

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2131903 IN THE NAME OF  
KPMG**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 47825 IN THE NAME OF  
LOMBARD RISK SYSTEMS LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF application No 2131903 in the name of KPMG**

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**and**

**IN THE MATTER OF opposition thereto under No 47825 in the name of Lombard Risk Systems Limited**

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**Background**

On 6 May 1997, KPMG, of PO Box 695, 8 Salisbury Square, London, EC4Y 8BB, applied to register the trade mark GLOBERISK in Classes 35 and 36 in respect of the following services:

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Class 35: Business consultancy services; business management consultancy services; business organization consultancy services; preparation and writing of business reports; accountancy and management information systems services; business risk appraisal; risk analysis; management assistance; economic forecasting; business research.

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Class 36: Financial consultancy services; financial management consultancy services; preparation and writing of financial reports; financial risk appraisals; risk analysis; financial forecasting; financial modelling; auditing.

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On 20 November 1997, Lombard Risk Systems Limited filed notice of opposition to this application, in which they say that they are the proprietors of the following United Kingdom trade mark registration and Community trade mark application respectively:

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<b>Number</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
2107199	GLOBERISK	9	Computer software.
338988	GLOBERISK	9	Computer software

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The grounds of opposition are in summary:

- 1. Under Section 5(2)(a)** Because the mark applied for is identical to the opponents' trade mark and is to be registered for services which are similar to the goods for which the earlier trade mark is registered./applied for.

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**2. Under Section 3**

Because the application does not satisfy the requirements of Section 1 (1) by virtue of the opponents' earlier trade marks.

5 The opponents say that they proposes to use the trade mark GLOBERISK in relation to a software product to complement its existing computer software range for use in the financial services sector, and in particular, for risk management applications.

10 Both parties claim that they are the proprietor of the trade mark. The applicants deny all of the grounds of opposition and asks that the Registrar exercise her discretion and allow the application to proceed. Both sides ask for an award of costs in their favour.

15 Both sides filed evidence in these proceedings. The matter came to be heard on 7 August 2000, when the applicant was represented by Mr Piers Acland of Counsel, instructed by Urquhart Dykes & Lord, their trade mark attorneys, and the opponents by Ms Jessica Jones of Counsel, instructed by D Young & Co., their trade mark attorneys.

**Opponents' evidence**

20 This consists of a Statutory Declaration dated 23 September 1998, and executed by Nigel John Duxbury, the Group Finance Director of Lombard Risk Systems Limited, a position he has held for two years. Mr Duxbury confirms that the facts set out in his Declaration have been obtained from his company's records to which he has free access, and that he is authorised to make the declaration of behalf of the opponents.

25 Mr Duxbury begins by referring to his company's United Kingdom trade mark registration and Community trade mark application, details of which are shown at exhibit NJD1. He describes Lombard Risk Systems Limited as a specialist company principally concerned with the design of computer software for use in the financial services sector, in particular, for risk management applications, and as a provider of consultancy and training services for companies in the financial services sector, with particular reference to risk management.

30 He refers to Exhibit NJD2, which consists of promotional materials showing use of the marks OBERISK and OBERON in relation to risk management software applications, all of which are designed for use by customers in the financial services industry, namely trading in bonds, futures, interest rates swaps, foreign exchange transactions and other financial dealings. Mr Duxbury continues by saying that there is a straight forward and clear association between his company's computer software products and the services claimed in this application because risk analysis, financial risk appraisals and financial modelling are key functions performed by his company's computer software products.

**Applicants' evidence**

45 This consists of a Statutory Declaration dated 17 December 1998, and comes from Dr Andrew Luke Henri Smith, a Partner within the Risk Management Consulting Group of KPMG (the applicants), a position he says he has held since 1 October 1995.

Dr Smith refers to exhibit AHS1 which sets out the details of the application which is the subject of these proceedings. He goes on to explain his company's involvement in the risk management business and refers to exhibit AHS2 which is a copy of the KPMG's promotional material for the GLOBERISK consultancy which sets out various concepts involved. This promotional literature is said to having been released in early 1997, but is undated.

