

0/470/17

TRADE MARKS ACT 1994

TRADE MARK APPLICATIONS 3160919, 3161765 & 3161841

AND TRADE MARK REGISTRATION 3144933

IN THE NAME OF M & G LIMITED

AND

CONSOLIDATED OPPOSITIONS 407039, 407103 & 407104

AND APPLICATION FOR INVALIDATION 501268

BY METROPOLE GESTION SA

Background and pleadings

1. M & G Limited (“M & G”) is the applicant for trade mark applications 3160919, 3161765 & 3161841. M & G is also the proprietor of registered trade mark 3144933.

2. Application 3161765 is for a series of three marks. Therefore there are six marks in total. All six of M & G’s marks are very similar. For present purposes, nothing appears to turn on the minor differences of stylisation between them. That being so, it is sufficient to show just the mark registered under 3144933.



3. Each of M & G’s applications, and registration 3144933, cover the following goods and services.

Class 9: Software in the nature of a mobile application; computer programs; computer software for use in accessing, tracking, managing, analysing, downloading and dashboard reporting of financial information and investments; computer software for delivering updates and notifications; software platform to enable users to make financial transactions.

Class 36

Financial services; financial management; asset and fund management; investment services; capital investment; financial advisory and consultancy services; financial analysis and research services, financial forecasting; financing and funding services.

Class 42

Providing a platform for initiating and handling financial investments; providing temporary on-line use of downloadable computer software for accessing,

tracking, managing, analysing, downloading and dashboard reporting of financial information and investments; providing a website featuring non-downloadable software for use in database management, compiling and tracking information and data; providing a website featuring non-downloadable software for presenting a user dashboard of custom information; technical support services; maintenance and updating of computer software; maintenance of databases.

4. Trade mark 3144933 was applied for on 18th January 2016 and registered on 13th May 2016. Application 3160919, 3161765 and 3161841 were applied for on 22nd, 27th and 28th April 2016, respectively. These filing dates are “the relevant dates” for assessing the grounds of opposition/invalidation described below.

5. Metropole Gestion SA (“Metropole”) opposes M & G’s applications and has applied to invalidate registration 3144933. There are three legal grounds based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. All are based on Metropole’s use and registration of this mark.



6. This mark is registered in black and white as an EU trade mark under 5223847. A virtually identical EU mark is registered in a shade of red under 5223821. Nothing turns on the colour in which the latter mark is registered.

7. Registration 5223847 includes the following description of the trade mark.

“Stylised representation of an owl sitting on the branch of an olive tree, behind which is a circle which represents the moon.”

8. Registration 5223821 includes a similar description.

9. Metropole’s marks were applied for in 2006 and registered in 2007. They are therefore ‘earlier trade marks’ compared to M & G’s marks. Metropole claims that the mark shown in paragraph 5 above has been used in the UK since 2005.

10. The earlier marks are registered in classes 35 and 36. There are minor differences between the lists of services for which the earlier marks are registered, but the statement of use of the marks made in connection with these proceedings relies on the same services. These are:

Class 35: Business information; reproduction and distribution of newsletters relating to financial, banking and insurance matters.

Class 36: Financial products, design for others (banks, financial institutions, in particular) and brokerage of financial products; fund investment; monetary affairs; financial analysis; financial consulting services; portfolio management; asset management; mutual funds; fund investment; financial management.

11. Metropole claims that M & G’s marks are similar to the earlier marks, that the respective goods/services are identical or similar and that there is a likelihood of confusion.

12. Additionally or alternatively, Metropole claims that the earlier marks have a reputation in the EU and that M & G’s marks would, without due cause, take unfair advantage of that reputation and/or be detrimental to the reputation or distinctive character of the earlier marks.

13. Metropole also claims that use of M & G’s marks would amount to a misrepresentation to the public which would cause confusion and damage the goodwill established in the UK under the mark shown at paragraph 5 above.

14. M & G filed counterstatements denying the grounds of opposition/invalidation and putting Metropole to proof of use of the earlier marks and the reputation claimed in them.

15. The proceedings were consolidated.

Representation

16. M & G is represented by HGF Limited, trade mark attorneys. Metropole is represented by Page, White and Farrer, trade mark attorneys. A hearing took place on 7th September 2017. Mr Chris Aikens appeared as counsel for M & G. Mr Douglas Campbell QC appeared as counsel for Metropole.

Evidence

17. The opponent's evidence takes the form of two witness statements by Francois-Marie Wojcik, who is the CEO of Metropole. The second of Mr Wojck's statements was filed in reply to the applicant's evidence described below.

18. In his first statement, Mr Wojcik describes his company as *"an asset management company."* The company manages various collective investment schemes via a regulatory regime established by the EU Commission which harmonises the rules governing the management and sale of mutual funds in the EU. Each such fund, known as a UCITS, has its own prospectus. The total value of the funds managed by Metropole grew from around €2 billion in 2011 to around €6 billion in 2015. I note the following points.

