

O-199-10

TRADE MARKS ACT 1994

APPLICATIONS 2463596 & 2465695 BY LION GLOBAL INVESTORS LIMITED

TO REGISTER THREE TRADE MARKS IN CLASS 36

AND

CONSOLIDATED OPPOSITIONS 96751/52

BY LION CAPITAL LLP

1. On the 8 August 2007, Lion Global Investors Limited (“Global”) made application 2463596 to register LION GLOBAL INVESTORS as a trade mark in class 36 for:

Financial services; fund management; investment management; asset management; unit trust management, financial and investment portfolio management; financial advisory services; financial investment advisory services; investment advisory services; advisory services relating to unit trusts; investment analysis; fund investments; capital investments; unit trust investments; marketing of mutual funds; mutual fund distribution; mutual fund administration; unit trust services; including such services provided on-line or via the Internet.

2. On 29 August 2007, Global made application 2465695 to register the series of two marks shown below for the services shown above.



3. The colour of the background in the first mark in the series corresponds to the colour standard known as PMS 7453C. The application has a priority date of 20 August 2008, but nothing turns on this.

4. Application 2463596 was published on 4 April 2008. Application 2465695 was published a bit earlier, on 22 February 2008. Both applications are opposed by Lion Capital LLP (“Capital”) on the same grounds. These are as follows:

- (a) Under s.5(2)(b) and s. 5(3) relying upon the earlier UK trade mark 2377779 comprising the words LION CAPITAL, registered in class 36.
- (b) Under s.5(2)(b) and s. 5(3) relying upon the earlier Community trade mark 4430096 comprising the words LION CAPITAL, registered in class 36
- (c) Under s.5(2)(b) and s. 5(3) relying upon the earlier UK trade mark 2226248 comprising the words LION, registered in class 36.

(d) Under s.5(2)(b) and s. 5(3) relying upon the earlier Community trade mark 5820691 comprising the words LION, registered in class 36.

(e) Under s. 5(4)(a) relying upon earlier passing off rights in the marks LION and LION CAPITAL.

5. Global generally denies the grounds of opposition and specifically denies that

“... the mark LION GLOBAL INVESTORS is confusingly similar to the earlier marks LION or LION CAPITAL. The only common element to these three marks is the word LION, which itself is used widely in trade as part of many marks for financial and monetary services in class 36 and is devoid of distinctive character for such services. The overall phonetic, visual and conceptual nature of the Applicant’s mark is very different from that of the Opponent’s marks. The Opponent is put to strict proof that any confusion would be likely to arise out of the use of the Applicant’s mark.”

6. Global also puts Capital to proof that:

- i) UK registration 2226248, which was registered more than five years prior to the dates of publication of the opposed marks, was to put to genuine use in the five year periods ending on the dates of publication.
- ii) The earlier marks have sufficient goodwill and/or reputation to found the s.5(3) and 5(4)(a) grounds of opposition.

7. Global also points out that Community trade mark (“CTM”) 5820691 is the subject of a relatively recent application by Global to the Office for Harmonisation in the Internal Market (“OHIM”) for a declaration of invalidity. This was followed by a further application by Global, to the Registrar, for the suspension of the current proceedings pending the outcome of the invalidation application. I return to that matter below. It is sufficient for present purposes to record that, contrary to what one might have expected from the pleading re-produced at paragraph 5 above, the legal ground that Global relies upon to invalidate CTM 5820691 is not that the CTM LION is devoid of any distinctive character, but that the CTM was applied for in bad faith.

Case Management

8. Following the application by Global to suspend the current proceedings a case management conference was held on 1 April 2010. For the reasons set out in a letter dated 6 April, I directed that:

- i) Global’s request to suspend the current proceedings in order to await the outcome of its application to invalidate CTM 5820691, and another application made to this Office to revoke UK registration 2226248 – LION – for non-use, should be refused.
- ii) Instead the oppositions, which have already been pending for over two years, should proceed.

