

O/650/19

TRADE MARKS ACT 1994

IN THE MATTER OF UK DESIGNATION OF INTERNATIONAL REGISTRATION
NO. 1410949 DIAMOND COIN IN CLASS 26 STANDING IN THE NAME OF
WORLDWIDE DIAMOND CORPORATION LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 414857 BY EUI
LIMITED

Background and pleadings

1. The details of the International Registration (IR), the subject of these proceedings are as follows:

Mark: DIAMOND COIN

Applicant: Worldwide Diamond Corporation Limited

International registration date: 30th January 2018

Date of UK designation: 30th January 2018

Published on: 23rd November 2018

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; providing a wide range of information and analysis to financial institutions by electronic means in connection with credit, debit, stored value and other payment cards, specifically, cardholder spending, fraud, risk management, terminated merchants, reporting of charge backs, retrievals and exceptions; providing financial services information via a global computer network; banking and credit services; services of credit, debit, purchasing, cash payment and prepayment cards; provision of financial account details, namely, cash balances, deposits and withdrawals to cardholders through automatic teller machines; financial settlement and authorisation services; foreign currency transfers; electronic payment services, namely, electronic processing and transmission of bill payment data; cardholder financial authorisation and debt settlement services; online banking services; investment services including the services of insurance and assurance agents, insurance and assurance brokers, insurers, financiers, investment consultants and agents; mortgage banking, providing loans, consultancy, insurance and financial services of all kinds.

2. EUI Limited (the opponent) oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier



EU Trade Mark No 1 111 9393 for the mark: . The entirety of the specification contained within this trade mark is relied upon. However, the opponent focusses upon the following earlier goods and services:

Class 16:

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); typewriters adapted for producing legal documentation; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; publications; albums, almanacs, booklets, books, brochures, diaries, directories, guides, handbooks, journals, leaflets, notebooks, pamphlets, magazines, manuals and periodicals; announcement and greeting cards; charge cards, credit cards and debit cards (other than encoded or magnetic); cards (other than encoded or magnetic) for use in relation to the payment and transfer of funds; trading cards; place cards; post cards; coasters of paper; document files and holders; folders for papers and stationery; loose leaf binders; photograph stands; apparatus for mounting photographs; artwork, diagrams and illustrations; address stamps; book marks; book plates and markers; book bindings; book ends; calendars; charts; graphic prints and posters; graphic reproductions; drawing boards, pads and materials; etchings and engravings; flags of paper; handkerchiefs of paper; instructional and teaching material (except apparatus); letter trays; mats for glasses; napkins of paper and cellulose; office requisites (except furniture); paintings and pictures (framed or un-framed); paper weights; patterns for making clothes; paper and cardboard frames; pens, pencils and holders therefor; paper knives; scrap books; signboards of paper or cardboard; stamps (seals); stencils; table cloths, linen and mats of paper;

tissues; towels of paper; wrappers; wrapping and packing paper; writing pads; writing paper; parts and fittings for all the aforesaid goods.

Class 36:

Insurance; motor and non-marine general insurance services; fire insurance; health insurance; life insurance; marine insurance; information services relating to insurance provided on-line from a computer database or the Internet; insurance brokerage, consultancy, information and underwriting services; underwriting of motor accident insurance; financial evaluation (insurance); provision of financial information relating to the purchase of automobile and non-marine insurance; identification, investigation, management and initiation of claims for damage to property, persons and animals arising from motor accidents, accidents occurring in the home, place of work, sports fields and environs, public and private roads, educational and religious institutions and other public domains; advice and consultancy services relating to all the aforesaid services

3. The opponent argues that the respective goods and services are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.
5. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

DECISION

Section 5(2)(b)

6. 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”.

Comparison of goods and services

7. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

8. It is noted that each of the specifications include insurance. They are self-evidently identical. Further, the following contested term is included within insurance at large and so is identical: investment services including services of insurance and assurance agents, insurance and assurance brokers, insurers, financiers, investment consultants and agents.

