

**TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 1544510  
IN THE NAME OF CLAIMS PROTECTION PLAN LIMITED**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 42871 IN THE NAME OF  
CARD PROTECTION PLAN LIMITED**

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AND TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 1544510  
in the name of Claims Protection Plan Limited**

**AND**

**IN THE MATTER OF Opposition thereto  
under number 42871 in the name of  
Card Protection Plan Limited**

**Background**

On 10 August 1993 Claims Protection Plan Limited, of Corrunna House, Selby, Yorkshire applied to register the trade mark CPP Claims Protection Plan in Class 36 in respect of the following services:

Insurance services; uninsured loss recovery services; all included in Class 36.

The application is numbered 1544510

On 31 July 1995 Claims Protection Plan Limited filed notice of opposition to this application. The grounds of opposition are in summary:-

- 1. Under Section 12** because the mark applied for is confusingly similar to the opponents' mark and is in respect of the same services or services of a similar description. Details of the opponents' marks are set out below.
- 2. Under Section 11** because the opposed mark would be disentitled to protection in a Court of Justice and/or would be contrary to law.
- 3. Under Section 17(1)** because the applicant cannot properly claim to be the proprietor of the mark and cannot properly claim to be using or have a bona fide intention to use the mark in respect of all the services

The opponents ask that the Registrar exercise his discretion under Section 17(1) and Section 18(5) and refuse to register the mark

Details of the opponents' registered marks cited in Section 12 of the grounds of opposition are as follows:

No.	Mark	Class	Journal/Page	Specification
5 10	1345254 CPP	36	5865/1757	Insurance against loss of valuables, documents and credit, cheque and membership cards; medical insurance; emergency financial services for travellers; arranging discounts for travel services; all included in Class 36.
15 20	1345255 CPP CARD PROTECTION PLAN	36	5907/504	Insurance against loss of credit, cheque and membership cards; emergency financial services for travellers; arranging discounts for travel services; all included in Class 36.
25 30	1442663 	42	5928/4712	Lost property services and services relating to the safeguarding of credit cards, cash cards, cheque cards and charge cards; property identification, retrieval and replacement services; all included in Class 42.
35 40 45 50	1494434 CARD PROTECTION PLAN	36	6077/3772	Insurance services relating to the unauthorised use of payment cards, loss of personal money, communication costs incurred in pursuing and recovering property and in assisting police, provision of emergency cash advances and of airline tickets to repatriate policy holders.
	The applicants for registration filed a counterstatement in which they acknowledge the opponents' trade mark registrations but deny all other grounds of opposition. They ask that the opposition be rejected			

Both sides ask that an award of costs be made in their favour.

Only the opponents have filed evidence in these proceedings. The matter fell to be heard on 7 January 1999, but shortly before the date of the hearing both sides stated that they did not intend to be represented and that they were content for a decision to be made from the papers on file. Acting on the Registrar's behalf and after a careful study of the evidence filed I now give this decision.

By the time this matter came to be determined, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the 1938 Trade Marks Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all reference in this decision are references to the 1938 Trade Marks Act.

### **Opponents' evidence**

This consists of a Statutory Declaration dated 18 December 1996, executed by Mr Hamish McGregor Ogston, Chairman of Card Protection Plan Limited, the opponents in these proceedings. Mr Ogston confirms that he has held this position since April 1994, having previously been Managing Director from the date of the formation of the company in 1980, and refers to Exhibit HMO1 which consists of a copy of his company's certificate of registration.

Mr Ogston begins saying that the mark CARD PROTECTION PLAN, the abbreviation CPP and the composite form in which they are used were devised by him, and were first used by his company in the United Kingdom in April 1981. He refers to Exhibit HMO2 which is a copy of his company's statement of accounts for the year 1981/82, and which includes the company name but there is no mention of a trade mark.

Mr Ogston confirms the origins of his company's mark, and that it was first used and promoted in April 1981, and that the use has been continuous and has expanded steadily. He says that the marks are used separately and together, the mode of use being dependant on the size, layout, etc of the document. Mr Ogston goes on to set out details of his company's trade mark registrations, which are as set out above, and refers to Exhibit HMO3 which consists of copies of the certificates of registrations for these marks. He next details the services in respect of which the mark is used, which are all of the services covered by the registrations saying that the mark is also used on goods such as stickers and key rings as part of the promotion of the services.

Mr Ogston next details the turnover figures for his company under the mark, which ranges from £9,827 in 1981/82, rising year on year to a figure of £10,088,869 in the year 1992/93, the rest being after the relevant date. He says the marks have been widely promoted in the United Kingdom and elsewhere, and lists the promotional expenditure, which ranges from £8,741 in 1981/82 rising to £5,390,120 in 1992/93, the rest being after the relevant date. The phrase "and elsewhere" indicates that the figures do not relate solely to the United Kingdom, and no apportionment has been made. Mr Ogston next says that his company's services are promoted mostly by direct mailing and sometimes by an insert in trade journals and magazines, and refers to Exhibit HMO4 which consists of samples of promotional material. Most items bear the mark

CARD PROTECTION PLAN or the abbreviation CPP, although in a significant number of cases is used on literature bearing the name of another financial or retail organisation. None of the printed matter forming the exhibit is clearly dated, the only date shown being that relating to copyright, which, where given, is before the relevant date.

