

**o/982/22**

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001564345 DESIGNATING THE UK  
IN THE NAME OF THE BLACK SANDS PROPERTIES LIMITED

IN CLASS 36

AND THE OPPOSITION THERETO UNDER NO. 425521 BY FBS NEXT S.P.A.

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF LEANNE FAYTER (O/443/22) DATED 24  
MAY 2022.

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DECISION  
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**Introduction**

1. This is an appeal by The Black Sands Properties Limited ("**Appellant**") from decision O/443/22 of Ms L. Fayter ("**Decision**") concerning the opposition by FBS Next S.P.A. ("**Respondent**") to International trade mark 1564345 ("**the IR**"). The IR is registered with effect from 26 August 2020, for the mark shown below:



2. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the IR in relation to the following services in class 36:  
*Currency trading and currency exchange services; stock brokerage; brokerage.*
3. On 14 July 2021, the Respondent opposed the protection of the IR in the UK based upon section 5(2)(b) of the Trade Marks Act 1994, relying upon EUTM registration no. EU018003850 ("**Earlier Mark**"), shown below.



4. The Earlier Mark is registered, *inter alia*, in respect of the following services in class 36, upon which the Respondent relied:

*Insurance underwriting; Finance services; Monetary affairs; Credit recovery and collection; Credit brokerage; Acquisition and transfer of monetary claims; Debt collection; Debt recovery and collection agencies; Consultancy services relating to credit; Issuance of documentary letters of credit; Debt recovery; Debt collection agency services; Credit assessment services; Organising of debt collections; Credit scoring services; Real estate affairs; Financial analysis and research services; Financial evaluation and analysis; Financial analysis; Online financial transactions; Brokerage; Financial consultancy; Deposits of valuables; Safe deposit services; Issuance of travellers' cheques; Issuance of tokens of value; Issuance of credit cards; Fund investment services; Surety services; Financial management of reimbursement payments for others; Financial information; Providing financial information via a web site; Capital investment; Hire-purchase financing; Insurance brokerage; Online banking; Currency trading and exchange services; Clearing, financial; Organization of monetary collections; Instalment loans; Lending against security; Loans [financing]; Lending against securities; Arranging finance for construction projects; Stock exchange quotations; Banking; Credit bureau services; Savings bank services; Debt advisory services; Financing services; Provident fund services; Business liquidation services, financial; Stock brokerage services; Retirement payment services; Mortgage banking; Fiscal valuation; Financial customs brokerage services; Financial sponsorship; Real estate appraisal; Financial evaluation [insurance, banking, real estate]; Electronic funds transfer; Processing of credit card payments; Processing of debit card payments; Financial appraisals in responding to calls for tenders; Cheque verification; Financial valuation of personal property and real estate; Valuation relating to the surveying of buildings; Financial assessment of company credit; Credit card transaction processing services; Financial transaction services; Financial sponsorship of entertainment activities; Securities underwriting; Financial consultancy and information services; Trusteeship; Information services relating to financial business appraisals; Financial valuation services; Electronic payment services; Financial brokerage services; Financial consultancy relating to credit services; Banking and financing services; Electronic banking services; Insurance and financial information and consultancy services.*

5. In the Decision, L. Fayter for the Registrar held that the opposition was successful in its entirety.
6. On 20 June 2022 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

#### **The Hearing Officer's decision**

7. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):
  - a. The average consumer will be members of the general public or businesses, who will select the services primarily by visual means, although an aural component cannot be discounted.
  - b. The average consumer will pay between a medium and high degree of attention during the purchasing process for the services which are financial in nature.
  - c. The parties' services are identical.
  - d. The Earlier Mark is inherently distinctive to at least a medium degree.
  - e. The marks are visually similar to a high degree, aurally identical and conceptually neutral.

- f. There is a likelihood of direct confusion, alternatively a likelihood of indirect confusion.

