

O/530/17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATIONS UNDER NOS. 3170185 AND 3173946  
BY INDEPENDENT FIRST LTD.  
TO REGISTER AS TRADE MARKS:



AND



FOR SERVICES IN CLASS 36

AND

IN THE MATTER OF THE CONSOLIDATED OPPOSITIONS THERETO  
BY IF SKADEFÖRSÄKRING HOLDING AB (PUBL)  
UNDER OPPOSITION NOS. 407229 AND 407775

## BACKGROUND AND PLEADINGS

1. On 17 June 2016, Independent First Ltd (“the Applicant”) applied to register the figurative trade mark that is shown in the table below and which bears the text “iF independent first”. That application (“the First Application”) is in respect of numerous types of financial services in class 36 (detailed in the table below). The First Application was published for opposition purposes in the Trade Marks Journal on 8 July 2016.
2. The following month, on 11 July 2016, the Applicant applied for the figurative trade mark that is shown later in the table below, which bears the text “iF”. That application (“the Second Application”) is in respect of comparable but slightly more numerous types of financial services in class 36 (again details are provided in the table). The Second Application was published for opposition purposes in the Trade Marks Journal on 30 September 2016.
3. The details of the two Applications are:

<p><b>The First Application</b></p> <p>(3170185 - iF Independent First and device - opposed under Opposition No. 407229)</p> <p>Application date: 17 June 2016</p>	
<p style="text-align: center;"><b>Applicant’s services under the First Application</b></p> <p><b>Class 36:</b> <i>Financial services in the field of money lending; Financial services in the nature of an investment security; Financial services related to the sale and purchase of securities; Financial services relating to buying and trading of commodities; Financial services; Financial services provided over the telephone and by means of a global computer network or the internet; Financial services for securing funds for others; Financial services for the management of credit cards; Financial services for the purchase of real estate; Financial services for the purchase of vehicles; Financial services offered by a building</i></p>	

*society; Financial services provided by building societies; Financial services provided to businesses in the oil industry; Financial services provided to partnerships; Financial services related to dealing in shares; Financial services related to house purchase; Financial services related to real estate; Financial services related to the issuance of bank cards and debit cards; Financial services relating to airports; Financial services relating to bank cards; Financial services relating to bonds; Financial services relating to business; Financial services relating to cash disbursement; Financial services relating to credit cards; Financial services relating to insurance; Financial services relating to international securities; Financial services relating to investment; Financial services relating to letters of credit; Financial services relating to mortgages; Financial services relating to motor vehicles; Financial services relating to personal equity plans; Financial services relating to property; Financial services relating to real estate property; Financial services relating to real estate property and buildings; Financial services relating to savings; Financial services relating to securities; Financial services relating to stocks; Financial services relating to the acquisition of property; Financial services relating to the insurance of motor vehicles; Financial services relating to the issuance and sale of mortgage-backed securities; Financial services relating to the leasing of aircraft; Financial services relating to the maintenance of vehicles; Financial services relating to the motor trade; Financial services relating to the provision of loans; Financial services relating to the provision of vouchers for the purchase of goods; Financial services relating to the purchase of aircraft; Financial services relating to the sale of property; Financial services relating to the securing of funds; Financial services relating to the transportation of goods; Financial services relating to the withdrawal and depositing of cash; Financial services relating to travel.*

**The Second Application**

(3173946 - iF and device  
- opposed under Opposition No. 407775)

Application date: 11 July 2016



**Applicant's services under the Second Application**

**Class 36: ALL SERVICES AS LISTED ABOVE FOR THE FIRST APPLICATION, ALONG WITH THE ADDITIONAL SERVICES LISTED BELOW:**

*Financial services rendered by insurance companies; Financial services, namely, debt settlement; Financial services relating to the provision and structuring of capital; Financial services provided over the Internet and telephone; Financial services relating to pensions; Financial services provided by electronic means; Financial services relating to wealth management; Financial services relating to the funding of broadcasting.*