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Mr Ogston continues saying that his company's services are well known in the United Kingdom and have been reviewed in national newspapers, and refers to Exhibit HMO5. This consists of a copy of an article from the Daily Mail published on 16 June 1993 and the Sunday Mirror published on 21 May 1992. Both relate to card protection insurance in general and mention the opponents (as either CPP or CARD PROTECTION PLAN) as providers of such a service. The remaining part of the exhibit is a copy of an advertisement endorsed "1993 Mortgage Finance Gazette" and relates to the services provided by the opponents, referring to them as CPP, CARD PROTECTION PLAN or the composite form CPP Card Protection Plan.

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Mr Ogston says that his company's services extend throughout the United Kingdom. He refers to Exhibit HMO6 which consists of a list of organisations which he says recommend his company, and to Exhibit HMO7 which consists of a collection of letters from companies which Mr Ogston says recommend or sponsor his company's services. Mr Ogston says that his company now has 3.2 million subscribers in the United Kingdom, and expresses his belief that his company was the first and remains the largest company offering these services in the United Kingdom.

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He continues giving his opinion on the likelihood of confusion, and states that a limitation of the services covered by the application to motor insurance would not remove the likelihood of confusion because his company's services are also provided in the motoring industry. He refers to Exhibits HMO8 which consists of samples of publicity letters sent to prospective clients by the Caravan Club and Frizzell. The letters originate from the insurance arm of the Caravan Club and from the banking services arm of Frizzell, both offering the card protection service and refer to CPP Card Protection Plan. Mr Ogston concludes by referring to Exhibit HMO9 which consists of four identically worded declarations from persons within financial institutions and the International Airlines Passengers Association stating that they would confuse the applicants' mark with the opponents' mark.

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No evidence was filed by the applicants and I therefore turn to consider the grounds on which the opposition is based.

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### **Decision**

Sections 11 and 12 of the Act read as follows:-

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**11** It shall not be lawful to register as a service mark or part of a service mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

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**12.-(1)** Subject to the provisions of subsection (2) of this section, no service mark shall be registered in respect of any services or description of services that is identical with

or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same services, the same description of services, or goods or description of goods which are associated with those services or services of that description.

5 The reference in Section 12(1) to a near resemblance is clarified by Section 68(2)(b) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

10 The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

15 **Under Section 11** Having regard to the user of the marks CPP, Card Protection Plan and CPP Card Protection Plan, is the tribunal satisfied that the mark applied for, CPP Claims Protection Plan if used in a normal and fair manner in connection with any services covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

20 **Under Section 12** Assuming user by the opponents of their marks CPP, Card Protection Plan and CPP Card Protection Plan in a normal and fair manner for any of the services covered by the registrations of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark CPP Claims Protection Plan, normally and fairly in respect of  
25 any services covered by their proposed registration?

I will deal with the matter firstly under Section 12. The opponents have three registered marks in the same goods class and for identical services to those set out in the application, and another in Class 42 for services which I would consider to be similar. For convenience I propose to make  
30 the comparison based on two registrations in the same class, number 1345254 and 1345255 for the marks CPP solus and CPP CARD PROTECTION PLAN as the opponents will not be in a better position on the basis of the other registrations. The matter falls to be decided by a comparison of the marks themselves, and for this purpose I adopt the well known test propounded  
35 by Parker J in Pianotist Co's application (1906) 23 RPC 774. The relevant passage reads:

"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you  
40 must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you  
45 may refuse the registration, or rather you must refuse the registration in that case."

The applicants' mark consists of the letters CPP placed above the words CLAIMS PROTECTION

PLAN. The positioning and size of the letters CPP in the applicants' mark makes them the most prominent feature and although stylised are clearly recognisable. The words CLAIMS PROTECTION PLAN are descriptive of the services provided under the mark and likely to be regarded as such by the public but nonetheless should be taken into account in considering the similarity of the marks. There can be no dispute that the opponents' registration for the letters CPP is identical to the dominant distinctive element of the applicants' mark, and that the opponents other mark, CPP CARD PROTECTION PLAN is as a whole extremely close visually, orally and conceptually.

Adapting the wording of the Pianotist test, having determined that the same and similar services are involved I must go on to consider the nature and kind of customer and the surrounding circumstances. Insurance is of some importance and although carefully selected in terms of cover and cost, the familiarity of the purchaser with the service provider is often the basis on which the selection is made. Taking this into account with my findings on the similarities of the marks, I think that there is a real tangible risk of deception amongst a substantial number of persons on the basis of normal and fair use of their mark by the applicants. The opposition, therefore, succeeds under Section 12.

Although my findings under Section 12 effectively decide the matter, I will consider the grounds under Section 11 should I be found to be wrong in my determination.

The test set out earlier requires me to consider the user established by the respective parties at the relevant date, that is, the date of the application for registration of the trade mark under opposition. The opponents claim to have first used their mark in 1981, and the evidence shows that they have made substantial use of their marks CPP and CARD PROTECTION PLAN both individually and in a composite mark for a range of insurance related services for credit card, bank card and membership card holders, etc. The applicants have not filed any evidence in these proceedings, but taking into account the similarities in the respective marks, that the services included in the application are identical to those provided by the opponents and that they are likely to be provided to the same customers, I take the view that if the applicant were to use their mark in relation to the services covered by their application there is a strong likelihood of deception and confusion. That being the case, I find the opposition to also be successful under Section 11 and do not need to go on to consider the matter of the registrar's discretion.

The opposition having succeed, I order that the applicants pay the opponents the sum of £735 as a contribution towards their costs.

**Dated this 29 day of April 1999**

**Mike Foley  
for the Registrar  
The Comptroller General**