice versa. I therefore find that there is no similarity between the contested *real estate affairs* and the services covered by the earlier mark.

32. *Real estate evaluation* are services provided by estate agents. The purpose of those services is to give an estimate regarding the market value of a property. The services are typically used as part of the process of putting a property on the market though they can also be sought by the relevant users when making important decisions regarding real estate transactions. Whilst real estate lending also involve the evaluation of properties for the purpose of assessing the value of the collateral securing the loan, the bank's evaluation activity is part of its own lending process and it is not offered to the public as a separate service. Thus, I find that there is no similarity between the contested *real estate evaluation* and the opponent's services.

33. 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.

34. Accordingly, for a claim under Section 5(2)(b) to succeed, there must be at least a degree of similarity of goods and services. Having concluded that there is no meaningful similarity between the opponent's services and the contested:

Class 36: *real estate affairs and services for valuation of real estate*

there can be no likelihood of confusion and the oppositions to these services under Section 5(2)(b) fail accordingly.

Average consumer

35. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

36. In his skeleton arguments, Mr Guise submitted (reproduced as written):

“For majority of services attention level will be relatively high and purchase act will involve both visual and aural experiences of the mark. Possible exception

for some low value insurance purchases and for some consumer services such as use of ATMs or payment processing on routine purchases where attention may be lower. If this lower attention level is determinative, Applicant requests opportunity to offer an amended specification excluding these services (as permitted by, e.g., Amanda Michaels acting as Appointed Person in O-328-16 (*Eris FX*), supplemental decision).”

37. The request was reiterated at the hearing. Mr Guise’s position was that there is no likelihood of confusion “at whatever level of attention” and certainly “at an average level of attention”, and that it would be unreasonable for the applicant to exclude preemptively certain services, so the request was made in the event that I considered the level of attention to be determinative. Mr Norris resisted the request on two grounds. First he said that the request was made too late in the proceedings; secondly, he argued that to permit the applicant to amend its specification now would enable it “to have another go” at the applications. I shall return to this point later, if required.

38. As to the level of attention, Mr Norris submitted, on behalf of the opponent, that the average consumer is the general public paying an average degree of attention. He relies on *Morgan v Morgan*, Case T-399/15 that the average consumer for financial and insurance services is the general public having an average level of attention. In that decision, which involved services similar to the ones at issue here, the Court stated:

“25. In the present case, the Board of Appeal noted, in paragraph 10 of the contested decision, that the services at issue were intended for the general public, which has an average level of attention, and for a professional public, which has a high level of attention. Consequently, it took into consideration a public formed of average consumers in the European Union, who are reasonably well informed, attentive and circumspect.

26. The applicant maintains, contrary to the Board of Appeal, that the relevant public is made up of specialists in the field of insurance, where the applicant’s main activity lies. The consumers targeted are, therefore, more attentive.

27. EUIPO disputes the applicant's arguments.

28. In that regard, it should first be noted that, as the earlier mark is an EU trade mark, the Board of Appeal acted correctly in taking into account EU consumers.

29. Next, in order to determine the relevant public, it is necessary to take into account all of the services in respect of which registration of the mark is sought, regardless of the actual use of that mark (see, to that effect, judgment of 20 May 2014, *Argo Group International Holdings v OHIM — Arisa Assurances (ARIS)*, T-247/12, EU:T:2014:258, paragraph 26). Consequently, even though the applicant claims that the relevant public is composed exclusively of specialists in the field of insurance, it is necessary to take into account each of the services for which registration is sought, inter alia sickness or accident insurance services, and to consider that each of those services is liable to be intended both for specialist consumers and for the general public.

30. According to settled case-law, when the relevant public is made up of two categories of consumers each having a different level of attention, the public with the lower level of attention must be taken into consideration (see judgments of 15 July 2011, *Ergo Versicherungsgruppe v OHIM — Société de développement et de recherche industrielle (ERGO)*, T-220/09, not published, EU:T:2011:392 paragraph 21 and the case-law cited, and of 20 May 2014, *ARIS*, T-247/12, EU:T:2014:258 paragraph 29). The Board of Appeal was therefore right to take into account the general public in order to determine whether there is a likelihood of confusion.

