

**BL O/0392/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. UK00003666555**

**BY PROPERTY MINE LTD TO REGISTER AS A TRADE MARK:**



**IN CLASS 36**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO.**

**OP000427936 BY ADRIAN FOSTER**

## BACKGROUND AND PLEADINGS

1. On 9 July 2021, Property Mine Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. On 3 September 2021, the application was accepted and published in the Trade Marks Journal in respect of the following services:

*Class 36: Financial services; financial consultation services; computerised financial services; financial brokerage services; financial advisory services; financial loan services; financial intermediary services; financial services relating to mortgages.*

2. On 3 November 2021, Adrian Foster (“the opponent”) filed a notice of opposition on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at the applicant’s mark in its entirety. The opponent relies on the following trade mark:



UK registration no. UK3441751

Filing date 5 November 2019; date of entry in register 27 March 2020.

Relying on all its services:

(“the opponent’s mark”)

*Class 36: Advice relating to mortgages for residential properties; advice services relating to enhancement of mortgages; advisory services relating to mortgages; arranging of mortgages; arranging of mortgages and loans; financial services relating to mortgages; financing of loans, mortgages and sureties; financing of mortgages and sureties; insurance services for the protection of mortgages; lending on mortgages; providing advice relating to the arranging of mortgages; provision of information relating to mortgages; provision of mortgages.*

3. The opponent submits that there is a likelihood of confusion because the applicant's mark is similar to its own mark and the respective services are identical or similar. The applicant filed a defence and counterstatement denying that the marks are similar but admitting to the services being either identical or similar.

4. Both parties represent themselves. Neither party filed evidence or submissions. No hearing was requested. Neither party filed submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

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

#### **Section 5(2)(b): legislation and case law**

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

“(2) A trade mark shall not be registered if because- (a) ...

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

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

7. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. The applicant selected both yes and no in relation to the applicant providing proof of use of its mark. The opponent’s mark did not complete its registration process five years before the filing date of the applicant’s mark. The conditions of use, therefore, do not apply to the opponent’s mark. Therefore, the opponent can rely on all its services in the opposition.

10. 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 impression created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## COMPARISON OF THE SERVICES

11. The services to be compared are as follows:

The applicant's services	The opponent's services
<p><u>Class 36</u></p> <p><i>Financial services; financial consultation services; computerised financial services; financial brokerage services; financial advisory services; financial loan services; financial intermediary services; financial services relating to mortgages.</i></p>	<p><u>Class 36</u></p> <p><i>Advice relating to mortgages for residential properties; advice services relating to enhancement of mortgages; advisory services relating to mortgages; arranging of mortgages; arranging of mortgages and loans; financial services relating to mortgages; financing of loans, mortgages and sureties; financing of mortgages and sureties; insurance services for the protection of mortgages; lending on mortgages; providing advice relating to the arranging of mortgages; provision of information relating to mortgages; provision of mortgages.</i></p>

12. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. 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 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account.

Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

13. Guidance on this issue has also come from Jacob J. (as he was then) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

“(a) The respective uses of the respective goods or services;

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

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

14. In *Kurt Hesse v OHIM* (Case C-50/15 P), the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, (Case T-325/06), the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (*OHIM*) case T-133/05, the General Court (“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark”

16. The applicant admits in its Form TM8 that the trade marks “goods and services are identical or similar”. I accept this admission made by the applicant and find that the services are identical or similar. However, as the applicant has not admitted which services are identical and which are similar, I will do a services comparison below.

17. The applicant’s specification includes the term “*financial services*” which has not been limited. This is a wide term which covers “*financial services relating to mortgages*”. They are identical services on the principle outlined in *Meric*. Applying the same reasoning, I find “*computerised financial services*” in the applicant’s specification to be identical on the principle outlined in *Meric*.

18. “*Financial services relating to mortgages*” appear in both parties’ specifications and are self-evidently identical.

19. “*Financial loan services*” in the applicant’s specification has not been limited. It is a broad term that encompasses mortgages, home equity loans and sureties. Therefore, I find “*financing of loans, mortgages and sureties*” in the opponent’s specification is identical to the applicant’s services on the principle outlined in *Meric*.

20. “*Financial advisory services*” in the applicant’s specification is a broad category which has not been limited and that encompasses advice in relation to all financial services, including mortgages. Consequently, I find the applicant’s services encompass “*advisory services relating to mortgages*” in the opponent’s specification. Therefore, I find the services to be identical on the principle outlined in *Meric*.

