

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 11792
BY SAFRA S.A. FOR A DECLARATION OF INVALIDITY
IN RESPECT OF TRADE MARK No 2171538
IN THE NAME OF BANCO SAFRA S.A.

DECISION

1) Trade Mark No 2171538 “SAFRA” is registered with a specification of services which reads “Banking services such as sales credit financing and credit risk insurance, credit cards, financing services, exchanging money; credit agencies, safe deposit services, insurance business.” in Class 36. The mark stands registered from the filing date of 8 July 1998.

2) By an application dated 4 August 2000 Safra S.A. applied for a declaration of invalidity in respect of this registration. The action is brought under Section 47(2) (a) of the Act having regard to the applicant’s International Trade Mark M704454 for the word “SAFRA” and covering:

Class 14: “Ingots of precious metals, medals, coins.”

Class 36: “Banking transactions, financial operations, monetary operations, financial analysis, financial information, financial consultancy, financial management, brokerage, financing services, credit and loans, exchange transactions, credit card services, issuing of travellers’ checks, rental of safes”.

3) The applicant’s mark has an international priority date of 1 July 1998.

4) The registered proprietor filed a counterstatement acknowledging that the applicant is the proprietor of International Trade Mark No704454, and that an application was made to extend the protection of this mark to the UK based on the International priority date of 1 July 1998. The proprietor claims that the mark relied upon by the applicant is not an earlier mark because the proprietor’s mark was a well-known trade mark at the time of filing and is entitled to protection under the Paris Convention.

5) Both sides ask for an award of costs in their favour. Only the applicant filed evidence. By letter dated 21 May the Registry indicated that it felt that an oral hearing was unnecessary. The parties were invited to say whether they wished to be heard or in the alternative given six weeks to provide written submissions. Neither side asked for a hearing and only the applicant supplied a written submission. Acting on behalf of the Registrar and after a careful study of the evidence I give this decision.

6) The applicant filed a witness statement by Denis Soussi with exhibits DS1-3. I do not propose to offer a summary of this evidence but will draw on it and the applicant’s written submission as necessary in reaching my decision.

7) Section 47(2)(a) reads:

“(2) *The registration of a trade mark may be declared invalid on the ground -*

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, or

(b)

Unless the proprietor of that earlier mark or other earlier mark has consented to the registration.”

8) As the applicant’s International Trade Mark is clearly not identical to the mark in suit Section 5(2)(b) applies. This reads:

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 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.”

9) An earlier right is defined in Section 6, the relevant parts of which state

6.- (1) In this Act an ‘earlier trade mark’ means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b)...

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

10) The applicant’s International Trade Mark registration has a filing date of 1 July 1998. The mark is protected in the UK for the goods and services claimed under Classes 14 & 36. It is therefore, an earlier trade mark for the purposes of Section 5(2)..

11) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that: -

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods

/ services in question; *Sabel Bv v Puma AG* page 224, 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; *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;

(h) further, 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; *Marca Mode CV v Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

12) In the counterstatement the registered proprietor is silent as to the similarity of the services and trade marks. The applicant claims that the marks are similar and that the services are either identical or very similar.

13) The registered proprietor's mark has a Class 36 specification of "Banking services such as sales credit financing and credit risk insurance, credit cards, financing services, exchanging money; credit agencies, safe deposit services, insurance business." The applicant's trade mark is protected in the UK for "Class 36: "Banking transactions, financial operations, monetary operations, financial analysis, financial information, financial consultancy, financial management, brokerage, financing services, credit and loans, exchange transactions, credit card services, issuing of travellers' checks, rental of safes".

14) Clearly, in my view, there is a considerable overlap in the specifications. Certain of the services are identical, the others are very similar and are the types of services that one would expect a bank to provide. It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given

to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the goods or services for which it is registered, and any other relevant factors.

15) Both marks consist solely of the word SAFRA and as such are identical.

16) With all of this in mind I come to the conclusion that there was a likelihood of confusion at 8 July 1998.

17) The registered proprietor sought refuge under Section 56 of the Act claiming that their mark was entitled to protection under the Paris Convention as a well-known mark. Even if there was evidence that the registered mark was well known in the UK prior to 1 July 1998, this would not provide a defence to the application for invalidation. It would allow the registered proprietor to apply to oppose / invalidate the applicant's protection for its mark in the UK with effect from 1 July 1998. As the registered proprietor has not taken this action then the claim is irrelevant. Further, the registered proprietor has filed no evidence that the mark is well-known. The onus is clearly on the registered proprietor to make out a prima facie case if refuge is sought under this Section. Consequently, the application under Section 47(2)(a) succeeds. In accordance with Section 47(5) the registration will be declared invalid and deemed never to have been made.

18) The application for invalidity having succeeded the applicant is entitled to a contribution towards costs. I order the proprietor to pay the applicant the sum of £700. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10TH day of September 2001

George W Salthouse
For the Registrar
The Comptroller General