- iii) The question of whether it is open to Capital to rely on its earlier UK registration for the trade mark LION should be determined as an issue in the opposition proceedings.
- iv) Global would be free to make a renewed application for suspension of the opposition proceedings to await the outcome of the OHIM invalidation proceedings if, on the basis of a provisional decision, the Hearing Officer found that all the other grounds of opposition failed, but that the ground of opposition based on CTM 5820691 was liable to succeed.
- v) Otherwise the outcome of the ground of opposition based on CTM 5820691 could be left open.

9. Global subsequently sought leave under Rule 70(2) of the Trade Mark Rules 2008 to appeal the Registrar's decision to refuse to suspend the opposition proceedings pending the outcome of its application to revoke UK registration 2226248. Such leave was refused on the grounds that the issue of whether Capital could rely on UK registration 2226248 was already in play in these opposition proceedings and could be fairly resolved to the extent necessary as part of these proceedings.

The Hearing

10. The matter therefore came to be heard on 18 May 2010 when Global was represented by Ms Iona Berkeley of counsel, instructed by White and Case LLP, and Capital was represented by Mr Adrian Speck of counsel, instructed by S J Berwin LLP.

The Evidence

11. Capital's evidence takes the form of two witness statements by Janet Dunlop, who is Capital's Chief Operating Officer, and David Paul Rose, who is a solicitor and a partner in S J Berwin LLP.

12. Ms Dunlop's evidence is that Capital adopted the name LION CAPITAL in April 2005. Prior to that Capital traded under the name Hicks Muse (Europe), and was part of a US private equity firm called Hicks, Muse, Tate & Furst. The name change marked a separation in the ownership of the US and European businesses.

13. According to Ms Dunlop, Capital's business revolves around raising funds and investing those funds by buying shares in companies associated with consumer focussed brands. In October 2008, Capital managed assets worth 2.8 billion euros. Examples of the companies in which Capital has invested are provided. These include Jimmy Choo, La Senza, Wagamama and Weetabix. Capital also provided turnover figures representing the fee income it earned in the years 2005-2008. These figures are the subject of a confidentiality order issued by the Registrar on 26 January 2009. It is sufficient to note that they amount to millions of pounds.

14. Advertising and promotion of Capital's marks appears to have been quite low key; mainly on corporate literature presented at investor presentations, press releases and private placement memorandums aimed at potential investors, such as pension funds, hedge funds, mutual funds, banks, insurance companies and wealthy individuals. Capital has also maintained a web site since 2005, which features the mark LION CAPITAL. Pages from the web site make up exhibit JD1.

15. Exhibit JD2 to Ms Dunlop's statement consists of copies of press articles about Capital. It is clear from these examples that Capital was often mentioned in the business pages of well known publications, such as The Times, The Daily Telegraph and the Evening Standard during the period 2005-2007. For example, an article which appeared on page 3 of the business section of The Sunday Times on 3 June 2007 states that:

"LION CAPITAL, the European buyout firm best known for investing in Jimmy Choo shoes, is close to walking away with the Dutch department store chain Hema for an estimated E1.1m.."

and

"Lion specialises in buying consumer-related companies. It already owns Weetabix, the cereal brand; the maker of Kettle crisps; and the lingerie retailer La Senza".

Another article from the business section of The Sunday Times dated 15 April 2007 covers the "*saga of the Cadbury Schweppes' break up*" and records that:

"All the usual private equity suspects are reckoned to be interested Blackmore, KKR, Lion Capital, CVC, Texas Pacific and others."

16. Mr Rose's evidence is that he was given copies of two e-mails sent to Ms Dunlop in 2009 by a recruitment agency called Selby Jennings. Both are addressed to Janet Dunlop (not Capital) and appear to assume that she works for Global. Mr Rose claims that this is evidence of actual confusion.

17. Global's evidence consists of two witness statements by Daniel Chan Choong Seng, who is the Chief Executive Officer of Global, and Marcus Leonard Collins, who is a solicitor with White & Case LLP, which represents Global in these proceedings.

18. Mr Seng's evidence is that Global is one of the largest capital management companies in South East Asia. Global provided asset management and related services in Singapore and overseas between September 2005 and June 2008 under the mark LION CAPITAL. The word LION was adopted because it was part of the name of one of firms that merged to form Global. The other firm used a lion figurative mark in its branding. Also Singapore is referred to as "*The Lion City*".