15. On 23 August 2016 If Skadeförsäkring Holding AB (publ) ("the Opponent") filed a notice of opposition against the First Application, and on 31 October 2016 filed a notice of opposition against the Second Application. Since the parties are the same in each case and since the oppositions are based on the same grounds and on the same three EU trade mark registrations, it is sensible that the matters be dealt with as one decision. Hence the oppositions were consolidated in January 2017.
16. The Opponent relies on three EU trade marks, which I refer to in this decision as **Registrations A, B and C**. Their details are set out in the following table:

<b>Registration A</b> (EUTM No. 1584911)  <u>Date of application for registration:</u> 30 March 2000 (claiming priority as of 18 October 1999 from a mark registered in Sweden)  Registered as a trade mark in the EU on 5 February 2003	<b>IF</b>
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**Registration A is in respect of the following services in class 36:**

*Insurance; insurance brokerage; capital management; captive management; financial affairs; monetary affairs; bank affairs including remote banking services which shall include telephone banking services, banking services provided online from a computer database or capable of being accessed by mobile or wireless devices or by means of web pages provided on the Internet or through interactive television; trade in securities; real estate affairs; securities brokerage concerning stocks and other securities; real estate agencies; real estate management; surety services for charitable fund raising.*

**Registration B (EUTM No. 8569221)**

Date of application for registration: 23 September 2009 (claiming seniority from 18 October 1999, based on a UK trade mark)

Registered as a trade mark in the EU on 30 March 2010

IF

**Registration B is registered for services in class 36 in the very same terms as for Registration A, along with the additional services:** *financial evaluation (insurance, banking, real estate); analysis (financial -); insurance consultancy; information services in insurance business relating to damage prevention work.*

**Registration B is also in respect services in classes 35, 42 and 45.**

*35 General agencies; retail services; retail services concerning first-aid kits, locks, padlocks, shackle locks, window locks, bicycle locks, motorcycle locks, fire alarms, fire detectors, fire-extinguishers, electric switches, life jackets, lifebuoys, bicycle helmets, electric plug cover, stove cover, electronic tracking devices, children's car safety-seats, fire hoses and fire escapes; commercial or industrial management assistance; business management; business appraisals; business inquiries; business research; marketing research and business information.*

42 *Inspection of buildings [surveying]; technical inspection services; project studies (technical -); engineering; quality control; surveying; consultation services related to computer security; laboratory services; network monitoring; technical investigations; technological services; industrial analysis.*

45 *Consultation services related to safety; fire-fighting; monitoring of burglar and security alarms; security consultancy; house sitting; rental of fire extinguishers; rental of fire alarms; legal services.*

**REGISTRATION C** (EUTM 8569551)

Date of application for registration: 23 September 2009

Registered as a trade mark in the EU on 30 March 2010



**Registration C is in respect of the same services in classes 35, 36, 42 and 45 as listed above for Registration B.**

17. Section 6(1)(a) of the Trade Marks Act 1994 (“the Act”) defines an “earlier trade mark”, as including “a *European Union trade mark ... which has a date of application for registration earlier than that of the trade mark in question ...*”. Therefore, as will be clear from the table above, Registrations A, B and C are all earlier trade marks under the Act.
18. The Opponent has indicated (by way of a ticked box in its notice of opposition) that it relies on all the services covered by its earlier marks. Since Registrations A, B and C had been registered for five years or more when the Applicant’s mark was published for opposition, those earlier marks are subject to the proof of use provisions under section 6A of the Act. The Opponent has duly provided a statement of use of Registrations A, B and C in respect of all services under those marks. However, the Applicant has not requested that the Opponent provide such proof of use, which means that the Opponent is therefore able to rely on its registrations in these oppositions without having to prove use.

