TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2139348A
BY THE ROYAL BANK OF SCOTLAND GROUP PLC

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER No 48122 BY TERENCE COLE

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2139348A
by THE ROYAL BANK OF SCOTLAND GROUP PLC
in class 36

and

IN THE MATTER OF Opposition thereto under No 48122
by TERENCE COLE

Background

1. On 16 July 1997, The Royal Bank of Scotland Group plc applied to register the trade mark shown below:

2. The application was subsequently divided accepted and published in respect of the following services in Class 36:

> "Financial banking services; savings account services".

3. On 28 January 1998, Terence Cole of 24 Philimore Gardens, London, W8 7QE filed notice of opposition to this application, numbered 2139348A.

4. The opponent states that he is the registered proprietor of United Kingdom registration no: 2067732 and Community Trade Mark registration no: 564195 in respect of the trade mark shown below.

5. The goods and services for which these trade marks have been registered are reproduced as part of the decision in opposition No 48123 a copy of which is annexed to this decision.

6. The opponent claims that the respective trade marks are similar and encompass similar goods and services; consequently registration of the application in suit would be contrary to Section 5(2)(b) of the Act. In addition, the opponent claims that because his earlier trade mark has a reputation in the United Kingdom, registration of the application would be contrary to Section 5(3) of the Act. The opponent also states that he has made significant use of his earlier registration and that the trade mark has acquired goodwill in the United Kingdom. Consequently he believes that registration of the application in suit is liable to be prevented by the law of passing off and so would be contrary to Section 5(4)(a) of the Act.

7. The opponent also submits that the application should be refused under Section 3(6) of the Act because a new proprietor was recorded and the basis for such a recordal was unclear and that it was therefore made in bad faith. Section 3(1)(c) is also pleaded on the basis that the trade mark designates the kind and/or intended purpose of the services.

8. The applicants subsequently filed a counterstatement denying all the grounds of opposition.

9. Both parties filed evidence and sought an award of costs but neither sought or took up the invitation to be heard at a hearing. Consequently a decision has been taken from the papers on file.

10. Acting on behalf of the Registrar and after careful consideration of the papers, I duly give the following decision.

11. Parallel opposition proceedings, under No 48123, in respect of application number 2139348B, and involving the same parties in the same roles (applicants and opponent) is the subject of a decision issued today and as indicated earlier is attached.

The Evidence

12. Both the opponent's and applicants' evidence in these proceedings are substantially the same as that filed in opposition No 48123, with the exception of one additional exhibit filed by the applicants, namely exhibit MRM6 which comprises a copy of the certificate of registration for their United Kingdom registration No 2143300, applied for on 29 August 1997 for the trade mark "RATEwatch" in respect of the same services as those for which registration is sought under the present application.

13. A summary of the evidence filed by both parties is provided in the decision given in respect of opposition No 48123 and annexed to this decision and I rely upon that in this case.

Decision

14. In the parallel proceedings I found that the opposition, insofar as it was based upon Sections 5(3), 5(4), 3(1)(c) and 3(6) of the Act, was for various reasons without substance. The allegations and evidence in this case are the same. Therefore, despite the slight differences

between the trade marks the subject of the respective applications - which do not in my view affect matters - the opposition in respect of those grounds are dismissed also in this case. But I do need to consider the ground of opposition based upon Section 5(2)(b).

Section 5.-(2)(b) reads:

> "(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."

The term 'earlier trade mark' is defined in Section 6 of the Act as follows:

> "6.-(1) .....
>
> (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,"

15. In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG,* paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

16. First of all, both of the opponent's trade marks, United Kingdom registration 2067732 and Community Trade Mark (CTM) 564195 are earlier trade marks within the definition of Section 6 of the Act. The goods and services encompassed by the specifications of the earlier trade marks are wide ranging. On a plain and simple reading of the respective specifications I do not consider that the applicants' services in this case are either the same or similar to any of the opponent's goods and services in Classes 9, 16, 35, 38, 41 and 42 covered by the earlier trade marks. However, the respective Class 36 specifications need further consideration.

17. In relation to Section 5(2)(b), I need to consider notional and fair use of the earlier trade marks in relation to all of the services claimed in the specifications in Class 36 against the notional and fair use of the applicants' trade mark across the range of services set out in the application (*React Music Limited v. Update Clothing Limited* [2000] RPC 285, page 288).