19. Global changed its branding in June 2008 to the opposed marks. Mr Seng says that "*This change embodies [Global's] aspirations and expanding client base, and underpins its ambition to build awareness of its services in the global marketplace*". Since 2006, Global services have won over 60 awards. All of those listed are from Singapore, Taiwan, Hong Kong or Taipei.

20. Mr Seng states that:

“I am aware that the word LION per se, and/or a graphic representation of a lion, are widely used in the financial sector in the United Kingdom and European Union. There is now produced and shown to me marked Exhibit "DC6" a list of the numerous business names that include the word LION for entities operating in the financial sector in the European Union. I have also discovered that the word LION, and/or a graphic representation of a lion, form part of numerous trade marks that have been registered in Class 36 in the United Kingdom and as Community trade marks. There is now produced and shown to me marked Exhibit "DC7" a non-exhaustive list detailing such marks. In light of the foregoing, I consider that the word LION per se cannot possibly be said to distinguish and be distinctive of any single trader.”

21. Exhibit DC7 shows that there are eight UK and Community trade marks registered in class 36 by six third parties that include the word LION or LIONS. There are many more marks including devices of lions, often as part of various crests or heraldic devices, and usually accompanied by non-Lion word marks.

22. Exhibit DC6 includes details of 14 marks including the word Lion, which are claimed to be in use in the financial sector. However, most of these are simply reports of company names. There is no evidence that these companies were trading under the corporate names at the date of Global's applications in August 2007, or at all. Other documents show use of Lion names in December 2008 in the USA or in Ireland. Only one of these references appears to me to be relevant. This is a copy of a page from a website dated December 2008, which indicates that a business in Sussex called Lion Finance has been trading under that name since 1979 and *“..providing financial solutions to business and private individuals”*.

23. Exhibit DC6 also includes a list of 13 entries for firms with names including the word LION, that have been registered with the UK Financial Services Authority. One of these is Lion Finance mentioned above. Two others - Golden Lion Garage Limited and Lion World Travel Limited were not registered until 2008 – after the dates that the opposed applications were filed. Another nine are recorded as *“no longer authorised”* or *“Appointed Representative – Former”*, which suggest that they are historical entries. Another entry appears to relate to the opponent's FSA registration.

24. Mr Collins' evidence comprises copies of letters between the parties' legal representatives during the first half of 2007. There is no suggestion that they are covered by privilege. The first letter dated 18 January 2007 draws Global's attention (then called Lion Capital Management Limited) to Capital's UK and EU trade marks and its *“global reputation”* before warning that Global's trading activities in South East Asia, including the fact that it manages two European funds and has an English language web site *“will inevitably infringe our client's intellectual property rights”*. The reply dated 16 February points out that Global is the owner of the Singapore registered trade marks LION, LION CAPITAL and LION CAPITAL MANAGEMENT.

Decision

25. I will start by examining the s.5(2)(b) ground of opposition based on UK registration 2226248 – LION, which is registered in class 36 for:

Advice and consultancy services relating to raising funds and finances.

The registration procedure was completed on 2 March 2001. The mark is registered with effect from the filing date, which was 17 March 2000.

26. The relevant part of s.5 is as follows:

5 (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 of association with the earlier trade mark.

27. The earlier UK mark had been registered for more than five years at the dates of publication of the opposed marks. Further, Global challenges Capital's statement of the use of that mark. It is therefore necessary to take account of s.6A of the Act, which (insofar as is relevant) is as follows.

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or

(ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

28. The leading authorities on genuine use are *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40, *La Mer Technology Inc. v Laboratoire Goemar SA* [2004] FSR 38, *Sunrider v OHIM, Case C-416/04 P* and *Il Ponte Finanziaria SpA v OHIM* [2008] ETMR 13, all ECJ. The following legal principles can be derived from these cases.

