

THE UK INTELLECTUAL PROPERTY OFFICE

The Rolls Building  
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Fetter Lane  
London EC4A 1NL

Monday, 4th June 2018

Before:

MR GEOFFREY HOBBS QC  
(Sitting as the Appointed Person)

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In the Matter of the Trade Marks Act 1994

- and -

In the matter of UK Trade Mark Application No. 3146197 brandft in  
Class 41 ("the Application") in the name of  
Brand Financial Training Ltd ("the Applicant")

- and -

Opposition No. OP000406980 ("the Opposition") by The  
Financial Times Limited ("the Opponent")

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In the Matter of an Appeal to the Appointed Person from the  
decision of Mrs Ann Corbett, acting on behalf of the  
Registrar, the Comptroller-General, dated 5 October 2017.

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*(Transcript of the Stenograph Notes of Marten Walsh Cherer Ltd.,  
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MS MICHELLE WARD of Indelible IP Ltd, appeared for the Appellant.  
MS CHARLOTTE BLYTHE instructed by Bristows LLP appeared for the  
Respondent.

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APPROVED DECISION

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THE APPOINTED PERSON: The domain name brandft.co.uk has, since 9 August 2006, been registered in the name of Ms Catriona Brand. The website at that web address became operational in January 2008 in connection with the business she had founded and carried on as a sole trader since 2006 under the trading name Brand Financial Training. That business has since 2010 been carried on by a company called Brand Financial Training Ltd, of which she is the sole director.

On 25 January 2016, Brand Financial Training Ltd applied under number 3146197 to register **brandft** as a trade mark for use in relation to training and education services in Class 41. The motivation for the filing is explained in paragraph 6 of the witness statement dated 30 March 2017 made by Ms Brand using the name Catriona Standingford, by which she is now known:

"Recognising the ever-rising risk of a successful business being the subject of copycats, and the potential risk to various business brand elements, to provide some recourse against those seeking to register alternative domains using brandft, the decision was taken to seek trade mark registration along with other branding elements of the business".

The services for which registration was requested were listed as:

"Training; Training and education services; Training

courses; Training services; Training consultancy; Training of financial personnel; Training services relating to finance; Training courses (provision of-); all being by the provision of technical learning resources, including, but not limited to, mock exams, video training, audio training, workbooks, calculations, based around the syllabi and learning requirements for qualification and retention of qualification for professionals and businesses in the fields of insurance, financial planning/advice or wealth management, or with an interest in the fields of insurance, financial planning/advice or wealth management".

The application for registration was opposed by The Financial Times Limited on the basis of the rights to which it was entitled under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 as proprietor of two earlier trade mark registrations. The first of these was UK trade mark registration number 3017887 for the sign **FT** registered for identical services in Class 41, with a filing date of 13 August 2013. The second was EU trade mark registration number 13169735 for the sign **FT**, also registered for identical services in Class 41, with a filing date of 13 August 2014.

It was contended in paragraph 8 in the amended grounds of opposition that the Applicant's mark **brandft** fell to be assessed for similarity with the Opponent's earlier trade

marks on the basis that it consisted of the non-distinctive word "**brand**" combined with its distinctive earlier "**ft**" mark.

This was contested in paragraph 4 of the Applicant's amended counterstatement on the following basis:

"... The name Brand Financial Training was chosen by the Applicant as it was the surname at the time of the founder of the Applicant. Furthermore, as the first element of the Applicant's Mark it is considered that this is the dominant and distinctive element of the Applicant's Mark, the last two letters being simply an abbreviation for "financial training", this being the Applicant's business. Furthermore, there is no separation of the "brand" or "ft" elements of the Applicant's Mark, these being represented as a single conjoined word, and no different treatment of the letters to place any greater or lesser emphasis on the "ft" element".

In paragraph 3 of its counterstatement, the Applicant set up a claim to proprietorship of an earlier right acquired through use of the mark **brandft** in answer to the claims based on the earlier registered trade marks relied on by the Opponent:

"3. The Opponent has relied upon two earlier trade mark registrations, UK trade mark registration number 3017887 and EU trade mark registration number 13169735 ("the Opponent's Registrations"). It is notable that the application dates, and registration dates, of both of those

registrations fall after the date of first use by the Applicant of their brandft trade mark. Given the niche sector in which the Applicant operates, and the reputation they have established, it is considered that, for their activities, they are the owner of earlier rights to these registered rights relied upon by the Opponents".

