O/094/18

TRADE MARKS ACT 1994

OPPOSITION No. 408247

BY WEALTHKERNEL LIMITED

TO THE DESIGNATION OF THE UK

FOR THE PROTECTION OF INTERNATIONAL REGISTRATION No. 1305234

IN THE NAME OF UBS GROUP AG

Background and pleadings

1. This is an opposition by Wealthkernel Limited ("the opponent") to UBS Group AG's ("the holder") designation of the UK on 5th April 2016 for protection of international registration 1305234 ("the IR"). The trade mark the subject of the IR is **UBS SMARTWEALTH** ("the contested mark"). The holder claims priority based on an earlier filing of the same mark in Switzerland on 26th October 2015 ("the relevant date").

2. The opponent opposes the protection of the IR in the UK in relation to the following services in class 36:

> "Banking and financial affairs; providing financial information via computer systems; financial services by means of computer systems; electronic interactive execution of financial and banking services via global computer networks; stock exchange services, including the securities market, derivatives, currencies and certificates of precious metal; monetary affairs; brokerage or ordering and/or consulting services in connection with banking, financial, real estate, insurance as well as monetary affairs; services of a custodian bank; financial transactions; financial planning and management consulting; services in the field of investment and risk management; financial management; financing of real estate; preparation of financial reports; valuation of financial investments; all the aforementioned services provided via secured access to electronic platforms for the provision of financial and banking services via global computer networks; consulting services via secure access to interactive electronic platforms for all the above services."

3. The ground of opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent is the proprietor of UK trade mark registration 3131114, which consists of a series of two marks WEALTHSMART and WEALTH SMART. As nothing turns on the difference between the marks, I will simplify matters by considering the opponent's case based just on the mark WEALTHSMART.

The earlier mark is registered in class 36 in relation to:

> "Investment by electronic means; investment advisory services; investment brokerage; investment fund services; investment management services; investment; investment advice."

The application to register the opponent's mark was filed on 12th October 2015. It is therefore an 'earlier trade marks' under s.6 of the Act. The earlier mark was not registered as at the date of publication of the contested mark. Therefore, the proof of use requirements in s.6A of the Act do not apply. The opponent can therefore rely on all the services covered by the earlier mark. The opponent claims that:

- The contested mark is similar to the earlier trade mark and is to be protected for identical or similar services;
- There is a likelihood of confusion on the part of the public.

4. The holder filed a counterstatement denying the ground of opposition. I note, in particular, that:

- The holder claimed that the SMARTWEALTH element of the contested mark is a coined term and *"a distinctive mark in its own right"*;
- The UBS mark is a world famous trade mark for financial services;
- The inclusion of the UBS house mark conveys information to consumers about the commercial origin of the services being offered and, as a result, the respective trade marks are conceptually dissimilar and distinguishable;
- Compared as wholes, including the reversal of WEALTHSMART to SMARTWEALTH, the respective marks are dissimilar.

5. Both sides seek an award of costs.

Representation

6. The holder is represented by Reddie & Grose LLP. The opponent is represented by Trade Mark Wizards Limited. A hearing took place on 13th December 2017 at which Ms Charlotte Blythe appeared as counsel for the holder and Mr Jamie Muir Wood appeared as counsel for the opponent.

The evidence

7. Only the holder filed evidence. This consists of two witness statements from Mr Jamie Broderick, who is the Head of UBS Wealth Management for the UK and Jersey. Mr Broderick says that UBS is *"the world's leading provider of wealth management services and the world's largest private bank".* Although the business dates back further, it has traded under the UBS name for 20 years. According to Mr Broderick, BrandFinance ranked UBS as the 150th most valuable brand in the world.

