

O/021/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2454954
BY THE CHARTERED INSTITUTE FOR SECURITIES AND INVESTMENT TO
REGISTER THE TRADE MARK**

CISI

IN CLASSES 9, 16 AND 41

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 101259
BY CSI GLOBAL EDUCATION INC**

BACKGROUND

1) On 27 April 2010, The Chartered Institute of Securities and Investment (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark CISI in respect of the following goods and services:

Class 9

Magnetic data carriers, recording discs; CDs; videos; tapes; recordings of sound or images; software and data relating to securities, investment management, corporate finance, derivatives and related businesses; calculators; computers; teaching apparatus; downloadable electronic publications; downloadable website pages.

Class 16


Books; printed matter relating to securities, investment management, corporate finance, derivatives and related businesses; photographs; stationery; instructional and teaching material; playing cards.

Class 41

Education; providing of training; publication of books; arranging and conducting of conferences, seminars, symposiums and workshops; production of radio and television programmes; videotape film production; education information; all relating to securities, investment management, corporate finance, derivatives and related businesses.

2) The mark was published in the Trade Marks Journal in 10 September 2010 and on 3 December 2010, CSI Global Education Inc (“the opponent”) filed notice of opposition to the application. The ground of opposition is that the application is in respect of a mark that is similar to two earlier marks belonging to the opponent and in respect of identical, or at least highly similar services. Further, the goods listed in the application are highly similar to the services covered by the opponent’s earlier marks. Consequently, the application should be refused pursuant to Section 5(2)(b) of the Act.

3) The two earlier marks relied upon are in respect of identical marks and services. This mark and list of services, together with other relevant details are shown below:

Earlier marks and relevant details	List of services
<p>Application nos. 2545193 and CTM*9037391</p>  <p>Relevant dates for 2545193: Filing date: 19 April 2010 Registration date: 10 September 2010</p> <p>Relevant dates for CTM9037391: Filing date: 19 April 2010 Registration date: 2 November 2010</p>	<p>Class 41: <i>Educational services namely developing and providing courses, examinations, seminars and workshops; granting educational accreditations in the field of financial services.</i></p>

4) The opponent's marks are earlier marks as defined in Section 6 of the Act. Further, they are not subject to the proof of use provisions because, at the date of publication of the contested application, they had not been registered for five years. Therefore, the provisions set out at Section 6A of the Act do not apply.

5) The applicant subsequently filed a counterstatement. Whilst it concedes that some of the respective services are either identical or similar, it claims that the differences between the marks are such as to render negligible the similarities in the services.

6) Both sides filed evidence in these proceedings and both sides ask for an award of costs. The matter came to be heard on 7 December 2011 when the opponent was represented by Fiona Clark of Counsel, instructed by Rapisardi Intellectual Property and the applicant represented by Amanda Michaels of Counsel, instructed by Bircham Dyson Bell LLP.

Opponent's Evidence

7) This takes the form of an affidavit by Dr Roberta Wilton, President of the opponent. Dr Wilton states that the opponent company was founded in Canada in 1970 and provides training to the financial sector, offering more than 170 courses. Company information about the opponent appearing on the *Bloomberg Businessweek* website is provided at Exhibit RW1. The extract confirms the

company information provided by Dr Wilton and provides a business address in Toronto, Canada.

8) Dr Wilton explains that the opponent partners with organisations world-wide and its courses partially satisfy requirements for registration categories within the securities industry for the UK, in particular the Financial Services Authority (“FSA”) and the opponent runs exam sittings in London once a month. At Exhibit RW3 is an extract from the appendix to the Final Handbook Text of the FSA Training and Competence Sourcebook. This lists the qualifications recognised by the FSA and includes a number of courses where the provider is listed as “Canadian Securities Institute”. In the UK, certain of the opponent’s examinations and some of those of the applicant “are considered by the regulator to be generally equivalent, though treated slightly differently”.

