

O-106-05

TRADE MARKS ACT 1994
AND

THE TRADE MARKS (INTERNATIONAL
REGISTRATION) ORDER 1996 AS AMENDED

IN THE MATTER OF INTERNATIONAL REGISTRATION
NO 752776 AND THE REQUEST BY GLOBAL
INVESTMENT SELECTION TO PROTECT A TRADE
MARK IN CLASS 36.

TRADE MARKS ACT 1994

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THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996 AS AMENDED

IN THE MATTER OF INTERNATIONAL REGISTRATION NO 752776 AND THE REQUEST BY GLOBAL INVESTMENT SELECTION TO PROTECT A TRADE MARK IN CLASS 36

BACKGROUND

1. On 5th April 2001, the World Intellectual Property Organisation ('WIPO') notified the United Kingdom of an international registration 752776, in the name of Global Investment Selection (the holder) for which protection was sought in the UK under the provisions of the Madrid Protocol. The details of the registration are as follows:



Specification:

Class 36

Banking, financial and monetary affairs, financial analysis, capital investment services, mutual funds, financial consulting, fund investments, financial operations, monetary operations, financial operations, electronic transfer of funds.

International registration date: 5th January 2001. This is the effective date for the purposes of this decision.

2. It was considered that the request failed to satisfy the requirements for registration in accordance with Art 3 of the Trade Marks (International Registration) Order 1996 as amended and under Art 9(3) of that Order, Notice of Provisional Total Refusal was sent to the holder via WIPO on 30th April 2001. Such a Notice is issued in accordance with Rule 17(1) and (2) of the Common Regulations under the Madrid Protocol. It constitutes a provisional notice, subject to final confirmation, against

which the holder is entitled to argue on provision of an address for service in the United Kingdom.

3. The ground of refusal was stated as being under section 5(2). Four marks were cited against the registration: Community trade marks: 1061217, 1614577 and 571364, and UK trade mark 2143623. Community trade mark 571364 has since been withdrawn and will not therefore be considered further. Full details of the remaining cites, and the class of services which were cited against the registration, are as follows:

CTM 1061217 OYSTER

In the name of : Transaction Systems Ltd

Class 35

Direct mail advertising; dissemination of advertising matter; market research; marketing studies; business management organisation advice, consultation and assistance.

Class 36

Banking, brokerage, insurance, custom brokerage, issuing of travellers' cheques, instalment loans, monetary exchange, factoring and guarantee services, lease purchase financing; lending against security; financing of loans, mortgages and sureties; real estate agency services.

Filing date: 1st February 1999

CTM 1614577 MY OYSTER

In the name of: myOyster plc

Class 35

Advertising; business management; business administration; office functions; professional business consultancy services; provision of business information; organisation of exhibitions for commercial advertising purposes; market research; all of the aforesaid services relating to career management services, recruitment services, vocational guidance services, executive search services, management selection services, management consultancy services and employment agencies; personnel management consultancy services; personnel recruitment services; employment agencies; personnel management consultancy services.

Filing date: 17th April 2000

UK 2143623 OYSTER

In the name of: Transaction Systems Ltd

Class 35

Direct mail advertising; dissemination of advertising matter; market research; marketing studies; business management organisation advice, consultation and assistance.

Class 36

Banking, brokerage, insurance, custom brokerage, issuing of travellers' cheques, instalment loans, monetary exchange, factoring and guarantee services, lease purchase financing; lending against security; financing of loans, mortgages and sureties; real estate agency services.

Filing date: 2nd September 1997

4. Attorneys based in the UK were subsequently appointed by the holder within the period notified in the provisional refusal to contest that refusal. They wrote on 26th September 2001 notifying the registry of their interest.

5. Between September 2001 and February 2004 successive extensions of time were requested and granted, in which the attorneys in the UK acting for the holder notified the office of negotiations between the holder and the representatives of the owners of the cited marks, with a view to settlement and consent. I note in passing that the question of whether there was indeed a likelihood of confusion under section 5(2) was not raised by the attorneys during this time. A final extension up to 28th February 2004 was granted by letter of 19th December 2003. No response was made by the deadline.

6. A standard letter of refusal was sent to the attorneys on 2nd February 2005 telling them that they had one month from that date in which to appeal against the original provisional refusal, in which case a statement of grounds explaining the reasons for the refusal would be provided. Otherwise, final refusal would be notified to WIPO. The attorneys duly requested a statement of grounds.

DECISION

7. Although broadly stated as section 5(2) in the preliminary refusal letter, the ground of refusal is, more precisely, section 5(2)(b) of the Act which reads:

“5.-(2) A trade mark shall not be registered if because -

(a)

(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.”

8. An earlier right is defined in section 6 of the Act, 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,”

9. All of the earlier trade marks on which the examiner relies are registered and comprise “earlier trade marks” as defined by Section 6(1) of the Act.

