

O-354-12
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2537724
BY
INTEGRATED FINANCIAL ARRANGEMENTS PLC
TO REGISTER A SERIES OF 2 TRADE MARKS

MONEYMAP
MoneyMap

IN CLASS 36

AND

THE OPPOSITION THERETO
UNDER NO 102145
BY
MOTU LIMITED

Trade Marks Act 1994

In the matter of application no 2537724
by Integrated Financial Arrangements Plc
to register a series of 2 trade marks:

MONEY MAP

and

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in class 36
and the opposition thereto
under no. 102145
by Motu Limited

BACKGROUND

1. On 28 January 2010, Integrated Financial Arrangements plc (the applicant) applied to register the above trade marks in class 36 of the Nice Classification¹ system for the following services:

The provision of financial information, namely analysis of investments in portfolios.

2. Following publication of the application on 8 April 2011, Motu Limited (the opponent) filed notice of opposition against the application.

3. The ground of opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4. The opposition is directed against all the applicant's services.

5. The opponent relies on the following earlier mark:

Mark details	Services
<p>TM: 2325727</p> <p>MARK:</p>  <p>Filing date: 6 March 2003</p> <p>Registration date: 27 February 2004</p>	<p>Class 36:</p> <p>Insurance services, financial affairs, monetary affairs, real estate affairs, financial planning, collection of financial information</p>

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

6. In its statement of grounds the opponent states, inter alia:

“4. The marks are similar because the earlier mark comprises the word Money Mapping. The mark applied for comprises the word combination MONEYMAP. The mark applied for is visually, aurally and conceptually similar to the earlier trade mark and is to be registered for services which are identical with or similar to those for which the earlier trade mark is protected, to the extent that there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier mark.

7. On 16 September 2011, the applicant filed a counter statement in which it denies the ground of opposition and puts the opponent to proof of use of its mark.

8. Only the opponent filed evidence. Both parties filed submissions in the course of proceedings and the applicant filed written submissions in lieu of attendance at a hearing. Neither party asked to be heard. I will refer to these various submissions as necessary below.

EVIDENCE

The Opponent's evidence

9. The opponent's evidence consists of a witness statement from Austyn Smith, dated 21 November 2011, accompanied by 2 exhibits. Mr Smith is the Director of Motu Limited, a position he has held for 12 years. The main facts emerging from Mr Smith's statement are, in my view, as follows:

- Austyn James Consulting Limited (a licensee of Motu Limited) have offered MONEY MAPPING services from 2003.
- The service provides financial advice to individuals.
- The mark is Mr Smith's own handwriting.
- During consultation with customers Mr Smith uses paper which has a copy of the mark on the top right hand corner. An example of this is provided at exhibit AJ1. It consists of one sheet of A4 paper. On the paper are some handwritten figures, a hand written date of 19 November 2010 and a handwritten version of the mark in the top right corner. It is not the exact version of the mark which has been registered. However, for reasons that will become clear, nothing rests on this difference.
- Mr Smith also provides financial forms and papers for customers, which have been used since 2004. An example is provided at exhibit AJ2. The form consists of one A4 sheet which is headed '360 REVIEW', there is a space below for name and date. A blank spider diagram takes up the majority of the page, which has a copyright date of 2004 - 2011. The mark, as registered, can be seen in the top right hand corner and the address for Austyn James Consulting Limited is provided at the bottom.

DECISION

10. Section 5(2)(b) of the Act reads 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

12. In these proceedings the opponent is relying upon the trade mark shown in paragraph 5 which constitutes an earlier trade mark under the above provisions. The application was published on 8 April 2011. The opponent's earlier mark completed its registration procedure on 27 February 2004. Consequently, the opponent's registration is subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004, and, as I mentioned above, the applicant has asked the opponent to provide proof of use in relation to all of its services. The relevant sections of the Proof of Use Regulations read 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 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.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2)(application on relative grounds where no consent to registration)."

13. The relevant period is the five year period ending on the date of publication of the application, namely 9 April 2006 to 8 April 2011. The onus is on the opponent, under section 100 of the Act², to show genuine use of its mark during this period on those services relied on or, alternatively, to show that there are proper reasons for non-use of the mark during this period.

Proof of use

14. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use.

15. The requirements for "genuine use" have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-

² "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."

40/01 [2003] RPC 40 and Silberquelle GmbH v Maselli-Strickmode GmbH Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in LABORATOIRE DE LA MER Trade Mark [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed Person in O-371-09 SANT AMBROEUS:

“42. The hearing officer set out most of the key extracts from Ansul and La Mer in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to Silberquelle where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: Ansul, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: Ansul, [36].

(3) The 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 by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: Ansul, [36]; Silberquelle, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: Ansul, [37]-[38]; Silberquelle, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: Ansul, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: Ansul, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: Ansul, [38] and [39]; La Mer, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is

genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

16. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29. I have no doubt that Pumfrey J. was correct to reject the approach advocated in the *Premier Brands* case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30. Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say *Cox's Orange Pippins*, should the registration be for fruit, apples, eating apples, or *Cox's Orange Pippins*?

31. Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

17. The comments of Mr Justice Jacob in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20. The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus,

for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

18. The comments of the Court of First Instance (now the General Court) in Reckitt Benckiser (Espana), S L v OHIM, Case T- 126/03 are also relevant where it held that:

"45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub- divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

19. First, I have to identify, as a matter of fact, the services on which the opponent has actually used its trade mark. In its submissions the applicant states:

"The applicant contends that the opponent has failed to provide proof of use to the requisite standard. Accordingly, the earlier right should no longer be considered a basis for this opposition."

20. Further, in its written submissions, dated 5 September 2012, it states:

“The scale of use shown is obviously non-existent; the Applicant submits that the ‘evidence’ submitted by the Opponent simply does not show use in accordance with the essential function to guarantee the origin of the services in order to create or preserve an outlet or market share.”

21. The evidence provided by the opponent consists of two sheets of A4 paper. The first of these contains some handwritten figures, presumably for use as part of a financial consultation. In the top right hand corner there is a hand written representation of the mark. The form is dated 19 November 2010. The other is a blank form, headed ‘360 review’, with a representation of the mark, as registered, in the top right hand corner. Copyright dates 2004 -2011 are provided at the bottom of the page.

22. The forms provided in evidence appear to be documents used for the collection of financial information for the purposes of financial planning. However, neither of these exhibits assists in any way to provide the information necessary for me to reach a conclusion on whether or not and to what extent the mark has been used. These forms may have been used on many occasions or only once. I have no turnover figures before me, no indication of marketing spend and no evidence to show the average consumer is exposed to the mark at all. The material provided by the opponent does not go to show evidence of use of the mark, in relation to the services for which it is registered, within the relevant period. Consequently, this opposition fails at the first hurdle.

Conclusion

23. The opposition fails as the opponent has failed to prove use of his earlier mark on the relevant services within the relevant period.

Costs

24. The opposition having failed, the applicant is entitled to a contribution towards its costs. I have taken into account the fact that no hearing has taken place and the evidence filed was very limited.

Preparing a statement and considering the other side’s statement:	£300
Written submissions:	£200
Total:	£500

25. I order Motu Limited to pay Integrated Financial Arrangements Plc 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 21ST day of September 2012

Ms Al Skilton
For the Registrar,
The Comptroller-General