8. UBS carries on business in over 50 countries. The headquarters of the UK business are based in London. It also has offices in Birmingham, Newcastle, Manchester, Edinburgh and Leeds. The London and Edinburgh offices have the name UBS prominently displayed on the outside of the buildings (I infer from this that the other offices do not). The UK offices provide *"wealth management, investment banking and asset management services to a substantial UK and foreign client base."*

9. According to Mr Broderick, *"significantly over £1m is routinely invested in the UK to drive positioning, awareness and brand reputation of the UBS brand in the UK."* In support of this claim he cites:

- Sponsorship of the Tate Modern to 2010;
- Sponsorship of Formula 1 since 2010, including of the British Grand Prix;
- Sponsorship of the Mercedes Formula 1 team since 2011;
- Partnership with the London Symphony Orchestra to mid-2015.

Some printouts said to show these things are in evidence.[1] The supporting documents confirm that UBS sponsored the Mercedes Formula 1 team, special openings of the Tate Modern over one weekend (up to 2010), and the Music Education Centre of the London Symphony Orchestra, which is located at a former church in East London called St Luke's. The Mercedes team has nearly 11m followers on Facebook.

10. The holder has won numerous global awards, for example, in 2015, 'Best Global Private Bank' and 'Best Global Wealth Manager'. In 2017, the holder won a number of UK specific awards, including 'Best private banking services overall' and 'Net-worth-specific-services' (for high net worth clients).

11. Mr Broderick says that UBS invests heavily in brand tracking to understand awareness of the UBS brand amongst both institutional and personal investors, including brand tracking in the UK. He claims that in the years 2011 to 2015 this demonstrated *"strong awareness"* of the UBS brand. However, he does not explain what he means by *"strong"* or provide any more specific results of this brand tracking activity.

12. Mr Broderick says that UBS SMARTWEALTH is a new kind of investment service through which clients are provided with on-the-go, online access to their investments at all times. The target audience for the service is those with between £100k and £2m to invest. The service was first announced in the UK in October 2016 (i.e. after the relevant date) and was first made available to employees and an initial tranche of clients in November 2016. According to Mr Broderick, UBS SMARTWEALTH has been covered in over 100 media articles in the specialist and mainstream press, predominantly in the UK. He exhibits three examples.[2] These are articles from the websites finextra.com, portfolioadvisor.com and international-advisor.com. They are dated 7th or 8th March 2017. The first article refers to the UBS SMARTWEALTH service having been *"launched today."*

[1] See RB3
[2] See RB5

13. According to Mr Broderick, since February 2017 advertisements for UBS SMARTWEALTH have also been placed in publications with a strong affluent readership, including The Times, The Telegraph, FT Weekend, The Lawyer and Accountancy Magazine. The holder has also used Sky TV and social media to target advertisements at those with high accumulated wealth and affluence.

Section 5(2)(b)

14. Sections 5(2)(b) of the Act is as follows:

> "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".

Comparison of services

15. In the light of the judgment of the General Court in *Gérard Meric v OHIM*[3] (that services may be considered identical where a broad description includes a narrower one, or vice versa), counsel for the holder sensibly accepted at the hearing that the respective services should be considered identical, except in relation to the holder's *services of a custodian bank* and *financing of real estate.* The holder accepts that these services have limited similarity to those covered by the earlier mark. The similarity being limited to the mere fact that they are all financial services.

16. Counsel for the opponent accepted that *services of a custodian bank* are specialist financial services. He submitted that these services protect the assets or investments of an individual or firm and are therefore akin to investment services. Therefore, the respective services are *"similar if not highly similar."*

[3] Case T- 133/05

17. There is no evidence to assist me to understand the *services of a custodian bank.* I am not familiar with such services, so I cannot rely on my experience as a consumer. Therefore, I can only go on the ordinary meaning of the words at issue. I accept that a custodian bank is likely to act as a custodian of money or other assets for its clients. The apparent purpose of the service is to protect the money or assets. It is not clear to me whether, or how, that makes these services related in purpose to investment services. It follows that I cannot find that they are competitive or complementary services. I accept that the services are similar in nature, both being financial services, and that the respective users will overlap to some extent. I therefore accept the submission that there is a limited (i.e. low) degree of similarity between them.

