

**O-472-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3208526  
BY ANGEL RODRIGUEZ ISSA  
TO REGISTER THE TRADE MARK**

**Panthera Capital**

**IN CLASS 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 409464 BY PANTHERA PRIVATE OFFICE LLP**

## BACKGROUND

1. On 24 January 2017 Angel Rodriguez Issa applied to register the trade mark shown on the cover page of this decision. The specification has been subject to amendment after filing and now reads as follows:

**Class 35:** *Business management and consultancy advice; management consultancy services; business administration; market research and analysis; business support services; promotional services; transacting mergers and acquisitions for institutions and corporations except for funds and for individuals; financial statement preparation and analysis for institutions and corporations only; information, advisory and consultancy services relating to all the aforesaid services.*

2. The application was accepted and published for opposition purposes on 07 April 2017.

3. The application is opposed in full by Panthera Private Office LLP (“the opponent”) under Section 5(2)(b) of Trade Marks Act 1994 (“the Act”), for the purpose of which it relies upon UK registration no. 3154232 for the mark PANTHERA which has a filing date of 10 March 2016 and a registration date of 24 June 2016. The opponent relies upon all the services for which the mark is registered, namely:

**Class 36:** *Financial affairs; monetary affairs; fund management; personal finance and asset management; financial services; capital investment services; investment services; property investment and management; financial sponsorship of sporting events, sports teams/organisations and sportsmen/sportswomen, including motor racing teams and racing drivers; fund raising activities; charitable collections; advisory, information and consultancy services relating to the aforesaid.*

4. The significance of the dates mentioned above is that (1) the opponent's mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed less than five years before the publication of the applied for mark.

5. The opponent claims that (a) the "Capital" element of the contested mark is descriptive of the [financial<sup>1</sup> and] business services being opposed and that the distinctive element of the contested mark, namely "Panthera" is identical to the earlier mark, (b) that the respective services are [identical or] highly similar and (c) that there is a likelihood of confusion. Mr Issa filed a counterstatement in which he denies the grounds of opposition.

6. Only Mr Issa filed evidence. This will be summarised to the extent that it is considered necessary. Both sides filed written submissions. Neither party requested a hearing, but the opponent filed submissions in lieu of attendance at a hearing. Mr Issa represented himself; the opponent is professionally represented by Forresters. This decision is taken following a careful reading of all of the papers.

## **Evidence**

7. The applicant's evidence comes from Mr Issa. His statement contains a mixture of evidence and written submissions. I will discuss this evidence later in this decision.

## **DECISION**

8. Section 5(2)(b) of the Act reads:

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

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<sup>1</sup> Mr Issa initially applied for, inter alia, a range of financial services in class 36, however, following the filing of the opposition he filed a Form TM21 requesting the deletion of Class 36 from the application.

(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.”

### **Section 5(2)(b) - case-law**

9. 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 greater 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.

## Comparison of services

10. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

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

11. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

13. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

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

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

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...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”.

16. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

17. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

18. The earlier services are:

**Class 36:** *Financial affairs; monetary affairs; fund management; personal finance and asset management; financial services; capital investment services; investment services; property investment and management; financial sponsorship of sporting events, sports teams/organisations and sportsmen/sportswomen, including motor racing teams and racing drivers; fund raising activities; charitable collections; advisory, information and consultancy services relating to the aforesaid.*

19. The applied for services are:

**Class 35:** *Business management and consultancy advice; management consultancy services; business administration; market research and analysis; business support services; promotional services; transacting mergers and acquisitions for institutions and corporations except for funds and for individuals; financial statement preparation and analysis for institutions and corporations only; information, advisory and consultancy services relating to all the aforesaid services.*

20. Mr Issa provided evidence directed at supporting his claim that there is “no overlap of the marks in the markets” because the opponent’s services target individuals and families whereas the applied for services target businesses (exhibit 5). The opponent’s earlier mark is not subject to proof of use, which means that it must be considered across the notional breadth of the services relied upon<sup>2</sup>. Therefore, the extent to which the opponent has used the earlier mark is irrelevant when it comes to assessing the similarity between the respective services based on just the registration of the earlier mark.