- Subscriptions to the UCITS managed by Metropole are not made directly to Metropole, but to a 'custodian' who holds the managed funds.
- Metropole's main custodian is Société Générale of Paris.
- Any entity in the EU can ask their bank to subscribe to the funds managed by Metropole.

- Metropole specialises in investments in ‘value’ funds, i.e. companies whose market value is considered by Metropole to be lower than its actual value.
- There is no direct relationship between Metropole and the investors in the funds it manages.
- The legal contracts are between the customer and his/her bank, broker or distribution platform that submits the order to the UCITS custodian.
- The UCITS custodians pay Metropole a management commission based on the funds it manages.
- Metropole is “at least” aware of the geographical origin of the funds investors from the information provided by the professional investors with whom it does have a contract.
- Around 8-12% of the funds investments come from UK investors. 60-80% come from French investors. The balance come from other EU countries.
- 75% of the investors in Metropole’s funds are institutional investors and its marketing is directed at such investors. 73% of the assets under management as at 30th June 2015 were those of pension funds. Around 13% were “multimanaged”, that is managed jointly with other parties, and 14% were managed as a result of “Private Banking/Family offices & Distribution.”¹
- Four of Metropole’s 45 staff are engaged in marketing. The total marketing budget for 2015 was around €850k. This included attendance at 11 marketing events in the EU and Switzerland (none in the UK) and €190k spent on printing.
- Metropole issues ‘Metropole Gestion Funds Range’ documents to “*the English, French and German speaking public markets*”.² The earlier marks relied on by Metropole are used on those documents.
- Metropole issues a monthly newsletter called ‘La Lettre’ “*to its clients, and to intermediaries, distributors and consultants that it works with.*”³ The document is available in English and shows the black and white version of the earlier mark relied on alongside the name Metropole Gestion. It is said to provide “*financial information, advice on the financial markets, and more generally information and advice about the economy.*”

¹ See Annex 3 to Wojcik 1, page 77

² See Annex 3 to Wojcik 1

³ See Annex 4 to Wojcik 1

- Metropole also issues a fact sheet for each UCITS which informs investors about the progress of their investments.⁴ It is issued to the same constituency as the monthly newsletter. It is also available in English. The earlier marks also appear on this document alongside the name Metropole Gestion.
- Metropole issue annual reports and key investor information documents, which also bear the earlier marks alongside the name Metropole Gestion.⁵
- Mr Wojcik claims that some investors request special monthly reports of their investments. He exhibits an example.⁶ It appears to be addressed to someone in France.
- In addition to printed publications and events, Metropole promotes its services through a website www.metropolegestion.com which has a section in English. The earlier marks are used on this website alongside the name Metropole Gestion.⁷
- Metropole also holds “Rendez Vous” events for its clients and potential clients which Mr Wojcik says provide financial analysis and advice on topics such as *‘Oil prices and the Euro on the decline: big changes for 2015’* and *‘Financial markets at a turning point; new European policy and risk premium’*. Examples of literature relating to these events are in evidence.⁸ They show the black and white version of the earlier mark used alongside the name Metropole Gestion.
- Metropole has received awards for the quality of its services. These are mostly for ‘Excellent Fund Management’ and/or ‘Equities Europe’.
- Mr Wojcik says that the earlier marks sometimes appear in press article about his company. He exhibits 2 such articles, one of which was published in Italy in 2011 and the other in Belgium in 2015.
- Finally, Mr Wojcik explains that the parties operate in the same field and their names/logos are therefore listed on some of the same websites. Metropole is therefore concerned that the use of owl devices by both parties will result in confusion.

⁴ See Annex 5 to Wojcik 1

⁵ See Annexes 6 and 7 to Wojcik 1

⁶ See Annex 8 to Wojcik 1

⁷ See Annex 14 ro Wojcik 1

⁸ See Annex 12 to Wojcik 1

19. M & G's evidence takes the form of a witness statement by Cathal Dowling, who is the Head of Marketing Services. Much of Mr Dowling's statement relates to the relative size of the parties, M & G's history, the creation of M & G's owl device marks, M & G's target customer base and its branding guidelines, particularly with regard to colour. There is no claim that M & G's owl device marks have been used. The other matters mentioned above appear irrelevant, either because they were always irrelevant or because of positions taken at the hearing. For example, on the (non) significance of colour to the required assessments.

20. It is therefore sufficient to record that:

- M & G is also an asset management company.
- It manages funds in excess of £255 billion.
- Mr Dowling had never heard of Metropole prior to these proceedings.
- Mr Dowling provides a number of examples of third party using owl devices in relation to financial services, which he says is because on association between owls and the values of wisdom and knowledge that are particularly relevant in the financial sector.

