

O-467-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3004031
BY ALEXANDER HOUSE FINANCIAL SERVICES
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 36 & 42:**

Alexander House FS

AND

OPPOSITION THERETO (NO. 400783) BY FOXTONS LIMITED

Background and pleadings

1. Alexander House Financial Services (“the applicant”) applied to register the trade mark **Alexander House FS** on 29 April 2013. It was published for opposition purposes on 31 May 2013. Registration is sought in respect of “financial services” in class 36 and “technological services” in class 42.

2. Foxtons Limited (“the opponent”) opposes the registration of the trade mark, but only in relation to the class 36 services. Its grounds for doing so are under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The first ground is based upon its earlier UK registration 2366077 for the mark **ALEXANDER HALL** and the second ground on the use of that sign since 1992 in respect of certain financial services. The opponent claims that the use of the mark will lead to confusion/deception. It states that the services are identical. It states that the marks are both, essentially, two word marks that share the same first word (ALEXANDER) and that the second words of the respective marks (HOUSE/HALL) have conceptual similarities and that those words both begin with the letter H and differ in length by only one letter. It further states that FS is not distinctive in relation to financial services so does not help to distinguish the marks. The opponent’s mark was filed on 18 June 2004 and entered on the register on 10 December 2004. Although it is registered for a slightly wider specification, the opponent relies on its earlier mark to the extent that it is registered for the following services in class 36:

Insurance; financial affairs; monetary affairs; provision of finance; life insurance; mortgage service financial loan services, real estate management; real estate appraisal; information, advisory and consultancy services all relating to the aforesaid services.

3. As the earlier mark completed its registration process (the date that it was entered on the register) more than five years before the date on which the applicant’s mark was published, the proof of use provisions are applicable to the earlier mark as per section 6A of the Act. This means that the earlier mark may only be relied upon to the extent that it has been used (in that five year period ending on the date of publication). In relation to this, the opponent made what is called a “statement of use”. It states that its earlier mark has been used in relation to the above identified services, as relied upon. In terms of its goodwill, the opponent states that it has acquired substantial goodwill and that the opponent “incorporated themselves” in early 2013. It states that the signs could be imperfectly recalled and/or the opponent’s potential clients could be deceived into believing that the services of the applicant are those of the opponent and that damage could arise through loss of sales or, alternatively, damage in a more general sense if unacceptable services were to be offered by the applicant.

4. The applicant filed a counterstatement denying the claims. It did not put the opponent to proof of use for the purposes of the proof of use provisions. It makes a number of points including that:

- There are 242 other persons using ALEXANDER in relation to financial services.

- The opponent does not use its mark for all of the services listed in its class 36 specification, nor does it have permission from the Financial Conduct Authority (“FCA”) to do so.
- The words HALL and HOUSE FS have no real similarities.
- FS is not in common usage and the syntactical juxtaposition of HOUSE FS is aimed at a marketing ploy of “Alexander – the house of financial services”; this, it is stated, leans on the definition of “house” in a commercial sense.
- The primary meaning of hall is of an entrance room - other meanings include rooms in buildings (e.g. dining hall, assemblies, for public meetings etc).
- The primary meaning of house is a building used for a dwelling, other meanings allude to commercial companies and legislative bodies.
- HOUSE and HALL are not interchangeable words and are not synonyms, they mean entirely different things.
- The FCA requires both parties to make certain disclosures (who they are, what they do etc), so lessening the likelihood of confusion/deception.
- Both parties meet clients face-to face – reference is made to the judgment of Miss Recorder Amanda Michaels in *Casino DE Monte Carlo* to the extent that there was in practice (in that case) no likelihood of confusion given the high degree of attention paid to the service provider of the defendant’s services which would need face-to-face meetings.
- A reduction of goodwill will have occurred due to the use by others of the name Alexander.
- Alexander House FS has the right to use its chosen name, it being the name of its corporate vehicle; reference is made to the “own name” defence¹.

5. Both sides filed evidence. A hearing then took place before me on 9 October 2014, with the opponent represented by Ms Amanda Michaels, of counsel, instructed by Mishcon de Reya and the applicant by Mr Paul Lockyer of Breeze & Wyles Solicitors LLP.