10. In reaching my decision I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & 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 the relevant factors: *Sabel BV v. Puma AG*;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* who is deemed to be reasonably well informed and 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 B.V.*;

(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*;

(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*;

(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-Mayer Inc*;

(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*;

(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*;

(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*;

(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-Mayer Inc*.

11. I should add that in my view it is correct to add, as the appointed persons do occasionally (eg BL O-079-05 CARSMART para 16), that the test under section 5(2) is a “single composite question”. In the CARSMART case Richard Arnold QC, sitting as appointed person, said:

“Answering this single composite question involves (inter alia) making an assessment of the degree of distinctiveness of the earlier mark and an assessment of the degree of similarity of the respective goods or services in order to arrive at an overall assessment of the likelihood of confusion.”

12. I propose to adopt his approach, bearing in mind of course the rather more detailed guidance from the ECJ set out above.

Assessment of the degree of distinctiveness of the earlier marks

13. Community registration 1061217 and UK registration 2143623 are ‘oyster’ solus marks, whilst Community registration 1614577 only differs in that the word ‘my’ precedes ‘oyster’. It is hard to regard any of these marks as other than highly distinctive for the services. Whilst not being at the highest end of the scale, which would, in my view, be occupied by invented words, these marks are not far behind in terms of distinctiveness. That is to say, that the word ‘oyster’ has no clear descriptive, or even plainly allusive, meaning in relation to financial services. The only allusion one may draw is the fact that oysters are of course capable of keeping safe something of considerable value, pearls, which could well be the parallel the users of such a mark in relation to financial services are seeking to get across.

14. In my view, ‘oyster’ for financial services is a good, strong, highly distinctive trade mark. This finding carries through into my overall assessment of likelihood of confusion below.

Assessment of the degree of similarity of the respective services

15. The best case for refusal lies with the class 36 services specified in CTM 1021617 and UK 2143623, which are the same for each. In terms of scope, I regard the services specified in these two cited marks as being wholly contained within the specification of the mark in suit. It could be argued that the much vaguer terms used in the specification of the mark in suit, specifically: “financial and monetary affairs”, “financial analysis”, “financial consulting”, “financial operations” and “monetary operations”, potentially extend the scope of the mark in suit into services which would not be identical, or even similar to those covered by the two cited marks.

16. The point has not been argued and I think it would be a dangerous road to do the holder’s job of putting clear water between his specification and that of the cited marks. In effect, I am unwilling to reward the holder for the vagueness of the terms of his specification. The fact is that both cited marks contain the broad terms “banking” and “brokerage”. Within those broad services one may expect, eg “financial consulting” to be offered as part of the package, complementing or ancillary to the core provision.

17. I thus conclude that all services specified in CTM 1021617 and UK 2143623 are identical to those in the subject registration. If, and to the extent that, the subject registration is broader in scope than the cited marks, then all such further services are similar to those of the cited marks.

18. I carry this finding through to my overall assessment of likelihood of confusion below.

Likelihood of confusion with CTM 1021617 and UK 2143623

19. The registration comprises the word 'oyster' plus device. However, it is well established trade mark law that words speak louder than devices (see eg *Oasis Stores Ltd's Application [1998] RPC 631*). In terms therefore of the recollections of the average consumer, who admittedly in this case is going perhaps to be more than reasonably circumspect, the (highly) distinctive and dominant element of the earlier marks CTM 1021617 and UK 2143623 will inevitably be the word 'oyster'. This must especially be the case where the device element cannot easily be described, eg a consumer recalling the source of a financial service by reference say to a 'Black horse', rather than the name Lloyds/TSB. The device used in the registration is far from being so recognisable.

20. Thus, visually, aurally and conceptually all the earlier marks and the registration are all but identical. This is not to say that the device element can be ignored, but the effect of such an element on the average consumer, within the totality of the mark, would not, in my view, be nearly enough to lead them to conclude that different operators were providing the services.

21. Taking account of my assessments above, comparison of the respective marks and following the guidance of the ECJ, I conclude that the examiner was correct in his preliminary refusal. Protection in the UK must therefore be refused on the basis of section 5(2)(b) in relation to the earlier trade marks CTM 1021617 and UK 2143623.

22. I make no such finding in respect of CTM 1614577 the 'My Oyster' mark as I do not believe the issues are quite so clear cut; for one thing the services covered are not so close.

23. In this decision I have considered all the documents filed by the holder in relation to the international registration and, for the reasons given, it is refused under the terms of Articles 3, 9(3) and 11(5) of the Trade Marks (International Registration) Order 1996 (as amended) because it fails to qualify under section 5(2) of the Act.

Dated this 21st day of April 2005

**Edward Smith
For the Registrar, the Comptroller-General.**

