

o/0024/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003516667

BY KEYSTONE FINANCIAL LIMITED TO REGISTER A DEVICE MARK

IN CLASS 36

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 600001553

BY KEYSTONE IEA LIMITED

DECISION

INTRODUCTION

1. This is an appeal from the decision of the hearing officer who upheld, in part, an opposition brought by Keystone IEA Limited (“the opponent”) to the mark in issue:



sought to be registered by Keystone Financial Limited (“the applicant” or “appellant”) for the following services:

Class 36 Financial services, financial affairs, financial advice, financial analysis and consultancy; investment services; fund, asset, unit trust and investment management services; portfolio management; monetary affairs; mortgage services; pension services; financial management services; financial risk assessment, analysis and management; financial appraisal; brokerage services; financing; insurance, assurance and reinsurance; insurance brokerage; provision

of funds; provision of financial information; economic financial research services; financial investment research services; financial research; financial evaluation; monitoring of financial portfolios; administration of financial affairs; preparation of financial reports and analysis; investment research; advisory, consultancy and information services relating to all of the aforesaid

2. The mark was opposed under section 5(2)(b) of the Trade Marks Act 1997 (“the Act”) based on trade mark UK00002641172, registered on 15 February 2013, namely:



registered for the following services: Class 36 Estate Agents.

3. That mark was subject to the proof of use requirements. The hearing officer, who decided the case at the parties’ request without a hearing and without written submissions additional to the forms, was satisfied that the opponent had demonstrated genuine use of that mark in relation to estate agency services in the United Kingdom. The hearing officer considered that the specification “Estate Agents” was therefore appropriate.
4. He went on to consider the similarity of the services and marks and whether there was a likelihood of confusion in a conventional way, setting out the law (statutory and case law) in a way which is not suggested to have been wrong and which it is not necessary to repeat here.

Similarity of services

5. As to the range of services in respect of which the mark applied for was found to be confusingly similar, which is the focus of the opponent’s appeal, the hearing officer undertook a detailed analysis. He referred to the case law relating to this kind of evaluation at length, including specifically the approach to complementarity of services. He said:

“49. The applicant’s “Financial services, financial affairs, financial advice, financial analysis and consultancy” and “monetary affairs” are potentially similar to the opponent’s “Estate Agents” services. Financial services include

mortgage services, which have a key role to play in the overall house-buying process. I consider their core purposes to be different, the former being services in relation to the managing, lending and investing of money, the latter being about facilitating the buying, selling, renting and maintenance of property. They are not in competition. However, they are complementary in respect of mortgage advice and brokerage, whereby the user of estate agent services will often need to avail themselves of a loan when buying property and, when it is a necessity, such services are indispensable. The second element of complementarity is also present in that the relationship is one where it is also likely that the average consumer may think the responsibility for those services lies with the same, or an economically linked, undertaking. It is not uncommon for financial advisers to be housed on the same premises and sometimes they are part of the same group of companies, their separation being necessary for regulatory purposes. The same overlap of trade channels occurs when the estate agent's website offers financial services which can be linked through to. I find the services to be of medium similarity.

50. "Mortgage services", "financing", "provision of funds" and "brokerage services" differ in their purposes from estate agent services and they are not in competition. However, they are complementary in respect of advice on mortgages, financing, the provision of funds, and their brokerage in the same way as financial services are as set out above. I find the services to be of medium similarity.

51. "Insurance, assurance and reinsurance" services, and "insurance brokerage" are services which differ in their purpose from estate agent services and they are not in competition. However, they are complementary where insurance and insurance brokerage play a key role in property transactions. The user of estate agent services may need to insure their life as a condition of being granted a mortgage and the fabric and contents of the property that they intend to purchase will need to be insured. In these circumstances, such services are at least important and are sometimes indispensable. The second element of complementarity is also present in that the relationship is one where it is also likely that the average consumer may think the responsibility for those services lies with the same, or an economically linked, undertaking. It is not uncommon

for financial advisers who deal with insurance companies to be housed on the same premises and sometimes they are part of the same group of companies, their separation being necessary for regulatory purposes. The same overlap of trade channels occurs when the estate agent's website offers insurance services which can be linked through to. I find the services to be of medium similarity.

52. I also find "advisory, consultancy and information services relating to ..." the above services to be of medium similarity.

53. "Financial appraisal" "provision of financial information", "economic financial research services" "financial investment research services", "financial research", "financial evaluation", "preparation of financial reports and analysis" and "investment research" are assessment, research and analytical services which can relate to individual transactions, but can also involve the assessment of market conditions as a whole. They are not closely related to the services offered by estate agents in the way that mortgages and insurance are. They are not in competition, nor are they complementary. They are dissimilar.