- i) 'Genuine use' means actual use of the mark in relation to goods or services which are already marketed, or about to be marketed, for the purpose of creating or preserving a market for those goods/services (*Ansul*, paragraph 36);
- ii) Such use must be external and by the trade mark proprietor or by a third party with authority to use the trade mark (*La Mer*, paragraph 37);
- iii) Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user (*Ansul*, paragraph 36):
- iv) Genuine use does not include token use for the sole purpose of preserving the rights conferred by the registration (*Ansul*, paragraph 36 and *Il Ponte*, paragraph 72);

29. Section 100 is also relevant and is as follows.

100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

The evidential burden is therefore on Capital to show use of the earlier UK LION mark in the five year periods ending on 22 February and 4 April 2008.

30. The parties disagree as to whether the use shown in Ms Dunlop's evidence amounts to use of LION (as Capital contends) or only use of LION CAPITAL (as Global contends). However, before it is necessary to resolve that matter it is first of all necessary to establish if the evidence shows use of either mark in relation to the services shown at paragraph 25. Ms Dunlop's evidence on this point amounts to a single sentence.

"As can be seen from exhibits JD1 and JD2, the mark LION is clearly in use in relation to "Advice and consultancy services relating to raising funds and finances."

31. On behalf of Global, Ms Berkeley submitted that all these exhibits show is that Global is a private equity business. I agree. Mr Speck argued that these services were an inherent part of running a private equity business and that the opponent provided advice to (a) those who wish to make investments to raise borrowing to supplement their own money to use, and (b) also to companies or businesses who wish to acquire financing or funding from investors. It seems to me that in making point (a) Mr Speck was trying to remedy through submission, facts that should have been made in evidence. Point (b) is plausible, but again there is no evidence on that point, and what evidence there is (see paragraph 13 above) does not support it. Nor do I know enough about the business of a private equity firm, or how well known this

would be to the relevant public, to take judicial notice of the fact that it inevitably involves providing advice and consultancy relating to raising funds and finances as a discrete service, or at all. Consequently, I find that Ms Dunlop's statement of use is mere assertion and there is no evidence of the use of either LION or LION CAPITAL in relation to these services. In these circumstances it is not necessary to decide whether the use of the latter includes use of the former, or use of a mark not differing in distinctive character from the form in which the mark LION is registered.

32. It follows from the above finding that Capital is not entitled to rely on UK registration 2226248.

33. I turn next to consider the s.5(2)(b) ground based on CTM 4430096 – LION CAPITAL – which is registered with effect from 9 May 2005 in respect of:

Insurance; financial affairs; monetary affairs; financial services; real estate affairs; corporate finance; private equity; investment services; capital, fund and trust investment services; investment management services; mutual fund, collective investment scheme and hedge fund services; unit trust services; financial and investment planning and research; advisory, consultancy and information services relating to all the aforesaid services.

34. It is common ground that Capital's CTM is an earlier trade mark, that the respective services are identical, and that having been registered for less than five years at the dates of publication of the opposed marks, the earlier mark is not subject to the proof of use requirements in s.6A.

35. I will first consider the likelihood of confusion between the earlier LION CAPITAL mark and Global's LION GLOBAL INVESTORS word-only mark.

36. In my consideration of whether there is a likelihood of confusion between the earlier mark and the Global's mark, I take into account the guidance from the settled case law of the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v OHIM* C-334/05 P(LIMONCELLO). 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*,

(b) the matter must be judged through the eyes of the average consumer of the services in question; *Sabel BV v Puma AG*, 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.*,

(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*,

(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; *Sabel BV v Puma AG*,

(e) 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; *Shaker di L. Laudato & C. Sas v OHIM*

(f) 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.*,

(g) 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*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*

Average Consumer

37. The average consumer of some of the general services covered by the applications (financial services and financial advisory services) may be a member of the general public or a business. In either case, an above average level of attention is likely to be paid when selecting a financial services provider. The other more specialised services covered by the applications, such as 'marketing of mutual funds' are more likely to be business-to-business services. A high level of attention is likely to be paid when selecting services such as this.

Distinctive Character of the Earlier Mark

38. This is really at the heart of the dispute between the parties. On behalf of Global, Ms Berkeley tried to persuade me that LION is no more distinctive for financial services than is GLOBAL INVESTORS. On that view of the matter, LION is not the dominant and distinctive feature of either mark. I do not agree. There can be no doubt that CAPITAL is a descriptive term for financial services. Indeed 'capital investments' is one of the services for which registration is sought.