31. Finally, as regards the level of attention of consumers of the services in question, who, as already stated in paragraph 29 above, are consumers of all of the services in respect of which registration was sought, it must be held that the applicant has failed to adduce any evidence to show that the Board of Appeal erred in taking the view, in paragraph 10 of the contested decision, that the general public has an average level of attention.” (my emphasis).

39. It is quite clear that, in considering the question of the average consumer, the Court concentrated narrowly on the appellant's argument that the BoA should have taken into account the level of attention of the specialist consumers as opposed to the general public. There was no challenge (and consequently no finding) in relation to the BoA's conclusion that the level of attention of the average consumer of the services was average, since the appellant did not particularise any meaningful error in relation to that part of the BoA's decision. Further, there is no indication that the finding of the BoA was a finding based on any evidence. As EUIPO decisions are not binding upon me, I am not required to take the same view as the BoA about the level of attention of the relevant consumers of the services. Hence, I will proceed to my own assessment.

40. Given that the services are identical, the same average consumer(s) is/are applicable to both parties. The parties' specification cover a range of insurance and financial services aimed both at professional consumers in the financial and insurance sector and ordinary members of the public. The opponent argues, in its submissions, that the services "are not all complex, sophisticated, potentially high risk and expensive" and that "many of the services [involved] are low-priced and purchased online by member of the general public without professional advice or assistance". I do not agree. Even considering the level of attention of the general public, the services are not acquired on an everyday basis. The purchasing act for all the respective services will be, at least, well considered, i.e. above average, because consumers are likely to take into account factors such as the reliability of the services affecting their finances, the terms of the insurance cover, interest rates, borrowing limits, service charges, price comparisons, etc. In this connection, Mr Norris submitted, on behalf of the opponent, that some banking services such as obtaining cash from an ATM involve little consideration at all. Even if average consumers are likely to perceive the marks in circumstances unconnected with any act of purchase, i.e. when withdrawing the cash, this possibility does not prevent to consider the level of attention deployed by consumers when making their choices between different service providers³. That being the case, considerations such as, inter alia, type of bank account, cash withdrawal limit, usage fees and accessibility of the services, i.e. online banking, fees and charges when using the service outside the UK, are likely to play an important

³ See by analogy Case C 361/04 paragraph 41-42

part in the selection process, all of which suggest an above average degree of care and attention. Where the services are more specialised, the degree of attention will be high.

41. In all cases the purchase may be made visually from a website, brochure, prospectus, etc. or aurally, such as, in the local branch of a bank, over the telephone or via a broker, financial advisor or other intermediary.

Comparison of marks

42. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

Applied for marks	Earlier mark
<p data-bbox="204 250 512 286">3158844 (series of 5)</p>  <p data-bbox="204 300 544 443">one Commercial Lending</p> <p data-bbox="204 456 544 600">one Lending</p> <p data-bbox="204 613 544 757">one Loans</p> <p data-bbox="204 770 544 913">one Commercial</p> <p data-bbox="204 927 544 1070">one Secured Lending</p>	 <p data-bbox="810 353 1238 510">oney</p>

Applied for marks	Earlier mark
<p data-bbox="204 1211 512 1247">3157623 (series of 3)</p>  <p data-bbox="204 1261 568 1404">one Specialist Mortgages</p> <p data-bbox="204 1417 568 1561">one Mortgages</p> <p data-bbox="204 1574 568 1736">one Intermediaries</p>	 <p data-bbox="810 1261 1238 1417">oney</p>

Applied for marks	Earlier mark
<p data-bbox="204 250 512 286">3157630 (series of 3)</p> 	

Applied for marks	Earlier mark
<p data-bbox="204 1030 512 1066">3157635 (series of 2)</p> 	

Applied for marks	Earlier mark
<p data-bbox="204 1612 520 1648">3159040 (series of 3):</p> 	

	
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Applied for marks	Earlier mark
<p>3158863 (series of 2):</p>  	