The evidence

The opponent’s evidence

6. This comes from Mr Karl Daly, senior legal counsel of Foxtons Group Limited, a group comprising the opponent and Alexander Hall Associates Limited (“AH”). I note the following in respect of how the earlier mark is used:

- The opponent is an estate agent operating under the name Foxtons. Founded in 1981, it now has a network of 42 offices in London and 2 in Surrey.
- AH is a mortgage broker founded in 1992. It is authorised in respect of protection, residential mortgage and general insurance business. It provides its services via its office in London and through its website. The opponent recommends the services of AH to its customers, although, Mr Daly states

¹ This argument was not pressed at the hearing, but, for sake of clarity, the argument is rejected – the own name defence is a defence in infringement proceedings not any form of right to have a trade mark accepted for registration.

that its services are not provided exclusively to the opponent's customers (although he identifies no other source for custom). AH uses **Alexander Hall** as its primary indication of trade origin.

- Mr Daly feels this "joint marketing" to be a significant factor in the success of AH's business. The earlier mark is licensed by the opponent to AH.
- AH offers the sort of services one would typically expect from a mortgage broker. Mr Daly states that it also offers consultancy/advisory services relating to insurance policies (life, critical illness and income protection).
- Exhibited documents include website extracts² and a client pack³ which include a "key facts" document together with other pieces of relevant information. The words "Alexander hall" are used, often with the tagline "London's mortgage broker".
- Website statistics show that in the three year period between January 2010 and December 2013 there were over 1.2 million unique visits to the website, broken down fairly equally over the three years.
- The group "do not spend excessively" on marketing the ALEXANDER HALL brand because of the direct marketing via the opponent. The total advertising spend for the group has ranged between £3.9 million at its highest (in 2008) and just under £2 million at its lowest (in 2009); in 2012 it was just under £3.2 million.
- Turnover for the opponent (presumably in connection with the Foytons' estate agent business) has been on an upward curve from £75 million in the year ending December 2008 to £114 million in 2012.
- AH's turnover was at its highest in 2008 at just over £8.6 million, but, since then, annual turnover has been between just under £3.5 million and just under £4 million per annum.
- AH's services have been the subject of articles in the Foytons' Area Magazine. AH has won some business awards including: Best Regional Advisor 2006 and 2007 (What Mortgage Magazine) and was Highly Commended at the Legal & General Mortgage Club Awards 2013. AH was a sponsor of the Business Development Award at the British Mortgage Awards 2013 and AH was voted Bronze Award winner in 2013 for Residential Mortgage Broker of the Year⁴.
- The opponent became aware of the applicant following a watch notice from its trade mark advisors. Mr Daly states that Alexander House Financial Services Limited was incorporated on 8 January 2013 and that an individual called Roderick Reed registered the domain alexanderhousefs.com on 7 January 2013. Extracts from the applicant's website (Exhibit KD8) show use of **Alexander House** with a spiral logo between the two words. Further website prints show that the applicant provides financial advisor services and that the

² Exhibit KD1

³ Exhibit KD2

⁴ All in Exhibit KD5

wording on other parts of the website suggests that they will help find a mortgage for a customer⁵.