18. According to counsel for the opponent, *financing of real estate* is also *"similar if not highly similar"* to *investment advisory services* covered by the earlier mark. This was said to be because these services could include investment advice in the field of real estate. Again, these are not everyday services and there is no evidence to guide me. On the face of it *financing of real estate* is about the provision of funds for real estate purchase or development. *Investment advisory services* identify opportunities for investors to invest money for financial gain, which includes investing in real estate. The target users are therefore different: the users in the first group are those seeking funds, whereas the users in the second group are those looking to invest funds. Consequently, the specific purposes of the services is different and they are not in competition. However, it is usual for financial service providers to offer both types of services. Funds have to be raised for finance to be offered. It seems likely that the same service provider that offers *investment advisory services* to one group of clients would also offer *financing of real estate* to another group. The consumers concerned would understand this relationship and, at different times, the same undertaking could be a consumer of both services. The respective services are therefore related in purpose and complementary in the sense indicated in the case law.[4] They are also similar in nature. In my view, these services are similar to a medium degree.

[4] *Boston Scientific Ltd v OHIM,* Case T-325/06, General Court

Global comparison

19. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v 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.

The principles

(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 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 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.

Average consumer and the selection process

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

21. Counsel for the opponent submitted that the opposed services could be divided into general banking/financial services, for which the relevant consumer was the general public, and specialist financial services, for which the relevant consumer was

someone in the financial services market with investible assets. Mr Muir Wood submitted that consumers in the first group would pay an average degree of attention when selecting a service provider whereas consumers in the second group would pay an elevated level of attention.

22. Counsel for the holder submitted that there was no sharp distinction between average consumers of the opposed services. In Ms Blythe's submission, average consumers of all the services would pay a high level of attention when selecting a service provider. In this connection, Ms Blythe pointed out that the opponent's representatives had previously accepted in written submissions that the average consumer pays a high level of attention when selecting financial services.

23. In my judgment, average consumers of financial services comprise the general public as well as businesses, traders and intermediaries in the financial services sector. Because of the high importance of financial transactions to most consumers, average consumers of financial services are likely to pay an above average degree of attention when selecting a service provider. Consumers of specialist financial services, such as *stock exchange services, including the securities market, derivatives, currencies and certificates of precious metal* are likely to be wealthy individuals, businesses, financial traders and advisors. Such consumers are likely to pay a high degree of attention. This is because those services are likely to involve larger sums and/or the funds of clients.

24. The services are likely to be promoted and selected mainly by visual means, from advertisements in publications etc. but word of mouth recommendations are also likely to play an important part, particularly in the case of specialist financial services, where intermediaries are involved.

Distinctive character of the earlier mark

25. Counsel for the holder submitted that WEALTHSMART is a mark of average distinctiveness. The distinctive character of the mark was a consequence of the specific combination of the words WEALTH and SMART (in that order). According to Ms Blythe, the mark was likely to be understood as referring to a person who is

shrewd or clever with their money. She likened the term to ‘book smart’ and ‘street smart’.

26. Counsel for the opponent submitted that the earlier mark alluded to ‘affluence’ and ‘clever’, but that the combination of the words created a made up word with no clear descriptive meaning in relation to the services at issue. Therefore, Mr Muir Wood submitted that the mark was of above average distinctiveness.

27. I have not heard of the terms ‘book smart’ or ‘street smart’ and there is no evidence that the public are familiar with these terms. Even if they are known to some extent, there is nothing to suggest that WEALTHSMART is familiar to the public. In these circumstances I decline to infer that, through a process of extrapolation, WEALTHSMART will be readily understood as referring to the characteristics of a person. In my view, the submission assumes a degree of analysis of the earlier mark that even consumers paying a high degree of attention during financial dealings are unlikely to give to it. I accept the opponent’s submission that the earlier mark conveys the meanings ‘affluence’ and ‘clever’, but the combination of words is not a natural one and the meanings of the words WEALTH and SMART do not combine to form a clear description of any characteristic of financial services. In my judgment, WEALTHSMART is therefore a mark of average distinctiveness for the services at issue.