21. Mr Wojcik's second statement in reply responds to some of the matters that are not (or are no longer) relevant. It is therefore sufficient to record that:

- Metropole provided evidence showing that some of the third party uses of owls in the financial sector identified by Mr Dowling were not in the jurisdiction or were otherwise irrelevant.
- Despite Mr Dowling's claim to the contrary, M & G was aware of Metropole, at least at some level in the organisation.

Proof of use

22. Section 6A of the Act is as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the period of five years ending with the date of
publication.

(2) In opposition proceedings, the registrar shall not refuse to register the
trade mark by reason of the earlier trade mark unless the use conditions are
met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of
the application the earlier trade mark has been put to genuine use in
the United Kingdom by the proprietor or with his consent in relation to
the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper
reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements
which do not alter the distinctive character of the mark in the form in
which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

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

23. Section 47(2A) – (2E) of the Act applies essentially the same conditions to earlier marks which had been registered for 5 years or more at the date of filing of an application for invalidation. This means that in order to be able to rely on its earlier EU trade marks, Metropole must show that they were put to use in the 5 year periods ending on the dates of publication of M & G’s three pending applications or, in the case of registered mark 3144933, the date of the application to invalidate the registration. The relevant 5 year periods end between 29th April 2016 and 26th July 2016. In practice, nothing turns on the small differences between the periods so I will consider them as one.

24. M & G accepts that the earlier marks have been put to genuine use in relation to the services underlined below.

Class 35: Business information; reproduction and distribution of newsletters relating to financial, banking and insurance matters.

Class 36: Financial products, design for others (banks, financial institutions, in particular) and brokerage of financial products; fund investment; monetary affairs; financial analysis; financial consulting services; portfolio management; asset management; mutual funds; fund investment; financial management.

25. With the possible exception of financial advice/analysis, there did not appear to be much dispute at the hearing as to the services shown in Metropole's evidence. Rather the dispute appeared to be more about which of the services covered by the earlier marks should be retained on the basis of the use shown.

26. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*,⁹ Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of

⁹ [2016] EWHC 3103 (Ch)

the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

27. It is true that Metropole's newsletter (1) includes use of the earlier marks and (2) includes financial information that is useful to businesses. However, I do not consider that an average consumer would regard the distribution of the newsletter, or any of the other services provided under the earlier marks, as providing a 'business information' service. Rather Metropole provides financial information to businesses. Further, even if the distribution of the newsletter counts as the provision of *business information*, it is plainly only a narrow sub-category of the services covered by the broad term in question. For both these reasons I reject the submission made by counsel for Metropole that the use shown justifies the protection of the earlier marks for *business information* services. I find that *reproduction and distribution of newsletters relating to financial, banking and insurance matters* is an appropriate description of the class 35 services shown in the evidence.

28. Turning to the services in class 36, it seems to me that an average consumer would regard *financial analysis* to be integral to Metropole's *asset management* services. Therefore the earlier marks are entitled to protection in respect of these services too.

29. I understand *financial products, design for others (banks, financial institutions, in particular)* as meaning designing financial products for others. Although Metropole

trades in its own financial products, I see no evidence of use of the earlier marks in relation to financial products designed for others, or in relation to *brokerage of financial products*, which necessarily entails trading in third party financial products. *Financial consulting services* means providing financial consultation services to individual clients, not just providing financial analysis relevant to particular funds. I therefore see no use of the earlier marks in relation to *financial consulting services* either.

30. Metropole's services are covered by the broad terms *monetary affairs* and *financial management*, but there are many other subcategories of financial services which are also covered by these terms and for which no use of the earlier marks has been shown. Consequently, these are not fair descriptions of Metropole's services.

31. I therefore find that a fair specification for the earlier marks for the purposes of these proceedings would be:

Class 35: Reproduction and distribution of newsletters relating to financial, banking and insurance matters.

Class 36: Portfolio management; asset management; financial analysis; mutual funds; fund investment.

32. I should add that neither counsel contended that much turned on the difference between the specifications for which they contended that the earlier marks were entitled to protection. I have taken this into account in deciding how closely to analyse their rival contentions on this matter.

Trade mark registration 3144933

33. Section 47(2) of the Act states:

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

34. Consequently, registration 3144933 will be invalid if it was registered contrary to sections 5(2)(b), 5(3) or 5(4)(a) of the Act. Similarly, applications 3160919, 3161765 and 3161841 must be refused if the registration of the marks applied for would fall foul of any of those provisions.

The section 5(2)(b) case

35. Section 5(2)(b) of the Act is as follows:

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

(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”.