The applicant's evidence

Ms Jane Hodges

7. Ms Hodges is the applicant's Chief Operating Officer. The main points from her evidence are that:

- The applicant is a new national financial advice service incorporated on 8 January 2013. It advises its customers about, and makes arrangement for, pensions, investments and life insurance. If there is demand, it may arrange mortgages. Ms Hodges, earlier in her witness statement, stated that this will only occur if a customer was to ask for it as part of their financial planning.
- The applicant only deals with customers known to its advisors and customer relations managers.
- AH's business focuses on the provision of mortgage advice in London which the applicant does not specifically focus upon.
- That the branding and colouring used by the respective businesses is said to be different.
- That the applicant will display its unique FCA number and other disclosures as required by that regulatory body. Consumers can also see all financial service businesses on the Financial Services Register. The applicant will also be indicating that it is an appointed representative of Network Direct Limited.
- That the opponent did not break down its marketing spend between the Foxtons' business and that of AH.
- It is stated that at Foxtons' Pall Mall office, there are signs for Alexander Hall, but they are far less prominent than those for Foxtons.
- The opponent has allowed other businesses to use Alexander in their names, many of whom have been operating for a long time. Exhibit JH2 is an extract from the Financial Services Register and includes the names: Alexander & Co, Alexander & Co Estate Agents, Alexander & Payne, Alexander Adair, Alexander Adam, Alexander Alton, Alexander Hall Associates, Alexander Hamilton, Alexander Harvey, Alexander Harvey, Alexander Herbert, Alexander Heywood, Alexander House (four names based on this) – there are apparently 242 records in total (not all are detailed).
- Most of the opponent's "leads" will come from Foxtons; there is no evidence of how many leads come from its website. Ms Hodges believes the website statistics to be misleading.
- AH's business is authorised to arrange regulated mortgage contracts and non-investment insurance contracts – this, it is stated, is typical for a mortgage broker. It does not have authorisation to undertake the wider services covered by its specification including investment business and investment advice.
- In relation to mortgage advice, both parties would be required to meet clients face-to-face. This, together with the regulated disclosures, rules out confusion

⁵ Exhibit KD10 which includes references to "finding the right mortgage".

(as per the counterstatement, reference is made to the *Casino Monte-Carlo* case).

- The applicant has no business strategy to acquire leads from web traffic. Reference is made to leads from existing customers of its advisors. Reference is also made to social media campaigns and the web brand called “Smart Alex”.
- AH’s brokers are commission only whereas the applicant’s advisors are not allowed to be paid commission.
- AH operates out of Foytons’ estate agents and so there is no likelihood of confusion.
- The applicant accepts that the opponent’s earlier mark covers the whole of class 36, but it highlights, again, that it does not have permission to perform all of the activities. It is stated that “We have not, at this stage, suggested that [the opponent’s] mark is required to narrow its mark to cover its actual activity but we reserve the right to do so”.
- Various comments on the similarity of the marks are made, as per those made in its counterstatement.

Mr Roderick Reed

8. Mr Reed is the applicant’s marketing and IT director. He has conducted a number of web searches, the results of which were:

- Searches conducted for “Alexander” on Google – neither business appears in the results page, although, I doubt whether Mr Reed looked at all 184 million results. For Bing, Mr Reed states that the applicant does not appear (I could not see the opponent either) and on Yahoo neither appear, although there is a Welsh Estate agent called Alexander’s, a financial advice service with the same name and another estate agent called Alexander’s & Co.
- Searches for “Alexander H” – Google auto prompts Alexander Hall as a search term. Neither Bing nor Yahoo brings either side up in the first 5 pages.
- Searches for “Alexander Ha” - Google auto prompts Alexander Hall as a search term, the results of which bring the opponent’s Alexander Hall mark as the first result; the applicant’s business is not listed as a hit. Similar results were brought up from Bing and Yahoo.
- Searches for “Alexander Hall” – the nub of this is that the opponent is found (as hit one) and the applicant not (at least not in the first pages exhibited).
- Searches for “Alexander Ho/House/House FS – the nub is that the opponent’s business is not found.
- Searches for the term London’s mortgage Broker, the nub is that the opponent is found but the applicant not.
- Searches for Smart Alex – the nub is that neither sides’ business is found.

9. Mr Reed states that the use of search engines is the route taken by most people looking for mortgage advice and in the unlikely event (unlikely, he considers, due to the above) of getting to the wrong business they will realise the different focus of each. Mr Reed also questions the web statistics provided by Mr Daly. He states that

the terms used (hits, visits, website page views and unique visitors) are not properly defined. He states that unique visitors could be an individual or a robot. He explains that a hit often includes all images on a page, so if a page has 50 images this will equate to 51 hits. He states that people could visit the website accidentally

The opponent's reply evidence

Mr Leo Lapworth

10. Mr Lapworth is the web manager and senior web developer for both the opponent and AH. He states that the applicant's website has a very low site strength which is why it is not found in many searches, unlike that of the opponent which can be found in a variety of searches. He says that this could change in time which means that confusion could arise more easily. He says that in relation to the various searches, all they show is that neither sides' website comes towards the top of the more generic searches. In relation to the website statistics, he explains that the data was gathered from Google Analytics which uses the following [summarised by me] definitions:

- Page views – an instance of a page being loaded by a browser;
- Unique visitors – data which can help the user find out how many users viewed or interacted with content in a specific date range;
- Visits – a group of interactions within a timeframe- a single visitor can contain multiple views, interactions etc – they can be as short as a few seconds or last hours.