19. The Opponent requests that both the First Application and the Second Application should be refused in their entirety. The oppositions are based on section 5(2)(b) of the Act and the Opponent claims that the marks applied for are similar to its earlier trade marks and that the respective services are identical or similar, such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks.
20. The Opponent filed by way of submissions, a decision of the EUIPO<sup>1</sup> where the latter found in favour of the same opponent in relation to a previous opposition against an EUTM containing the word IF in class 36. The Opponent explained the relevance of filing that decision by submitting that the EUIPO's "*rationale for a finding in the opponent's favour (that a likelihood of confusion exists) also applies to these consolidated oppositions, in terms of the assessment of the similarity of the marks and identity between the services at issue.*"
21. The Opponent also filed submissions in lieu of a hearing, in which it seeks to counter particular points made by the Applicant in these proceedings. I shall refer to the Opponent's points where appropriate in this decision.
22. The Applicant filed notices of defence and counterstatements in which it denies claims against its marks and states as follows.
23. In respect of **the First Application:**

*"We do acknowledge that both marks will contain the word IF, but ours also contains our name Independent First, thus leaving no doubt that neither company is connected, nor are we trying to gain business through any inferred association with the opponent.*

*Our mark is different in shape (theirs is a circle and ours is a square and a circle that overlap), colour (different colours - ours is Pantone 297 for the logo and Pantone 288 for our name and we have no intention to change this), text (1. theirs is all lower case (if) and ours is lower and upper case (iF) 2. theirs is in italics ours is not), design (theirs has 3 dots after the word IF ours only has the word IF)."*

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<sup>1</sup> The European Union Intellectual Property Office, whose functions include a tribunal role in relation EU trade marks contested in opposition proceedings.

24. I note that the content of the latter paragraph relates to the Opponent's Registration C. The Applicant makes a similar counterstatement in respect of **the Second Application**:

*“Our mark is different in shape and layout (Theirs is a circle and ours is a square and circle that overlap), Colour (Different colours - ours is Pantone 297 for the logo and Pantone 288 for our name and we have no intention to change this), Text (Theirs is all lower case in italics and ours is lower and upper case not in italics) and Design (Theirs has 3 dots after the word IF & is centred in their circle logo ours only has the word IF which touches the outside of our logo.*

*Our initials IF stands for our company name Independent First.”*

25. And in connection with both **the First and Second Applications**:

*“The opponent company, as far as we are aware does not trade within the UK, and we have no interest or intention to trade outwith the UK. We are FCA<sup>2</sup> regulated and do not have extended permissions to trade outwith the UK, nor do we wish to seek such permissions. We are happy to give assurances that we will not use our logo outside the UK.*

*We are a UK firm of independent financial advisers who have been trading for over a decade and merely wish to protect our own brand that we have built over the years since Aug 2001.”*

26. In addition to the above submissions the Applicant also filed evidence, which I summarise below.
27. The Applicant represents itself in these proceedings, and the Opponent is represented by Haseltine Lake LLP. Neither party requested a hearing and I take this decision based on the papers received.

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<sup>2</sup> Financial Conduct Authority (which regulates and registers financial services).

## THE APPLICANT'S EVIDENCE

28. The Applicant has submitted evidence that takes the form of a witness statement from Scott John Abraham, dated 20 April 2017, together with Exhibits A and B. Mr Abraham is the director of Independent First Ltd, based in Scotland. He has held that position since July 2001 and the facts in his witness statement are given from his personal knowledge.

29. The witness statement makes the following points:

30. that the Applicant has used the marks under the First and Second Applications in the UK (Scotland, England & Wales) since 2001 in company letter heading, business cards, emails, leaflets, brochures and general advertising;

- **Annual sales** of the goods/services before the date of application were as follows:

Dates	Amount (£'s)
Year ending August 2016	451,000
Year ending August 2015	427,000
Year ending August 2014	326,000
Year ending August 2013	358,000

31. **Annual amounts spent on promoting** the goods/services before the date of application were as follows:

Dates	Amount (£'s)
Year ending August 2016	3,500
Year ending August 2015	3,250
Year ending August 2014	3,000
Year ending August 2013	3,000

- *"I truly believe that the public in the UK can recognise these and associate them with us and us alone. We are merely seeking to protect our branding within the UK. Our FCA authorisations allow us to work only within the UK and indeed we have no intentions to extend our permissions outwith the UK. We would be happy to guarantee that our*

*branding will be limited .to the UK only. Our branding is unique to us and we do not seek any association, implied or otherwise, with any other company.”*

32. **Exhibit A** and **Exhibit B** show the marks on company correspondence bearing dates from 2001. **Exhibit A** is a single sheet entitled “Personal Fact Find” prepared for Mr and Mrs B Smith, which states that the information was current as at Monday 15 October 2001. The exhibit includes the name and contact details of the Applicant. The mark that is the subject of the Second Application is shown in the top right hand corner of the exhibit.
33. **Exhibit B** is a three-page letter dated 2<sup>nd</sup> November 2001 addressed to Brian and Catherine Smith, which provides financial and investment advice. The letter includes the name and contact details of the Applicant. The mark that is the subject of the First Application is shown in the top right hand corner of the exhibit.

