

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 740205
AND THE REQUEST BY E.ON AG
TO PROTECT A TRADE MARK IN CLASSES 1, 4, 35, 36, 37, 38, 39 AND 40**

AND

**THE OPPOSITION THERETO
UNDER No 70535 BY AON CORPORATION**

TRADE MARKS ACT 1994
in the matter of international registration No. 740205
and the request by E.ON AG
to protect a trade mark in classes 1, 4, 35, 36, 37, 38, 39 and 40
and the opposition thereto
under No. 70535 by Aon Corporation

1) On 3 July 2000 VEBA AG of Germany, on the basis of a registration held in Germany, requested protection in the United Kingdom for the trade mark **EON**. The international registration is now in the name of E.ON AG (EAG).

2) An international priority date of 16 March 2000 was claimed, based on the German registration.

3) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with article 10 in the Trade Marks Journal of 22 November 2000. The registration encompasses eight classes of the International Classification of Goods and Services. However, only the services encompassed by classes 35 and 36 of the International Classification of Goods and Services are the subject of this opposition. The services in these classes are, respectively:

advertising; business management; business administration; office functions;

insurance; financial affairs; monetary affairs; real estate affairs.

4) On 22 February 2001 Aon Corporation (AC) of the United States of America filed a notice of opposition to the granting of protection to the international registration in the United Kingdom.

5) AC states that it is the registered proprietor of the following trade marks:

- United Kingdom registration no 2003240 of the trade marks (being a series of two):



which is registered in respect of the following services in class 36 of the International Classification of Goods and Services:

insurance; insurance brokerage; insurance consultancy; insurance information; insurance underwriting

- United Kingdom registration no 2137557 of the trade marks (being a series of two):



which is registered in respect of the following services in class 36 of the International Classification of Goods and Services:

insurance; insurance brokerage; insurance consultancy; insurance information; insurance underwriting; actuarial services; financial planning, management, consultancy and administration; financial risk management; financial and economic surveys; asset management; mutual fund establishment; investment; investment management and investment strategies; marketing investment management

6) AC states that it has used the trade mark AON for the services covered by the above registrations extensively and for a considerable time and that the trade name and trade mark AON has established a reputation, particularly in the field of financial and business advisory and insurance services.

7) AC states that the trade marks AON and EON are phonetically identical – both being pronounced “ayon”. It also states that the *business management, business administration, insurance, financial affairs and monetary affairs* of the application are identical to the services of its registrations. Consequently, granting protection in the United Kingdom to the registration would be contrary to section 5(1) of the Trade Marks Act 1994 (the Act).

8) AC states that the trade marks AON and EON are phonetically identical – both being pronounced “ayon”. It also states that the *advertising, business management, business administration, insurance, financial affairs, monetary affairs and real estate services* of the application are identical to the services of its registrations. Consequently, granting protection in the United Kingdom to the registration would be contrary to section 5(2)(a) of the Trade Marks Act 1994 (the Act).

9) AC states that EON is similar to AON and that the services encompassed by classes 35 and 36 of the international registration are similar to those of its registrations. Therefore, granting protection in the United Kingdom to the registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

10) AC states that it has used its trade mark in the United Kingdom for some time in connection with financial services and as a consequence has obtained an extensive goodwill and reputation in its trade mark in relation to these services. Therefore, use of

the trade mark EON is liable to be prevented by the law of passing-off and granting protection in the United Kingdom to the registration would be contrary to section 5(4)(a) of the Act.

11) AC requests that the international registration is refused protection in the United Kingdom for the services covered by classes 35 and 36 and seeks an award of costs.

12) EAG filed a counterstatement. EAG denies the grounds of opposition of AC, in particular EAG denies that AON and EON are similar. EAG accepts that *insurance, financial affairs* and *monetary affairs* of its international registration are similar to the services encompassed by the registrations of AC. EAG denies that any of the other goods and services are similar.