Comparison of marks

28. 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 *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."

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

29. The respective trade marks are shown below:

WEALTHSMART	UBS SMARTWEALTH
Earlier trade mark	Contested trade mark

30. Both counsel submitted that the reputation of UBS was a factor that I should take into account in my assessment of the degree of similarity between the marks. This led counsel for the opponent to submit that the marks were more similar when considered in relation to specialist financial services, for which the opponent accepts that the contested mark has a reputation, than in relation to financial services targeted at the general public, amongst whom the opponent denies that UBS has a reputation.

31. The correct approach to the comparison of the marks is a question of law rather than a matter of fact. Therefore, I must decide for myself whether the parties' approach is correct. In *Ravensburger AG v OHIM*[5] the General Court held that:

"27. …… The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the

[5] Case T-243/08

likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 *Gateway* v *OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraphs 50 and 51)."

32. *Gateway* v *OHIM* was considered on appeal to the CJEU.[6] The CJEU held that it was not necessary for the General Court to make apparent the degree of renown of the earlier mark because it was not relevant in circumstances where the marks as a whole were not similar. The court reached a similar finding in *Calvin Klein Trademark Trust v OHIM.*[7] The CJEU could not have reached these findings if the reputation of the earlier mark was a relevant factor in the required assessments as to whether the marks at issue were similar. These cases therefore appear consistent with the judgment of the General Court in *Ravensburger AG v OHIM* cited above. I recognise that the reputation relied on in this case attaches to the contested mark, not the earlier mark. However, it could not possibly be right to disregard the reputation of the earlier mark as a factor which increases the degree of similarity between the marks, but take account of the reputation of the contested mark as a factor which reduces the degree of similarity between them. I therefore find that the reputation of UBS is a separate matter to the degree of similarity between the marks. It may nevertheless be a factor which affects the likelihood of confusion. I return to this below.

33. Counsel for the opponent submitted that the degree of visual similarity between WEALTHSMART and UBS SMARTWEALTH means that there is "*at least a moderate if not high"* degree of visual similarity between the marks as wholes. Counsel for the holder submitted that the addition of the letters UBS at the beginning of the holder's mark combined with the reversal of the words WEALTH and SMART meant that there was no overall similarity between the marks.

34. It is true that the letters UBS appear at the beginning of the contested mark and will therefore strike the consumer before the words SMARTWEALTH. On the other hand SMARTWEALTH is much longer than UBS and is therefore at least equally

[6] Case C-58/08
[7] Case C-254/09

visually dominant in the composite mark. The words SMARTWEALTH and WEATHSMART are comprised of the same letters and same words ‘wealth’ and ‘smart’, albeit in a different order. In my view, this creates a high degree of visual resemblance between SMARTWEALTH and WEALTHSMART. The presence/absence of the letters UBS reduces the degree of overall visual similarity, but, in my view, considered as wholes, the marks are visually similar to a medium degree.

35. The letters UBS will be pronounced as such (as opposed to as a word). Consequently, the contested mark is comprised of five syllables whereas the earlier mark has just two. Additionally, the order of the two common syllables is reversed. Nevertheless, SMARTWEALTH is composed of the same syllables as WEALTHSMART and therefore sounds a little similar. In my view, the marks (as wholes) are aurally similar to a low degree.

36. The parties’ confusion over the relevance of the reputation of UBS to the similarity between the marks led counsel for the holder to submit that the conceptual identity of the contested mark was dominated by the meaning of UBS as a trade mark, i.e. as an indication that the services at issue were provided by UBS. For the reasons I have already explained, this is not the correct approach to the comparison of the marks, which must be based on their inherent characteristics and meanings. The letters UBS have no meaning in language. They are just a string of letters. Consequently, they convey no conceptual meaning.