9) Dr Wilton states that the average consumer of both parties’ products is individuals in the financial profession, other institutes, regulators and firms in the financial sector. Whilst the parties have been known to each other, this was not an issue until the applicant rebranded and sought to register the mark CISI.

10) Dr Wilton provides exhibits, mainly relating to Canada, illustrating that the opponent is known and referred to as CSI and has been since at least 1970.

11) At Exhibit RW5, extracts from the opponent’s website are provided showing some of its study tools and include practice exams, downloadable MP3 audio books, calculators and e-tutorials. The extract is dated 28 February 2011 and all prices quoted are in dollars.

12) At Exhibit RW6 is a list from *Omniture* showing the number of visits to the opponent’s website from the UK between January 2010 and March 2011. A total of 6,276 visitors is shown, usually in the region of 400 – 500 visits a month.

13) Dr Wilton also provides a number of submissions that I will not detail here, but I will keep them in mind.

Applicant’s Evidence

14) This takes the form of an affidavit, dated 6 July 2011, by Simone Culhane, Chief Executive of the applicant. He explains that the applicant is a Royal Charter company and a charity in England, Wales and Scotland. As a professional body, it has more than 42,000 members in 89 countries, with about 36,000 of these being in the UK. It began using the domain name *cisi.org.uk* in July 2008 and it took over the operations of its predecessor after its Royal Charter was granted in October 2009 and referred to itself by the abbreviation for Chartered Institute for Securities and Investment, namely CISI. It is the largest membership body for individuals working in the financial services sector in the UK.

15) Mr Culhane states that the applicant works closely with the FSA who ensures that qualification bodies are clearly identified and that there is no confusion between the providers of the qualifications. At Exhibit SC7, Mr Culhane provides an extract from an Internet search using the *Google* search engine. It shows the first two pages of search results for “CISI”. It shows a number of third parties referring to the applicant by this acronym.

16) Mr Culhane states that its members operate in a sophisticated market and as such the parties’ marks will be identify the differences between the marks.

17) He also provides information regarding the number of visits to the applicant’s website from November 2009 and May 2011. These figures are in generally in the region of 200,000 to 300,000 page hits per month.

Opponent’s Evidence in reply

18) This takes the form of a second affidavit, dated 4 August 2011, by Dr Wilton. She discusses future plans regarding an expansion of the opponent’s business in the UK and links between the respective parties and how they have both developed from providing services to their respective home markets to operating in a global market. As a result of the high similarity between the respective businesses, they are often in competition with each other.

DECISION

Section 5(2)(b)

19) Section 5(2)(b) reads:

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

(a) ...

(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.”

20) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) 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 B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v.*

Thomson Multimedia Sales Germany & Austria GmbH C-120/04 and Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO). 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*,
- (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 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 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) 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*,
- (i) 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 and Adidas Benelux BV*,

(j) 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.*

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

Comparison of goods

21) It is common ground between the parties that *Education; providing of training; [...] ; arranging and conducting of conferences, seminars, symposiums and workshops; [...] all relating to securities, investment management, corporate finance, derivatives and related businesses* in the applicant's Class 41 specification are identical services to the opponent's *Educational services namely developing and providing courses, examinations, seminars and workshops* insofar as they relate to *securities, investment management, corporate finance, derivatives and related businesses*. This identity of services presents the opponent with its greatest opportunity for success and if its opposition does not succeed in respect of these services, it will not succeed in respect of the remainder of the applicant's goods and services. Consequently, I will go on to consider the case within the context of these services only.

The average consumer and nature of the purchasing act


22) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods and services at issue.

