

TRADE MARKS ACT 1994

**In the matter of application no.2104830
by General Guarantee Corporation Limited
to register a Trade Mark in Class 36**

TRADE MARKS ACT 1994


IN THE MATTER OF APPLICATION TO REGISTER TRADE MARK NO 2104830 IN CLASS 36 IN THE NAME OF GENERAL GUARANTEE CORPORATION LIMITED

On 10 July 1996, General Guarantee Corporation Limited, of P.O Box 166, Ambassador House, Devonshire Street, Manchester, applied under the Trade Marks Act 1994 to register the trade mark FIRST FOR FINANCE In respect of:-

Insurance services; insurance brokerage; credit brokerage; credit services; credit card services; debt collection agency services; provision of finance; lending against security; loans (financing); arranging of loans; installment loans; professional loans; corporate finance; payment protection insurance; lease-purchase financing; hire purchasing financing; car finance; commercial vehicle finance and motor cycle finance; finance leasing, operating leasing and contract hire; all included in Class 36.

Objection was taken under paragraphs (b) & (c) of Section 3(1) of the Act on the grounds that the mark is a sign which may serve in trade to designate the kind or quality of the services

Objection was also taken under Section 5(2) of the Act as the mark was considered to conflict with the following earlier mark owned by Lombard North Central Plc of Lombard House, 3 Princess Way, Redhill, Surrey:-

Number	Mark	Class	Goods
2104685		36	Financing services; securing funds for others; banking services; telephone banking services; computerised banking services; credit and credit card services. Hire, rental and leasing of industrial plant, machinery and equipment; repair, maintenance and servicing of motor vehicles.

The cited mark was also applied for and accepted in Classes 35, 39 and 42 although these classes are not considered to be in conflict

At a hearing at which the applicants were represented by Mr Adrian Spencer of Grant, Spencer, Caisley & Porteous, their trade mark agents, the objections under Section 3(1)(b) & (c) and Section 5(2) were maintained. Following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of decision and the materials used in arriving at it.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Section 3(1)(b) & (c) of the Act reads as follows:-

3(1) The following shall not be registered -

- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in the trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of the goods or services.

The mark consists of words three ordinary dictionary words FIRST FOR FINANCE. The words “FOR FINANCE” have an obvious meaning as a statement that the type of services being provided are of a financial nature. They are words which are individually and collectively devoid of any distinctive character. The only remaining consideration is whether the word “FIRST” has individually, or in combination with the other words, a distinctive character. Collins English Dictionary (Third Edition Updated 1994) gives the following definition, inter alia:

First: **1.a.** coming before all others; earliest; best or foremost. **3.** rated, graded, or ranked above all other levels

This clearly indicates that the word “FIRST” is laudatory, and consequently, devoid of any distinctive character. I must of course consider the meaning of the mark in totality. It seems to me that the word “FIRST” in combination with “FOR FINANCE” simply exhorts that the service provider is pre-eminent in the field of finance. It is a collection of words which other traders may wish, and should be free to use in the course of trade, for example, TRY US FIRST FOR FINANCE”. It follows that the mark is debarred from prima facie registration by Sections 3(1)(b) & (c) of the Act.

Turning now to the objections raised under Section 5(2) of the Act, which reads as follows:

5 (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 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

The trade marks are not identical so the matter falls to be decided under sub-section (b) of Section 5(2).

Dealing first with the respective services. It is clear that the services contained within the specification of the earlier trade mark are identical or would cover the services contained within the specification of this application, and consequently the matter hinges on the question of the similarity between the respective marks.

The earlier mark is for the words “Lombard FIRST FOR FINANCE” in plain type, with a stylised letter “L” placed above. For convenience I have shown the mark below:



The applicants' mark is the words “FIRST FOR FINANCE” in plain type and in upper case and is clearly part of the earlier mark. It is, however, only one element and I have to consider if the totality “L - Lombard FIRST FOR FINANCE” is so similar to the mark of this application that there exists a likelihood of confusion on the part of the public.

At the hearing the agent argued that the marks were not similar in totality because there were other elements in the earlier mark which served to differentiate. The capacity of a house mark to distinguish two otherwise confusingly similar marks was considered in the BULOVA ACCUTRON trade mark case (1969) RPC 102 in which Mr Justice Stamp said at page 109 line 44 to page 110 line 8;

“Particularly having regard to the fact that BULOVA is the house name of the applicants and has a significance other than as a trade mark, its addition before the word ACCUTRON does not in my judgement serve to prevent the deception or confusion which would in the view of the Court of Appeal have been caused but for that adoption. As the Assistant Registrar remarks in his decision: “As BULOVA and ACCUTRON do not hold together as a phrase or present a wholly different meaning to the separate components, I think that their combination will be taken by many persons on first impressions as an indication that the manufacturer of the watches is using two separate trade marks in connection with his products”. I would add that the combination of the two words is likely to be taken by other persons on first impression as an indication that the part of the trade mark which consists of BULOVA is a house name of the marketers of the watches, that the trade mark is ACCUTRON and they will confuse them with watches marketed under the trade mark ACCURIST simpliciter.”

The combination of “Lombard” and “FIRST FOR FINANCE” does not hold together as a phrase or present a wholly different meaning to the separate components. If I am found to be wrong under Section 3(1)(b)&(c) of the Act, and the words “FIRST FOR FINANCE” are capable of distinguishing the goods of one trader, I think it likely that the public will assume that the applicants' mark and the earlier trade mark denote services from the same trader or traders connected in trade. On that footing, the applicants' mark is excluded from registration under Section 5(2)(b) of the Act.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) & (c) and Section 5(2) of the Act.

Dated this 20 day of October 1998.

MIKE FOLEY
For the Registrar
The Comptroller General