18. In assessing whether similar or identical Class 36 services are involved, I refer to the test set out in *British Sugar PLC v. James Robertson & Sons Ltd* [1996] RPC 281 (and which was endorsed by the European Court of Justice in *Canon v. MGM* Case C-39/97), namely:-

> "... the following factors must be relevant in considering whether there is or is not similarity:
>
> (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;

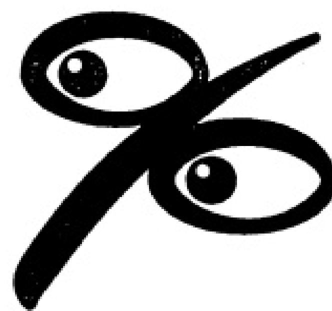
....

(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."

19. Taking these factors into account, it seems to me that a number of the services in Class 36 covered by the opponent's earlier registrations are the same or similar to the services covered by the applicants' specification. By way of illustration, the "financial banking services" of the applicant may encompass any or all of the "financial consultancy, information and management services, capital investments; charge card, credit card and debit card services (which may also be savings account services), electronic transfer of funds and advisory and consultancy services in relation to all the aforesaid services" covered by both the opponent's registrations. In these circumstances it seems to me that the services of the applicants as set out in the application for registration are wholly contained within the opponent's specification of services falling within Class 36 of the registrations, or they are at least similar.

20. Having concluded that the services at issue are identical or similar, the degree of similarity between the two marks is the pivotal issue in assessing the likelihood of confusion within the meaning of Section 5(2)(b). I go on then to assess the similarity or otherwise of the trade marks, which are as follows:

Earlier registration: Application in suit:



21. In assessing the similarity of the two trade marks, I must consider the aural, visual and conceptual similarities and the overall impression created. First, I consider the aural impression created by the two trade marks. Here, the word element "RATEwatch" in the applicants' trade

mark results in a different aural impression from that of the opponents trade mark. This word element is placed in a prominent position above the device. The trade mark in suit would therefore be likely to be described as a "RATEwatch" trade mark, whereas the opponent's trade mark is likely to be described as a "smiling percent sign" logo or similar.

22. The words "RATEwatch" whilst clearly not devoid of any distinctive character, as exemplified by its registration under United Kingdom application No 2143300, does possess an allusive character in that it informs the public that the services provided under the trade mark watch or monitor rates of interest. The allusive nature of the word element therefore reduces the penumbra of protection to be given to the trade mark. The device element of the applicants' trade mark therefore, as a result, assumes a significant and predominant part. The applicants' evidence indicates that the device was conceived with the idea of turning a percent symbol into a distinctive sign by adding features that give the allusion of a face. The opponent's trade mark, it could be said, was conceived using the same concept. The applicants claim that the percent sign is commonly used in the trade "as a shorthand way of referring to interest rates in advertising material, as interest rates are always calculated as a percentage of the capital sum invested". Exhibits MRM 1 - MRM 3 of the applicants' evidence show examples of other traders using the percent sign alone used in this way. But in this case the addition of features that give the impression of a face to the percent sign, is nevertheless a concept that appears to me as unusual. Though in the opponent's trade mark, different elements have been used to achieve the same 'humanised' result, there is no evidence that this concept is one which has been recognised or used by others in the financial services sector.

23. In opposition No 48213 in respect of application No 2139348B I held that the respective device elements were confusingly similar. But in this case the applicants' trade mark includes, in addition to the device, the word RATEwatch which is a registered trade mark in its own right. In my view that addition brings about a very different trade mark to that of the device on its own.

24. The prominent position of the registered trade mark RATEwatch within the applicants' trade mark imparts significant aural and visual differences between the applicants' and the opponent's trade marks (and significant differences between the applicants' trade mark the subject of application No 2139348B and the trade mark the subject of this trade mark application). The allusive term RATEwatch is given added emphasis by, and complements, the use of eyes within the percent sign. Thus the device becomes more a pair of eyes than a humanised percent sign. Thus adding to the differences between the trade marks.

25. The differences are sufficient in my view to hold, even taking account of imperfect recollection, that the applicants' trade mark in this case is not similar to that of the opponent's trade mark. The ground of opposition in respect of Section 5(2)(b) fails. Thus the opposition as a whole fails and the application may proceed to registration.

26. The opposition having failed the applicants are entitled to an award of costs and I order the opponent to pay to the applicants the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11 day of January 2002

M KNIGHT
For the Registrar
the Comptroller-General