13) EAG requests that the opposition is rejected and that the international registration is granted protection. It also seeks an award of costs.

14) A hearing on the opposition was held on 20 November 2002. EAG was represented by Mr Jones of Baker & McKenzie. AC was represented by Ms Himsworth of counsel, instructed by William Jones.

Evidence of Aon Corporation

15) This consists of a statutory declaration by John L Hill who is the company secretary of Aon Group Limited (AGL).

16) Mr Hill begins by giving a history of AC.

17) AGL is a subsidiary of Aon Corporation. AGL had a revenue of \$910 million in 2000 with 9,278 employees at 90 locations throughout the United Kingdom. Mr Hill describes it as the leading retail insurance and risk management provider in the United Kingdom with responsibility for 15-20% of the total Lloyds market premium. Mr Hill states that AGL is reinsurance broker to all United Kingdom composite insurers and a broker for 30% of the United Kingdom banking industry.

18) Mr Hill states that AON has been used in the United Kingdom in connection with insurance broking since May 1996. Reinsurance services were introduced into the United Kingdom under the AON trade mark in July 1997. Human capital consulting services were first offered to United Kingdom companies and clients in September 1997 and risk management services in May 1996.

19) Mr Hill states that AON has been used as a trade mark in the United Kingdom in respect of the following services:

insurance, insurance brokerage, insurance consultancy, insurance information, insurance underwriting, actuarial services, financial planning, management consultancy and

administration, financial risk management, financial and economic surveys, asset management, mutual fund establishments, investments, investment management and investment strategy, marketing investment management

20) Total value of services sold under the trade mark since the date of first use in the United Kingdom is £2,980.1 million.

21) The following annual figures for turnover in the United Kingdom are given:

	£m
1997	483.4
1998	537.1
1999	567.0
2000	660.7
2001	731.9

22) The total for promotion of services sold under the trade mark since 1997 is:

Advertising	£2,132,432
Promotional activities	£1,070,223
Conferences	£1,647,000
Sponsorship	£2,370,876
Corporate Gifts	£814,496
Corporate Hospitality	£2,481,195
Public Relations	£975,000

There has been television advertising. However, Mr Hill does not advise for how long the advertisements were run, in what regions the advertisements were seen or any other clear indicators as to the scale and penetration of the advertisements. The advertisements clearly advertise AON but it is not quite so clear as to the specific service that they are advertising. The advertisements also appear to be aimed at the businesses rather than individuals.

23) The evidence has not been tailored to the relevant date, 16 March 2000. It is as of this date that AC has to show goodwill or reputation to assist its objections. Owing to the blurring of the relevant date I have had some considerable difficulty in extracting from the large amount of evidence a clear conclusion. Passing-off is dependant upon establishing a goodwill as of the relevant date.

24) Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 stated:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima

facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 As qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

25) Professor Annand, sitting as the appointed person, in *Loaded* BL0/191/02, accepted that proof of goodwill could be accomplished by other means.

26) In *UK @ Work 2000*, part of exhibit JLH2, there is a description of Aon as follows:

"Aon provides insurance, reinsurance, wholesale and specialty brokerage; employee benefits and human resources consulting; personal lines insurance; warranty and credit insurance; and niche insurance services."

The actual document emanates from after the relevant date but it still seems to me to give a good indication of the business. Having carefully considered all the exhibits, in conjunction with the declaration of Mr Hill, I have come to the conclusion that AC has established that there was a goodwill in respect of the above services sold under the trade mark AON. I do not consider that any wider ambit of the goodwill is justified based upon the evidence. I am of the view that the evidence shows that AC's business is with businesses and professionals. The nature of the products and the type of customers shown in the evidence, are such that I consider that the products are bought as a result of a careful and educated purchasing decision by educated persons in a specialist field. The business is not about bog standard, general insurance products.

Evidence of E.ON AG

27) This consists of a witness statement by Stephen Francis Jones who is a partner at Baker & McKenzie Solicitors.