21. The opponent claims that the respective services are complementary and that whilst some of the applied for services “do not explicitly have a financial association, business and finance always go “hand in hand”. It also states:

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<sup>2</sup> *Roger Maier v ASOS* [2015] EWCA Civ 220 at paragraphs 78 and 84

“The services "transacting mergers and acquisitions for institutions and corporations except for funds and for individuals; financial statement preparation and analysis for institutions and corporations only; information, advisory and consultancy services relating to all the aforesaid services" are undoubtedly closely related to financial services (they even feature the word 'financial'), and thus must be considered highly similar to the Opponent's services.

The other services In the Application are broad and constitute general business services which are relevant to all businesses. These services are commonly offered alongside financial and monetary affairs, by (for example) firms of business advisors, accountants or consultants. For this reason, they too are highly similar to the Opponent's services.

We refer to the Applicant's own words, in their counter-statement of 11 August 2017, where they state *"Furthermore, the Applicant's services in class 35 have no relevant commonalities with the Opponent's services; my application is strictly and essentially referred to business management and advisory services for corporations and institutions, which amongst other [sic], might include financial institutions, venture capital and private equity that in turn invest in other businesses"* (emphasis added).

The clear applicability/relevance of the Applicant's class 35 services to financial institutions is further supported by the inclusion of the word CAPITAL (with its clear financial/monetary connotations) in the applied-for mark.”

22. In *IG Communications v OHMI - Citigroup and Citibank (CITIGATE)*, Case T-301/09, the GC upheld the Board of Appeal's decision that there was “a low degree of similarity between the [applicant's] *market research, market analysis and strategic marketing services; preparation of business reports; public agency services; management consultancy services; [and] “consultancy services relating to business operations”* in class 35 and the opponent's *“insurance, financial affairs, monetary affairs, real estate affairs services* in Class 36.” The Court stated:

“48. The Board of Appeal made a distinction, within Class 35, between ‘advertising services; marketing services; public relations services; preparation of publicity material; promotional services; [and] consultancy services relating to brand development’, which are not similar to the services in Class 36 (paragraph 29 of the contested decision), and the other services in Class 35 covered by the mark applied for.

49. As regards those other services, the Board of Appeal pointed out, at paragraphs 26 to 28 of the contested decision, that “‘market research, market analysis and strategic marketing services” could be concerned with the financial markets’. Furthermore, it stated that “‘management consultancy services” and “‘consultancy services relating to business operations” are vague expressions that denote a general link to the world of business and commerce’ (paragraph 26 of the contested decision). ‘[Public agency] services could be provided in the area of banking and finance [and] are therefore similar to the services for which the [interveners’] mark CITIBANK has a reputation’ (paragraph 27 of the contested decision). Lastly, “[p]reparation of business reports” is a service that presents obvious links to the world of finance’ (paragraph 28 of the contested decision).

[...]

54. Thus, as regards the services in Class 35 identified in paragraph 49 above, it should be noted that, by their nature and intended purpose, they are different from the services in Class 36. First, those services are directed at professionals in a business context, whereas the services in Class 36 may be aimed equally at both professional circles and final consumers. Second, according to the explanatory notes to the list of classes of goods and services of the Nice Agreement, the services in Class 35 relate inter alia to help in the working or management of a commercial undertaking or help in the management of the business affairs or commercial functions of an industrial or commercial enterprise, whereas the services in Class 36 relate to services rendered in financial and monetary affairs, which include, in particular, the services of all banking establishments, or institutions connected with them.

55. The fact nevertheless remains that the services in Class 35 identified in paragraph 49 above are necessarily connected with the banking and financial sector.

56. Accordingly, as regards, first, 'market research, market analysis and strategic marketing services', 'management consultancy services' and 'consultancy services relating to business operations', such services will necessarily have financial implications for undertakings which intend, for example, to enter a new market and, in order to do so, would like to be apprised of the investments they will be required to make and the benefits which may be accrued. To that extent, there is a certain connection, or even a degree of complementarity, between those services and, in particular, 'investment information and management services' in Class 36.

[...]

58. As regards, third, 'preparation of business reports' services, it should be noted that, as is the case with 'market research, market analysis and strategic marketing services', a section of a business report will necessarily be devoted to the financial implications which the business activity contemplated may have.

59. Thus, while the services referred to above covered by the mark applied for are different, on account of their nature and intended use, from the services in Class 36 covered by the earlier marks, there is nevertheless a connection between them. The services in Class 35 identified at paragraph 49 above are mainly directed, having regard to their nature, at professional circles, in particular undertakings which, after having recourse to the services in Class 35, may need the services in Class 36. For example, if the market analysis is positive, the undertaking may wish to put its plan into practice, and, to that end, will need to have recourse to investment services. That connection is sufficiently close that it cannot be ruled out that consumers may think that the services are provided by one and the same undertaking. There is therefore a low degree of similarity between those services."