Identity/similarity of goods/services

36. The respective goods/services are shown below.

M & G's goods/services	Metropole's services
Class 9: Software in the nature of a mobile application; computer programs; <u>computer software for use in accessing, tracking, managing, analysing, downloading and dashboard reporting of financial information and investments</u> ; computer software for delivering updates and notifications; <u>software platform to enable users to make financial transactions.</u>	

<p>Class 36: Financial services; financial management; asset and fund management; investment services; capital investment; financial advisory and consultancy services; financial analysis and research services, financial forecasting; financing and funding services.</p> <p>Class 42: <u>Providing a platform for initiating and handling financial investments; providing temporary on-line use of downloadable computer software for accessing, tracking, managing, analysing, downloading and dashboard reporting of financial information and investments; providing a website featuring non-downloadable software for use in database management, compiling and tracking information and data; providing a website featuring non-downloadable software for presenting a user dashboard of custom information;</u> technical support services; maintenance and updating of computer software; maintenance of databases.</p>	<p>Class 35: Reproduction and distribution of newsletters relating to financial, banking and insurance matters.</p> <p>Class 36: Portfolio management; asset management; financial analysis; mutual funds; fund investment.</p>
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36. Counsel for M & G accepted that the services shown in bold encompassed Metropole's services and must therefore be regarded as identical services.

37. Counsel for M & G also accepted that the services underlined in classes 9 and 42 were similar to Metropole's services. When pressed he had to accept that, as a matter of logic, the other descriptions of goods in class 9 must also be similar to Metropole's services because they are broad enough to include the specific software applications that M & G accepts are similar goods.

38. M & G does not accept that *financing and funding services* in class 36 are similar to Metropole's services. It points out that these are different in purpose to investment type services. One involves taking funds in, the other providing funds out. Counsel for M & G also took the point, with some justification, that Metropole has not explained why it claims these services are similar.

39. The relevant case law is now well known and is set out in the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*.¹⁰ Applying this case law I find that there is a degree of similarity between the services at issue. This is because they are similar in nature, both being financial services, and the purpose of both is similar in that they involve the use of financial funds to make a profit for the ultimate investor and the institution using the funds. However, the similarities are at a fairly high level so the level of similarity is moderate.

40. This leaves *technical support services; maintenance and updating of computer software; maintenance of databases* in class 42. Counsel for Metropole submitted that these are similar services because they go hand in hand with some of the class 9 goods and class 42 services which M & G concedes are similar. However, he fairly accepted that these services are “*further away*” from Metropole’s services than M & G’s other goods/services. Metropole’s argument is essentially that these services are complementary to its own services. However, as counsel for M & G pointed out, the case law indicates that goods/services are only complementary for the purposes of trade mark law if:

“...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.”¹¹ (emphasis added)

41. No one would expect a financial services company to be responsible for providing *technical support services; maintenance and updating of computer software; maintenance of databases* to other parties. Therefore these services are not similar. This means that the s.5(2)(b) ground is bound to fail so far as these services are concerned.

Global assessment

¹⁰ Case C-39/97 at paragraph 23 of the judgment.

¹¹ *Boston Scientific Ltd v OHIM*, Case T-325/06

42. 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.

The principles

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Average consumer and the selection process

43. 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*.

44. Counsel for M & G initially submitted that the average consumer would pay a medium to high level of attention when selecting the goods/services covered by its marks. He later revised this to a 'high' level of attention. This was because

consumers are liable to pay particular attention when selecting financial service providers and related goods/services.

45. Counsel for Metropole submitted that relevant consumers would pay only a normal or medium level of attention. He argued that consumers would pay less attention than, for example, when selecting a pharmaceutical product.

46. I find that average consumers are likely to pay an above average level of attention when selecting the goods/services at issue. This is because financial decisions are particularly important to most consumers and selecting an appropriate provider of goods/services therefore justifies a higher level of attention than normal. In the case of the sort of asset management services provided by the parties to these proceedings, I would expect consumers to pay a high level of attention because of the likely size of the investment and the risks involved. In the case of intermediaries, such as financial consultants, this includes the reputational risk of promoting the wrong fund for their clients.

47. Judging from Metropole's evidence, most consumers are likely to see the trade marks in listings, newsletters, reports and fact sheets. However, word of mouth recommendations may also play some part in the selection process so aural confusion cannot be ruled out.

Distinctive character of the earlier marks

48. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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)."

49. Metropole's position is that the earlier marks are inherently distinctive and have become more distinctive through use.

50. M & G's position is that the earlier marks are of an average level of distinctiveness in the form that they are registered, but that an owl *per se* is below average in distinctiveness because it alludes to wisdom and knowledge, which are important attributes for financial services providers. In this connection, it draws attention to Mr Dowling's evidence that other financial service providers use owls as logos or parts of logos. At least four of these examples survived Metropole's criticisms that they were not used in the UK, or did not clearly relate to financial services.¹² Counsel for Metropole sought to deny the significance of these uses on the basis that the parties concerned were not direct competitors of Metropole. That appears to be so. The only real significance of this evidence is that it supports M & G's case that owls *per se* are not highly distinctive in the financial services sector.

