

O/356/20

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3368154 BY
ACCESS FINANCIAL SERVICES LIMITED**

TO REGISTER:

ACCESS

AS A TRADE MARK IN CLASSES 36 & 41

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 416530 BY
ACCESS UNDERWRITING LIMITED**

BACKGROUND AND PLEADINGS

1. Access Financial Services Limited (“the applicant”) applied to register **ACCESS** as a trade mark in the United Kingdom on 18 January 2019. The application was accepted and published on 8 March 2019 in respect of the following services:

Class 36

Advising and arranging mortgages, secured loans which includes releasing equity from your home – Advising and arranging mortgages, secured loans which includes releasing equity from your Commercial property. Home reversion plans; Life insurance; Investments and pensions.

Class 41

Training academy.

2. On 7 June 2019, the application was opposed by Access Underwriting Limited (“the opponent”). The opposition is based on section 5(1), 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and concerns all the services in the application. The mark on which the claims under sections 5(1), 5(2)(a) and 5(3) are based is UK Trade Mark 2645171 **ACCESS**, which was applied for on 10 December 2012 and registered on 14 June 2013 in respect of the following services:

Class 36

Insurance services; vehicle, commercial property and liability insurance services; vehicle, commercial property and liability insurance underwriting services; vehicle, commercial property and liability insurance brokerage services; vehicle, commercial property and liability insurance intermediary services; vehicle, commercial property and liability insurance agency services; vehicle, commercial property and liability insurance claim assessments; information, advisory and consultancy services relating to all the aforesaid, including all of the aforesaid services provided on-line from a computer database or the internet.

3. Under section 5(1) of the Act, the opponent claims that the marks are identical and that the contested *Life insurance* falls within its *Insurance services*, rendering these

services identical. Under 5(2)(a) of the Act, the opponent claims that the remaining contested services are identical or similar to its earlier services. As the marks are identical, it claims, there will be a likelihood of confusion on the part of the public, which includes a likelihood of association.

4. Under section 5(3), the opponent claims that it has acquired a reputation in the UK for all the services for which the earlier mark is registered and that registration of the contested mark would cause the relevant public to believe that the marks are used by the same undertaking or think that there is an economic connection between the users of the trade marks. In addition, the opponent claims that:

- The contested mark will free ride on the coat-tails of the reputation and/or prestige associated with the opponent's earlier trade mark and take an unfair advantage and derive an illegitimate benefit from it and/or illegitimately exploit the marketing efforts expended by the opponent;
- The contested mark will damage and/or tarnish the reputation of the opponent's earlier trade mark as it will not be able to control the manner in which the applicant's trade mark is used, which may be in a manner adverse to the reputation of the opponent's earlier trade mark; and/or
- The contested mark will dilute the distinctive character of the opponent's earlier mark because the presence on the market of an identical mark will reduce the capacity of the earlier mark to arouse an immediate association with the opponent's services for which they are registered.

5. Under section 5(4)(a), the opponent claims that use of the contested mark is liable to be prevented by the law of passing off as it has protectable goodwill based on use of the sign **ACCESS** throughout the UK since 2000 for the following services, all of which are covered by the earlier mark:

Insurance services; vehicle, commercial property and liability insurance services; vehicle, commercial property and liability insurance underwriting services; vehicle, commercial property and liability insurance brokerage services; vehicle, commercial property and liability insurance intermediary services; vehicle,

commercial property and liability insurance agency services; vehicle, commercial property and liability insurance claim assessments; information, advisory and consultancy services relating to all the aforesaid, including all of the aforesaid services provided on-line from a computer database or the internet.

The opponent submits that use of the applicant's trade mark is liable to lead to a misrepresentation to consumers that there is a link between the services of the applicant and those of the opponent, and that misrepresentation will lead to damage to the opponent's business including, but not limited to, the potential loss of sales, damage to the opponent's reputation and dilution of the opponent's mark.

6. The applicant filed a defence and counterstatement. While it admits that the marks are identical, it denies the claims, making the following points:

- The contested mark is not to be registered for identical or similar services, as the applicant is a mortgage broker and the opponent provides general insurance;
- The reputation of the opponent is very limited and local;
- The applicant will not benefit from the reputation of the opponent as the public will not believe there is any association between the parties;
- The contested mark will not diminish the power of attraction of the opponent's mark as the services of a general insurer and of a mortgage broker "are not in any way close", nor are they aimed at the same market;
- The contested mark will not dilute the distinctive character of the opponent's earlier mark; and
- There has been no misrepresentation, as the services are different and the applicant has not imitated the "get up" or "trade dress" of the opponent.