## **DECISION**

34. The Opponent relies on more than one earlier trade mark. For procedural efficiency, I find it sensible to consider first any likelihood of confusion on the basis of **Registration A**.
35. The Opponent’s claim is based on section 5(2)(b) of the Act, which states:

*“... 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.”*

36. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

*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.

37. The principles are that:

- (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.

### **Comparison of the services**

38. The services to be compared in the first instance are the Applicant's numerous types of financial services and the Opponent's services under Registration A, namely:

*Insurance; insurance brokerage; capital management; captive management; financial affairs; monetary affairs; bank affairs including remote banking services which shall include telephone banking services, banking services provided online from a computer database or capable of being accessed by mobile or wireless devices or by means of web pages provided on the Internet or through interactive television; trade in securities; real estate affairs; securities brokerage concerning stocks and other securities; real estate agencies; real estate management; surety services for charitable fund raising.*

39. The Opponent submits that “*all of the services in the Applications are stated to be “financial services”. It is evident that these are all either identical or substantially similar to the financial affairs; monetary affairs; bank affairs which are protected under the earlier marks.*”

40. In comparing the similarity of the respective services, I am mindful of the words of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), where he stated that:

*“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise ... Nevertheless the principle should not be taken too far ... a straining of the relevant language ... 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.”*

This principle holds true for services as well as for goods.

41. I also particularly bear in mind that in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court stated<sup>3</sup> that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application, or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark. This principle holds true for services as well as for goods.

42. I therefore find that on the basis of the Opponent’s protection in respect of “*financial affairs; monetary affairs; bank affairs including remote banking services which shall include telephone banking services, banking services provided online from a computer database or capable of being accessed by mobile or wireless devices or by means of web pages provided on the Internet or through interactive television ...*” its services may be considered identical to those of the Applicant.

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<sup>3</sup> Case T- 133/05 at paragraph 29 of that judgment.

## The average consumer and the purchasing process

43. It is necessary to determine who is the average consumer for the respective services and how the consumer is likely to select the services.
44. 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 relevant person is a legal construct and ... the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical...*”
45. It must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question (*Lloyd Schuhfabrik Meyer, Case C-342/97*).
46. I find that the average consumer to whom the services are directed will include the public at large. The general public routinely access financial services including, for example, financial services relating to *investments, motor vehicles, property, credit cards, withdrawal and depositing of cash* and so on. The average consumer for the services under the umbrella terms financial, monetary and banking services will also include the average business, ranging from sole traders to larger enterprises. The Applicant also specifies *Financial services relating to business* and more particular financial services still, such as those *relating to airports or to the leasing of aircraft*.
47. Overall, I find that the average consumer of financial services will pay a reasonable level of attention when selecting a provider, as they will naturally be concerned to ensure the reliability and effectiveness of services affecting their finances. Where the services are more specialised, the degree of attention will be higher than that.

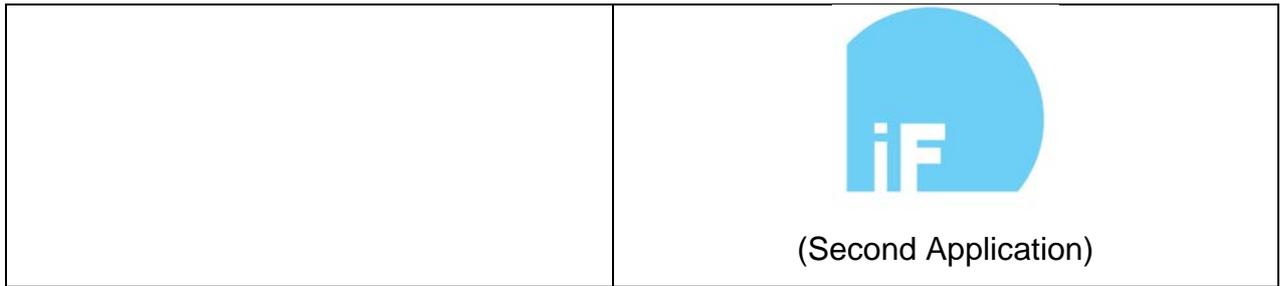
48. The purchasing act for the services will be visual as the mark will likely be seen on websites or in advertising materials. Word of mouth recommendations may also play some part in the selection process, so the way the marks sound is also relevant.

