

**O/0071/24**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3783104**

**BY MINDFUL CAPITAL PARTNERS S.A.**

**AND**

**OPPOSITION No. 437198**

**BY MPC MÜNCHMEYER PETERSEN CAPITAL AG**

## BACKGROUND AND PLEADINGS

1. This is an opposition by MPC Münchmeyer Petersen Capital AG (“the opponent”) to an application filed on 29<sup>th</sup> April 2022 by Mindful Capital Partners S.A. (“the applicant”) to register the trade mark shown below:



2. The application covers the following services in class 36:

Financial affairs; Private equity fund investment services; Management of private equity funds.

3. The application claims priority from an application filed the previous day (28<sup>th</sup> April 2022) for an EU trade mark. Therefore, the relevant date for determining priority vis-à-vis third party trade marks is 28<sup>th</sup> April 2022.

4. The opponent is the proprietor of the following earlier trade marks:

<i>Trade mark</i>	<i>Dates of filing and completion of registration process</i>	<i>Services</i>
UK810744246  <b>MPC</b>	05/01/2016 & 28/12/2016	Class 36: Real estate affairs, financial affairs, monetary affairs, development and brokerage of all kinds of capital investments, such as stock funds, pension funds, real estate funds, ship funds, media funds, local funds and leasing funds.
International registration IR744469	14/09/2000 & 13/12/2001	Class 36: Financial affairs; Private equity fund investment services; Management of private equity funds.



5. Trade mark UK810744246 was originally protected as an international trade mark (“IR”) designating the EU. The comparable UK trade mark was created on 31<sup>st</sup> December 2020 in order to replace the protection previously given to the IR by virtue of the UK’s membership of the EU. It is treated as though it was originally applied for and registered in the UK.

6. The opponent’s grounds of opposition are based on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), which are as follows.

*“(2) A trade mark shall not be registered if because—*

*(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or*

*(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.*

*(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—*

*(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,*

*(aa) -*

*(b) -*

*A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.*

*(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”*

7. The opponent claims the contested mark is similar to the earlier marks, that the respective services are identical or highly similar, and there is a likelihood of confusion on the part of the public. Therefore, registration of the contested mark would be contrary to section 5(2)(b) of the Act.

8. Further, the opponent claims that it has acquired goodwill as a result of use of MPC throughout the UK since 2014 in relation to:

Real estate affairs, financial affairs, monetary affairs, development and brokerage of all kinds of capital investments, such as stock funds, pension funds, real estate funds, ship funds, media funds, local funds and leasing funds.

9. According to the opponent, use of the contested mark would constitute a misrepresentation to the public that the user of the contested mark is, or is connected to, it. Such a belief would damage the opponent’s goodwill. Therefore, registration of the contested mark would be contrary to section 5(4)(a) of the Act.

10. The applicant filed a counterstatement denying the ground of opposition. I note, in particular, that:

- (1) The opponent was put to proof of genuine use of the earlier marks;
- (2) The opponent was put to proof of the claimed goodwill acquired under MPC;
- (3) The applicant claimed to have used the trade mark MCP in the UK since approximately 2012, with no known instances of confusion.

11. Both sides seek an award of costs.

## REPRESENTATION

12. The applicant is represented by Potter Clarkson LLP. The opponent is represented by Murgitroyd & Company. Neither side asked for a hearing. Both sides filed written submissions in lieu. I have taken these into account in reaching my decision.

## EVIDENCE

13. The opponent's evidence consists of a short witness statement (with three exhibits) by Claire Hutson, who is trade mark attorney at Murgitroyd & Company. The exhibits are described by Ms Hutson as current and historical pages from the opponent's website, and 'Corporate Presentations' said to provide information about the opponent's business.

14. The applicant's evidence consists of a witness statement (with eight exhibits) by Lorenzo Stanca, who is the applicant's Managing Partner and Head of Marketing. Mr Stanca provides information about his company's private equity business.

## PROOF OF USE

15. As the earlier marks had been registered (or protected) for more than 5 years at the relevant date, the opponent provided the necessary statement of use for the period 29<sup>th</sup> April 2017 to 28<sup>th</sup> April 2022 ("the relevant period"). This is in accordance with section 6A of the Act, which is as follows:

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

*(3) The use conditions are met if—*

*(a) within the relevant period the earlier trademark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or*

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

*(4) For these purposes—*

*(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and*

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

16. As UK810744246 is a comparable trade mark, paragraph 7(3) of Schedule 2B to the Act is also relevant. It provides as follows:

*“Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—*

*(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding (IR); and*

*(b) the references in section 6A to the United Kingdom include the European Union.”*

17. This means that use of the ‘246 mark in the EU between 29<sup>th</sup> April 2017 and 31<sup>st</sup> December 2020 counts as use in the UK for the purposes of section 6A of the Act.