23. The Court appears to have accepted that there was, to some degree, a complementary relationship between the some of the applied for services in class 35 and the opponent's financial services in class 36 because they might be used in connection with the same business venture and consumers might believe that they were offered by the same (or economically connected) undertaking.

24. The evidence before me does not cause me to reach a different conclusion. I therefore find that there is a certain (low) degree of similarity between the applied for *business management and consultancy advice; management consultancy services* and *market research and analysis* and the opponent's financial and investment services. I extend the same findings to 1) *business support services*, which is a very wide term and could well encompass business management support; 2) *financial statement preparation and analysis for institutions and corporations only* which, similarly to what the GC found in relation to "preparation of business reports", is a service that presents obvious links with the world of finance and 3) *business administration*, which relates to all administrative aspects of a business and is broad enough to include services relating to accounting and financial administration.

25. The contested *transacting mergers and acquisitions for institutions and corporations except for funds and for individuals*, would cover the execution of commercial transactions relating to mergers and acquisitions of companies. Indeed, financial considerations are likely to be integrated in the structure of the deal and buyers are likely to have recourse to banking services to finance the deal. Here the similarity between the respective services seem to be more pronounced, however, for the purpose of this decision, I find that the services are similar to, at least, a low degree.

26. The contested *promotional services* are concerned with advertising and are provided by advertising companies. The opponent has not raised any specific argument in relation to these services. Having applied the case law mentioned above and having reminded myself of the comments in *Avnet*, I cannot (without further explanation) see any meaningful relationship with the opponent's services. Although the opponent's services, like any other commercial activity, may be advertised, that does not make them similar services. In the absence of an explanation from the

opponent as to why *promotional services* should be considered similar to any of the services covered by the registration, I am not prepared to conclude that they are<sup>3</sup>. The users, uses, nature, purpose, methods of use are different, the trade channels do not coincide and the services are neither complementary nor competitive. Therefore, I conclude that these services are not similar to any of the opponent's services.

27. To the extent that the contested *information, advisory and consultancy services relating to all the aforesaid services* relate to services which I found to be similar to the opponent's services, they are also similar to the opponent's services to the same degree.

### **The average consumer and the nature of the purchasing act**

28. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue; I must then determine the manner in which these services will be selected in the course of trade. 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.”

29. The matter is to be approached on a notional basis, not on the basis of the parties' current customer base. The services at issue in these proceedings are, broadly speaking, a range of business-related services in class 35 and financial services in class 36. Whilst the average consumer of the services in class 35 is more likely to be

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<sup>3</sup> *Commercy AG, v OHIM*, Case T-316/07 , paragraph 43

a business user, the average consumer of the services in classes 36 will be both business users and members of the general public. The services are most likely to be selected by the eye having inspected marketing material, reviews etc. either in paper form or on-line, although I do not ignore aural considerations in form, for example, of aural recommendations. As to the degree of care that is likely to be taken when selecting the services at issue, I would expect, given the potential importance as well as the not insignificant sums that are likely to be in play, an above average degree of attention to be paid.

### **Distinctive character of earlier mark**

30. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>26</sup>, 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).”

31. Mr Issa's evidence includes copies of notices of change of name concerning the opponent (exhibit 6); in this respect Mr Issa's argument is that the earlier mark "is not particularly distinctive by virtue of intensive use or reputation as evidenced by the various brands that the opponent has been using since its incorporation [...]". The argument must be rejected. A mark might be inherently distinctive even if it has not been used; likewise, the fact that the opponent has traded under different names has nothing to do with distinctiveness of the earlier mark from an inherent perspective.

32. The opponent has not claimed that the earlier mark has an enhanced distinctive character through use and has filed no evidence in this regard. I therefore have only the inherent position to consider. The earlier mark consists of the word PANTHERA, which will be understood as referring to a large animal of the cat family. Although it is not an invented word, it creates a striking association in the context of the services concerned, which are, broadly speaking, financial services. In my opinion the earlier mark is inherently distinctive to a high degree.

### **Comparison of marks**

33. 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 them, 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."

34. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features, (which are not negligible) and therefore contribute to the overall impressions created by them. The marks to be compared are:

Application	Earlier mark
Panthera Capital	PANTHERA

### Overall impression

35. The earlier mark consists exclusively of the word PANTHERA. As this is the only component of the earlier mark, it is the only thing that contributes to its overall impression.

36. The applied for mark consist of the words Panthera and Capital presented in title case. As the words do not form a unit, the mark lends itself to a division between Panthera and Capital; these two elements will be perceived as distinctive and separate components of the mark. However, the Capital element of the mark carries less weight in the overall impression. In this connection, I remind myself that the application no longer includes financial services in relation to which the word Capital would be descriptive<sup>4</sup>. Nevertheless, it seems to me that, even in the context of the applied for services, which are, broadly speaking, business-related services, the word Capital carries an association with the concepts of money, wealth, assets and, ultimately, business capital, and it is less distinctive than Panthera.

37. The presence of the dominant and distinctive word Panthera at the beginning of the applied for mark which is identical to the only component of earlier mark creates a high degree of visual and aural similarity between the marks. In this connection, it is worth noting that as notional and fair use means that the opponent's word mark could

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<sup>4</sup> See, for example, the EUIPO TM class database which includes terms like capital management, capital investment, capital fund management, etc in class 36

be used in upper or lower case, the difference created by the cases as presented above is not relevant. Conceptually, the word Capital does not have the effect of creating a clear and obvious conceptual gap. To that end, the marks are considered to be conceptually similar to, also, a high degree.

### **Likelihood of confusion**

38. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective services and vice versa. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

39. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

40. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

41. Earlier in my decision, I found that the marks are visually, aurally and conceptually similar to a high degree and that the similarity between the marks stems from the presence in both marks of the dominant and distinctive component Panthera/PANTHERA. The earlier mark, whose only element is the word PANTHERA, has a high degree of inherent distinctiveness in relation to the registered services. The parties’ services are likely to be selected visually with an above average degree of attention and are similar only to a low degree. Given the low degree of similarity between the respective services, it is unlikely that the marks will be directly confused. In terms of indirect confusion, whilst in other cases, a low degree of similarity between the services involved might be sufficient to avoid indirect confusion, in this case it is not. The high degree of distinctive character of the earlier mark, which is identically reproduced in the application, combined with the aggravating factor that the application includes the word Capital, which is obviously descriptive of the financial services for which the earlier mark is registered, is likely to result in the consumer being indirectly confused in thinking that the applied for mark is another brand of the owner of the earlier mark. There is a likelihood of indirect confusion in relation to *business management and consultancy advice; management consultancy services; business administration; market research and analysis; business support services; transacting mergers and acquisitions for institutions and corporations except for funds and for individuals; financial statement preparation and analysis for institutions and corporations only; information, advisory and consultancy services relating to all the aforesaid services.*

42. As I found that the *promotional services* are not similar to the opponent's services, there is no likelihood of confusion in relation to these services<sup>5</sup>. Likewise, there is no likelihood of confusion in relation to *information, advisory and consultancy services relating to promotional services*.

## **Conclusion**

43. The opposition succeeds and the application will be refused in relation to the following services:

**Class 35:** *Business management and consultancy advice; management consultancy services; business administration; market research and analysis; business support services; transacting mergers and acquisitions for institutions and corporations except for funds and for individuals; financial statement preparation and analysis for institutions and corporations only; information, advisory and consultancy services relating to all the aforesaid services.*

44. But fails, and the application shall proceed to registration (subject to appeal) in relation to:

**Class 35:** *promotional services; information, advisory and consultancy services relating to promotional services.*

## **Costs**

45. Although both parties have achieved a measure of success, as the opponent has been substantially more successful than Mr Issa, it is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice (TPN) 2/2016. Using that TPN as a guide but bearing in mind that Mr Issa's evidence was very light, and making a "rough and ready" reduction to reflect the measure of Mr Issa's success, I award costs to the opponent on the following basis:

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<sup>5</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Official fees:	£100
Preparing a statement and considering the other side's statement:	£170
Considering the other side's evidence:	£100
Written submissions:	£170
<b>Total:</b>	<b>£540</b>

46. I order Angel Rodriguez Issa to pay Panthera Private Office LLP the sum of £540 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

**Dated this day 31st July 2018**

**Teresa Perks**  
**For the Registrar**  
**The Comptroller – General**