The niche sector in which the Applicant carried on business was identified in paragraph 2 of the counterstatement as that of offering training and associated training materials for the Chartered Insurance Institute (CII) examinations. The services of the business are provided primarily by way of online delivery.

Both sides filed evidence. They each opted for the opposition to be determined by the Registrar on the basis of written submissions having regard to the papers on file without recourse to an oral hearing.

The opposition was subsequently upheld and the contested application for registration was refused in its entirety for the reasons given by Mrs Ann Corbett on behalf of the Registrar in a decision issued under Reference BL O-479-17 on 5 October 2017. The Applicant was ordered to pay £1,800 to the opponent in respect of its costs of the Registry proceedings.

In paragraph 3 of her decision, the Hearing Officer dismissed the Applicant's claim to an earlier right acquired

through use of the mark **brandft** on the ground that it was a claim which could provide no defence to the opposition in the absence of a concomitant claim to invalidate the registrations of the Opponent's earlier registered trade marks. She adopted that position by reference to the decision of Ms Anna Carboni sitting as the Appointed Person in *Ion Associates Ltd v Philip Stainton & Anr* (BL O-211-09) and the Registry's Tribunal Practice Note 4/2009. She was right to do so.

In paragraph 39 of her decision, the Hearing Officer declined to determine the objections to registration which has been raised under section 5(3) of the Act. She saw no need to do so in view of her decision to uphold the Opponent's objections to registration under section 5(2)(b). There is no appeal against her decision not to deal with the section 5(3) objections and I therefore say nothing more about it.

The question raised by the Opponent's objections under section 5(2)(b) was whether there were similarities, in terms of marks and services, which would combine to give rise to the existence of a likelihood of confusion if the marks in issue were used concurrently in relation to services of the kind for which they were respectively registered and proposed to be registered.

When answering that question, it was necessary, in

accordance with paragraph 66 of the judgment of the CJEU in Case C-533/06 *O2 Holdings Ltd v Hutchison 3G UK Limited* to have regard to all the circumstances in which the mark applied for might be used if it were to be registered for services of the kind specified.

It was also necessary in accordance with the settled case law summarised in paragraphs 19 to 25 and 33 to 36 of the judgment of the CJEU in case C-591/12P *Bimbo SA v OHIM* to give as much or as little significance to the visual, aural and conceptual differences and similarities between the marks in issue as the reasonably well-informed and reasonably observant and circumspect average consumer of training and education services would have attached to them at the date of the contested application for registration.

The Hearing Officer found as follows with regard to the nature and effect of the differences and similarities between the marks in issue.

"17. The opponent's marks consist of the two letters FT presented in plain block capitals. As neither letter is highlighted in any way, the distinctiveness rests in the whole. The applicant's mark is presented in lower case and, whilst presented as a single word, will not be pronounced as such: It is neither a natural combination of letters in the English language nor is it a combination that would be easy to pronounce as a single word. Rather, the mark naturally

breaks down into the word "brand" and the letters "ft" as two distinct elements. I find support for this in the applicant's own claims that the mark was coined from a former surname of the founder of the company - Brand - with the letters ft intended to be an abbreviation of the words financial training. I shall return to this latter point in due course.

...

"22. As set out earlier, the applicant submits that the word "brand" is derived from a former surname of the company's founder whilst the letters "ft" were intended to be an abbreviation of the words "financial training". This may be the case, however, I have to consider what the average consumer will make of the mark. I do not consider the average consumer would see the word "brand" as being a surname regardless of the fact the initial letter is not capitalised as would normally be the case with surnames. The word is an ordinary dictionary word in everyday use and will be well understood as being synonymous with the words "trade mark". Given that meaning, I consider the use of this non-distinctive word at the start of the applicant's mark will lead to the two letters "ft" being seen as a distinct element of the mark.

"23. The opponent's marks consist of the two letters FT. These letters appear as the final two letters of the applicant's mark. Because of this, the opponent submits that



the respective marks are visually similar. I agree although when considered as wholes, the degree of visual similarity is low.

"24. The opponent submits the respective marks are aurally highly similar with FT/ft in each mark being similarly pronounced as individual letters. There is no dispute that FT/ft in each mark will be pronounced as individual letters, however, the applicant's mark also begins with an element which has no equivalent in the opponent's marks. When considered as wholes, I find that there is a medium degree of aural similarity between the respective marks.

"25. The opponent submits the respective marks are conceptually highly similar. It refers to the dictionary meaning of the word "brand" and submits that the word "acts as a signpost for the distinctive letters FT, emphasising them" in the applicant's mark.