### Grounds of Appeal

8. The Appellant did not seek to argue that any of the Hearing Officer's decisions summarised in 7.a - d above are wrong. However, the Appellant contended that the Hearing Officer made the following errors of principle and/or assessment:
1. **Failure to give the visual comparison most weight:** The Hearing Officer held that the letters FBS play a greater role in the overall impression of the mark, with the stylisation and colours playing a lesser role. The Appellant disputes this on the basis that both parties have filed for the marks in a stylised manner with both marks being in colour. The Hearing Officer should have given much more weight to the stylisation and colour when deciding if the marks are similar, especially as the marks are short each consisting of three letters
  2. **Incorrect finding that FBS has no meaning in relation to the respective services:** A Google search would have found acronym finders, which state that FBS is an abbreviation for Financial Battlefield System, Fidelity Brokerage Services, and for Finance and Business Services. All of these abbreviations are used in the financial field, which is the very field both the Appellant and the Opponent are in. The marks therefore do have a conceptual meaning within the financial field.
9. The Appellant's trade mark attorney, Ms Wilson, expanded upon the above in her skeleton argument and orally at the hearing. The Respondent did not participate in the appeal. I set out below further details of the Appellant's arguments as are necessary to understand my overall conclusions.

### Standard of review

10. The approach to be adopted in an appeal hearing has been laid down a number of times in case law, both in general terms (e.g. by the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671) and specifically in relation to appeals before the Appointed Person (Daniel Alexander Q.C. sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17), approved by Arnold J in *Apple Inc. v Arcadia Trading Limited* [2017] EWHC 440 (Ch)). These cases establish the following principles:
- Appeals to the appointed person are by way of review, not re-hearing;
  - It is necessary for the appellant to satisfy the appeal tribunal that there was a distinct and material error of principle in the Hearing Officer's decision, or that the Hearing Officer was wrong;
  - In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it;
  - In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether

the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation;

- Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice;
- The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account.

11. In addition to the above, Mr Iain Purvis QC sitting as the Appointed Person in *ROCHESTER Trade Mark*, BL O/049/17, made the following observations at paragraph 33:

“... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test ‘likely to cause confusion amongst the average consumer’ is inherently imprecise, not least because the average consumer is not a real person

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence ....

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.”

12. I shall bear all the above in mind when reviewing the Decision.

### **Discussion**

13. Looking at the various alleged errors in turn, my analysis is as follows.

(1) **Failure to give the visual comparison most weight**

14. The Hearing Officer’s comparison of the marks is set out at paragraphs 22-29 of the Decision. She reminded herself that the average consumer normally perceives a mark as a whole and

does not proceed to analyse its various details. However, 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.

15. For both marks, the Hearing Officer noted the colours and other stylisation. For the Earlier Mark, she noted that the letters FB are dark grey, and the letter S is light grey. For the IR she noted:
  - the letters FBS are in a bold white font;
  - the letters are underlined;
  - the letters are placed against a green square background; and
  - the letters and the underline have a black shadow background which goes diagonally into the right-hand bottom corner of the mark.
16. Having noted these colours and stylisations, the Hearing Officer nonetheless concluded that the letters FBS play a greater role in the overall impression of the mark, with the stylisation and background playing a lesser role.
17. An argument that she was wrong to reach this conclusion is not, *prima facie*, a promising start for an appeal, given that the Hearing Officer both reminded herself of the applicable law and noted the differences in question. Her decision to give them less weight was a value judgment, of a type which is difficult to appeal for the reasons set out in paragraph 10 above.
18. However, the Appellant contends, specifically, that the Hearing Officer failed to take into account, when comparing the marks overall, the principle that, for a short word mark, the average consumer will more easily be able to distinguish between differences.
19. The Hearing Officer did address this argument at paragraph 27 of the Decision, where she said:

“I note that the holder submits that “case law advises that where the marks are short even small differences will be enough to distinguish them”. There is no special test which applies to the comparison of short marks, the visual similarities must be assessed in the normal way. However, I also consider that where a mark is short, the visual differences may be noticed between the differentiating letters of the mark, not the stylisation and background” (my underlining).
20. I need to consider, therefore, whether the Hearing Officer was correct to reject the Appellant’s argument on the basis that it applies to differentiating letters of the mark, rather than differences in the stylisation and background.
21. The Appellant did not specify precisely which case law it was relying upon, either in its Form TM8 or in its written submissions in this appeal. I expect, however, that the Appellant is referring to the decisions of the UK IPO and General Court which were considered by Mr James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20. Mr Mellor Q.C. said:

“38. In my view, it is clear that none of these cases establish any sort of special test for short marks. The point is a common sense one – that if marks differ e.g. by one letter, the difference may have a greater impact in marks which consists of two letters than four etc. But every comparison must be conducted according to the approach laid down in the CJEU case law and every comparison will depend on its own facts.