28) Mr Jones denies that EON and the trade marks of AON are similar. Mr Jones' deals with the co-existence of EON and AON in the United Kingdom without confusion having arisen.

29) There is no clear indication of use of EON in United Kingdom at all. Virtually all the evidence relates to the trade mark E.ON not EON. The references to EON are from Reuters Business Briefing. These references are to articles in various publications, they do not reproduce the articles as printed; so it is quite possible that the actual articles referred to E.ON not EON. There are articles dealing with the takeover of Powergen by E.ON. There is no indication that Powergen's name changed following the takeover. Anyway that is hardly relevant, there is nothing that indicates use in the United Kingdom

in relation to the financial or insurance services or the like, the services upon which AC have used their trade marks. That there has been no evidence of confusion, therefore, is not relevant. There has been no opportunity for confusion to arise. (It is also the case that even where similar goods or services are involved the absence of proven instances of confusion says little. If a customer is completely confused he would not be aware of the confusion, that is the nature of confusion. Even if he realised he had mistaken one undertaking for another why should he contact either undertaking after realising he had been confused?)

30) Mr Jones has supplied voluminous exhibits to support his claim that the respective trade marks have been used without confusion. As I have indicated they do not show use of the trade mark EON in relation to any services in the least related to those of AON and, therefore, have no bearing upon these proceedings.

31) Included in the exhibited material is the following:

“In June 2000, VEBA and VIAG became E.ON. The merged company ranks among the world’s largest investor owned energy service providers and is the world’s biggest specialty chemicals group. E.ON is also a new brand – a brand that’s already recognized by nine out of ten people in Germany. Each day last year, becoming E.ON was a big part of our lives. On each page of our 2000 Annual Report, you’ll find part of E.ON.”

32) It would appear that at the relevant date the trade mark E.ON had never been used in anger. (Of course the issue as to lack of confusion does not only relate to the relevant date as it is indicative of the perception of customers which is not necessarily dependant upon a particular date.)

33) Mr Jones then goes on to state that EAG owns three earlier international registrations with protection in the United Kingdom.

34) The earlier registrations are not for the trade mark EON; they are for the trade marks E.ON , e.on and



As they are for different trade marks I do not see how they can affect my deliberations. Also, I must consider the case on the facts before me in this particular case. The earlier registrations, therefore, do not have a bearing upon my findings.

35) Mr Jones then goes on to rely on rejections of oppositions against EON lodged by AC in Spain and Chile. I have to consider the case upon the basis of the evidence before me in the context of use in the United Kingdom. Decisions of other jurisdictions are not binding. They also do not assist me. They do not tell me what evidence was furnished by the parties. In the case of Chile and Spain, they also only relate to the perception of

Castellano speaks as to the similarity of the trade marks. I must consider the case on the facts before me, taking into account the conditions of the businesses of AC and EAG in the United Kingdom and how the average customer in the United Kingdom is likely to perceive the trade marks.

36) Unfortunately the evidence of Mr Jones, however voluminous, does not benefit the case of EAG.

Evidence of Aon Corporation in reply

37) This consists of a statutory declaration by Susan Wall who is a trade mark agent.

38) Ms Wall's declaration consists of a critique of the evidence of Mr Jones rather than evidence of fact. I take on board her comments in reaching my decision but will say no more about the evidence except in that it clarifies the extent of the opposition. In her declaration Ms Wall indicates that the opposition is only directed against the class 35 and 36 services of the international registration.

Preliminary issue

Relevant date

39) I have already touched upon the relevant date above. Section 35 of the Act deals with international priority claims. This part of the Act must be read in association with article 8 of the Trade Marks (International Registration) Order 1996 – however nothing turns upon this. The relevance of section 35, in this case, arises from the effects of section 6(1)(a) of the Act which states that an earlier trade mark means:

“a registered trade mark, international trade mark (UNITED KINGDOM) 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,”

To decide what is an earlier trade mark it is necessary to take into account the priority claimed. The corollary of this that if an international registration is under opposition the relevant date in dealing with the rights of the opponent is the date of the international priority claim of the application. Consequently, in this case the relevant date is 16 March 2000.