11. In relation to "hits", this is not defined by Google but Mr Lapworth states that the general meaning is that every image in a page view has a separate file and each file creates a hit. He adds that AH does not track hits. In relation to whether a robot would count as part of the unique visitor data, he explains that they do not. In relation to accidentally getting to a website, he states that people get to the website via either search engines or directly from Foxtons' website; supporting data is provided in relation to this⁶.

Mr Karl Daly

12. In his second witness statement Mr Daly replies to some of the points raised by Ms Hodges. In short, he does not agree with her. I note the following points:

- Although the trade mark in dispute includes the letters FS, this is not used in practice.
- It is clear that, in practice, the services overlap.
- The opponent is not limited to London and its website is a national one so the applicant is in direct competition.
- There are references to mortgages made on the applicant's website. Further evidence from the applicant's website is provided showing this.

⁶ Exhibit LL1

- There is nothing to show what Ms Hodges saw when she visited the Pall Mall office, but Mr Daly confirms that in all 45 Foxtons' office the branding for ALEXANDER HALL is carried and services offered under it.
- The Financial Services Register is not a list of trade mark rights. He adds that the opponent does not purport to have a monopoly in ALEXANDER. He is not aware of anyone applying for a trade mark that he considered to be similar. He also highlights that three of the other Alexander House companies listed on the register have the same registered office but do not trade under that brand.
- He disagrees that the opponent's mark is used as narrowly as Ms Hodges claims.
- He states that use of the marks is not limited to face-to face meetings, but will also be viewed on websites, marketing materials, word of mouth and other aural media such as radio.
- He provides a Google print showing that a search for "Alexander H" auto-prompts a number of options including both Alexander House and Alexander Hall.
- That a HALL can be in a HOUSE, so increasing the likelihood of confusion through imperfect recollection.

Section 5(2)(b) of the Act

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

"5(2) A trade mark shall not be registered if because-

.....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".

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or 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, and whose attention varies according to the category of goods or services in question;

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

15. The applicant wishes to register its mark for the term: financial services. The opponent relies upon the following of its services:

Class 36: Insurance; financial affairs; monetary affairs; provision of finance; life insurance; mortgage service financial loan services, real estate management; real estate appraisal; information, advisory and consultancy services all relating to the aforesaid services.

16. As can be seen from the evidence summary, the applicant has referred, on a number of occasions, to the services which the opponent actually provides. The

applicant makes the point that these are the services which it has authority to provide and that its specification is much wider. Ms Hodges stated in her witness statement: “we have not, at this stage, suggested that [the opponent’s] mark is required to narrow its mark to cover its actual activity but we reserve the right to do so”. At the hearing, Mr Lockyer strongly pressed these points. I asked him why, in that case, the applicant did not put the opponent to proof of use, an option that was open to it and an option which would have limited the opponent’s specification to only those services for which the mark had been genuinely used (or at least a fair specification that reflects such use). He stated that applicant did not consider it necessary because the applicant is not able to use the mark on a wider range of services unless it becomes authorised to do so (which he considered far-fetched) and, in fact, it would be a criminal offence to currently use the mark on any wider services than for which they are currently authorised. Mr Lockyer submitted that the opponent’s specification should be considered solely upon the basis for which it is currently authorised and the assessment on similarity should be made from that starting point.

17. Ms Michaels submitted that this would equate to proof of use through the back door. She considered that the opponent was able to rely on its full specification (to the extent relied upon) given that it had not been put to proof of use. It was also submitted that the opponent could gain authorisation for other services in the future and the matter must be considered on a notional basis, the parameters for which are set by the services applied for (by the applicant) and the services registered and relied upon (by the opponent).