**Comparison of the marks**

49. It is clear from *Sabel* 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 Court of Justice of the European Union (CJEU) stated in *Bimbo* 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.”

50. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared in the first instance are:

<p><b>Opponent’s Registration A</b></p>	<p><b>Applicant’s contested marks:</b>  <b>First Application</b>  <b>and</b>  <b>Second Application</b></p>
<p><b>IF</b></p>	 <p>(First Application)</p>



51. The Opponent’s Registration A is a word mark consisting entirely of the letters IF, without embellishment or device. The combination of those two letters in that order therefore comprises the overall impression of the mark. The Opponent’s mark uses standard characters and therefore includes use in upper and lower case.<sup>4</sup>
52. The Applicant’s First and Second Applications are figurative marks that involve a device that the Applicant describes as “*a square and a circle that overlap*”, in a colour that it states to be Pantone 297. In the bottom left quadrant of that blue device sit the letters “iF” – the letter “i” being in lower case, the “F” in upper case, both letters presented in white. The First Application differs inasmuch that beneath the device and letters, and extending beyond the device to the right, are the words “independent first” in lower case. Those words are stated to be Pantone 288. The word “first” appears to be in bold, but I do not think that this would be noticed by the average consumer.
53. The Opponent submits that “*the combined letters IF are readily identifiable as an independent distinctive component within the First and Second Applications.*” I agree with that submission, although I find that the blue device also plays a distinctive role. In the First Application I find that the words “independent first” also make a distinctive contribution, but that the central position and relative size of the two letters lead them to be more dominant in the overall impression of the mark than the two words, which take a secondary role. Similarly, in view of the prominent position of the two combined letters, plus the fact that they may be read, voiced and understood, I find they play a greater role in the overall impression of the mark than does the device in either the First or Second Application.

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<sup>4</sup> (I note, incidentally, that in the Opponent’s Registration C, the same single word is deployed in lower case.)

### Visual similarity

54. The Opponent submits as follows

*“The IF component within the Applications cannot be overlooked on a visual basis. It is presented against a background shape which in no way detracts from the dominance of IF. So far as the Second Application is concerned, the additional words INDEPENDENT FIRST are secondary in nature, being much smaller than the dominant IF logo. The addition of the words INDEPENDENT FIRST in the Second Application is not sufficient to offset the similarities between it and the earlier marks. We refer in this connection to the opponent's evidence filed in these proceedings which is a decision of the EUIPO's Opposition Division dated 31 May 2016. The mark applied for:*



*was held to be highly similar visually to the earlier mark IF. In these proceedings too, the trade marks are highly similar visually.”*

55. I find that in the present case the visual similarity between the marks is lessened by the presence of the blue device and because the letters “IF” are of different cases and are not as large as those presenting in the IDEA FACTORY mark. However, given the common presence of the letters “IF” between the Applicant’s marks and Registration A (where those letters comprise the entirety of that earlier mark), and in light of the relative prominence of those letters in the overall impression of the Applicant’s marks, I find that the respective marks at issue are visually similar to at least a medium degree.

### Aural similarity

56. Since the device present in the Applicant’s marks is of course not spoken, only the letters and words are relevant in this aural comparison.

57. Aurally, the 'IF' of Registration A is likely to be pronounced as a single word. It is possible that it may be pronounced as two separate letters, but I think that much less likely given the absence of punctuation between the letters “I” and “F”.