Applied for marks	Earlier mark
<p>3157627 (series of 2):</p>  	

Applied for marks	Earlier mark
<p>3157619 (series of 4)</p> 	



44. I also bear in mind that notional use of monochrome marks in colour include the green versions of the same marks.

Overall impression

Earlier mark

45. The earlier mark consists of the word 'oney' presented in a bright green colour, in lower case and in an "all-round gothic" bold typeface with the letter 'o' being slightly ticker than the letters 'ney'. The mark also contains a sequence of four small rings in yellow, orange, blue and purple aligned to the left, underneath the letters 'o' and 'n'. The opponent submits that the dominant and distinctive element of its mark is "the word 'oney', as presented in its particular font" and that the small rings are likely to be perceived as mere decorative embellishment. On the other hand, the applicant contends that the opponent's own use of the earlier mark demonstrates that "the colour and the device features are treated as dominant and distinctive elements". However, the way the mark is used is irrelevant: the assessment of the distinctive and dominant

components must be run on the basis of the marks as registered and applied for. I agree with the opponent that, owing to its prominent position, the overall impression of the earlier mark is dominated by the word element 'oney', by which the mark is likely to be referred to and which is the dominant and distinctive element. In relation to the font, I accept that it makes a more-than-negligible contribution to the visual impression created by the mark, however, I do not consider that it will have that much impact. This is because though it is rounder than a standard typeface, there is nothing striking or unusual about it, and the presentation is of a simple nature. As to the rings, the use of contrasting colours make a visual impact, however, taking into account their very small size and the fact that they consist, essentially, of simple geometrical shapes, I find that they play a subsidiary role in the mark. Finally, in relation to the colour, Mr Norris states:

“There is a curious anomaly in the UKIPO records of the EU designation in that it records text under the heading ‘Mark Type’ seemingly qualifying the registration. No such text appears in the EUIPO [...] or in the WIPO database. How or why it has appeared on the UKIPO online database is unknown but as the EU record is what is important, the UKIPO anomaly does not affect this opposition.”

46. The text to which Mr Norris refers consists of the following wording “Mark consists of colour or colours per se”. Regardless of that wording, the opponent’s mark was filed in a specific colour combination: that colour combination is a feature of the mark and is relevant in the overall comparison between the registered mark and the contested marks. Accordingly, I find that although the colour of the earlier mark is eye-catching and has a degree of visual impact, it is the word ‘oney’ which carries the greatest weight in the overall impression.

Contested marks

47. In relation to the contested marks, Mr Norris submits in his skeleton arguments that “they differ only as a matter of non-distinctive character” and that “there is little of significance in the differences within each series of marks, even though the text sometimes varies”. He also states that the word ‘one’ is the dominant and distinctive

element of all the applied for marks. Though, as the applicant says, each mark must be considered in isolation, I agree with Mr Norris that the prominent word in each mark is the word 'one'. This is the element by which all the contested marks will be remembered. The element 'one' is always presented in lower case, in an "all-round gothic" thick bold typeface with no space between the letters 'o', 'n' and 'e' which blend together touching each other. Each mark also contains a descriptive word underneath the word 'one', namely: i) Commercial Lending, Lending, Loans, Commercial, Secured Lending (mark 3158844); ii) Specialist Mortgages, Mortgages, Intermediaries (mark 3157623); iii) Specialist Mortgages, Mortgages, Loans (mark 3157630); iv) Secured Lending; v) Commercial Lending, Lending, Commercial (mark 3459040); vi) Commercial (mark 3158863); vii) Intermediaries (mark 3157627) and viii) Savings Bank (mark 3157619); these are all presented in the same typeface as the word 'one' but in a smaller size. Though the font and joining of the letters bring some distinctiveness to the marks, the dominant and distinctive element in each mark is the word 'one'. The descriptive words are not quite negligible, but are relatively small and contribute very little to the overall visual impression created by the marks. The marks differ in that some are presented in colour (or in colour and shades of grey) and others in black; also one of the contested series incorporates a circular device. Whilst the colours and the devices make also an impression to the eye, it is still significantly less than the word 'one', which is the dominant and most distinctive element of all the contested marks.