It did not put the opponent to proof of use of the earlier mark.

7. Both parties filed evidence. I shall summarise this to the extent that I consider it necessary.

8. Both parties also filed written submissions alongside their evidence, with the opponent's submissions dated 11 November 2019 and the applicant's dated 10 January 2020. The parties also filed written submissions in lieu of a hearing on 14 April 2020. These will not be summarised but will be referred to as and where appropriate during my decision.

9. The opponent was represented by Edwin Coe LLP and the applicant by Ronald Fletcher Baker LLP.

EVIDENCE

Opponent's evidence in chief

10. The opponent's evidence in chief comes from Simon Jonathan Hickman, Chief Executive Officer of Access Underwriting Limited. It is dated 11 November 2019.

11. Mr Hickman states that the opponent provides insurance brokerage and advisory services and has done so since 2000 under the names ACCESS UNDERWRITING, ACCESS INSURANCE SERVICES, ACCESS INSURANCE or ACCESS. An advertisement in Exhibit SJH-3 indicates that it specialises in insurance for charities, Christian organisations, the care sector and education.

12. Premium income between 2014 and 2019 was between £6.2 million and £10.3 million per annum.¹ Exhibit SJH-2 contains three examples of invoices. The first is dated 10 November 2010 and is for home insurance with a premium of £277.27; the second is dated 31 March 2015 and is for charity insurance with a premium of £998.31. The third invoice is dated 1 April 2019, which is later than the application date of the contested mark, and is for charity insurance with a premium of £32,560. The addresses of the purchasers are completely redacted so it is not possible to see where they are located. A heat map showing the spread of the opponent's customer base within the UK is found in Exhibit SJH-12. It also is undated. Mr Hickman does refer in the written

¹ Paragraph 9.

statement to “particularly strong client bases in the South East, East Midlands and Wales”.²

13. Since the end of 2002, the opponent has spent around £253,000 on online marketing through Google, Bing and Facebook. It has also used newsletter email campaigns to existing clients,³ marketing emails to solicit new clients,⁴ and adverts and marketing brochures. Screenshots from its website can be found in Exhibit SJH-17. The earliest is dated 28 November 2002 and the latest 17 October 2017. They show use of the mark in the following forms: ACCESS UNDERWRITING, ACCESS INSURANCE (with a device) and ACCESS INSURANCE SERVICES.

14. The results of Google searches for “Access Insurance” and “Access Financial Services” are contained in Exhibits SJH-18 and SJH-19 respectively. In the case of the latter, a page on the opponent’s website appears as the third result on the first page. Mr Hickman surmises that these results indicate that UK consumers are searching for the opponent’s services when they use those terms.

15. Mr Hickman states that:

“The Opponent has been regularly presented in press coverage as providers of, and experts in, the provision of insurance services. See for example **Exhibit SJH-20**, showing an article written by me and published in November 2016 in the Charity Finance Group’s Finance Focus magazine, regarding a campaign to exempt charities from Insurance Premium Tax.”⁵

16. Exhibit SJH-21 contains an image of the Charity Times Award for the provision of insurance services to charities, which was awarded to the opponent in 2010. Mr Hickman states that the opponent was a finalist for this award in 2008 and 2009.

² Paragraph 8.

³ Exhibit SJH-15.

⁴ Exhibit SJH-16.

⁵ Paragraph 14.

Applicant's evidence

17. The applicant's evidence comes from Mr Karl Wilkinson of Access Financial Services Limited. It is dated 9 January 2020.

18. Mr Wilkinson states that the applicant was set up in 2002 under the name Tailored Mortgages Ltd as a broker for residential mortgages, life insurance and equity release. Mr Wilkinson and his partner Mr Ali Goztas bought the shares of this company in February 2017. For a short time, it traded as Richard James Partnership Limited before becoming Access Financial Services Limited on 12 February 2018. It is intended that the business expands into financial advice in the future.