54. I consider "investment services", "fund, asset, unit trust and investment management services", "portfolio management" and "monitoring of financial portfolios" to be different in their purposes to "Estate Agents" services, the former being about investments, the latter about property. They are not in competition, nor are they complementary, the one not being important or indispensable to the other. They are dissimilar

55. "Pension services" are dissimilar to "Estate Agents" services. They are a branch of financial services - retirement planning and the setting up of and oversight of a pension - that is unrelated to the services offered by estate agents. They are not in competition, nor are they complementary, the one not being important or indispensable to the other. They are dissimilar.

56. I consider "financial management services" and "financial risk assessment, analysis and management" and "administration of financial affairs" to be different in their purposes to "Estate Agents" services, the former being about the day-to-day management of finances, rather than the lending of money that would be associated with property. They are not in competition, nor are they

complementary, the one not being important or indispensable to the other. They are dissimilar.

57. I also find “advisory, consultancy and information services relating to ... ” the above services to be dissimilar.”

Similarity of marks and likelihood of confusion

6. The hearing officer went on to consider the similarity of the marks, finding that they were of medium similarity aurally and visually and of high conceptual similarity. He did not find that there was any enhanced reputation from use. The hearing officer considered both direct and indirect confusion (namely that an average consumer would recognise that there was a difference between the marks but nonetheless believe that there was a connection between the businesses in respect of which they were used). He said:

“84.The average consumer would recognise the earlier mark as different from the applicant’s mark. The question remains whether the average consumer would consider the later mark to be another brand of the owner of the earlier mark, or that of a related undertaking, the marks having their first words, “KEYSTONE” / “Keystone”, in common.

85.Notwithstanding the stylistic differences and those of colour, the most important consideration is the words, and the additional respective words in this case, “INDEPENDENT ESTATE AGENTS” and “Financial” are entirely consistent with what the average consumer would regard as brand variation. The average consumer could see an economic connection between “KEYSTONE” as a purveyor of estate agents services and “Keystone” as an undertaking that provides financial services such that they would conclude that the parties’ marks indicate services sold by the same or economically linked undertakings. For those services where I have found similarity, I conclude that there is a likelihood of indirect confusion.”

No criticism is made on this appeal of this aspect of the evaluation.

7. The hearing officer accordingly allowed the mark to proceed to registration for some services but refused it for the following services:

Class 36 Financial services, financial affairs, financial advice, financial analysis and consultancy; monetary affairs; mortgage services; brokerage services; financing; insurance, assurance and reinsurance; insurance brokerage; provision of funds; advisory, consultancy and information services relating to all of the aforesaid.

8. The hearing officer addressed this issue by way of issuing a provisional decision dated 10 May 2021 and a supplementary decision, dated 16 June 2021, following further submissions from the parties which did not lead him to change his mind. The appellant challenges this aspect of both decisions.

GROUND OF APPEAL

9. The Grounds of Appeal were stated as follows in the TM55. I reproduce them in their entirety since there was no skeleton argument supplementing them.

1. The Applicant Appeals the amendments made to its Trademark Specification by virtue of the Hearing Officer's Decision.

2. The Applicant contends that the Hearing Officer has failed to take account of the facts relevant to Applicant and the Opponent's Marks and the Specification of those Marks.

3. The contents of the Applicant's Counter-statement are repeated.

4. Further, the Applicant relies on the fact that the Opponent's Trademark specification is simply "Estate Agents". As IPO guidance documents make clear to all applicants for Trade Marks: "your trade mark will only be protected for the goods and/or services you select in your application."

5. The Opponent chose only to list "estate agents" but by virtue of the Hearing Officer's Decision is, without further application or examination the Opponent is effectively obtaining much wider coverage than was sought or granted.

6. For example, "Financial services, financial affairs and financial advice" are key facets of the Applicant's business as Financial Advisors for which they are regulated by the FSA. The Opponent is not regulated by the FSA and, as a matter of law, cannot provide such services.

7. It is further submitted that the public at large are aware of the fact that the provision of financial advice is a separate and regulated activity. On the same basis, for example, the legal conveyancing of property is part and parcel of the house-buying process, but the public would not associate such services with an Estate Agent's services either. They might seek to introduce or refer such services, but they cannot carry them out themselves.