Visual similarity

48. Mr Norris submits, on behalf of the opponent, that the marks are visually similar to a medium or high degree. On his perspective, much turns on the fact that the word 'one' can be seen and read in both marks. He relies, in this connection, on the case-law that "consumers place a greater emphasis on the first part of the mark". In Mr Norris' words, "because the earlier mark is a word mark, the average consumer is looking to see a word so, when he reads the mark from left to right, he will see the word one". He also points out that i) the marks use the same "unusual font" and that the thickness of the letters and the round stylisation catch the reader's eye"; ii) "the small script underneath the [one] text occupies the same space and in the same proportions as the circle do in the [oney] text" and that "an inattentive consumer may

not take the care to read or even notice the text but would rather just appreciate that something is there”; iii) “the colour catch the eye in the colour marks, as they do with the earlier mark. The black marks [...] need to be seen in the same colour as the earlier mark, as they cover that colour. The common use of colour increases the similarity”. Mr Norris also submits that in relation to the contested colour marks, the presence of a colour (even if the colour is different from the colours used in the earlier mark) still creates a degree of visual similarity.

49. Mr Guise, on behalf of the applicant, admits that there is a visually mild similarity between the marks due to the similar font used, however, he contends that the font from which the similarity stems is a basic font which is not very distinctive. He also accepts that were the black marks to be used in the same colours of the earlier mark there would be an additional level of visual similarity. However, according to Mr Guise the similarity created by the font is dispelled, to some extent, by the presence of the letter ‘y’ at the end of the earlier mark and by fact that the letters in the contested marks are joined together. He states:

“The absence of the letter ‘y’ in the signs of the Applications is also significant: the mark is more balanced with the letter ‘n’ having greater prominence due to its central position. The thicker font stylisation, together with the blending of the joined letters makes the word and sign as a whole more visually compact and arguably ‘snappier’ for the relevant consumer. The same cannot be said for the Oney Registration which, in its stylised form, creates distance between each letter and has no central hinge point”.

50. Lastly, Mr Guise points out that Mr Norris’ reliance on the principle that consumers pay attention to the beginnings of marks is overstretched and that Mr Norris’ construction is contrary to the principle that marks must be assessed as wholes.

51. In assessing the visual similarity between the marks, the opponent has grouped the contested applications in three categories. I will use the same approach.

52. These two series of marks are applied for in black. Mr Norris relied on the judgement of the CJEU in *Specsavers*⁴ as support for the submission that these applications cover use of the marks in any colour. Mr Guise did not seriously challenge this approach⁵. Applying a complex colour combination that was not designated at the time when the applications were filed is, in my view, going beyond considering normal and fair uses of the contested marks in one colour or another⁶. Therefore, I will consider the contested applications as marks that could be used in any single colour, including green, yellow, orange, blue and purple, but not in the same (multi) colour combination used in the earlier mark.

53. In terms of visual similarity the distinctive and dominant elements of the respective marks, i.e. the words 'one' and 'oney', are of different lengths (4 and 3 letters respectively) the first 3 of which are shared. The last letter of the earlier mark, i.e. the letter 'y', has no counterpart in the contested marks. Contrary to what the opponent claims, the letter 'y' at the end of the earlier mark cannot be overlooked in the context of the comparison of the marks at issue and, as noted by Mr Guise, the marks must be compared as wholes. In relation to Mr Norris' submission that the beginnings of marks are generally more focused upon, this does not apply in all cases and it is only a rule of thumb⁷. Further, the length of the marks may influence the effect of the differences between them: in the case of word marks which are relatively short, even small differences might have a significant impact. Accordingly, I find that the similarity resulting from the same identical nature of the first 3 letters and from the use of a similar font is mitigated by the presence of the last letter in the earlier mark. The central presentation of the contested marks (as opposed to the left alignment used in the earlier mark) and the joining of the letters 'o', 'n' and 'e' also create some visual dissimilarity, which offsets the use of similar fonts. As for Mr Norris' argument that "the

⁴ *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035

⁵ On 15 April 2014 the EUIPO had issued a Common Communication on the Common Practice of the Scope of Protection of Black and White Marks; the communication deals with the issue of whether an earlier mark in black and white or greyscale is identical to the same mark in colour for the purpose of assessing relative ground for refusal, i.e. if the registration in black and white covers the colour version of the same mark. However, the common practice focuses exclusively on earlier black and white marks and does not cover the issue of identity when the earlier mark is in colour and the later mark is in black and white or greyscale, as it is in the case at issue.