19. Mr Wilkinson challenges the Google search evidence provided by the opponent and referred to in paragraph 14 above. He states:

"7. However such a person searching Google for 'Access Financial Services' would now be directed not to the Opponent's standard website but to a separate and specific website set up by the Opponent at entry 3 or 4. Please see the exhibited screenshot (see Exhibit KW1). This entry incorrectly suggests that the Opponent provides general financial services rather than just vehicle, commercial property or liability insurance. It contains the following words:

Mortgages or Loans

You may be looking to finance a charity or church building – we can help get you talking to the right lenders who will understand your requirements and the sector you operate in. We can also put you in contact with lenders who supply and advise on residential mortgages, remortgages and buy to let.

8. This is deliberately misleading because this page did not come into existence until 23rd of July 2019 at which point the Opponent had already launched its opposition to the current Application (see the time record of origination at Exhibit KW2). The Opponent must have built this webpage to

give the false impression that it was in the business of providing mortgages equivalent to the financial services provided by the Applicant. ...”

20. Exhibit KW5 contains information from the Bank of England on the volume of general (i.e. non-life) insurance business for 2016 and 2017 (£89,525,281,980 and £91,074,724,557 respectively). Mr Wilkinson calculates that the opponent’s business represents 0.00084% and 0.00096% of this market.

Opponent’s evidence in reply

21. The opponent’s evidence in reply comes from Mr Hickman. It is dated 10 March 2020.

22. He denies the allegation made by the applicant, saying that:

“... The New Page was set up to identify the type of financial advice being offered to our clients and to provide clarity for our customers about the additional services we can offer via partner intermediaries, with whom we have agreements to provide these services to our customers.”⁶

23. He admits that this New Page was launched after the opposition had been filed, but also notes that the provision of supplementary financial services through partners, and the marketing of these services through the opponent’s website under the sign, has been taking place since 2009. Evidence of this is provided in Exhibit SJH-22, with a 2009 blog entry and screenshots from the opponent’s website retrieved via the Wayback Machine and dated 25 July 2011 and 5 April 2016.

PRELIMINARY ISSUES

24. The earlier mark was registered more than five years before the date of application for the contested mark. It is therefore subject to the proof of use provisions in section 6A of the Act. The applicant chose not to put the opponent to proof of use, with the

⁶ Paragraph 5.

consequence that the opponent is entitled to rely on all the services for which the earlier mark stands registered. The services which the opponent actually supplies are therefore not relevant for the section 5(1) or 5(2)(a) claims.

25. A significant part of the applicant's submissions concerns the opponent's web content relating to financial services such as loans and mortgages, in particular the webpage exhibited by the applicant in Exhibit KW1. A webpage that was created on 23 July 2019 has no relevance in these proceedings, as it was created after the contested application had been filed. I shall consider it no further.

DECISION

Section 5(1)

26. Section 5(1) of the Act is as follows:

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

27. Section 6(1) of the Act is as follows:

“In this Act an ‘earlier trade mark’ means –

(a) a registered trade mark, international trade mark (UK), a European Union 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,

...”

28. The opponent's mark qualifies as an earlier trade mark under this provision. As already noted, the opponent was not put to proof of use and may therefore rely on all the services for which its mark stands registered.

29. The applicant admits that the marks are identical.

30. The opponent submits that the applicant's *Life insurance* is identical to its *Insurance services*. The applicant denies this and submits that:

“The commencing words ‘insurance services’ in the list of the opponent’s services are prefatory not defining. The Opponent’s services are insurance services, specifically vehicle, commercial property or liability insurance.”

31. However, in the opponent's specification the term *Insurance services* is followed by a semi-colon. In *Louis Vuitton Malletier v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-97/12 P, the Court of Justice of the European Union (CJEU) said:

“However, a semi-colon establishes a distinction between two different categories falling within the same class. Thus, the ‘jewel boxes in precious metals, their alloys or coated therewith’ are not, by definition, ‘jewellery’ and, consequently, they do not constitute articles falling within the general category of ‘jewellery’.”⁷

I must therefore take *Insurance services* as a category in its own right.

32. In *Gérard Meric v OHIM*, Case T-133/05, the General Court stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301,

⁷ Paragraph 96.

paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”⁸

33. When construing the terms used in a trade mark specification, I am guided by the case law. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

34. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

35. In my view, the average consumer would understand the term *Insurance services* to cover all types of insurance – whether the coverage is for cars, buildings or life. I

⁸ Paragraph 29.

find that the applicant's *Life insurance* is encompassed by the opponent's *Insurance services* and, per *Meric*, is identical.