21. In the absence of any evidence or submissions to the contrary, it is my view that “*financial consultancy*” in the applicant’s specification is the provision of advice on financial services and managing wealth/money. I note that the applicant’s services are not limited and



therefore, are inclusive of financial consultancy services relating to mortgages. Applying the definition above, it is my view that the applicant's services are a broad category of services that encompass "*advisory services relating to mortgages*" in the opponent's specification. Therefore, I find the services to be identical on the principle outlined in *Meric*. However, if I am mistaken, I find the services to be highly similar.

22. In the absence of any evidence or submissions to the contrary, it is my view that a financial brokerage service acts as a middleman who connects buyers and sellers to complete a transaction for financial services. Similarly, it is my view that a financial intermediary service acts as a middleman between two parties in a financial transaction. I find "*financial brokerage services*" and "*financial intermediary services*" in the applicant's specification to be similar to "*financial services relating to mortgages*" in the opponent's specification. It is my understanding that financial services relating to mortgages is a broad category that encompasses both mortgage brokers and mortgage lenders. Mortgage brokers provide a financial service by bringing together borrowers and lenders acting as a middleman between the two. Taking this into account, it is my view that the applicant's services are encompassed by the opponent's services, therefore, I find the services to be identical on the principle outlined in *Meric*. However, if I am mistaken, I find the services to be highly similar.

## **THE AVERAGE CONSUMER AND THE PURCHASING PROCESS**

23. As the law above indicates, it is necessary for me to determine who the average customer is for the parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) 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."

24. The parties' specifications cover a range of financial services that can be aimed at an ordinary member of the public and/or at a more specialised commercial customer or financial institution. The cost of the services at issue is likely to vary dependent on the services provided and in my view the services will be purchased relatively infrequently.

25. That said, the purchasing act for all of the respective services will be at least well considered as the average consumer, whether an individual or a commercial undertaking, will take note of, inter alia, charges, interest rates, price comparisons, security and accessibility of services, before entering into the purchasing act. In relation to the advisory and consultancy services, the average consumer will consider factors such as the education and experience of the advisor/consultant, professional fees, client profile and recommendations. Therefore, it is my view that the level of attention paid during the purchasing process will be high.

26. The purchase of the services may be made visually from a website, brochure, prospectus, etc; or aurally such as in their local branch of a bank, over the telephone or via a broker, financial advisor or other intermediary. However, given that word-of-mouth recommendations and advice from financial advisors, for example, may also play a part, I do not discount that there will be an aural component to the selection of the services.

**COMPARISON OF THE MARKS**

27. The respective trade marks are shown below:

	
The applicant's mark	The opponent's mark

28. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to all the overall impressions created by the trade 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.”

29. 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.

30. The opponent's mark consists of the words 'British Mortgages'. The word 'British' appears in blue and is presented above 'Mortgages' which is presented in red, both are in slightly stylised text. To the left of the text is a device that consists of three waves interspersed with a white background. The image present in the waves collectively make up the appearance of a union jack. The overall impression of the mark is dominated by the words 'British Mortgages' with the colour element and the device playing a lesser role.

31. The applicant's mark consists of the word 'BRITISH HOME MORTGAGES' that appears in capitalised black text. The text 'BRITISH HOME' is placed over the word 'MORTGAGES'. In smaller text to the right of the word 'MORTGAGES' are the words '.co.uk' which appear in lower case. To the left of the text is the device of curled union jack that is presented in the colours of the union jack. The overall impression of the applicant's mark is dominated by the word 'BRITISH HOME MORTGAGES' due to its size and placement in the mark. The colour element, device and text '.co.uk' all play a lesser role in the mark.

32. Visually, the marks are dominated by the words 'BRITISH HOME MORTGAGES' and 'British Mortgages' respectively, the marks share the words 'British' and 'Mortgages'. The marks differ in the presence of the word 'HOME' which exists between the shared words in the applicant's mark, the words '.co.uk' at the end of the applicant's mark and the stylisation and colour of the text in opponent's mark. Further, the devices in the marks are also a point of difference. I note that the devices in both marks are positioned to the left of the text and presented in the colours of the union jack, however, the devices differ in how they depict the

union jack as referenced above. Taking all of the above into account, I find the marks to be similar to a medium degree.

33. Aurally, the device elements cannot be pronounced. The opponent's mark consists of five syllables that will be pronounced as BRIT-ISH-MORE-GA-JES. Whereas the applicant's mark consists of six syllables that will be pronounced as BRIT-ISH-HOME-MORE-GA-JES. The syllables in the opponent's mark appear identically in the applicant's mark in the first two and the last three syllables, however, the presence of the third 'HOME' syllable in the applicant's mark is a point of difference. Overall, I consider the marks to be aurally similar to a high degree.