37. I earlier accepted the opponent’s submission that the earlier mark conveys the meanings ‘affluence’ and ‘clever’. The words SMARTWEALTH similarly convey the meanings ‘clever’ and ‘affluence’. It could be argued that ‘smart’ qualifies ‘wealth’ in SMARTWEALTH, whereas ‘wealth’ qualifies ‘smart’ in WEALTHSMART. However, neither combination has any meaning which is different to the meanings of the words ‘smart’ and ‘wealth’ separately. And consumers, even careful ones, are unlikely to undertake a forensic analysis of the words in order to find one. I therefore find that the meanings of the marks as wholes are unaffected by the order in which these words appear. In my view, the SMARTWEALTH element of the contested mark

conveys the same meanings as WEALTHSMART. Considered as wholes, I find that the marks are conceptually similar to a high degree.

Likelihood of confusion

38. The opponent's case is, essentially, that:

- The SMARTWEALTH element of the earlier mark will be imperfectly recalled as WEALTHSMART (or vice versa);
- The addition of the UBS house mark will make little or no difference to consumers of non-specialist financial services because the opponent's reputation is limited to consumers of specialist financial services;
- Even those familiar with the UBS mark are likely to assume a connection between the users of the mark (perhaps that one user is a subsidiary of the other, or that they are partners);
- The identity or high similarity of the services increases the likelihood of confusion.

39. The holder's case is, essentially, that:

- The reversal of the words WEALTH and SMART in the contested mark combined with the addition of the well-known UBS house mark is sufficient to avoid any likelihood of confusion;
- This applies to users of both the specialist and non-specialist financial services covered by the IR because the reputation of UBS is known to both groups of consumers;
- The high level of attention paid by users of such services reduces the likelihood of confusion.

40. There is no dispute that, in principle, the addition of a house mark may not be sufficient to avoid a likelihood of confusion. In this connection, my attention was drawn to the judgments of Arnold J. in *Aveda Corporation v Dabur India Limited*[8]

[8] [2013] EWHC 589 (Ch)

and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another.*[9] Arnold J. considered the impact of the CJEU's judgment in *Bimbo*[10] on the court's earlier judgment in *Medion v Thomson.* The judge said:

> "18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
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> 19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
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> 20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).
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> 21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent

[9] [2015] EWHC 1271 (Ch)
[10] Case C-591/12P

distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

41. It seems clear that SMARTWEALTH has an independent distinctive role in UBS SMARTWEALTH. This is because these two elements of the mark are not connected, either through positioning or meaning. Further, SMARTWEALTH is, in my judgment, similar to WEALTHSMART. I do not consider the opponent is exaggerating when it expresses concern that these elements could easily be confused through imperfect recollection, particularly bearing in mind that consumers rarely have the chance to make direct comparisons between marks.

42. This brings me to the significance of the UBS house mark. The holder accepts that the mark has a reputation in relation to the following services:

"Stock exchange services, including the securities market, derivatives, currencies and certificates of precious metal; brokerage or ordering and/or consulting services in connection with banking, financial, real estate, insurance as well as monetary affairs; services of a custodian bank; financial planning and management consulting; services in the field of investment and risk management; valuation of financial investments; all the aforementioned services provided via secured access to electronic platforms for the provision of financial and banking services via global computer networks; consulting services via secure access to interactive electronic platforms for all the above services."

43. However, the opponent disputes that the reputation extends to general banking services, namely: banking and financial affairs; providing financial information via computer systems; financial services by means of computer systems; electronic interactive execution of financial and banking services via global computer networks; monetary affairs; financial transactions; financial management; financing of real estate; preparation of financial reports.