36. The opposition succeeds under section 5(1) in respect of the applicant's *Life insurance*.

Section 5(2)(a)

37. Section 5(2)(a) of the Act is as follows:

“A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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.”

Comparison of services

38. When comparing the services, all relevant factors should be taken into account, as held by the CJEU in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-397/97:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”⁹

⁹ Paragraph 23.

39. Guidance was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (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.”

40. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”¹⁰

41. The services to be compared are shown in the table below:

¹⁰ Paragraph 82.

Opponent's services	Contested services
<p><u>Class 36</u> <i>Insurance services; vehicle, commercial property and liability insurance services; vehicle, commercial property and liability insurance underwriting services; vehicle, commercial property and liability insurance brokerage services; vehicle, commercial property and liability insurance intermediary services; vehicle, commercial property and liability insurance agency services; vehicle, commercial property and liability insurance claim assessments; information, advisory and consultancy services relating to all the aforesaid, including all of the aforesaid services provided on-line from a computer database or the internet.</i></p>	<p><u>Class 36</u> <i>Advising and arranging mortgages, secured loans which includes releasing equity from your home – Advising and arranging mortgages, secured loans which includes releasing equity from your Commercial property. Home reversion plans; Investments and pensions.</i></p> <p><u>Class 41</u> <i>Training academy.</i></p>

42. It is not the case that, as the applicant suggests in paragraph 2.4.1 of its written submissions, that “The services of the Opponent and the services of the Applicant must be considered as a whole not individually.” In *SEPARODE*, BL O/399/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated that:

“... The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”¹¹

¹¹ Paragraph 5.

43. The applicant's *Advising and arranging mortgages, secured loans which includes releasing equity from your home* and *Advising and arranging mortgages, secure loans which includes releasing equity from your Commercial property* involve the provision of advice relating to financial products that enable individuals or businesses to purchase property or to release some of the equity that an owner holds in a property and the setting up of such products. The nature of the services is advice and includes brokerage and is identical to that of the opponent's *vehicle, commercial property and liability insurance brokerage services* and *vehicle, commercial property and liability insurance intermediary services*, although the products that are sold as part of the respective services are not. They are, however, all forms of financial service, and so there is a degree of similarity. They are also targeted at the same users. The services are not in competition or complementary. I find the services to be similar to a medium degree.

44. The purpose of the applicant's *investments and pensions* is to provide a means by which an individual can tie up capital now and draw on it later when it is expected to have grown. They are, like *Insurance services*, a form of financial service, albeit with different purposes, as insurance protects the purchaser from the full financial impact of an unexpected future event. The users are the same, with both services being aimed at the public at large. The distribution channels are similar, and in some cases will be the same. The average consumer would expect large financial services companies to offer insurance, investments and pensions. The services are not in competition, nor are they complementary. I find the services to be similar to a medium degree,

45. *Home reversion plans* are financial products that involve a homeowner selling a share in their home in exchange for a lump sum or a regular income. Their purpose is to enable a homeowner to realise part of the value of their property. The nature of the service is the financial product itself. I have no evidence to indicate whether they are provided by specialists or by general financial services companies. Again, I compare these services to the opponent's *Insurance services*. The users are similar and both are financial services. The services are not in competition and it seems to me that it is less likely that the distribution channels will be similar than they were in the comparison I made in the previous paragraph. I find *Home reversion plans* and *Insurance services* to be similar, but to a low degree.

46. I turn now to the applicant's Class 41 services: *Training academy*. The opponent submits that:

"... given the highly complex and specialist nature of these [Class 36] services, providers will commonly provide training and education on their services to client as an add-on service or marketing tool. Given the complementary nature of the parties' services and target users there would be a natural overlap in the recipient consumers of such training services."¹²

47. Who uses a service is but one of the relevant factors that I must consider. In my view, *Training academy* would be understood by the average consumer to refer to a place of training where adults or young people would go to study specific courses, whether short sessions or longer programmes. Such a place might be physical or virtual. The purpose, nature and distribution channels are different from the opponent's insurance-related services. They are not in competition, and I do not consider them to be complementary. In my view, the services are not similar.