58. As for the element 'iF' of the Applicant's marks, part of the public may pronounce it as two separate letters, particularly given the lower and upper case usage between the letters. The possibility of that pronunciation is stronger for the First Application because at least part of the public may perceive 'iF' to be the initials of the two words "independent first" that appear below those letters in that mark. Conversely, since the Second Application contains no secondary words to suggest a clear different sense to the two letters, it is more likely that the average consumer would perceive and pronounce that element as a single word,
59. On the other hand, it is also possible that the average consumer, whilst perceiving the 'iF' element to be two initial letters, may simply find it easier and faster to voice it as a single word and so may choose to say it that way. Moreover, it is also possible that a part of the relevant public may not perceive the element 'iF' as initials at all, so again would pronounce it as a single word.
60. The marks would differ in the pronunciation of the words "independent first" in the First Application, which have no counterparts in the earlier mark. However, since those words are secondary in the mark, where the "iF" component dominates, it is possible that a part of the relevant public would not speak them.
61. The Opponent submits that "*the component IF within the Applications will be pronounced in an identical way to the earlier marks.*" I find that this may be the case in the majority of instances, as I have described above – either because the respective marks are pronounced as the same single word or as the same sequence of two separate letters. In those cases, the marks under Registration A and the Second Application are aurally identical. In cases where the average consumer voices the "iF" component of the Applicant's marks as separate letters, but Registration A as a single word, I find the marks aurally similar to a low to medium degree. Where the consumer voices the words "independent first" in the First Registration, the aural similarity is lower still.

## Conceptual similarity

### *The First Application*

62. Since the words “independent first” appear in the First Application, the letters “i” and “F” may be perceived as standing for those words, but I find that they may nonetheless be pronounced either as two individual letters or as one word. Where the First Application is pronounced as involving separate letters there is conceptual neutrality. Where the letters are pronounced as a single word – and I note the acknowledgement in the Applicant’s counterstatement “*that both marks will contain the word IF*” - the conceptual perception of the average consumer will be that it signifies the dictionary word “if” (the common word meaning, for example, a conjunction introducing a conditional clause). To that extent I find a degree of conceptual identity between Registration A and the First Application. That level of conceptual similarity will be lessened by the presence of the secondary words “independent first”, which carry their conceptual content.

### *The Second Application*

63. The Opponent submits that the Second Application will be seen as conceptually identical to the earlier marks “*insofar as both may be perceived as comprising the dictionary word “if”.*” I note that the “iF” component of the applicant’s marks is written with the letter “i” in lower case and the “F” in upper case, which may suggest that the letters should be seen as merely a sequence, standing for two words. However, I find that the case differences may be overlooked by the average consumer, with the consequence that they would perceive the word as the word “if”. This perception is all the more since the Second Application contains no words bearing the initials “i” and “F”. I therefore find that the Second Application is conceptually identical to Registration A.
64. Considering the visual, aural and conceptual aspects together, I find that overall Registration A is similar to the Applicant’s marks to at least a medium degree.

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

65. The distinctive character of an earlier mark must be considered. The more distinctive the earlier mark, either by inherent nature or by use, the greater may be the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

66. The word “IF” that is the Opponent’s Registration A is a familiar and standard English word. The word does not describe the services in respect of which it is registered, nor can it really be considered allusive. I find that it has at least a reasonable level of inherent distinctiveness. (The level of distinctiveness of a mark may be enhanced through use, but the Opponent has submitted no evidence for that purpose.)

## **Conclusion as to likelihood of confusion**

67. I now turn to reach a conclusion as to the likelihood of confusion between the marks if they were used in relation to the services specified.
68. Confusion can be direct (which in effect occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). Indirect confusion, was considered by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,<sup>5</sup> where he noted that:

*“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.*

*17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:*

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case)*

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<sup>5</sup> Case BL-O/375/10

(b) *where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).*

(c) *where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”*

69. I make a global assessment of likelihood of confusion that takes account of my findings set out in the foregoing sections of this decision and of the various principles from case law outlined in paragraphs 34 and 35 above.