39. The word LION is plainly not descriptive of financial services. It is a million miles away from the sign at issue in the well known passing off case of *Office Cleaning Services v Westminster Window and General Cleaning* [1946] 63 RPC 30, which was mentioned by Jacob L.J. in *Reed Executive plc v Reed Business Information Ltd* [2004] RPC 40, and to which Ms Berkeley drew my attention. Nevertheless, it does not necessarily follow that a non-descriptive word must therefore be distinctive. Global's case is that the word Lion is commonly used in the financial services field and therefore has little or no distinctive character. However, I find the evidence on this point to be wholly unconvincing. The evidence consists essentially of entries in trade mark registers and evidence supposedly showing use of LION in the relevant trade. As to the first type of evidence, it is well established that evidence of registration does not establish that marks are in use: see *British Sugar plc v James Robertson & Sons Ltd* [1996] 281 at 305. See also, by analogy, paragraphs 63-66 of the judgment of the Court of Justice in Case C-234/06-P, *Il Ponte v OHIM*, which concerned an attempt to rely on a 'family' of trade mark registrations as being sufficient to show the existence of a 'family' of like marks in the marketplace.

40. Ms Berkeley did her best to counter the body of case law against her on this point by drawing my attention to the judgment of Mr Daniel Alexander QC as a Deputy Judge in the case of *Digipos Store Solutions Group Limited v Digi International Inc.* [2008] RPC 24 in which (at paragraph 65 of the judgment) Mr Alexander appears to rely on the mere registration of marks containing the prefix DIGI. However, as Mr Speck was quick to point out, Mr Alexander did so for the limited purpose of showing that DIGI is a prefix likely to be popular amongst traders in digital equipment. He expressly states at paragraph 63 of his judgment that the register was not being deployed to show that the marks in question were in already in actual use. That is, of course, precisely what Mr Seng's evidence in this case seeks to do. I therefore reject this part of his evidence on the grounds that it is misconceived and/or irrelevant.

41. Mr Seng's evidence of actual use of the word LION in the UK market is potentially more significant. However, as can be seen from my analysis of his evidence in paragraphs 22 and 23 above, this evidence is of little probative value. At most it shows that there may have been some use from time to time of Lion-formative marks in the UK in relation to financial services, but the scale, length and extent of such use is impossible to determine. It is noteworthy that the only evidence of relevant and actual trade in the UK takes the form of a copy of web site relating to a local business in Sussex, which seems to have traded under the name Lion Finance for many years. I have no doubt that if Global had found similar evidence for the other names mentioned in exhibit DC6, it would have provided it. I conclude that Global has not shown that the word Lion is in common use in the financial services sector in the UK and therefore of low distinctiveness.

42. In my judgment, the word LION by its nature has an average degree of distinctiveness for the services at issue. It is true that it is not as distinctive as an invented word, and that it carries a vague allusion to strength, which I am sure is desirable characteristic for anyone trading in financial services. But the mark is not even semi-descriptive of any characteristic of the services at issue, and there is no evidence that it is, or has been, in common use in the financial services field in the UK.

43. Given my earlier finding that CAPITAL is descriptive of the services, it follows that I regard the word LION as the most distinctive element of the earlier mark.

44. Capital's evidence indicates that by the dates of Global's applications, LION CAPITAL was moderately well known in the financial investments market as a private equity business. The reputation was therefore narrowly focussed on top end financial undertakings and, even for them, quite 'niche'. Looked at in the context of the financial services market as a whole, the reputation would have been very modest indeed, even negligible. The majority of individuals and businesses in the market for all forms of financial investment would probably have never heard of Capital. I do not therefore consider that Capital's reputation would have resulted in a substantial increase in the level of distinctive character of the earlier mark by the dates of the opposed trade mark applications.