Decision

Grounds of opposition based on trade marks being identical – sections 5(1) and (5)(2)

40) Section 5(1) states that “a trade mark shall not be registered if it is identical with an earlier trade and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected”.

41) Section 5(2)(a) prohibits registration of a trade mark that “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” if “there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

42) Ms Himsworth submitted that the trade marks AON and EON are phonetically identical and so are identical in the terms of section 5(1) and 5(2)(a) of the Act. She based the claim on the evidence of Mr Hill, who stated that the two trade marks are phonetically identical. Mr Hill is not, as far as I can tell, an expert in the pronunciation of English. Ms Himsworth’s own dictionary definition of eon showed it pronounced as ee-on. AC’s own video pronounced AON as ay-on. My own view is that the words would be pronounced in these two ways, especially as eon is a dictionary word. I have never heard eon pronounced ay-on, the nature of the spelling would also be likely to militate against Mr Hill’s pronunciation. I do not consider the two trade marks are phonetically identical and so the basis of the claim to the trade marks being identical must fall. (I doubt that being phonetically identical is the same as being identical in the terms of sections 5(1) and 5(2)(a) of the Act. However, I have no need to consider this further as, on the basis of my finding above, nothing turns upon it.)

43) The grounds of opposition under section 5(1) and 5(2)(a) are dismissed.

Likelihood of confusion – grounds of opposition under section 5(2)(b)

44) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

“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.”

Section 6(1)(a), which is reproduced in paragraph 39, gives the definition of an earlier trade mark.

45) 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-Mayer Inc* [1999] RPC 117, *Lloyd*

Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723.

Comparison of goods

46) The European Court of Justice held in *Canon*, in relation to the assessment of the similarity of goods and/or services, that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

47) In considering the similarity of the services I bear in mind the words of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

48) I also consider it necessary to bear in mind the findings of the Court of Appeal in *Reliance Water Controls Ltd v Altecnic Ltd* [2002] RPC 34. The class in which goods or services are has to be taken into account. Consequently, the services of class 35 of the application cannot be identical to those of class 36 of the registrations; if they were identical they would be in the same class. As registration No. 2137557 includes all the services of registration No. 2003240 and more, I need only consider this registration.

49) The services to be compared are:

AC's registration

insurance; insurance brokerage; insurance consultancy; insurance information; insurance underwriting; actuarial services; financial planning, management, consultancy and administration; financial risk management; financial and economic surveys; asset management; mutual fund establishment; investment; investment management and investment strategies; marketing investment management – class 36

EAG's application

advertising; business management; business administration; office functions – class 35

insurance; financial affairs; monetary affairs; real estate affairs – class 36

50) AC has not put in any evidence to substantiate that the services in question are similar. Ms Himsworth did not advance any argument to show that the services are similar within the guidance set out in *Canon*.

51) In the absence of evidence as to the nature of the services under consideration I adopt the approach of Neuberger J in *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 and give the words their natural meaning subject to their being construed within their context.

52) The AON and the EON specification both include *insurance*, the respective services must be identical. EAG has accepted that *financial affairs* and *monetary services* are similar to the services of 2137557. I am of the view that all the services in the specification fall within the gamut of *financial affairs* and *monetary affairs*. In the absence of any specification or clarification of these general terms in the application, I must find that they encompass identical services.

53) Ms Himsworth conceded that *advertising services* of the application were not similar to the services of 2137557.