51. I accept that owls are associated with wisdom and knowledge and that these are important attributes for a financial services provider. However, this is only an allusive reference to the quality of the services. An owl device is not descriptive in the sense

¹² Wizzcash, pages 108-110 of the evidence, Erudio Student Loans, pages 113-114, Ark Life, pages 117-124, Owl Guardian Services, page 130.

that it may serve in trade as a designation of characteristics of the services. I therefore see no reason to find that the earlier marks have anything other than a normal level of inherent distinctiveness.

52. Metropole's case is that the earlier marks have become highly distinctive through use. Counsel for M & G submitted that the evidence was insufficient to show that the earlier marks had acquired an enhanced level of distinctiveness through use. He pointed out that most of the use of the earlier marks shown in the evidence was in conjunction with the name Metropole Gestion. He suggested that in these circumstances it would be natural to infer that more relevant consumers would remember and identify Metropole by its name rather than by the device used with the name.

53. Counsel for M & G submitted that there is no rule of law that a mark cannot acquire distinctiveness through use as a result of its use with another mark. Further, he pointed out that not all the use of the earlier marks was as part of a composite word and device mark.

54. It is true that there is nothing which, as a matter of law, precludes a trade mark acquiring distinctiveness, or enhanced distinctiveness, as a result of its use with, or as part of, another trade mark.¹³ However, it is also true that more consumers are likely to remember and identify Metropole by its primary word mark than by supporting marks, such as the earlier marks in these proceedings. After all it is the word mark that is likely to feature in financial listings and in oral discussions about the services provided by Metropole.

55. Although the amount that Metropole manages through investment funds appears at first sight to be large, there is no evidence as to its share of the EU asset management market, the value of which I would expect to be huge. That is borne out by the evidence of M & G's asset management business, which appears to be much larger than that of Metropole. Therefore, despite the apparently large sums of money that Metropole manages, it appears to be a relatively small player in the asset

¹³ See *Société des Produits Nestlé SA v Mars UK Ltd*, CJEU, Case C-353/03

management market. Further, the majority of Metropole's business appears to come from investors in France. The ultimate question I am addressing is whether there is a likelihood of confusion amongst relevant average consumers in the UK. In these circumstances, it is difficult to see how an enhanced level of distinctiveness of the earlier mark in France (or elsewhere in the EU) could increase the likelihood of confusion amongst UK consumers of the services at issue.¹⁴

56. Although it claims to distribute financial publications bearing the earlier marks to its clients, it is not clear from the evidence how many actual clients Metropole actually has in the UK (as opposed to the % of investment income coming from the UK). Further, there is very little evidence of active promotion of the mark in the UK or of exposure of the earlier marks in third party UK publications. In these circumstances, I do not consider that Metropole has established that the earlier marks had acquired enhanced distinctiveness amongst the relevant UK public by the relevant dates.

57. If I am wrong about that, then any such enhancement would be limited to those UK consumers and businesses operating in the asset management/mutual funds investment market, particularly amongst institutional investors and those that advise them or act on their behalf, i.e. the market which Mr Wojcik claims is targeted by Metropole's marketing efforts.

Comparison of marks

58. 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 *Bimbo SA v OHIM*¹⁵ that:

¹⁴ See the decision of Mr Ian Purvis QC as the Appointed Person in *China Construction Bank Corporation v Groupement Des Cartes Bancaires* BI O/281/14

¹⁵ Case C-591/12P

“.....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.”

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.

59. The respective trade marks are shown below:

	
Earlier trade mark EU 5223847	Contested trade mark

60. As the earlier trade mark is registered in black and white and is therefore unrestricted to particular colours, it was common ground at the hearing that nothing turns on the fact that the contested mark is presented in a particular colour, in this case green.

61. Metropole’s counsel made the following points at the hearing:

- (1) Both marks include a frontal view of an owl.

- (2) The eye area of the earlier mark is highlighted by big dark circles which creates a similar impression to the large circular eyes of the owl in the contested mark.
- (3) The irises of the owls have a tiny white spot in them.
- (4) The forehead of both owls are presented as reverse triangles with the apex between the eyes.
- (5) Both foreheads are rounded on top with ear-like feather tufts.
- (6) In neither mark is the head of the owl clearly divided from the torso.
- (7) The earlier mark has some pointed feather elements with the peak pointing downwards. The feathers of the owl in the contested mark are also shown in the form of little points again pointing downwards.
- (8) Although the earlier mark shows only three quarters of the owl, and there is no clear similarity between the bottom of the marks, there is a resemblance arising from the presence of two separated elements at the bottom (the downward facing leaves in the case of the earlier mark and the 'feet' of the owl in the case of the contested mark).

62. Counsel for Metropole submitted that the marks are therefore visually similar to a medium to high degree.

63. Counsel for M & G submitted that:

- (1) Although both marks depict owls the earlier mark is a life-like silhouette of an owl, whereas the contested mark is a cartoon-style representation with oversized eyes and therefore a friendly, even baby-like demeanour.
- (2) The earlier mark includes a branch of a tree and a full moon as a background, neither of which has any counterpart in the contested mark.