He goes on to say that the trade mark GLOBERISK was first conceived within KPMG towards the end of 1993, and was first used externally as a trade mark in the UK in the first half of 1994. Dr Smith provides details of the annual turnover for the financial period to 30 September 1998 in relation to the services sold under the trade mark GLOBERISK, which he says is in the region of £6.5 million. Dr Smith states that KPMG does not sell software in the UK under the GLOBERISK trade mark and has no intention of doing so.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

### **Decision**

Prior to the hearing Ms Jones on behalf of the opponents withdrew the grounds founded under Section 3 and Section 1(1) of the Act. This leaves the grounds under Section 5(2) of the Act to be determined.

Section 5(2) of the Act reads as follows:

**5(2)-** 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 earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

The term 'earlier trade mark' is itself defined in Section 6 as follows:

**6 (1)** In this Act an earlier trade mark means -

(a) a registered trade mark, international trade mark (United Kingdom) or Community trade mark 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,

In my determination of the likelihood of confusion I look to the approach adopted by the European Court of Justice in *SABEL v. PUMA* 1998 RPC 199 at 224, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* Case C-39/97) and in *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* (1999 ETMR 690 at 698). It is clear from these cases that:

the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

5 the matter must be judged through the eyes of the average consumer, of the goods/services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind;

10 the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

15 the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

20 there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it.

25 The applicant is seeking to register the mark GLOBERISK. The opponents' trade mark is also GLOBERISK, and self evidently, is identical. In determining whether the services covered by the application are similar to the goods covered by the opponents' earlier trade mark I have considered the guidelines formulated by Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281 (Pages 296, 297) as set out below:

30 (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 services;

35 (d) The respective trade channels through which the goods or services reach the market;

40 (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;

45 (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.

Whilst I acknowledge that in view of the CANON - MGM judgement by the European Court of Justice (3-39/97) the TREAT case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in TREAT) are still relevant in respect of a comparison of goods and services.

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The services of the application cover, inter alia, consultancy services to assist client companies in minimizing risks of various types, in particular, in business and finance, whereas the opponents' specification in Class 9 gives broad coverage for computer software at large, and notionally, software for the same purpose as the applicant's services.

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From the evidence it is clear that the respective goods and services are for the same, specialised purpose, and I find it quite feasible that one could be used as an alternative to, or in conjunction with the other, for example, the software may be used in the provision of the services. The physical nature of goods is obviously quite different to that of a service, even where the respective purposes are the same. The goods and services are likely to be selected after a high degree of consideration, and most likely will be used by well informed and knowledgeable persons. Although there is no evidence from the trade, I consider that it is not beyond the realms of reasonable possibility that companies operating in this industry could provide both the software and the services. Whether or not this is the case, given their specialised nature, they would, at the very least, be in such close proximity that if sold under a similar brand name even a knowledgeable and expert consumer is likely to consider that they originate from a single undertaking.

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Both parties concede that the marks are identical. It can be readily seen that the marks consist of two ordinary dictionary words; GLOBE which is very close to and likely to be understood to be a reference to "Global" (meaning world-wide or comprehensive), and RISK, or as a whole, "Global Risk" which is clearly a reference to a characteristic of the goods and services provided under the mark. I have no evidence of the uniqueness or otherwise of the trade mark in the market place, but as a combination of two well known, ordinary, dictionary words where the descriptiveness is not that difficult to discern, I do not consider the trade mark to have such a high degree of distinctiveness such as to warrant a wide penumbra of protection.

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The evidence establishes that the applicants have used their trade mark on a significant scale throughout the United Kingdom in relation to the provision of risk management services since 1994, and I have no difficulty in accepting that at the date of application they had built up a substantial reputation/goodwill in respect of provision of risk management services. However, the opponents' mark, although an earlier trade mark, is not yet in use, and it is necessary to consider the likelihood of confusion if the opponent were to put its mark into normal and fair use. On the evidence before me, I find that when all of the factors are taken into account, that the respective trade marks are identical and the goods of the opponents would be associated with the services of the applicants. I therefore have no difficulty in coming to the view that there is a real likelihood of confusion, and the objection under Section 5(2)(a) succeeds.

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The opposition having been successful I order the applicants to pay the opponents the sum of £835 as a contribution towards their costs. This sum 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.

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**Dated this 6<sup>th</sup> day of December 2000**

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