23) No evidence has been presented on this issue, but it is an issue where there is a significant point of difference between the parties. Ms Clark submitted that the respective goods and services are wide ranging and include goods and services where the level of consideration is minimal. By way of illustration, she submitted that the *educational services* contained in the opponent's earlier mark could include basic courses for school children and in such a case, a low level of attention involved in the purchasing process. I am unconvinced by the example

used by Ms Clark. It is true that the opponent's *educational services* are unlimited and, as such, includes such basic courses. However, the applicant's corresponding services are limited to what is, in essence, specialist financial fields where the purchasing act will be well considered and the consumer of such services is likely to be those in the financial industry who wish to obtain specialist sector qualifications. Consequently, in respect of the overlap of services in the parties' respective specifications, the consumer will be specialist and will have a considered approach when purchasing such services. I do not accept that education and training in such specialist subject matter will be targeted at people who previously had no experience or knowledge of the financial industries and certainly not at school children. As Dr Wilton states in her own evidence, the average consumer of both parties' products are financial professionals, other institutes, regulators and firms in the financial sector. Whilst her comments were made in the context of the actual market position and not based on the notional list of goods and services, it is nevertheless relevant as the overlap between the respective services is in this specialist area only as evidenced by the applicant's limitation present in its Class 41 specification.

Comparison of marks

24) For ease of reference, the respective marks are:

Opponent's trade mark	Applicant's trade mark
	<p style="text-align: center;">CISI</p>

25) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23).

26) Considering the dominant and distinctive components first, in respect of the applicant's mark, it consists of only one component, namely the acronym CISI. It therefore follows that this is the dominant and distinctive component.

27) In respect of the opponent's mark, this consists of the letters CSI appearing in a shaded circle that is, itself, encapsulated by a further outer circle, the outline of which is broken into dashes over about a third of its circumference. Whilst I do not agree with Ms Clark's submission that the additional matter is negligible, it is true that the dominant and distinctive part of the opponent's mark is the acronym CSI. The device element also plays a part as it alludes to some sort of countdown clock and is more than a mere background. Such an allusion has no

relationship with the type of services provided by the opponent and therefore, it is not likely to go unnoticed by the consumer.

28) Turning to the comparison of the marks, from a visual perspective, the letters CSI dominate in the opponent's mark with all the letters appearing in the same order in the applicant's mark CISI. Ms Clark submitted that the additional letter "I" in the applicant's mark merely comprises a thin line that does not attract the eye like the letters "C" and "S". There is some force to this, but this is negated to a greater degree because, firstly, the letter elements of both marks are short in nature, one being three letters, the other four. The GC in *Inter-Ikea Systems BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T - 112/06* commented on this issue as follows:

"54 As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter 'd' in the contested mark and the letter 'k' in the earlier word marks. However, the Court has already held in Case T-185/02 *Ruiz-Picasso and Others v OHIM – DaimlerChrysler(PICARO)* [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them."

29) Whilst Ms Michaels, when sitting as the Appointed Person in BL O-387-11 *BOO BOO trade mark*, cautioned about applying these comments of the GC as a general principle, it is my view that in the current case the addition of the letter "I" does have an impact upon the visual comparison of the marks. This is especially so in short acronyms, where the visual impact of individual letters is heightened because the consumer is alert to each letter representing a word. Taking all of this into account, I conclude that the respective marks share a moderate level of visual similarity.

30) From an aural perspective, both marks being acronyms, each individual letter is likely to be pronounced. Consequently, the opponent's mark will be pronounced as the three syllables SEE-ES-EYE and the applicant's mark as the four syllables SEE-EYE-ES-EYE. Clearly there is similarity arising from all three syllables in the opponent's mark being present, and forming three quarters of the applicant's mark. Whilst I do not accept Ms Clark's submission that the stress will be placed upon the end of the respective marks highlighting the common "SI" elements, the marks nonetheless share a reasonably high level of aural similarity.

31) Conceptual, both marks will be perceived as acronyms, but this is as far as any conceptual similarity extends and the parties are in agreement that neither mark brings any concept to mind. I conclude that the marks are will generally be perceived as being neither conceptually similar nor dissimilar.

32) To summarise, I have found that the marks share a moderate level of visual similarity, a reasonably high level of aural similarity and that, conceptually, they are neither similar nor dissimilar. Taking all of this together, I conclude that the respective marks share a moderate level of similarity overall.

Distinctive character of the earlier trade mark

33) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

34) The inherent level of distinctive character of the opponent's mark is moderately high because of its visual impression created by the combination of the circular device element and the acronym CSI.

35) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

36) The opponent's evidence illustrates that its examinations are held, in London, once a month in respect of requirements for registration categories in the securities industry. A close inspection of the exhibits shows that these, in the main, relate to Canadian securities. However, there is no information regarding the scale of this use, the length of use in the UK, how well known it is in the relevant field or the level of sales in the UK. As such, I am unable to conclude that the distinctive character of the opponent's mark has been enhanced through use.

Likelihood of confusion

37) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

38) Whilst both parties made much of their respective positions in the market, I am mindful that I must conduct an analysis based upon normal and fair use of the respective marks based upon the respective lists of goods and services (*Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41). At the hearing, both Ms Clark and Ms Michaels acknowledged that this is the correct approach. In this respect, I note that the opponent's specification covers a broad range of education services and that, at least in respect of the parties' education services they are identical.

39) I have also noted that the marks share a moderate level of visual similarity, a reasonably high level of aural similarity and that they are conceptually, neither similar nor dissimilar. I have concluded that this combines so that the respective marks share a moderate level of similarity overall. I have also found that the average consumer, at least as far as the identical services are concerned, is a specialist who will have a considered approach to the purchase of the services.

40) Ms Clark submitted that imperfect recollection is a factor and that whilst acronyms may be common in field of finance, the average consumer is not so limited here. This is true, however, where the respective services overlap, it is in this specialist field. Ms Clark also submitted that because the mark CSI has a high level of distinctive character, the marks are "close" and identical services are involved, there is a clear case of confusion. She further contended that there is no conceptual hook to dispel the aural and visual similarity in the minds of the consumer.

41) I note this argument, but I am unconvinced. The dominant and distinctive part of the opponents mark is an acronym and the applicant's mark consists of an acronym. Whilst I acknowledge the similarities between these two marks, in general terms, the consumer is familiar with the concept behind them, namely that each letter represents a word. Letters in acronyms therefore have a higher

level of importance in the minds of the consumer than may be the case in ordinary words. This is particularly so where the acronyms concerned consist of a small number of letters. Consequently, the consumer will also be alert to the differences between the marks. In addition, the opponent's mark contains the device element that will impact upon the consumer as being more than a mere background. Consequently, small differences between short acronyms are not likely to go unnoticed by the consumer and the addition of a further letter to an acronym will give rise to a difference that will be immediately noticed. This is particularly so in this case where the considered purchasing act mitigates against any imperfect recollection.

42) Ms Clark's submitted that the fact that there has been no actual confusion to date is not determinative because of the low level of use in UK by applicant and that its actual use is in a form that is arguable more distinctive than the form applied for. I accept this point is not determinative. Nevertheless, in conducting an assessment of the likelihood of confusion, taking account of all the relevant factors including, in particular, the consumer's perception of acronyms, imperfect recollection, the nature of the purchasing act and the identical services involved, I find that there is no likelihood of confusion.

Applicant's Intention to seek to invalidate the opponent's earlier mark

43) There is one further issue that I must comment upon. The applicant notified the Registry, in writing a week before the hearing, that if it did not successfully defend the opposition proceedings that it intended to lodge an invalidation action against the opponent's earlier mark. Whilst it did not detail on what grounds it intended to do, the matter has become somewhat academic, as I have found that the opposition has indeed failed. Under the circumstances, I do not need to comment further on this issue.

COSTS

44) The opposition having failed, The Chartered Institute of Securities and Investment is entitled to a contribution towards its costs. I take account of the fact that a hearing has taken place. I award costs on the following basis:

Considering Notice of Opposition and statement	£200
Statement of case in reply	£300
Preparing and filing evidence	£500
Considering evidence	£250
Filing written submissions	£400
TOTAL	£1650

45) I order CSI Global Education Inc to pay The Chartered Institute of Securities and Investment the sum of £1650. This sum is 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 24th day of January 2012

**Mark Bryant
For the Registrar,
the Comptroller-General**