There is therefore only a low degree of visual similarity between the marks.

64. I accept the submissions made on behalf of M & G. The difficulty with Metropole's approach is that it does not pay sufficient regard to the average consumer's tendency to form overall impressions of trade marks based on their dominant and distinctive components. Rather it assumes that consumers will

analyse the various details of the marks. Looked at the correct way, I find that points (3),(4),(5),(6) and (7) in Metropole's submissions would (whether alone or together) make little or no impression on average consumers. I doubt that average consumers would register point (8) at all, even if they engaged in a detailed analysis and comparison of the marks.

65. I find that point (2) is simply wrong. The circles around the eyes of the owl in the earlier mark will not, in my view, create a similar impression to the over sized eyes of the owl in the contested mark. The size of the eyes of the owl in the contested marks is in fact part of the characterisation of those marks which helps to distinguish them from the earlier marks: the former marks are cartoon-like owls, whereas the latter marks are comprised of a silhouette of a life-like owl sitting on a branch. I find that these are the overall visual impressions that the parties' marks will make on average consumers.

66. I therefore agree with M & G that there is only (at best) a low degree of visual similarity between the marks.

67. Counsel for Metropole accepted that as the marks contain no words they cannot be pronounced. At the very most, the visual and conceptual content can be described orally.¹⁶ According to Mr Campbell, both descriptions of marks in this case would be 'owl'. However, he fairly accepted that it was more appropriate to assess the significance of this under the heading of conceptual similarity rather than as a matter of aural similarity.

68. Counsel for M & G submitted that as neither mark had any word elements, an aural comparison was not possible.

69. There did no appear to be much between the parties on this point. I agree that a conventional aural comparison is not appropriate where purely figurative marks are being compared. Further, in a comparison between two purely visual marks, not

¹⁶ See the judgment of the General Court in case T-424/10, *Dosenbach-Ochsner Schuhe und Sport v Sisma*.

much importance should be attached to the fact that, if required to give the marks a name, consumers could call both parties' marks 'owl'.

70. Counsel for Metropole submitted that the marks were conceptually identical, i.e. owls. Counsel for M & G accepted that there was a degree of conceptual similarity, but he argued that the proper comparison was 'life-like owl' v 'cartoon owl'.

71. The central concept of all the marks is an owl. There is therefore a high degree of conceptual similarity. However, for the reasons given by counsel for M & G, the marks are not identical, even from a conceptual perspective.

72. Overall I find that there is a moderate degree of overall similarity between the marks.

Likelihood of confusion

73. The contested marks are applied for, or registered, for services which are identical to those for which the earlier marks are entitled to protection. I remind myself that a lesser degree of similarity between the marks may be offset by the identity of, or a high degree of similarity between, the respective goods/services.

74. The main similarity between the marks at issue is that they both contain owls. In *Sabel v Puma* the CJEU stated that:

“24..... the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.”

25. However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the

two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.”

75. I have rejected Metropole’s case that the earlier marks were highly distinctive (at least in the UK) through use prior to the relevant dates in these proceedings. The earlier marks do not therefore appear to be fall within the category of marks described in paragraph 24 of the judgment in *Sabel*. Rather they appear to fall within the generality of cases described in paragraph 25 of the judgment.¹⁷ This is because the element in common between the marks – a front facing owl *per se* – is hardly a sign with a high level of imaginative content. Thus the mere fact that the marks have analogous semantic content and are therefore highly similar from a conceptual perspective is not sufficient, by itself, to create a likelihood of confusion.

76. I accept that the fact that both owls are front facing adds a certain degree of visual similarity to the “*analogous semantic content*”, but this will make much less of an impression on average consumers than the very different forms in which the respective owls are presented. In my view, the cartoon-like owl in the contested marks makes a strikingly different visual impression to the life-like silhouette of the owl shown in the earlier marks.

77. Particularly in the case of average consumers paying an above average level of attention when selecting financial services, this difference is sufficient to exclude the likelihood of direct confusion, even after making some allowance for imperfect recollection.

78. As I explained earlier, counsel for Metropole did not advance a distinct case based on the risk of aural confusion. In my view, he was right not to do so. The mere fact that both marks could be described as owls is not sufficient to create a likelihood of confusion. In *Chemise Lacoste*,¹⁸ Mr Geoffrey Hobbs Q.C. as the Appointed Person found that i) a concept is not a sign capable of being a trade mark, ii) that the rights conferred by registration are centred on the graphic representation of the registered mark, iii) the concept of a mark cannot be protected without regard to the

¹⁷ Which is repeated in the CJEU’s formal answer to the question posed by the referring court

¹⁸ BL O/333/10

specific form in which it is registered. Accordingly, he held that there was no likelihood of confusion between the word ALLIGATOR and the well known device of the Lacoste crocodile. In reaching this finding, Mr Hobbs accepted that the position might be different if the word(s) had the capacity to spontaneously trigger a recollection of a very specific image corresponding to an earlier pictorial mark, such as MONA LISA, EIFFEL TOWER or STARS AND STRIPES. These findings appear entirely consistent with the guidance of the CJEU in the *Sabel* case cited above. The latter makes it clear that they apply with at least as much force where both the marks at issue are purely figurative marks. I therefore find that there is no likelihood of direct aural confusion either.