"26. Despite the applicant's submissions regarding how its mark was coined, I do not consider the average consumer will see the letters "ft" as meaning financial training unless educated to that fact. In my view the letters FT/ft will not convey any particular conceptual meaning. Given the meaning of the word brand, I do not consider this adds any conceptual message to the applicant's mark. I find the conceptual position to be neutral.

...

"30. In my view, the opponent's marks have no meaning in relation to the services for which they are registered and have an average degree of inherent distinctive character.

...

"33. What has not been provided in the opponent's evidence, are any details of e.g. who and how many people may have attended any particular training or educational events, any turnover or income which was derived in relation to them or anything which enables me to establish the opponent's share of the relevant market. In view of this, whilst the use of its marks in connection with these education or training events is likely to have enhanced their distinctiveness to some extent, I am unable to quantify that extent. I therefore conclude that the opponent has not established that the distinctive character of the earlier marks has been materially enhanced through use".

It is not clear from her decision whether, or how far, the Hearing Officer acted upon the basic proposition established by the evidence filed on behalf of the Opponent that the letters **FT** have at all relevant times been widely recognised and used in the United Kingdom as an abbreviation for the words "Financial Times" (and especially in relation to the newspaper of that name) when she went on to conclude, as she did in paragraph 38 of her decision, that the mark

**brandft** was likely to be perceived by the relevant average consumer as the non-distinctive word **brand** juxtaposed with the distinctive mark **ft** in the manner of a sub-brand or brand extension.

That amounted to a finding of the existence of a likelihood of confusion sufficient to justify refusal of registration under section 5(2)(b) of the Act in relation to the services listed in the contested application.

In substance, the Applicant contends before me on appeal that the Hearing Officer's decision was wrong and should be set aside for failing to give effect to the well-established principle that marks must be assessed for similarity without dismemberment or excision and, additionally or alternatively, for not accepting that the single word **brand** possessed a distinctive character augmented through use by the Applicant in relation to training and education services which left no real room for the element **ft** to perform an independent distinctive role as part of the mark **brandft** from the perspective of the reasonably well-informed and reasonably observant and circumspect average consumer of such services.

With regard to the first limb of the argument, it is clear that the requirement for marks to be assessed holistically does not in point of law prevent a decision taker from recognising the reality, if it be the reality,

that a particular mark is constructed or assembled in a way which naturally leads to it being perceived and recognised as a collocation of elements juxtaposed in the manner of a sub-brand or brand extension.

I see no escape from the Hearing Officer's conclusion that **brandft** is just such a mark. It was - and was put forward for registration because it was - used as the main identifying feature of the domain name brandft.co.uk. In common with countless other domain names which people in the world at large are well-used to dealing with, it was an identifying feature recognisably composed of discrete elements.

I take the view that no appreciable intellectual effort is required to recognise the two elements of which it is composed, whereas appreciable intellectual effort is required in order to synthesise them into a difficult-to-pronounce seven-letter word, imbued in its totality with no apparent meaning or significance, which happens to end with the letters **ft**.

I am satisfied that the Hearing Officer was entitled to decide, and correctly decided, that **brandft** would naturally be perceived as a collocation of the elements **brand** and **ft**. I do not think that this is a case in which it is realistic to uncouple the visual from the aural and conceptual dimensions of perception. To say it as two elements is to

see it as two elements and also to conceptualise it as two elements.

The second limb of the Applicant's argument goes to the proposition that the word **brand** performs an independent distinctive role in the mark **brandft** and, in doing so, relegates the **ft** element to the status of a non-distinctive abbreviation. For this to be a sustainable proposition, it would need to be maintainable for all services in Class 41 within the scope of the contested application for registration. However, the evidence filed on behalf of the applicant does not establish use in commerce of the designation **brand** otherwise than in conjunction with the words "financial training" or as part of the domain name **brandft.co.uk** and it establishes only that such uses have occurred within the niche area in which the Applicant carries on business.

I do not accept that the single word **brand** is shown by the evidence to have possessed a distinctive character augmented by use for training and education services in that niche area. Still less do I accept that it is shown by the evidence to have possessed a distinctive character augmented by use for training and education services across the width of the specification of the mark applied for in Class 41. The second limb of the Applicant's argument does not assist it on this appeal. For the reasons I have given, the appeal

is dismissed.

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Appeal dismissed; Applicant ordered to pay £1,500 to the Opponent in respect of its costs of the Appeal; that sum to be paid (and being payable in addition to the sum of £1,800 awarded by the Hearing Officer in respect of the Registry proceedings) within 14 days of 4<sup>th</sup> June 2018.