Similarity of Marks

45. The marks are similar to the ear and to the eye in that the first word of both marks is the word LION. There is also a high degree of conceptual similarity in that the word Lion conjures up an immediately recognisable concept that is not changed in its distinctive impact by the addition of the descriptive words CAPITAL or GLOBAL INVESTORS. In my view, the marks are highly similar overall.

Likelihood of Confusion

46. I have considered Mr Rose's evidence of 'actual confusion', but I have decided to attach no weight to it. This is because it may show no more than that the recruitment agency in question was confused as to which of the parties Ms Dunlop works for, rather than they confused one business with the other. The similar names may have played a part in this, but I think that making a finding on this basis would cross the line between a proper inference and mere speculation. However, given that Global does not yet appear to have traded in the UK in a significant way, I don't think that it would be right to attach any weight to the absence of evidence of actual confusion, which in any event is rarely decisive.

47. Despite the identity of the services and the high level of similarity between the marks, I think the average degree of distinctiveness of the earlier mark combined with the high level of attention paid by consumers is sufficient to prevent direct confusion on the part of average consumers of specialised financial services, such as 'fund management'. However, I find that there is a likelihood that such an average consumer is likely to believe that LION GLOBAL INVESTORS is a global development by the undertaking responsible for the LION CAPITAL business in the UK. Accordingly, I find that there is a likelihood of indirect confusion (or 'association' as it is described in the section) and the s.5(2)(b) ground therefore succeeds against application 2463596 on this basis.

48. It follows that if there is a likelihood of confusion in relation to the use of the marks for the more specialised financial services listed in the application, then there is also a likelihood of confusion in respect of the less specialised ones, such as 'financial services' and 'financial advisory services', where the average consumer's

level of attention is likely to be lower (although still above average). In the case of such generic descriptions of financial services, which cover services aimed at the general public, there is also a likelihood of confusion through imperfect recollection. There is therefore a likelihood of confusion with regard to Global's use of the mark in respect of all the services listed in the application.

49. In reaching these findings I have not ignored the distinguishing effect of the words CAPITAL and GLOBAL INVESTORS. Rather, my conclusion is that the addition of these descriptive words to the distinctive word LION is insufficient to avoid a likely of confusion when the respective word marks are used in relation to identical financial services.

Conclusion on application 2463596

50. The opposition under s.5(2)(b) succeeds and, subject to appeal, the application will be refused in total.

Application 2465695

51. Most of my findings apply equally to application 2463596. However, the degree of similarity between the respective marks is a bit less because Global's marks include a figurative element. I have asked myself whether this makes any difference to my findings about the likelihood of confusion. I have concluded that it does not. This is because the figurative element of the marks is no more than a background on which the words LION GLOBAL INVESTORS appear. As such it is unlikely to affect the average consumer's perception as to whether the user of the marks is, or is economically linked to, the user of the LION CAPITAL mark. It is true that one of the marks in the series is in colour. However, it is just one colour. There is nothing at all distinctive about the presentation of words on a background made up of one colour. Consequently, I find that this application must be refused on the same basis as application 2465695.

Other Grounds

52. Given my clear findings under s.5(2)(b), I do not consider it necessary on this occasion to examine the s.5(2)(b) grounds based on CTM 5820691 and UK trade mark 2377779, or the other grounds of opposition based on s.5(3) and 5(4)(a).

Costs

53. There is nothing about the case which justifies a departure from the Registrar's usual approach to awarding costs from the published scale (and no-one has asked for anything different). I bear in mind that these oppositions were consolidated which reduced the cost of filing and reviewing two sets of evidence, and also meant that there was only one hearing. With that in mind I order Lion Global Investors Limited to pay Lion Capital LLP the sum of £3000. This is made up of:

- i) £700 for filing two notices of opposition (including official fees)
- ii) £300 for considering two (similar) counterstatements
- iii) £500 for filing evidence

- iv) £250 for reviewing Global's evidence
- v) £750 for the substantive hearing, including skeleton
- vi) £500 for the cost of responding to Global's request to stay the current proceedings to await the outcome of other proceedings, including the cost of attending to a case management conference.

54. The above sum to be paid within 7 days of the end of the period allowed for appeal.

Dated this 21 Day of June 2010

**Allan James
For the Registrar**