79. Counsel for Metropole advanced (for the first time at the hearing) an alternative case based on the likelihood of indirect confusion. The argument goes that consumers who are aware of the differences between the parties' trade marks will nevertheless be caused to believe that the common use of owl-based marks signifies that the users of the marks are the same, or are economically related undertakings.

80. However, I agree with counsel for M & G that the complete absence of any 'family' resemblance between the marks is sufficient to exclude this risk. Put simply, the contested marks look so different that it is not plausible that they would be seen as developments or variations of the earlier marks. It is far more likely that consumers will, if they think about it at all, assume (correctly) that different undertakings have adopted owl-based marks because owls convey the idea of wisdom and knowledge, and are therefore a logical and attractive choice of trade mark for traders in the financial services sector.

81. I should make it clear that I would have come to the same conclusions even if I had found that the earlier marks had acquired an enhanced distinctive character through use. This is because the very most that could be made of Metropole's evidence is that the earlier marks have acquired an enhanced level of distinctiveness in the field of asset management/mutual funds. If this is right, there could be a higher risk of confusion in relation to those services. On the other hand, this is the specific area of the financial services market where I held that average consumers would pay

the highest level of attention when selecting a service provider. This is likely to reduce the risk of confusion, particularly when it stems from very little more than the “*analogous semantic content*” of visually quite different looking figurative marks. These points balance themselves out. Therefore, confusion is no more likely in this sub-sector of the financial services market.

82. Having rejected Metropole’s case in relation to identical services, it follows that I also reject it where the respective goods/services are only similar. For the reasons stated above, I find that there is no likelihood of confusion. The grounds of opposition and invalidation based on s.5(2)(b) of the Act therefore fail.

The passing off right case

83. Counsel for Metropole could not say that the grounds based on s.5(4)(a) took its case any further than those based on s.5(2). Therefore, whilst I do not doubt that Metropole has sufficient business and goodwill in the UK to warrant protection under the law of passing off, it cannot show that use of the contested marks would amount to a misrepresentation to the public. This means the grounds of opposition and invalidation based on s.5(4)(a) of the Act also fail.

The section 5(3) grounds

84. Section 5(3) states:

“(3) A trade mark which-
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark 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.”

85. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009]

ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

Reputation

86. Counsel for M & G conceded that the earlier marks had the sufficient reputation in the EU to satisfy the requirement for a 'reputation' as explained in *General Motors*. He did so on the basis that he understood the threshold for a qualifying reputation to be a rather low one.

87. I therefore find that the earlier marks have a qualifying reputation in the EU for

Portfolio management; asset management; financial analysis; mutual funds; fund investment.

88. Metropole's newsletter, which bears the earlier marks, is part and parcel of its reputation for the above services. I find that it has no separate reputation for newsletters relating to financial information, banking and insurance matters.

89. M & G's primary position is that (a) the parties' marks are sufficiently different that the relevant public will not make a link between them, and (b) Metropole's had not, at least prior to the hearing, properly explained what was the basis for its claims that use of the contested marks would take unfair advantage or, or be detrimental to, the reputation or distinctive character of the earlier marks.

90. M & G does not claim or, according to it, need, 'due cause' to use the contested marks.

91. Counsel for Metropole submitted that the relevant public would, at least, make a link between the parties' marks and this would lead to the contested marks taking unfair advantage of the earlier marks and/or dilution of the distinctive character of the earlier marks.

Link

92. The reputation of the earlier marks is only liable to cause the relevant public in the UK to make a link between the parties' marks to the extent that the reputation is known in the UK.¹⁹

93. As I noted earlier when assessing the distinctiveness of the earlier marks in the UK, the evidence of the earlier marks having a reputation in the UK is rather thin. I find that, if the earlier marks have a qualifying reputation for the purposes of s.5(3), it is only likely to a small reputation in the UK.

¹⁹ *Iron & Smith kft v Unilever NV*, CJEU, Case C-125/14

94. I now turn to the other factors which the CJEU identified in *Intel* as being relevant to the question of whether the public will make a link between the respective marks.

- (i) The degree of distinctive character of the earlier marks is average or 'normal': they are not the sort of marks that would immediately prompt consumers to make a connection with another mark used in relation to the same services just because it has "*analoguous semantic content*".
- (ii) The degree of overall similarity between the marks is moderate, even taking account of their "*analoguous semantic content*": the degree of visual similarity is low.
- (iii) Some of the services are identical and most of the other goods/services covered by the contested marks are similar to the services for which the earlier marks have a reputation in the EU.
- (iv) There is a direct overlap between the users of the respective goods/services.
- (v) The end users of the services for which the earlier mark have a reputation (which will also be the users of the identical services covered by the contested marks) are likely to be financial investors considering investing significant sums. Most of these will be institutional investors. The direct users of the services are likely to be those advising and/or investing on behalf of the end users.
- (vi) Although it is not decisive, I have already found that there is no likelihood of confusion between the marks, even when used in relation to identical services.