⁶ See by analogy Case T-623/11

⁷ See Case T-363/06

small script underneath the [one] text occupies the same space and in the same proportions as the circle do in the [oney] text” and that “an inattentive consumer may not take the care to read or even notice the text, but would rather just appreciate that something is there” it is clearly misleading. Though it is true that consumers tend to recollect marks imperfectly, the contingency of the small texts in the contested marks being blurred to the extent that they might be recollected (not as words but) as shapes is farfetched, at least when attributed to a person with the attributes of an average consumer and who is paying at least an average level of attention. This is all of the more so since I found that the average consumer here is paying at least an above average degree of attention. I find that overall there is a medium degree of visual similarity between the marks. However, as I have already said, I must also consider what the position would be if the contested marks in the series were used in one of the colours of the earlier mark. Given that letters ‘oney’ in the earlier mark are presented in green, the best prospect of success for the opponent is to imagine the contested black marks in the same bright green colour used in the earlier mark. In my view, the notional appearance of the marks in the series in green would increase the overall visual similarity between the marks to medium to high.

3157630, 3157635, 3159040, 3158863 and 3157627

54. These series of marks are applied for in colour and in grey scales. Similar considerations to those outlined in the preceding paragraph apply here. However, the colour element of the marks admit for different considerations. I will therefore consider them individually.

55. The three marks of the series 3157630 are presented with the ‘o’ in purple/pink and the ‘n’ and the ‘e’ in shades of grey. As these marks contain a colour, they cannot be equivalent to an application in black and white. Consequently, I consider that normal and fair use of the contested marks would not cover use of the grey elements, i.e. the ‘n’ and the ‘e’, in any colour. Contrary Mr Norris’ argument that the use of different colours still creates a degree of visual similarity, I find that the presentation of the letters in purple/pink and shades of grey reduces the visual similarity between the marks to a low to medium degree.

56. The same conclusion applies to the first marks of the series 3157635, i.e. the mark presented with the 'o' in blue and the 'n' and the 'e' in shades of grey. It also applies to the first mark of the series 3158863 and 3157627, i.e. the marks presented with the 'o' in a dark wine colour and the 'n' and the 'e' in shades of grey.

57. In relation to the monochrome versions of the same marks, I find that the applications cover use of the marks in colour, including in shades of green. However, even if the marks were to be presented in green, the impact created by the presence of shades of green, which makes the darker letter 'e' at the end of the marks stand out, means that the level of visual similarity would be lower than the one I found in relation to the marks in the series 3158844 and 3157623.

58. In relation to the marks in the series 3159040, I find that the pale green colour of the letter 'o' is much less eye-catching than the bright green colour used in the earlier mark and that taking into account the contrast created by the presentation of the letters 'n' and 'e' in shades of grey, it does not materially increase the level of visual similarity above what I found in paragraph 55.

3157619

59. Finally, the element 'one' in the contested marks in the series 3157619 is incorporated in a reversed version within circular devices; the devices are presented in blue, pale green, purple and grey.

60. In relation to the marks presented against the blue and purple device, I find that the device and the contrasting colour reduce the level of visual similarity to low. In relation to the marks presented against a pale green background, the colour does not materially improve the opponent's position because the pastel green colour used in the application is different from the bright green colour used in the earlier mark and the colour concerns the background rather than the letters 'one'. Finally, in relation to the grey version of the mark, even if it were to be presented in the same bright green colour of the earlier mark, the level of visual similarity would at most increase to low to medium.

Aural and conceptual similarity

61. Neither side disputed that the element 'one' in the applications will be pronounced as UAN. The verbal elements that appear underneath the word 'one' in the contested marks are descriptive and are unlikely to be verbalised. In relation to the opponent's 'oney' mark, the applicant has filed evidence that shows the pronunciation of that mark as ON-E. Mr Norris contended, at the hearing, that the said evidence does not apply to the UK as it relates to adverts in French. In his opinion, the likely pronunciation of the mark is UAN-E. This is because, he claims, when looking at the mark the average consumers will grasp the meaning of the word 'one'" and will split the mark into two elements, i.e. 'one' and 'y'. In other words, the conceptual perception of the mark would affect its pronunciation. The applicant criticises this approach saying that there is no reason why the relevant public should perceive the element 'one' and 'y' separately from one another and points out that "there are no special characters, hyphens or other punctuations" that would cause the relevant consumer to split the mark as suggested by Mr Norris. According to the applicant the earlier mark is likely to be pronounced as ON-AAY (like in money) or OWN-EE.