Average consumer and the purchasing act

48. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

"The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."¹³

¹² Opponent's written submission in lieu of a hearing, paragraph 2.

¹³ Paragraph 60

49. The average consumer of the opponent's and applicant's services is either a member of the general public, a business or not-for-profit organisation. Where the services are products, such as pensions, insurance policies or home reversion plans, they will be bought after consultation with a professional adviser or, in some instances, after the purchaser has done their own research using websites, brochures and reviews in the media. These are infrequent purchases that can be expensive. The consumer will be taking a great deal of care to ensure that the services meet their particular needs, both in terms of immediate cost and future expectations. The consumer will see the marks on website and printed matter and because of the significant role for advice they will also hear the marks spoken. In my view, the average consumer will be paying a high degree of attention.

50. Where the services are advisory or brokerage, the average consumer will be the same and the purchasing process similar. Trust will be an important factor and it seems to me that word-of-mouth recommendations, as well as independent reviews, will play a large part in the selection process. The marks will also be seen on promotional material and websites. Again, it is my view that the average consumer will be paying a high degree of attention.

Distinctiveness of the earlier mark

51. There is a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, Case C-342/97:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

52. The opponent submits that its mark is highly distinctive, both inherently and because of its reputation. The applicant submits that the association of the word “ACCESS” with the credit card provider MasterCard means that “the distinctive character of the Opponent’s trademark fades into obscurity and implies that it must enjoy much less broad protection”.¹⁴

53. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of or allude to a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

54. “ACCESS” is a word in common usage and the applicant has repeatedly referred to its use by MasterCard, which is not, of itself, of relevance here. However, dictionary words are inherently less distinctive than invented words. In my view, the word alludes to the brokerage and intermediary services of the opponent, which involve providing access to insurance products and services. I find the mark has a low degree of inherent distinctiveness for these services, but a medium degree for the remaining services.

55. I now turn to the question of whether the distinctiveness of the mark has been enhanced through use. The relevant public is the general public. Earlier, I noted that the opponent appears to specialise in particular sections of the market (charities,

¹⁴ Applicant’s written submissions, paragraph 2.6.2.

Christian groups, for example). However, the specification is generally worded and so it is the whole of the market for insurance and related services that is relevant. The opponent has not challenged the applicant's information on the size of the market. While it is the case that these Bank of England figures consist of the total premium value and therefore will include a proportion of business that does not go through intermediaries or brokers, the income figures given by the applicant are still relatively small. The amounts spent on advertising and promoting the mark are also small: £253,000 since 2002. I am led to find that the distinctiveness of the earlier mark has not been enhanced through use.

Conclusions on likelihood of confusion

56. In assessing the likelihood of confusion, I must adopt a global approach, taking account of all relevant factors and judging the matter through the eyes of the average consumer of the services in question. If the association between the marks creates a risk that the public will wrongly believe that the respective services come from the same or economically-linked undertakings, there is a likelihood of confusion: see *SABEL BV v Puma AG*, Case C-251/95, *Canon Kabushiki* (cited above), *Lloyd Schuhfabrik Meyer* (also cited above) and *Marca Mode CV v Adidas AG & Anor*, Case C-425/98.

57. Some similarity of services is essential for a finding of likelihood of confusion: see *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA, paragraph 49. As I found no similarity between the applicant's *Training academy* and the opponent's services, the opposition under section 5(2)(a) fails in respect of these services.

58. The applicant submits that there have been no instances of actual confusion. In *Roger Maier & Anor v ASOS Plc & Anor* [2015] EWCA Civ 220, Kitchin LJ (as he then was) stated that:

“... the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between this, this may be

powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods of services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”¹⁵

59. I must make my assessment based on a fair and notional use of both marks. The absence of any instances of actual confusion in the past does not mean that there is not a likelihood of confusion occurring should the contested mark be registered, for the reasons set out above.

60. The opponent submits that the applicant’s Class 36 services

“... refer to an array of other general financial services such as mortgages, investments and pensions. Applying the global assessment test for the purposes of s.5(2)(a), the Opponent submits that these other services are similar enough to those claimed in the Opponent’s Mark to create a likelihood of confusion, in light of the shared or similar distribution channels, origins and target users of the respective parties. It is very common for consumers of mortgage and insurance services to seek – and therefore providers to provide – these services in line with similar complementary financial services.”¹⁶

61. Given the identity of the marks and the medium degree of similarity between the Class 36 services, I find that the average consumer is likely to be confused – even taking account of the high degree of attention paid during the purchasing process.