...

43. All the cases to which I have made reference on this topic establish that there are no special tests which apply to 'short' marks – whatever falls within the supposed category of 'short' marks. In reality, the tribunal simply has to apply the well-established propositions for assessing the visual, aural and conceptual similarities.”

22. Although that decision is not a binding authority on another Appointed Person, I do not believe that Mr Mellor Q.C. was seeking to lay down a binding authority. Rather, he was simply stating an obvious truth – a “common sense” point, as he put it – that the impact of a single changed or additional character in a short mark is likely to be greater than that it would be in a longer mark.
23. I respectfully agree with Mr Mellor Q.C.’s analysis. However, I can see no good reason why the “common sense” point discussed in *Robert Bosch* would apply also to the impact of changing stylisation and background, rather than the letters in the mark itself. I do not see, as a matter of logic or from practical experience, why changing colours, font, background etc would have any greater impact on a short mark than a long mark. Nor am I aware of any case law stating that such changes are likely to have more impact on a short mark (and the Appellant has not referred to any). Accordingly, I consider that the Hearing Officer was right to dismiss the Appellant’s argument that the shortness of the mark means that differences in stylisation and background are more likely to be noticed.
24. Accordingly, the Hearing Officer made no error of principle in her analysis. Her decision was not wrong. I reject this ground of appeal.

**(2) Incorrect finding that FBS has no meaning in relation to the respective services**

25. At paragraph 29 of the Decision, the Hearing Officer held:

“Conceptually, the opponent submits that neither mark has a meaning. I agree. I consider that the letters FBS in both marks will be recognised as initialism, which is an acronym in which each letter is pronounced separately, rather than the acronym being pronounced as a word, with no immediate conceptual meaning. The underline and background of the holder’s IR do not add to the meaning of the mark. Consequently, I consider that the marks are conceptually neutral”.
26. In its skeleton argument, the Appellant contends:

“a simple Google search would have found acronym finders, which state that FBS is an abbreviation for Financial Battlefield System, Fidelity Brokerage Services, and for Finance and Business Services. All of these abbreviations are used in the financial field, which is the very field both the Appellant and the Opponent are in. The marks therefore do have a conceptual meaning within the financial field and it is for this reason that both the Appellant and the Opponent filed for stylised abbreviations of their marks in colour”.
27. I noted that this argument was not raised at all in the Appellant’s Form TM8, and questioned the Appellant’s representative at the hearing whether it is correct to criticise the Hearing Officer for failing to take notice of this point. Ms Wilson acknowledged that the specific point was not raised before the Hearing Officer, but contended that it is commonplace for Hearing Officers to carry out their own investigations, and had that been done she would have identified the abbreviations set out above. That may well be so, but in my view, the flaw in the Appellant’s argument is that it is not obvious that any of the potential meanings of FBS do in fact apply to

the marks in question. The fact that a string of letters may be an abbreviation of terms which are relevant to the services in question does not mean that it is, nor that it would be perceived by the average consumer as such. To succeed on such an argument, the Appellant would have needed to submit evidence in relation to the same, which was not done either before the Hearing Officer, or in this appeal.

28. Accordingly, the Hearing Officer was not wrong, on the materials which were before her, and also on the materials that she might reasonably have located herself, to conclude that FBS does not have a meaning. I reject this ground of appeal.

#### **Conclusion**

29. The Hearing Officer made no errors of principle, and her decision was not wrong. The appeal is dismissed.

#### **Costs**

30. Clearly, the Respondent has been the successful party in this appeal. However, as the Respondent did not participate in the appeal, it has incurred no costs, and I therefore make no order as to costs.

**Dr. Brian Whitehead**

**5 November 2022**

#### **Representation**

Ms Alison Wilson of of Murgitroyd & Company for the Applicant / Appellant