62. In my opinion, the construction put forward by Mr Norris in order to find that the respective marks are aurally (and conceptually) similar involves an artificial segmentation of the earlier mark that the average consumer is unlikely to engage in. There is no evidence to support Mr Norris's assumption and the way he suggests the mark 'oney' would be read is not the way I would read it myself. Though in a number of cases the GC has considered that invented words may have a conceptual connotation despite not being in themselves dictionary words⁸, I do not think that the element 'one' of the word 'oney' is recognisable at first sight or that the average consumers would focus their attention instinctively on that element. This is because there is nothing between the 'e' and the 'y' which would lead the average consumers to break the mark into 'one' and 'y': if anything, the fact that the 'o' at the beginning of 'oney' is thicker than the other letters, creates a distance between the letter 'o' and the sequence 'ney'. Further, for an invented word to have an evocative effect it must be

⁸ *Usinor SA v OHIM* Case T-189/05, *Ontex NV v OHIM* Case T- 353/04 and *Hipp & Co v OHIM* T-221/06

highly reminiscent of an idea or a word that is particularly well known and easily recognisable. That is not the case here. The sequence 'one' is made up of only three letters and is incorporated in many English words, e.g. done, gone, tone, none, bone, zone, etc, such that when the mark 'oney' is considered as a whole, the element 'one' is not so unusual that it stands out and it is, in my view, unlikely to be immediately recognisable as the number one. I am fortified in this conclusion by the evidence filed which shows that the opponent does not emphasise the element 'one' of 'oney' in its marketing material.

63. Mr Norris also refers to examples where the addition of the 'y' at the end of the word does not change the meaning of the word itself, e.g. stick-sticky, meat-meaty, etc. I do not think that one can equate these examples to the case at hand, simply because meaty and sticky are dictionary words and, in any event, that rule is used to make adjectives from nouns by adding the suffix 'y' and it is not applicable to numbers. In my view, the average consumers who are faced with the earlier mark 'oney' without being conditioned to see the element 'one' will not grasp that meaning and will perceive and remember the mark simply as an invented word.

64. Lastly, I should briefly deal with Mr Norris' submission that whilst some consumers may not grasp the meaning of 'one' within the 'oney' mark, enough consumers may do for there to be a problem. For the reasons I have already explained above the legibility of the mark as suggested by Mr Norris is truly unrealistic and I reject his submission on that point.

65. In my opinion the opponent's mark is likely to be perceived as an invented word with no meaning and I agree with the applicant that it is likely to be pronounced either as ON-AAY (like in money) or OWN-EE. The contested marks are all likely to be pronounced as UAN. Accordingly, I find that the respective marks are aurally different.

66. From a conceptual perspective, again, the earlier mark is an invented word with no conceptual connotations. Having already dismissed the opponent's argument that the average consumers will make an association between the word 'oney' and the word 'one' I also dismiss the applicant's argument that the same consumers will make an association between the word 'oney' and the word 'money'. In my opinion the earlier

mark has the look and feel of an invented word and carries no conceptual weight. The common concept conveyed by all the contested marks will be that of the number 'one'. There is therefore a conceptual difference between the respective marks.

Distinctive character of the earlier mark

67. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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).

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).”

68. The word 'oney' in the earlier mark appears to be an invented word with no meaning. As such it is endowed with a high level of inherent distinctive character. In its submissions, the opponent refers to the evidence relating to its reputation being relevant, however the opponent's evidence is all related to use outside the UK and therefore it cannot show that the earlier mark has acquired an enhanced level of

distinctive character through use in the UK. In any event, at the hearing Mr Norris sensibly accepted that the evidence filed does not advance the opponent's case beyond the inherent level of distinctiveness. The green colour is part of the distinctive character of the earlier mark as a whole. However, absent use on scale that would make the earlier mark particularly familiar to UK consumers, the colour green is no more distinctive than any other colour. In any event, as the distinctiveness of the earlier mark is relevant only insofar as it resides in common elements⁹, any distinctiveness brought by the colour of the earlier mark is relevant only in relation to the monochrome versions of the contested marks.