¹⁵ Paragraph 80.

¹⁶ Opponent’s Written Submissions in lieu of a hearing, paragraph 2.

62. The opposition under section 5(2)(a) succeeds in respect of the following services:

Class 36

Advising and arranging mortgages, secured loans which includes releasing equity from your home – Advising and arranging mortgages, secured loans which includes releasing equity from your Commercial property. Home reversion plans; Investments and pensions.

Section 5(3)

63. Section 5(3) of the Act states that a trade mark which is identical with or similar to an earlier trade mark

“... shall not be registered if, or to the extent that, the earlier trade has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

64. The conditions of section 5(3) are cumulative:

- 1) The opponent must show that the earlier mark has a reputation;
- 2) The level of reputation and the similarities between the marks must be such as to cause the public to make a link between the marks; and
- 3) One or more of three types of damage (unfair advantage, detriment to distinctive character or repute) will occur.

65. It is not necessary for the services to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

66. In *General Motors Corporation v Yplon SA*, Case C-375/97, the CJEU stated that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

67. I have already discussed some of these factors earlier in my decision insofar as they were relevant to the section 5(2)(a) ground: see paragraph 55. The share of the market for *Insurance services* is very small, as are the sums the opponent states that it has spent on promoting the mark. The opponent has shown use of the mark in relation to insurance services for charities and Christian organisations, but I have no evidence of the size of these particular sectors of the market. It is the case that the opponent won an award for its services for charities, but this was in 2010 and there is no evidence of later awards. Exhibit SJH-20 contains a 2016 article written by Mr Hickman, but the circulation figures of the Charity Finance Group’s Finance Focus magazine are not given. It is, however, a specialist publication, and the relevant public for the services in the specification is the general public. Taking account of all these

factors, I find that the opponent has not shown reputation and the section 5(3) claim therefore fails.

Section 5(4)(a)

68. Section 5(4)(a) of the Act states that:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met

...”

Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

69. It is settled law that for a successful finding of passing off, three factors must be present: goodwill, misrepresentation and damage. HHJ Melissa Clarke, sitting as deputy Judge of the High Court, conveniently summarised the essential requirements of the law in *Jadebay Limited, Noa and Nani Limited t/a The Discount Outlet v Clarke-Coles Limited t/a Feel Good UK* [2017] EWHC 1400 IPEC:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] RPC 341, HL) namely goodwill or reputation; misrepresentation leading to deception or a likelihood of

deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all these limbs.

56. In relation to deception, the court must assess whether ‘*a substantial number*’ of the Claimant’s customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

70. *Halsbury’s Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant Date

71. In *SWORDERS Trade Mark*, BL O-212-06, Mr Allan James, acting for the Registrar, summarised the position in section 5(4)(a) proceedings:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”¹⁷

¹⁷ This summary was cited with approval by Mr Daniel Alexander QC, sitting as the Appointed Person, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11.

72. The only evidence that the applicant has provided of use of the contested mark is found in Exhibit KW4.



The image is undated. I therefore accept the opponent’s submission that the applicant has not shown that it has used the contested mark before the application was filed, and so the relevant date is the date of application: 18 January 2019.

Goodwill

73. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

74. The opponent submits that it has been using the sign in relation to the sale of insurance brokerage, intermediary and advisory services from 2000. The applicant admits that the opponent has goodwill. In paragraph 4.2 of its written submissions, it says:

“The Applicant acknowledges that the Objector has goodwill in the sign (although such goodwill is only of limited extent on account of the link of the word Access with Mastercard) but denies that has been misrepresentation or that there is the likelihood of damage to the goodwill.”

75. However, the courts have determined that the sign being relied upon need not be exclusively distinctive. In *Associated Newspapers Ltd v Express Newspapers* [2003] FSR 51 (HC), Laddie J stated that:

“As Mr Watson implicitly accepts, there is no requirement in the law of passing off that the claimant’s reputation has to be exclusive. There have been a number of cases where a claimant has succeeded even though he was not the only trader with a reputation in the mark. A newcomer who adopts a mark employed by more than one competitor and thereby deceives the public harms each of them. There is no reason in principle and no authority which suggests that because a number of proprietors are harmed, none of them can seek to restrain the interference with their trade.”¹⁸

Misrepresentation

76. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

¹⁸ Paragraph 28.