18. Ms Hutson’s statement provides no first-hand evidence about the opponent’s use of the earlier marks. Indeed, it does not even mention any such use. Exhibit CH01 to Ms Hutson’s statement consists of webpages from the website [www.mpc-container.com](http://www.mpc-container.com). These indicate that a Norwegian company called MPC Container Ships ASA runs a shipping business and has, since 2017, raised \$475m in investment, some of which came from its principal sponsor, the opponent based in Germany.

19. Exhibit CH02 to Ms Hutson’s statement consists of a Corporate Presentation prepared by MPC Container Ships ASA about its shipping business, financial position, and future prospects. It is dated 2023. It is not clear who the presentation was for. I note that ‘MPC Group & Affiliates’ is listed on one page as a 17% shareholder in the

company. Other than that, and one further reference to MPC Group as an investor, there is nothing which connects this material with the opponent or the earlier marks.

20. Exhibit CH03 to Ms Hutson's statement consists of historical webpages dated 2017 from the website of MPC Container Ships ASA. They provide information about the ships the company operated at that time. As far as I can see, there is nothing about the opponent or the earlier marks.

21. The opponent's submissions filed with Ms Hutson's statement do not explain the relevance of this material. The opponent's final written submissions provide no clarification either. They do not even mention the proof of use issue.

22. Not surprisingly, the applicant disputes that this material shows the earlier marks were put to genuine use in the UK during the relevant period.

23. In *Awareness Limited v Plymouth City Council*,<sup>1</sup> Mr Daniel Alexander Q.C. as the Appointed Person stated that:

*"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."*

---

<sup>1</sup> Case BL O/236/13

24. The opponent clearly could have provided evidence from a witness with first-hand knowledge of the use made of the earlier marks during the relevant period. Instead it provided only a short witness statement from its UK trade mark attorney with the results of some internet research she undertook. As it turns out, the material is not (as Mr Hutson claims) from the opponent's website, but from a Norwegian shipping company in which the opponent appears to have invested. There is no evidence of any use of the earlier marks as registered in relation to financial services. If – which is not clear – the material is intended to encourage me to draw the inference that the MPC mark must have been used in the course of the opponent's investment in the Norwegian company, I refuse to do so for at least these reasons. Firstly, investing in a company as a shareholder is not, without more, evidence of the provision of a financial service under the earlier marks. Secondly, Norway is not a member of the EU. Therefore, this cannot represent use of the earlier marks in the UK, even on the wider geographical basis on which use of the '246 mark must be assessed.

25. Consequently, I find the opponent has not shown use of the earlier marks during the relevant period in the UK. The opposition under section 5(2)(b) of the Act therefore falls at the first hurdle.

### **SECTION 5(2)(b)**

26. Just in case I am wrong about the absence of proof of use, I will deal briefly with the section 5(2)(b) ground of opposition assuming against myself that the opponent has provided proof of use of the '246 mark (the MPC letter mark) in relation to *private equity fund investment services*. This is the opponent's best chance of success based on the most optimistic view of the evidence.

### **Status of EU Law**

27. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.



## The case law

28. 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.

### **The services**

29. At least some of the services are identical.

### **The average consumer and the selection process**

30. The average consumer of the identical services is likely to be a financial investor or a business seeking investment funds from a third party. Because of the financial risk and importance of such transactions, such consumers are likely to pay a high level of attention when selecting a service provider.

31. The services are likely to be selected through visual means, such as presentations, prospectuses, websites etc. However, word of mouth recommendations are liable to play an important part in the process.

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

32. The applicant submits that the letters MPC are low in distinctive character because of the actual and potential use of letters as acronyms for undertakings with different names, e.g. the Bank of England uses MPC for its Monetary Policy Committee.

33. In my view, for essentially the reasons given by the applicant, the letters MPC have a below average (although not very low) degree of distinctive character in relation to financial services, including *private equity fund investment services*.