18. I consider Mr Lockyer’s submissions on this point to be misconceived. If the applicant wished the specification of the earlier mark to be limited to the services which it has offered then it could have put the opponent to proof of use. It did not, which means, effectively, that the applicant has neither denied nor not admitted the opponent’s statement of use (as per rule 20(2)(c) of the Trade Marks Rules 2008) and that the opponent’s statement should be accepted. That the applicant may not currently be authorised to use the mark in relation to all the services is not pertinent. Once the parameter of the earlier mark has been decided then it is a notional (not an actual) assessment that is to be made based upon the specifications of the marks. I reject the applicant’s submission; the earlier mark may be taken into account for its full specification as set out above. In relation to this, Ms Michaels highlighted that in addition to a number of specific financial services, the specification includes the term “financial affairs”. This is, essentially, the same as “financial services”, both terms being broad ones covering various financial based services. Even if the applicant limited its specification to what it does (financial advisory services) then its position is not improved because this would still be encompassed by the term financial affairs and additionally, the opponent has protection for various advisory services including those in relation to the various financial services specified in its specification. **Whatever way one looks at it, the applied for term fall within the ambit of the earlier terms and, so, are to be considered as identical⁷.**

⁷ Goods and services may be considered as identical when one falls within the other – see *Gerard Meric* Case T-133/05

Average consumer and the purchasing act

19. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

20. The average consumer of financial services could be a member of the general public or a business. Either way, I agree with Mr Lockyer that the process for deciding upon a financial service provider is a considered one. I did not understand Ms Michaels to seriously dispute this. Mr Lockyer did go on to discuss the fact that the financial services sector is one of the most highly regulated industries in the world. However, I think that he overplayed his hand in relation to this. He highlighted the various disclosures that need to be made by financial service providers to its potential customers, including fully setting out the company name of the service provider and their FCA registration number. He highlighted that consumers could go on to the register to make checks etc. He considered that these added factors virtually ruled out any chance of confusion. Whilst this is borne in mind, none of the additional information (full company names and FCA numbers) are in the marks before the tribunal, and, in any event, such information is unlikely to form part of the way in which average consumers would store away information about the service provider. Nevertheless, and as I have already stated, the degree of care and consideration put into the selection of a financial service provider will be higher than the norm given the likely importance of the choice being made.

21. It seems to me that both visual and aural impacts of the respective marks are important. The marks may be encountered visually on web-sites, brochures, business cards, advertisements, but will also be encountered aurally by way of telephone calls and potential face-to-face meetings. Face-to-face meetings were highlighted by Mr Lockyer as being particularly important on account of certain financial services (such as mortgages) requiring such a meeting. Whilst this is noted, this does not apply to all financial services.

Distinctive character of the earlier trade mark

22. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“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).”

23. From an inherent perspective, and as I will explain later, Alexander Hall will be perceived as a person’s full name. Names are often used in relation to financial services, but it does not necessarily follow that it possesses only a low degree of inherent distinctive character. Therefore, whilst it is not highly distinctive from an inherent perspective, it has an average level of inherent distinctive character.

24. The earlier mark has also been used, so I must consider whether its level of distinctive character has been enhanced. There are, though, a number of points to bear in mind. Firstly, the geographical spread is limited to London and/or the Greater London area. Whilst this is not, in and of itself, fatal to the gaining of enhanced distinctive character for the purpose of establishing a likelihood of confusion, it is a factor none the less. Secondly, it is the opponent’s own evidence that the earlier mark is not promoted “extensively”. It appears that most promotion is done through the network of Foxtons estate agents, so most business and/or awareness will have developed via this route. There is no evidence as to the impact of any Alexander Hall branding in the Foxtons’ offices, although, the evidence is that there is some, albeit it is likely to be subordinate to Foxtons. There is also the issue of client numbers. Ms Michaels suggested that a feel for the numbers could be gained by dividing the turnover figures by the average cost of a mortgage application (£499). Mr Lockyer argued that it would be unsafe to use such a calculation. Mr Lockyer was right to caution against relying on such general estimates, the opponent could easily have put in evidence showing client numbers if it wished to rely on such evidence. However, even if one were to make an estimate to provide a feel for the numbers of clients involved, there would seem to be clients in the region of 17k at its highest (in 2008) and less than half that in subsequent years. Whilst clearly not insignificant,

such numbers, in circumstances when promotion more generally is quite limited, does not strike me as the type of use which will have enhanced distinctive character with the average consumer in the UK to any material extent.