9. The contested term real estate affairs will include activities such as the management of real estate, providing valuations, buying and selling of

properties and the like. However, the term is also broad enough to include services such as the provision of mortgages. Such services are invariably provided by financial institutions, notably banks. They also commonly provide insurance and so the services coincide in terms of provider. They can also coincide in terms of trade channels and end user as a mortgage customer may also decide to purchase insurance as part of a mortgage. They are considered similar, to at least a low degree.

10. The remaining services are all types of financial or monetary services, the likes of which will be provided by financial institutions to one another (for example, for the purposes of mitigating against fraud and risk). Further, many of these services will be provided to the general public. Providers of such services also commonly offer insurance services (again, whether to other financial institutions or the public). As such they will coincide in this respect. Further, the channels of trade may coincide. They are all considered similar, at least to a low degree.

Comparison of marks

11. 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 Court of Justice of the European Union 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.”

12. 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.

13. The respective trade marks are shown below:

	DIAMOND COIN
Earlier trade mark	Contested trade mark

14. The earlier trade mark is a composite mark as shown. Its dominant and distinctive element is clearly the word DIAMOND. The contested trade mark is word only, each element of which plays an equal role as regards dominance and distinctiveness.

15. Visually, the marks coincide in respect of DIAMOND and differ in all other respects. The inclusion in each of this element leads me to conclude that they are visually similar, to a medium degree.

16. Aurally, the marks coincide in two syllables and differ in respect of the additional syllable that appears in the contested trade mark. They are similar to a medium to high degree.

17. Conceptually, the earlier trade mark will be understood as referring to the precious stone. In the contested trade mark the word diamond will be understood in the same manner and coin will be understood as referring to a disc or piece of metal, used as money. It is accepted that this is an odd combination of words. However, the meaning is most likely to be understood as a coin comprised of a precious stone or containing such an item. The sum of this is the addition of coin in the contested trade mark does not have the effect of creating a conceptual gap. Rather, it is qualified by the word diamond. The impact of this is that there is conceptual similarity. This is pitched as being medium.

Average consumer and the purchasing act

18. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

19. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

20. The relevant consumer will be comprised of both the public at large and the professional user, such as businesses. It is likely that this will be a reasonably considered purchase with factors such as cost and levels of cover (and potential exclusions), being particularly important. The level of attention expected to be displayed is therefore at least medium. As regards the nature of the purchase, this may have a visual component (particularly if being purchased on the internet) but may also follow a period of research and word of mouth recommendations. As such, aural considerations are also to be borne in mind.

Distinctive character of the earlier trade mark

21. 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).”

22. There is no claim from the opponent that the earlier trade mark enjoys an enhanced degree of protection as a result of the use made of it. I therefore have the prima facie case to consider. Diamond has connotations of luxury, but I see no obvious connection to the services at issue here. It is however a common English word and as such, I consider it to have no more than an average degree of distinctiveness.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

23. 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.

24. The marks have been found to be visually and aurally similar to a medium to high degree and conceptually similar to a medium degree. The earlier trade mark is distinctive to an average degree and there will be at least a medium degree of attention displayed during the purchasing process. There are also differences between the marks as already described. These differences, together with the degree of attention expected to be displayed, lead me to conclude that the differences in the marks are unlikely to go unnoticed. As such, they will not be mistaken for one another and so there is no likelihood of indirect confusion.

25. However, this is not the end of the matter. In considering whether or not there is a likelihood of indirect confusion, I take into account the guidance in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained 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”.

26. It is noted that the element DIAMOND is coincidental in both trade marks. This is the element that is likely to, upon seeing the later trade mark, provide a

hook in the mind of the relevant consumer. The effect of this is likely to be that the relevant consumer will consider the trade marks to emanate from the same source. The addition of COIN will not detract as it does not dilute DIAMOND and does not create an unequivocal and differing meaning. Upon viewing DIAMOND COIN, I am satisfied that the relevant consumer will conclude that it is another brand of DIAMOND.

27. The upshot of this is that there is a likelihood of indirect confusion and so the opposition succeeds in totality.

COSTS

28. The opponent has been successful and so is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition and accompanying statement plus official fees - £400

29. I therefore order Worldwide Diamond Corporation Limited to pay EUI Limited the sum of £400. 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 25th day of October 2019

Louise White
For the Registrar