54) I view *business management* and *business administration* as being the day to day running of businesses for others. *Office functions* strikes me as taking place in a similar arena; supplying office services within an undertaking eg supplying administrative support. All the services of AC's registration relate to insurance and finance. They, in my view, have a different character and purpose. I cannot see how the respective services intersect. I would not replace advice over financial planning with a service that administers the running of an office, the services are not in competition therefore. I cannot see that they are complementary in any meaningful way, there is no symbiotic or mutually dependent relationship. The services might be supplied to the same persons or undertakings but that tells me little; equally a sandwich delivery service might be supplied to the same undertakings. In my view the key issue in relation to common end user is the nature of the service, it is this that defines the user. I cannot see that the services of *business management*, *business administration* and *office functions* and the services of registration 2137557 are similar within the guidelines set out in *Canon*. If I do not apply the rigour of case law I would feel intuitively that the services are not similar.

55) This leaves *real estate affairs*. Mr Jones characterised *real estate affairs* as being the buying and selling of properties and estate agency services. I consider this a reasonable view of the matter. I am at a loss to see where the services of AC's registration intersect with those of the application. In my view there is a clear divergence in the services.

56) I, therefore, find that *insurance, financial affairs and monetary affairs* of the application are identical to the services of the earlier registration. I also find that the other services are neither identical nor similar.

Comparison of trade marks

57) The trade marks to be compared are:

Earlier registration:



Application:

EON

58) AC's best case rests with the non-stylised AON and so I will consider just this trade mark.

59) Both Mr Jones and Ms Himsworth referred me to cases which they considered supported their contentions as to the similarity or absence of similarity of the respective trade marks. I consider that the cases referred to turned very much upon their own facts.

60) 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). 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). I take into account 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 Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* page 84, paragraph 27).

61) As I have already stated above I consider that the trade marks will be pronounced as ay-on and ee-on. In pronouncing the words I find that the emphasis falls upon the final syllable. Although the vowels at the beginnings of the words are pronounced differently I am not of the view that the difference is enormous. Aurally, I am of the view that there is a good deal of similarity between the two trade marks.

62) The letters A and E are not similar in appearance. I am of the view that the average consumer, despite the common letters at the end of the trade marks, will not view them as similar. He/she will view the marks in their entirety.

63) Eon, according to the dictionary, is the American spelling of the word aeon. This came as a surprise to me. Although someone who religiously eschews Americanised spellings and Americanisms at large, I have always spelt eon as eon, or aeon as eon!. As I am writing this the spell-check, which is for United Kingdom English, accepts eon but

shows aeon as an error. To complicate matters, the American Philip Roth in “Portnoy's Complaint” uses the aeon spelling. There are two spellings of aeon/eon. This places AON in the hinterland between the two. It also means that someone might remember EON as aeon, relying upon the conceptual association of the trade mark as the hook for his memory. I believe that this muddies the differences between AON and EON. (Ms Himsworth has not introduced new evidence with the dictionary reference she attached to her skeleton, Mr Jones exhibits at SFJ2 dictionary references for eon and aeon, which also include phonetic transcriptions.)

64) It has often been decided that short words can be differentiated by small differences. However, each case must turn upon its own facts. In this case, owing to the phonetic similarity, and taking into account the variant spellings of aeon/eon I consider that the trade marks EON and AON are similar.

65) It is certainly not determinative of anything, however, I would add that in referring to the trade marks verbally I have found myself substituting EON for AON and vice versa.

Conclusion

66) In considering whether there is a likelihood of confusion I have to bear in mind the closeness of the services, proximity of goods and services can compensate for a lesser degree of similarity in respect of the trade marks. In this case the services are identical or not similar; in the latter case there can be no finding of a likelihood of confusion. This is what the Act says, this is what the European Court of Justice said in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

I also have to bear in mind whether the earlier trade mark is particularly distinctive, whether intrinsically or because of the use made of it. AON for all intents is an invented word. It certainly does not allude to the services for which it is registered. I am of the view, consequently, that it AON enjoys a high degree of inherent distinctiveness.

67) Taking all these factors into account I find that there is a likelihood of confusion in respect of *insurance, financial affairs and monetary affairs* of the application.

Passing-off – section 5(4)(a)

68) According to section 5(4)(a) of the Act “a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented 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”.