97. Taking account of all of these factors I find that the relevant UK public will not make any link between the parties' marks. This is because of the relatively low degree of reputation in the UK of the earlier marks and the only moderate degree of similarity between those marks and the contested marks.

98. If I am right, the case based on s.5(3) of the Act must fail. This is because in the absence of the public making a link between the marks, there is no possibility of the contested marks taking unfair advantage of, or being detrimental to, the reputation or distinctive character of the earlier marks.

99. However, even if I am wrong about the public making a mental link being made between the parties' marks, then I would still have rejected Metropole's case because it has not established a seriously arguable case of unfair advantage or detriment to the reputation/distinctive character of the earlier marks.

100. In this connection, I note that Metropole's pleaded case raised two complaints under this heading. Firstly, that M & G's marks would take unfair advantage of the reputation of the earlier marks.²⁰ Secondly, that use of the contested marks would be detrimental to the reputation of the earlier marks because Metropole would lose control of its reputation.²¹ The latter concern appears to be linked to Metropole's claim that the public will assume that the parties are economically connected.²²

101. At the hearing, counsel for Metropole appeared to place little weight on the second complaint. He was right not to do so. As Ms Anna Carboni as the Appointed Person held in *Unite The Union v The Unite Group Plc*,²³ the theoretical risk of damage to the reputation of an earlier mark arising from the future use of a so far unused mark, is hypothetical and therefore not of the kind that can justify an objection under s.5(3). This must be all the more so where, as here, it appears to be founded on the likelihood of indirect confusion, which is a risk I have already rejected.

102. The argument Metropole raised at the hearing based on blurring or dilution of the distinctive character of the earlier marks does not appear to be covered by its pleadings. In any event, it amounts to no more than saying that there is currently only one owl mark in the sector of the financial services market in which Metropole operates and that will no longer be true if the contested marks are also used in that sector. However, the CJEU made it clear in *Environmental Manufacturing LLP v OHIM*,²⁴ that this kind of objection cannot succeed without evidence of a likely change in the economic behaviour of consumers. The court stated that:

²⁰ Answer to question 4 on the Forms TM7/261

²¹ Answer to question 5 on the Forms TM7/261

²² Answer to question 3 on the Forms TM7/261

²³ Case BL O/219/13

²⁴ Case C-383/12P

“39. The General Court found, at paragraph 62 of the judgment under appeal, that ‘the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark’s ability to identify the goods for which it is registered as coming from the proprietor of that mark’.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”

103. Metropole has not put forward any reasons for supposing that its customers or potential customers will change their economic behaviour as a result of the use of the contested marks beyond a bare assertion that the appearance of other, albeit different, owl marks in the relevant sector will divert custom to M & G. In the absence of a likelihood of confusion, I see no logical basis for that assertion. Therefore, even if it is open to me to consider this ground, I would reject it.

104. This brings me to the unfair advantage claim. In *Aktieselskabet af 21. november 2001 v OHIM*,²⁵ the CJEU stated that:

“22. With regard to the appellant’s argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded *prima facie* that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 Intel Corporation [2008] ECR I-0000, paragraph 38).”

105. Metropole’s case on unfair advantage has also been left at a rather general level. When I asked him at the hearing whether Metropole claimed that use of the contested marks would take unfair advantage of any particular aspect or characteristic of the reputation of the earlier marks, counsel for Metropole reply was that it was the whole reputation that would transfer to the contested marks.

106. However, given the modest extent of the reputation of the earlier marks, the absence of a likelihood of confusion, and the nature of the market in question, which appears to me to be much less susceptible to economic decisions being based on ‘image’ than is the case in some other markets, I find Metropole’s case unconvincing. In my view, it is highly theoretical and I reject it.

107. This means that I also reject the grounds of opposition and invalidation based on s.5(3) of the Act.

²⁵ Case C-197/07P

Outcome

108. Metropole's oppositions and its application for invalidation fails. Trade marks 3160919, 3161765 and 3161841 will therefore be registered. Trade mark 3144933 is valid and will remain registered.

Costs

109. M & G has been wholly successful and is therefore entitled to a contribution towards its costs. I calculate this as follows:

£700 for considering the notices of opposition and the application for invalidation and filing four counterstatements.

£1500 for filing evidence and considering Metropole's evidence.

£1000 for attending a hearing and filing a skeleton argument.

110. I therefore order Metropole Gestion SA to pay M & G Limited the sum of £3200. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 3rd day of October 2017

**Allan James
For the Registrar**