Comparison of marks

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

26. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. For ease of reference, the competing marks are shown below:

Alexander House FS v ALEXANDER HALL

27. In terms of the applied for mark (**Alexander House FS**), the overall impression is made up of the words Alexander House (with Alexander qualifying the word House) and the letters FS. Ms Michaels submitted that FS would be perceived by the average consumer as an abbreviation for “financial services”, however, even if this were so, it is not negligible in the context of the mark and still, therefore, contributes to its overall impression; although, if it were to be perceived simply as an abbreviation for financial services, the relative weight of this element in the overall impression of the mark would be very low indeed. If, on the other hand, the average consumer just saw the letters FS as letters without a particular meaning, their relative weight would be greater, although, I still consider that Alexander House would retain greater relative weight in the overall impression on account of the combined effect of its position at the beginning of the mark and that it has a more memorable concept. Although, as Mr Lockyer pointed out, there is no evidence of FS being used in the market as an abbreviation for financial services, I think there will be some that would perceive those letters as an abbreviation but some that would not.

28. In terms of the earlier mark, the overall impression is based upon the words ALEXANDER HALL, with Alexander qualifying the word Hall. Neither words takes on more relative weight than the other in the overall impression.

29. I will make, firstly, a conceptual comparison. The claims and counterclaims refer to the meanings of the words HOUSE and HALL. However, it is important to bear in mind that the marks must be considered in totality and the contexts of the whole marks considered. From that perspective, the primary meaning of ALEXANDER HALL will, in my view, be of a person's full name; Alexander (forename) Hall (surname). Ms Michaels submitted that some people would see the words as indicating a Hall (as in a type of building) named Alexander. I think this is unlikely. This is particularly so in the field of financial services which often use trading names based upon the person that runs or founded the business. Furthermore, Alexander strikes me as a fairly common forename and Hall as a fairly common surname. These factors combine so that it would be counterintuitive to believe that anything other than a full name perception will be taken in the vast majority of cases. In relation to Alexander House FS the position is somewhat different. This is because House does not strike me as a particularly common surname so its combination with Alexander does not so obviously suggest a person called Alexander House. I consider the primary meaning will be of a house named Alexander or house (in the commercial sense) of Alexander. It is possible that some consumers may see the words as a full name, although this will be in a minority of circumstances. The mark as a whole has FS on the end. I do not, though, consider that this adds much to the overall concept because it will just be seen as a reference to the services offered or, alternatively, just two random letters with no conceptual meaning. In terms of how this impacts upon the conceptual similarity, the position is as follows. The primary meanings of the mark bring forward a conceptual difference as one mark references a person the other the name of a building (with the addition of the letter FS). Even if the secondary meaning of the applied for mark (as a person's name) were taken then there is some (low degree) of similarity as both marks reference a person with the forename Alexander, albeit with a different surname. The only potential for conceptual similarity is if the earlier mark were also seen as the name of a building, but, for reasons already expressed, this is not likely.

30. From a visual perspective, both marks contain the word ALEXANDER as the first part of each mark which creates an inevitable degree of similarity. The second word of each mark starts with the letter H but the rest of that word looks quite different. The applied for mark also has the letters FS, although, as already stated, they contribute less (than the other words) to the overall impression of that mark. I consider there to be a moderate degree of visual similarity and I consider the same degree of similarity to follow through to the aural assessment.