### **Similarity of marks**

34. The opponent submits that:

*“The marks MPC and [the contested mark] are visually, phonetically and conceptually similar due to the shared MPC/MCP lettering. The marks share the same three letters as the distinctive component of the respective marks. The additional wording MINDFUL CAPITAL PARTNERS is descriptive of the services applied for and so does not reduce the similarity overall.”*

35. The applicant disputes that the marks are similar. It points out that the different position of the letters PC/CP in short three letter signs makes a significant difference. Further the applicant:

*“... denies MINDFUL CAPITAL, per se, is descriptive, but even if it was, the addition of PARTNERS would make the mark indicative of trade origin. We submit that the inclusion of MINDFUL CAPITAL PARTNERS has a twofold impact, namely, (1) the marks to be compared are MCP MINDFUL CAPITAL PARTNERS and MPC, with different stylisation, and (2) that it cements the difference between the acronyms as the earlier marks cannot be an acronym for MINDFUL CAPITAL PARTNERS.”*

36. The point about “*different stylisation*” does not strictly apply to the comparison with the ‘246 letter-only mark. However, it is appropriate to take account of the stylisation of the letters in the contested mark, which is more than only normal and fair use of the letters MCP *per se*. The absence of that stylisation, or anything similar, from the ‘246 mark is therefore a point of difference between the marks, albeit a small one.

37. I accept the applicant’s other submissions about the differences between the marks. In particular, I accept that the words MINDFUL CAPITAL PARTNERS are not so insignificant or descriptive as to unnoticed, or be ignored, by average consumers. The inclusion of those words in the contested mark will, therefore, steer such consumers to see MCP as an acronym for those words. This will help to avoid those letters being mis-recalled as MPC.

38. I do not accept that there is *no* similarity between the marks. After all, the same three letters are clear in the largest, or only, element of the marks, albeit that the last two letters are in a different order. However, the differences described above lead me to conclude that the marks are visually similar to only a low degree. It is possible that the contested mark will be verbalised by a significant proportion of average consumers as simply MCP. Therefore, there is a higher – medium – degree of aural similarity between the marks. The letters MPC have no conceptual meaning to most people. The words MINDFUL CAPITAL PARTNERS have a concept, of a partner organisation that provides capital and is mindful of its partner’s needs. Therefore, there is a degree of conceptual difference between the marks.

### **Likelihood of confusion**

39. I find the following points persuasive:

- (1) the below average degree of distinctive character of the earlier mark;
- (2) the high degree of attention likely to be paid by relevant average consumers;
- (3) the low degree of visual similarity between the marks and the fact that the contested mark has a concept, which the earlier mark does not;
- (4) the selection process is likely to include times when the marks can be seen.

40. For these reasons, I find there is no likelihood of direct confusion between the marks, even after making some allowance for imperfect recollection. I find there is no likelihood of indirect confusion either. If consumers recognise that these are different marks, there is no rational reason why the same undertaking should be using marks with the same letters arranged in a different order as variant marks.

41. These findings must also apply to the other earlier mark - IR744469. This is because it is less similar to the contested mark than the '246 letter-only MPC mark.

42. In coming to these conclusions, I have not attached any weight to the applicant's claim to have made concurrent use of MCP, without causing confusion. This is because (1) the mark the applicant used up until 2022 was actually MANDARIN CAPITAL PARTNERS with a highly stylised device (i.e. a vastly different mark), (2) there is next-to-no evidence of use of that mark in the UK, and (3) the applicant (rightly) submits that the opponent has not provided proof of use of the earlier marks. In which case there is no evidence of concurrent use, and without that, the absence of evidence of confusion tells us nothing.

#### **SECTION 5(4)(a)**

43. The essential requirements for establishing passing off are well established: goodwill; misrepresentation leading to deception, or a likelihood of deception, of a substantial number of the opponent's customers, or potential customers; and damage resulting from the misrepresentation.

44. The burden is on the opponent to satisfy me of all three limbs.

45. As to goodwill, in *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*,<sup>2</sup> Lord Neuberger (with whom the rest of Supreme Court agreed) stated that:

---

<sup>2</sup> [2015] UKSC 31 at paragraph 47 of the judgment

*“I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.”*

46. The opponent's evidence does not show it has any customers in the UK. Consequently, the section 5(4)(a) ground of opposition also falls at the first hurdle. Further, even if I am wrong about that, for the reasons given above, I would have found there is no likelihood of deception and, therefore, no misrepresentation or damage.

## **OVERALL OUTCOME**

47. The opposition fails. The contested mark will therefore proceed to registration.

## **COSTS**

48. The applicant is entitled to a contribution towards its costs. I assess this as follows:

£300 for considering the notice of opposition and filing a counterstatement;

£1100 for considering the opponent's evidence and filing evidence in response;

£300 for filing submissions in lieu of a hearing.

49. The applicant's own evidence was not helpful, but I have taken into account the additional and unnecessary work created by having to carefully comb through the opponent's evidence to work out (without any explanation from the opponent) what relevance it might have to the proof of use issue.

50. I therefore order MPC Münchmeyer Petersen Capital AG to pay Mindful Capital Partners S.A. the sum of £1700. This sum must 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 if the appeal is unsuccessful or does not proceed.

**Dated this 6<sup>th</sup> day of February 2024**

**Allan James**

**For the Registrar**