Likelihood of confusion

69. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

70. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 Mr Iain Purvis Q.C. sitting as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the

⁹ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

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.

71. In its evidence the applicant refers to the absence of instances of confusion. It also refers to its earlier registrations for related UK marks incorporating the name ONE SAVINGS BANK. These, are said, to have never been challenged by the opponent. The absence of evidence of actual confusion is rarely significant when it comes to assess the likelihood of confusion under section 5(2)(b)¹⁰. Further, though the earlier mark is an EU trade mark, the likelihood of confusion must be assessed from the perspective of a UK consumer; however, in this case there has been no use of the earlier mark in the UK so the absence of confusion is hardly surprising. As for the argument that other registrations owned by the applicant have not been challenged, these refer to different marks and, in any event, I am not prepared to draw any inference from those facts.

72. Both parties referred me to various cases in support of their conclusion that there is, or there is not, a likelihood of confusion. In particular, the applicant relies on two decisions issued by fellow hearing officers where it was found that differences at the end of short marks were sufficient to avoid a likelihood of confusion¹¹. It also refers to a recent case¹² where the CJEU upheld the GC's decision that there was no likelihood of confusion between sign 'CHEMPIOIL' and a figurative mark incorporating the word 'CHAMPION'. The opponent, on its side, relies on three decisions of the Opposition Division of the EUIPO to support its argument that the principle that the beginning of the words tend to have more visual impact is applicable to cases involving short marks¹³. These decisions cannot assist. Firstly, because I am not bound by decisions

¹⁰ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220

¹¹ BL-O-028/16, BL-O-448/12

¹² Case C-437/16

¹³ Oppositions number B2560939, B2558313, B2413071

of fellow hearing officers or the EUIPO and, secondly, because these cases were decided in the context of different facts. The principle that the beginnings of marks are generally more focused upon and the fact that the word elements of the respective marks are made up of short words with different endings are, indeed, points that may be taken into account as part of the overall assessment of the similarity between the marks. However, one cannot simply reduce the global assessment of the likelihood of confusion to the application of a 'rule of thumb' or decide a case by drawing a factual analogy with a different case.

73. Finally Mr Norris referred at the hearing to *OZ Management LP v OCH Capital LLP*¹⁴. However, that decision relates to a dispute about trade mark infringement. Mr Norris nonetheless argued that it is relevant inasmuch as it shows that confusion arising from advertising can cause damage to the proprietor of the earlier right and that I should consider how the likelihood of confusion can manifest itself in real life. The main point about that decision in *OZ Management LP v OCH Capital LLP* is that the claimant successfully pleaded that to prove a "likelihood of confusion" they needed only show "initial interest confusion" which the judge considered as "confusion on the part of the public as to the trade origin of the goods or services [...] arising from use of the sign prior to purchase [...], and in particular confusion arising from use of the sign in advertising or promotional materials" (paragraph 87). I do not agree that the US doctrine of "initial interest confusion" is the correct test under section 5(2)(b).¹⁵ Thus I shall say no more about this.

74. Earlier in my decision I found that the respective services are identical, a factor that weighs in favour of the opponent. I also found that the services will be selected with an above average degree of attention which, indeed, reduces the effect of imperfect recollection. The earlier mark is inherently distinctive to a high degree: the most distinctive element of the mark is the word 'oney', which is an invented word. Both aural and visual similarity are important during the selection process. Though the contested marks are visually similar to various degrees, I found that they are all aurally and conceptually different. The crux of the opponent's case is therefore whether,

¹⁴ [2010] EWHC 2599 (Ch)

¹⁵ See paragraph 155 of the judgment of the Court of Appeal in *Interflora v Marks and Spencer*, [2014] EWCA Civ 1403

taking into account the factors mentioned above, the visual similarity between the marks is sufficient to offset the aural and conceptual differences.