8. The reality is that the Opponent introduces and refers such services to a separate sister-company, it is not even claimed by the Opponent that it carries out such services

9. The Applicant would seek by way of Appeal, the re-instatement of these deleted wordings in the Specification.

10. This is on the basis that they were not sought as part of Opponent's Trade Mark and further the Opponent cannot claim to deliver such services. What it may do in related companies not holding a Trade Mark is irrelevant to that analysis and should not be considered.

10. When arrangements came to be made to fix the hearing of this appeal, the parties said that they were content for the matter to be determined on the papers. Neither side filed any further submissions. Accordingly, the only material setting out the reasons why the hearing officer's decision is said to be erroneous is that reproduced above.

Principles

11. The principles for evaluating this appeal have been summarised on several occasions in slightly different language. An appeal is not a rehearing nor an opportunity to reargue the case decided below. It is not appropriate to overturn a hearing officer's decision even if this tribunal has some doubts about it. The purpose of an appeal is to correct errors not re-do the decision (see *TT Education Ltd v Pie Corbett Consultancy Ltd* [2017] RPC 17 at [52] and *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 at [11]). The key question is whether the decision was wrong. In *TT Education* at [52(v)] (approved in *Apple*) the Appointed Person put it as follows:

“Situations where the registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about

which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be “clearly” or “plainly” wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the registrar's decision was wrong, should the appeal be allowed...”.

Evaluation

12. In my view, the appellant’s appeal is not well founded. The appellant makes essentially two points (other than re-running the points made in the Counter-Statement, which is not the purpose of an appeal in the absence of an identifiable error in how they have been determined).

13. First, the appellant considers that the effect of the hearing officer’s decision is that the opponent is entitled to protection in respect of a wider range of services than those in respect of which the mark has been registered or used. That is true in the sense that a registered trade mark gives protection against registration (and use) of a confusingly similar mark not only in relation to identical goods or services but also in relation to similar goods and services, in the circumstances stated in the Act. That is therefore not a valid objection to the hearing officer’s decision. It is a feature of the law. Section 5(2)(b) of the Act provides that a (later) 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.” Once a finding has been made that there is similarity of services and a likelihood of confusion as a result of the similarity of the services and the respective marks, the Act prevents registration of a later mark to that extent. The appellant may have misunderstood the IPO Guidance referred to in the Grounds of Appeal. That states that a “trade mark will only be protected for the goods and/or services you select in your application.” It is correct so far as registration of the mark is concerned but does not have any impact on the ability of the mark to be asserted in opposition proceedings against registration in respect of other goods and/or services in the circumstances provided for in the Act.

14. Second, the appellant implicitly challenges the finding of similarity of services (paragraphs 6-7 of the Grounds). Again, I think this challenge is misconceived.
15. Financial services may be a separate activity from estate agency services and may be subject to different regulation but that is not the question for the Registrar under these provisions of the Act. The question under the Act is whether the average consumer would be led to think that there was a connection between entities undertaking the respective activities under the respective marks as a result of the similarity of the marks and the similarity of the activities. The hearing officer held, in effect, that the average consumer would think there was a connection on the basis of the common use of at least one of the dominant and distinctive features (and arguably the most dominant one) namely the word KEYSTONE.
16. It is further submitted by the appellant that the public at large are aware of the fact that the provision of financial advice is a separate and regulated activity. It is said that estate agents might introduce or refer services such as financial or conveyancing services but cannot carry them out themselves. That does not engage with the provisions of the Act. Indeed, if anything the fact that the appellant acknowledges that the opponent introduces and refers “such services” to a “separate sister-company”, suggests that it would be natural for a connection (with another company in the group undertaking financial services) to be made by an average consumer on the basis that undertakings under common control would be likely to undertake the respective services even if they were not undertaken by the same corporate entity. Again, the applicant’s position reflects a misunderstanding of trade mark law and the difference from the regulatory regimes authorising the conduct of businesses of various kinds. In any event, these Grounds of Appeal do not disclose any arguable error made by the hearing officer in his evaluation. Determinations of whether there is likely to be confusion on the basis of similarity of marks are multifactorial and, in this case, there is no error in the way in which the hearing officer went about making the evaluation in question.

CONCLUSION

17. Accordingly, this appeal must be dismissed.

COSTS

18. The hearing officer made a modest award of costs to the applicant (£150). Given that the opponent would not have incurred more than minimal costs on this appeal, only a nominal costs award would be warranted. In my view in all the circumstances, the costs award below should simply stand and there be no further order for costs on this appeal.

DANIEL ALEXANDER KC

Appointed Person

30 December 2022