Likelihood of Confusion

31. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

32. In its evidence the applicant provided an extract from the Financial Services Register showing entries for businesses with Alexander in their name. I do not consider this to be particularly instructive. As I have already stated, Alexander is a

common name and, in this case, whether there is a likelihood of confusion depends on the closeness of the marks as a whole not solely on the common presence of ALEXANDER. Indeed, it is stated in the opponent's evidence that it is not attempting to gain any form of monopoly in the name ALEXANDER. Another aspect of the applicant's evidence that is not instructive is the way in which the respective parties actually trade. The matter is a notional one and current marketing strategies are not relevant⁸. I have found that the services are identical and that this means that the same general marketing strategies could be in play. Further, any differences inherent in the get-up of the respective marks as actually used are not pertinent because such aspects are not part of the marks under consideration by the tribunal. Nor do I see much significance in the search engine evidence as this is more to do with how search engines work and the respective parties' current profile as opposed to being indicative of any greater or lesser likelihood of confusion.

33. Bringing the relevant factors forward, the financial services at issue are identical and will be selected by the average consumer with a degree of care and consideration that is higher than the norm. There is a moderate degree of visual and aural similarity between the marks and a conceptual difference based on the primary meanings of the marks. The earlier mark has an average level of inherent distinctive character. I must also bear in mind the concept of imperfect recollection, although, the more considered nature of the selection process reduces the significance of this, albeit, I should not rule out imperfect recollection from the assessment altogether. Confusion can be direct (mistaking one mark for the other) or indirect (where the similarities that are present between the marks leads to a same stable assumption). In my view, there is no likelihood of either form of confusion. The conceptual difference between the marks is such that the average consumer is unlikely to misrecall one mark as the other or to consider that they identify services that originate from the same or a linked undertaking.

34. Of course, the average consumer is a legal construct and it would be wrong to consider the matter on the basis of a single meaning rule if there are other potential meanings that would be perceived by at least a significant part of the relevant public (as per the discussion of Arnold J in *Interflora, Inc., Interflora British Unit v Marks and Spencer Plc*, Flowers Direct Online Limited [2013] EWHC 1291 (Ch). However, even if the secondary meaning of Alexander House FS were to be perceived (as a full name with the addition of the letters FS), and after taking into account the guidance given in *Harman International Industries, Inc v OHIM*, Case C-51/09P, the average consumer will still be able to distinguish between them because the surnames used in the marks are different. Even taking into account imperfect recollection it is unlikely that one surname will be misrecalled as the other on account of the fact that an alternate meaning of the surname is of a building (and that both begin with the letter H) this requires too great a degree of analysis to get to that outcome and consumers are generally used to distinguishing between names. The third potential scenario is the position of both marks being conceptualised as names of buildings. However, in my view, such a scenario is highly unlikely (as I have already observed) and would fall out-with the normative range of views that could be taken by the relevant public. Even if I am wrong on that then I am still not persuaded that many people would be confused as the degree of care and consideration that goes into

⁸ See, for example, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

selecting a financial service is such that the marks are likely to be recalled with enough precision to differentiate. This is so regardless of whether one is considering direct or indirect confusion. Put simply, the marks are not close enough, when the selection process is borne in mind, for a likelihood of direct or indirect confusion. **The opposition under section 5(2)(b) is dismissed.**

Section 5(4) of the Act

35. I will deal with this ground briefly. I accept that the opponent has a protectable goodwill associated with the financial services it actually offers (essentially, mortgage broking). However, for the reasons I have expressed above, I do not accept that a significant proportion of the opponent's customers or potential customers will believe that the applicant's services offered under the applied for mark are the responsibility of the opponent. Ms Michaels did not offer a materially different argument under this ground so what I have said is suffice to **dismiss the ground of opposition under section 5(4)(b).**

Costs

36. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £800 as a contribution towards the costs of the proceedings. I should add that the sums for evidence and attending at the hearing are lower than I may otherwise have awarded on account of the fact that much of the evidence and argument was simply not pertinent. The sum is calculated as follows:

Preparing a statement and considering the other side's statement - £300

Considering the opponent's evidence and filing evidence - £250

Attending the hearing £250

Total - £800

37. I therefore order Foxtons Ltd to pay Alexander House Financial Services the sum of £800. The above sum should 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 31st day of October 2014

**Oliver Morris
For the Registrar,
The Comptroller-General**