44. I find the proposed division of services a little artificial. For example, *services in the field of investment and risk management* is wide enough to cover investment services of the kind available in a high street bank. However, I accept the opponent's underlying contention that the reputation of UBS in the UK is likely to be concentrated amongst high net worth individuals and institutions with an interest in making large financial investments. This is consistent with Mr Broderick's evidence that the holder's UK offices provide *"wealth management, investment banking and asset management services to a substantial UK and foreign client base."* It is also consistent with the holder having received UK awards for 'Best private banking services overall' and 'Net-worth-specific-services' (for high net worth clients).

45. It is true that the holder invests over £1m per annum promoting its services in the UK, but much of this is spent on sponsorship of events. The high point of the holder's evidence is it has sponsored the Mercedes F1 team since 2011. It is not clear how much visibility this would have given the UBS mark prior to the relevant date. There is an example of a UBS street banner at the Monaco grand prix in evidence,[11] but it is not clear when this is from. In any event, as counsel for the opponent pointed out, it simply says UBS. Someone looking at this on television would not learn that UBS is a financial services provider. Therefore, to the extent that the reputation is a factor which helps to avoid confusion, the opponent is correct to submit that this can only really apply to services aimed at the highly affluent individual and businesses making large investments.

46. There is no evidence that the earlier mark has been used. Nor is there any evidence that the contested mark was used in the UK prior to the relevant date, or indeed much before February 2017. Accordingly, the absence of evidence of confusion sheds no light on the likelihood of confusion if and when the marks are used concurrently. Further, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered; not just used in relation to investment services aimed at those with £100k to £2m to invest.[12]

[11] See RB3

[12] See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited,* CJEU, Case C-533/06, at paragraph 66.

47. The high point of the holder's case, in my view, is that users of all kinds of financial services are likely to pay an above average level of attention when selecting a service provider. This reduces the likelihood of confusion, including the likelihood of imperfect recollection of SMARTWEALTH for WEALTHSMART (or vice versa). However, it does not eliminate this risk and, as counsel for the opponent pointed out, the risk of this occurring is higher where the services offered are (notionally) identical.

48. Taking all the relevant factors into account, I find that there is a likelihood of indirect confusion if the marks are used in relation to identical services, i.e. of consumers familiar with one of the marks mistaking SMARTWEALTH for WEALTHSMART, or vice versa, and the presence/absence of UBS not being sufficient to distinguish the providers of the services. In particular, a significant proportion of average consumers may be confused into believing that the user of the WEALTHSMART mark is connected with the services provided under the contested mark, for example as an agent or as a delivery partner.[13]

49. This finding also extends to *financing of real estate* where the respective services are similar and complementary.

50. I find that there is no likelihood of confusion as a result of the use of the contested mark in relation to s*ervices of a custodian bank.* This is because these services have no obvious connection to the services covered by the earlier mark, other than being financial services. In these circumstances, the differences between the marks is sufficient to avoid confusion.

Outcome

51. The opposition in class 36 succeeds, except in relation to s*ervices of a custodian bank.* The opponent did not oppose the protection of the IR in class 35 or in relation to *insurance underwriting* and *electronic banking services via a global computer network (Internet banking)* in class 36*.* Consequently, the IR will be protected in

[13] The likelihood of confusion in either direction being relevant confusion for the purposes of s.5(2): see *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 455.

class 35 and for these services in class 36. The IR will be refused protection in the UK for the remaining services in class 36.

Costs

52. The opponent has been successful and is entitled to a contribution towards its costs. I calculate these as follows:

£400 for filing a notice of opposition, including the official fee;
£600 for considering the holder's evidence and filing written submissions;
£500 for attending a hearing and filing a skeleton argument.

I therefore order UBS Group AG to pay Wealthkernel Limited the sum of £1500. The above sum should be paid within 14 days of the expiry of the appeal period.

Dated this 09th day of February 2018

Allan James
For the Registrar