69) The requirements for bringing a successful action for passing-off are goodwill, misrepresentation and damage.

70) For convenience I reproduce paragraph 26 below:

“In UK @ Work 2000, part of exhibit JLH2, there is a description of Aon as follows:

“Aon provides insurance, reinsurance, wholesale and specialty brokerage; employee benefits and human resources consulting; personal lines insurance; warranty and credit insurance; and niche insurance services.”

The actual document emanates from after the relevant date but it still seems to me to give a good indication of the business. Having carefully considered all the exhibits, in conjunction with the declaration of Mr Hill I have come to the conclusion that AC has established that there was a goodwill in respect of the above services sold under the trade mark AON. I do not consider that any wider ambit of the goodwill is justified based upon the evidence. I am of the view that the evidence shows that AC’s business is with businesses and professionals. The nature of the products and the type of customers shown in the evidence, are such that I consider that the products are bought as a result of a careful and educated purchasing decision by educated persons in a specialist field. The business is not about bog standard, general insurance products.”

71) So I accept that AC has established goodwill, within the parameters set out above.

72) Passing-off is not restricted by the concept of similarity of goods or services. However, neither does it give a blank cheque that a trader can use against all and sundry.

73) In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ states:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services”

74) In the same case Millet LJ states:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

75) In *Stringfellow v McCain Foods (G.B.) Ltd.* [1984] RPC 501 Slade L.J. said:

“even if it considers that there is a limited risk of confusion of this nature, the

court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

76) I am of the view, taking into account the above authorities, that AC could do no better under this ground than it has done under section 5(2)(b). The non-similar services are too far apart to “lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services”. Even the evidence in relation to “employee benefits and human resources consulting” shows use in consultation in such matters as pensions, a financial service.

77) In considering whether there would be a misrepresentation I have to bear in mind the nature of the goodwill of AC. As I have indicated the evidence supports a business that deals with products for businesses which will be carefully chosen. I am not considering the notional and fair use of the gamut of services for which AC has trade mark registrations. I am considering the services for which it has established a goodwill. The Court of Appeal in *BP Amoco PLC v John Kelly Ltd* [2002] FSR 5 held:

“We consider that it is a necessary ingredient of the tort that the customer is deceived into making the purchase by reason of the confusion engendered by the defendant’s use of a get-up similar to that of the plaintiff. As Lord Jauncey said in the *Jif Lemon* case at page 417, “Mere confusion which does not lead to a sale is not sufficient”.

78) In this case owing to the nature of the goodwill of AC I am not satisfied that it has established that a sale would be likely to take place. The difference in the trade marks, the nature of the services, the nature of the clientele, all these militate against such a finding. I accept that this case is not one about get-up, however, I feel that the principle still holds good. Any confusion would not survive the purchasing process.

79) I dismiss the grounds of opposition under section 5(4)(a) of the Act.

Outcome

62) AC has been successful in its opposition in respect of insurance, financial affairs and monetary affairs. The opposition fails in respect of the other services. Consequently, EAG should file, within one month of the expiry of the appeal period from the decision, a form TM21 to remove insurance, financial affairs and monetary affairs from the class 36 specification of the registration. If no form TM21 is filed within the period set protection will be refused to the registration in its entirety.

63) The specific services that were under attack were obscured by the statement of

case requesting the application to be refused, rather than just classes 35 and 36 to be refused. It was not until AC's evidence in reply was received that it was clear that only the class 35 and 36 services were under attack. However, the evidence of EAG would have had little weight if the entire specification had been the subject of the opposition. I consider that the inconvenience that AC was put through by considering the evidence of EAG is balanced by the inconvenience that EAG was put to by the lack of clarity of the scope of the opposition. AC and EAG have both been partly successful. Taking these factors into account I do not consider it appropriate to make an award of costs to either side.

Dated this 27 day of November 2002

D.W. Landau
For the Registrar
the Comptroller-General