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 RPC 97 at page 101.”

77. In the same judgment, Morritt LJ also noted that it was the plaintiff’s customers or potential customers that would need to have been deceived for there to be a real effect on the plaintiff’s goodwill.

78. The opponent submits that there is misrepresentation “as the Contested Application is identical to the sign and is being applied for in relation to very similar services to the Opponent”.¹⁹ While I found the applicant’s Class 36 services to be identical or similar to the opponent’s services, I found there to be no similarity between *Training academy* and the opponent’s services.

79. I shall not consider the Class 36 services any further here, beyond noting that in *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501, Lewinson LJ had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that ‘a *substantial number*’ of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both

¹⁹ Opponent’s written submissions, paragraph 35.

normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.”

80. The applicant’s remaining services, *Training academy*, are in a different field of activity from the brokerage, intermediary and advisory services of the opponent. In *Harrods Limited v Harroddian School Limited* [1996] RPC 697 (CA), Millet LJ made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression ‘common field of activity’ was coined by Wynn-Parry J in *McCulloch v May* (1948) 65 RPC 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to the numerous previous authorities (see, for example, *Eastman Photographic Materials Co Ltd v John Griffiths Cycle Corporation Ltd* (1898) 15 RPC 105 (cameras and bicycles); *Walter v Ashton* [1902] 2 Ch. 2 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although ‘the plaintiff and the defendant were not competing traders in the same line of business’. In the *Lego* case Falconer J acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘... whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel’s (Berkeley Square) Ltd v G Schock (t/a Annabel’s Escort Agency) [1972] RPC 838 at page 844 per Russell LJ

In the *Lego* case Falconer K likewise held that the proximity of the defendant’s field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant’s conduct would cause the necessary confusion.

Where the plaintiff’s business name is a household name the degree of overlap between the fields of activity of the parties’ respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties’ respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v McCain Foods (G.B.) Ltd* [1984] RPC 501 Slade LJ said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

In the same case Stephenson LJ said at page 547:

‘... in a case such as the present the burden of satisfying Lord Diplock’s requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden, how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged ‘passer off’ seeks and gets no benefit from using another trader’s name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents’ property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.’

81. In my view, the consumer would not expect a provider of the opponent’s services also to be selling training to the public. Even if this training were covering financial matters, it seems to me that the fact that the mark and sign are a commonly used word, and that the opponent’s customers would not assume that the training services were being supplied by the opponent. In *Phones 4u Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244, Jacob LJ commented:

“16. ... Sometimes a distinction is drawn between ‘mere confusion’ which is not enough, and ‘deception’, which is. I described the difference as ‘elusive’ in *Reed Executive plc v Reed Business Information Ltd* [2004] RPC 40. I said this, [111]:

‘Once the position strays into misleading a substantial number of people (going from “I wonder if there is a connection” to “I assume there is a connection”) there will be passing off, whether the use is as a business name or a trade mark on goods.’

17. This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing

off if there is a substantial number of the latter even if there is also a substantial number of the former.”

82. I find there to be no misrepresentation and the section 5(4)(a) fails in relation to *Training academy*.

CONCLUSION

83. The opposition has been partially successful and the application is refused in respect of all its Class 36 services. The application may proceed to registration in respect of the following services:

Class 41

Training academy.

COSTS

84. Both parties have had some success, with the greater share going to the opponent, who is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016 and adjusted to take account of the partial nature of its success. In the circumstances I award the opponent the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement:</i>	£200
<i>Preparing evidence and considering and commenting on the other side's evidence:</i>	£700
<i>Preparation of submissions in lieu of a hearing:</i>	£200
<i>Official costs for the successful grounds:</i>	£100
TOTAL:	£1200

85. I therefore order Access Financial Services Limited to pay Access Underwriting Limited the sum of £1200. The above sum should be paid within two months of the

expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 20th day of July 2020

Clare Boucher

For the Registrar

Comptroller-General