34. Conceptually, both marks elicit the idea of mortgages that are British, as I consider that the average consumer would be of the view that the 'British' part of the marks indicates the location of the services, as the word 'British' denotes the geographic origin of the services. The devices of union jack flags replicate the meaning and significance of being British. Further, it is my view that 'mortgages' is descriptive or in some instances allusive of the services at issue. Overall, the concept conveyed by 'BRITISH' and 'MORTGAGES' in both marks is identical, however, a conceptual difference comes in the word 'HOME' in the applicant's mark. It is my view that the word 'Home' is allusive of the services, as they may pertain to home mortgages. Taking into account the point of difference, despite the allusive nature of the difference, I consider the mark to be conceptually similar to a high degree.

### **DISTINCTIVE CHARACTER OF THE OPPONENT'S MARK**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C- 108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

36. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not pleaded that its marks have obtained enhanced levels of distinctiveness nor has it filed any evidence to that effect, therefore, I have only the inherent position to consider.

37. The opponent’s mark consists of the words ‘British Mortgages’, which as I have explained are ordinary dictionary words. The word ‘British’ appears in blue and is presented above ‘Mortgages’ which is presented in red, both are in slightly stylised text. To the left of the text is a device that consists of three waves interspersed with a white background. The image present in the waves collectively make up the appearance of a union jack. The word ‘British’ is capable of designating the geographical origin of the services and the territory in which the services are provided and/or the geographical location of the business providing the services. The word ‘Mortgages’ is descriptive of the services the mark provides. Therefore, ‘British Mortgages’ as a whole has little inherent distinctive character for the services on which the opponent relies. Given the above, I find that the opponent’s mark can be said to have a low degree of inherent distinctive character.

## **LIKELIHOOD OF CONFUSION**

38. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer

realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 trade marks may be offset by a greater degree of similarity between the respective services or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be mindful of the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

39. I have found the marks to be visually similar to a medium degree and aurally and conceptually similar to a high degree. I have found the opponent's mark to be inherently distinctive to a low degree. I have found the average consumer to be a member of the general public or a specialised commercial customer or financial institution who will select the services via aural and visual means. I have found the average consumer's degree of attention to be high. I have found the services vary in similarity from identical to similar to a high degree.

40. While I have found the opponent's mark to have a low degree of distinctive character, being a factor in the applicant's favour, this does not automatically give rise to a finding of no likelihood of confusion between the parties.<sup>1</sup> I consider that the differences between the marks are insufficient to avoid confusion, taking into account the principle of imperfect recollection. I am of the view that the average consumer will overlook or misremember the differences between the marks. This is particularly the case given that 'BRITISH HOME MORTGAGES' and 'British Mortgages' are the dominant elements of the marks respectively, and I have found the marks to be aurally and conceptually similar to a high degree. Therefore, it is likely that the marks will be misremembered or mistakenly recalled as each other, even when a high degree of attention is applied. Therefore, I find that there is a likelihood of direct confusion between the marks. I consider that this applies to the services that have been found identical and highly similar as I consider that the high conceptual and aural similarity will offset the similarity of the services.

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<sup>1</sup> *L'Oréal SA v OHIM*, Case C-235/05 P,

41. I bear in mind that it is possible that the differences between the marks may still be overlooked when it comes to indirect confusion. On this basis, I am of the view that the differences between the marks will be overlooked for the same reasons set out above in paragraph 41. As a result, the differences between the marks will be seen as indicative of an alternative mark or sub-brand from the same or economically linked undertaking. Consequently, I consider that there is a likelihood of indirect confusion between the marks. I consider that this finding will also apply to the services that have been found to be highly similar. I make this finding having taken into consideration that a high degree of attention will be applied by the average consumer.

## **CONCLUSION**

42. The opposition succeeds in full. As a result, the application is refused in its entirety.

## **COSTS**

43. The opponent has been successful and is entitled to a contribution towards its costs. The award of costs are governed by Tribunal Practice Notice 2/2016. The opponent is not professionally represented and on 19 January 2023 was sent a costs proforma by the Tribunal to complete. The opponent did not provide a completed costs proforma, therefore, the only costs that it is entitled to is the official fee for filing its opposition. The sum is calculated as follows:

Official fee	£100
<b>Total</b>	<b>£100</b>

44. I therefore order Property Mine Ltd to pay a total sum of £100 to Adrian Foster. The sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 26<sup>th</sup> day of April 2023**

**A Klass**

**the registrar**