70. I have found identity between the parties’ services. I have found that the relevant average consumer includes members of the public but also businesses, including more specialised interests, and that the relevant average consumer would pay at least a reasonable level of attention when choosing the services at issue. In that selection process, visual and aural considerations are important and I have found that the Applicant’s marks share with Registration A at least a medium degree of visual similarity.

71. I note submissions from the Opponent as follows. “... *the words INDEPENDENT FIRST are not strongly inherently distinctive of source, and that the relevant consumers may be led to believe that this is a trade mark of the opponent to which additional, quasi-descriptive words have been added. The likelihood of confusion remains.*”

72. I have found that the marks may be pronounced identically or else pronounced so as to sound similar to a low or low to medium degree. I have found that the respective marks may be conceptually identical, or else, if the mark is not seen as a single word, neutral as to conceptual similarity. I have found at least a reasonable level of inherent distinctiveness in the earlier Registration A, but which is not enhanced by use.

73. I also note the points made in counterstatements, submissions and evidence in relation to the Applicant’s use of its trade marks on the UK market since August 2001. The Opponent submits as follows:

*“Even if the claim to the applicant's date of first use is accepted, it is a fact that the opponent owns a relevant earlier right [Registration A], applied for 30 March 2000. Although the applicant does not explicitly state this, it may be seeking to rely on the effect of concurrent use and that this was without any instances of confusion.*

*According to established legal precedent, for concurrent use to be of assistance to an applicant the tribunal must be satisfied that the effect of concurrent trading has been that the relevant public has shown itself able, in fact, to distinguish between services offered under the marks in question without confusion as to trade origin (see Court of Appeal in *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283 at page 291, *Laddie Jin Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45 and Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18).*

*For this to be possible, both parties will have to be targeting an approximately similar or at least overlapping audience, and the use by the parties in nature, and extent and duration of trade must be sufficient to enable any apparent capacity for confusion to be adequately tested and found not to exist.*

*We contend that the minimal information submitted by the applicant regarding the extent of use of the marks subject of the Applications is not sufficient to establish that the parties have traded in circumstances where the relevant consumers will have been exposed to both marks, or been able to differentiate between them without confusion as to trade origin. We refer in particular to the statement by Kitchin L.J. in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220:*

*"80. ... the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood*

*of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur."*

*In this case - and we speculate - a substantial part of the applicant's offering may have been into the market in Scotland, whereas the opponent's UK branch office is in London (Lime Street), or it could be that the customers to whom the identical and similar services of the parties are directed might typically differ as between private individuals and corporations.*

*In summary, we contend that the prima facie likelihood of confusion is not disturbed by the applicant's claimed use of the marks the subject of the Applications. The limited materials filed by Independent First do not constitute persuasive evidence or a factual matrix illustrating that the average UK consumer has been adequately exposed to both parties' marks and is not likely to confuse the marks."*

74. When I weigh in the balance all of the above factors, I find in this case that there would be a likelihood of confusion on the part of the relevant UK public as to the origin of the services at issue. I note that the Opponent has not been put to proof of use of its earlier marks, and that there is no evidence in these proceedings to support submissions as to whether or not consumers have in fact been able to differentiate between the respective marks at issue. I agree with the Opponent's submission that that the prima facie likelihood of confusion is not disturbed by the Applicant's claimed use of the marks the subject of the First and Second Applications. **Consequently, the opposition succeeds on the basis of section 5(2)(b).**
75. The Opponent has succeeded in full on the basis of Registration A and would be in no better a position in respect of Registrations B or C. In the circumstances I do not consider it proportionate or necessary to consider the Opponent's claim in relation to those earlier marks.

## **Costs**

76. The Opponent has been successful and is entitled to a contribution towards its costs, which I assess based on the guidance in Tribunal Practice Notice 2/2016. I award the Opponent the sum of £600 (six hundred pounds) as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Reimbursement of the official fee for Notice of Opposition and Statement of Grounds:	£100
Preparing a statement of grounds and considering the other side's statement:	£200
Preparing submissions:	£300
<b>Total:</b>	<b>£600</b>

77. I therefore order Independent First Ltd to pay If Skadeförsäkring Holding AB (publ) the sum of £600 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 19th day of October 2017**

Matthew Williams

**For the Registrar, the Comptroller-General**