75. I will now consider the likelihood of confusion in relation to each of the contested series of marks.

3157619

76. Here I found that the degree of visual similarity between the marks is low. In such circumstances, I find that the degree of visual similarity when considered in the light of the aural and conceptual differences indicates that there is no likelihood of confusion, either direct or indirect. **There is no likelihood of confusion.**

3157630 and 3159040

77. In the series 3157630 and 3159040 the marks are presented with the 'o' in colour (purple-pink and pale green respectively) and the 'n' and 'e' in shades of grey. In relation to these marks, I found that the degree of visual similarity is low to medium. That being the case, I find that the aural and conceptual differences are still enough to avoid both direct and indirect confusion. **There is no likelihood of confusion.**

3157635, 3158863 and 3157627 (colour marks)

78. I reach the same conclusion in relation to the first mark of the series 3157635, 3158863 and 3157627, i.e. the marks which are presented with the 'o' in colour (blue and dark purple respectively) and the 'n' and 'e' in shades of grey. **There is no likelihood of confusion.**

3157635, 3158863 and 3157627 (monochrome marks)

79. In relation to the monochrome versions of the same marks, I found that although normal and fair use could be in shades of green, the visual impact created by the shading makes the darker letter 'e' at the end of the contested marks stand out. When this is combined with the absence of any contrasting shades in the earlier mark, the

marks can be seen to be visually similar to less than a medium to high degree. The question is therefore whether the average consumer of financial services having previous knowledge of the earlier 'oney' mark, will confuse it with these marks. Given the degree of care taken over the purchase and the aural and conceptual differences between the marks, I do not believe that average consumers are likely to mistake one mark for another, more so because, the letter 'e' at end of the marks stand out. In terms of indirect confusion, the dominant and distinctive element of the earlier mark is the word 'oney' and it does not seem to me that the word 'one' can be understood as a natural abbreviation or a brand extension of the 'oney' brand. Even considering the bright colour green and the particular font used in the earlier mark, the visual similarity between the marks is, in my view, insufficient to offset the conceptual (and aural) differences between the marks. **There is no likelihood of confusion.**

3157630 and 3159040

80. In relation to these marks, I found that normal and fair use could be in any colour including the same bright green colour used in the earlier mark. Here, the absence of shading in the contested marks leads to a medium to high degree of visual similarity. However, the main difficulty for the opponent is that, again, given the nature of the services, the level of care taken during the purchase and the clear aural and conceptual differences between the marks, it is unlikely that there will be more than an awareness on the part of consumers that the contested marks remind them of the earlier mark. Notwithstanding the medium to high degree of visual similarity between the marks, the average consumers' mental image of the earlier mark will still be of the invented word 'oney' whereas the average consumers' mental image of the contested marks will be of the word 'one'. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

81. The same principle applies in this case. In my view, even imagining the applied for marks in the same green colour used in the earlier mark, the medium to high degree of visual similarity between the marks is not sufficient to counteract their conceptual (and aural) differences. Whilst the contested marks may call to mind the earlier mark, this is not the correct test for assessing the likelihood of confusion. **There is no likelihood of confusion.**

OVERALL CONCLUSION

82. The oppositions fail.

COSTS

83. As the applicant has been successful, it is entitled to a contribution towards its costs. At the hearing Mr Guise complained that the evidence filed by the opponent was out of time and largely irrelevant and that the opponent's hearing request was also out of time and that the applicant had incurred additional costs as a result of it. The applicant requested that these factors are taken into account when assessing costs. Even if the evidence filed by the opponent was not totally relevant it was relatively light so I do not consider appropriate to award any additional costs in relation to it. However, in view of the opponent's late request for a hearing, I will increase the award to £1,200 (I would have normally awarded £800). Awards of costs are governed by Tribunal Practice Notice (TPN) 2/2016. I award costs on the following basis:

Preparing a statement	
and considering the other side's statement:	£200 (x 8)= £1,600
Preparing evidence and considering	
and commenting on the other side's evidence:	£500
Preparing for and attending a hearing:	£1,200
Total:	£3,300

84. I order Oney Bank to pay OneSavings Bank Plc the sum of £3,300 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 26th day of January 2017

Teresa Perks

For the Registrar

The Comptroller General