

O-270-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2655215
BY
KEYSTONE WEALTH MANAGEMENT LIMITED**



**TO REGISTER THE TRADE MARK
IN CLASS 36**

AND

**THE OPPOSITION THERETO
UNDER NO 400918
BY
KEYSTONE IEA LIMITED**

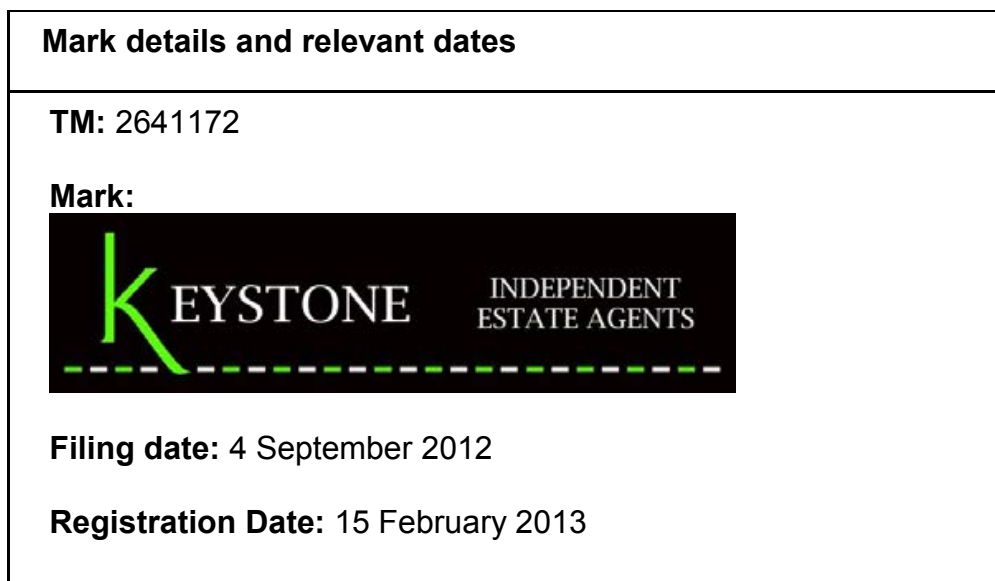
BACKGROUND

1. On 6 March 2013, Keystone Wealth Management Limited (the applicant) applied to register the above trade mark in class 36 of the Nice Classification system.¹ The specification stands as follows:

Mortgage & Protection Advice, Financial Services

2. Following publication of the application, on 5 July 2013, Keystone IEA Limited (the opponent) filed notice of opposition against the application.

3. The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon the mark shown below:



4. The opponent's mark is registered in class 36 for the following services:

Estate Agents

5. On 24 May 2013, the applicant filed a counter statement. It denies the grounds upon which the opposition is based. It states:

"8. In Keystone IEA Ltd's opposition they have stated that they offer financial services as part of their company but their website does not state these services whilst ours does. They are simply an estate agency which is exactly what they have trademarked and nothing more. Therefore what they have trademarked (Estate Agents) is not similar to the goods and services that we provide (Mortgage and Protection Advice, Financial Services)."

6. Neither party filed evidence or submissions in lieu of a hearing; neither party asked to be heard.

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

DECISION

7. The opposition is brought under section 5(2)(b) of the Act which reads as follows:

“5. - (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, or 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 trade mark 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 or international trade mark (EC) 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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. The opponent's mark is an earlier mark, which is not subject to proof of use because, at the date of publication of the application, it had not been protected for five years.²

Section 5(2)(b) case law

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

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] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal*

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

11. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

12. In making a finding with regard to the average consumer of the services at issue, I must consider the specification as published. The specification is for mortgage and protection advice and financial services. This will include services offered to members of the public as well as specialist services offered to business customers and commercial enterprises. Accordingly, I conclude that the average consumer may be a member of the general public or a professional (individual or organisation).

13. In reaching such a conclusion I bear in mind the comments in *Adelphoi Limited v DC Comics (a general partnership)*³, when Prof Ruth Annand (sitting as the Appointed Person) stated:

“21. As for the services, e.g., broadcasting, whilst I agree with Mr. Malynicz that the average consumer would include business consumers or professionals as well as the general public, the likelihood of confusion must be assessed in relation to the part of the public whose attention is lower (see e.g., Case T-448/11, *Golden Balls Ltd v. OHIM*, 16 September 2013, para. 26), although in any event, the Hearing Officer relied on an average consumer (reasonably well informed and reasonably circumspect and observant) paying an average level of attention (para. 41).”

14. The nature of the purchase is likely to be visual or aural, the average consumer encountering the services and trade marks on the internet, in a catalogue or product literature, through advertising or at the point of purchase such as in store or as a result of one-to-one financial advice. It is likely that enquiries may be made or advice sought, prior to or during the purchase of such financial products. In accordance with *Adelphoi*, the level of attention paid must be assessed from the point of view of a member of the general public and will vary according to the nature of the services. Withdrawing a small amount of money from a bank will demand a lower level of attention to be paid than signing for a mortgage, but, taking in to account the nature of the services, which are financial, the level of attention paid will always be at least reasonable.

³ BL O/440/13

Comparison of services

15. The services to be compared are as follows:

The opponent's services	The applicant's services
Estate Agents	Mortgage & Protection Advice, Financial Services

16. In comparing the services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

17. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*⁴ (hereafter *Treat*) for assessing similarity between goods and services:

- (a) the respective *uses* of the respective goods or services;
- (b) the respective *users* of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

18. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court commented:

“96...goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may

⁴[1996] R.P.C. 281

think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (*Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

19. The comments of Daniel Alexander, sitting as the Appointed Person, in *LOVE*⁵, which dealt with similarity of goods but by analogy is relevant to similarity of services, are also to be borne in mind:

“18... the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

20. Where appropriate I will, for the purposes of comparison, group related services together in accordance with the decision in *Separode Trade Mark*⁶:

“5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

21. When considering the parties services I am mindful of the decision in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, in which Jacob J stated:

“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 meaning attributable to the rather general phrase.”

22. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

“In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

23. I will also bear in mind Floyd, J’s statement in *YouView TV Ltd v Total Ltd*:⁷

“...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of

⁵ *BL O/255/13*

⁶ *BL O-399-10*

⁷ [2012] EWHC 3158 (Ch) at [12]

Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

24. In its statement of grounds the opponent submits:

"We are an estate agent who offer financial services as part of our company."

25. I have no further submissions or evidence before me to indicate what form these financial services might take, nor to provide any indication of the type of financial services offered by the applicant.

26. Estate agents arrange the selling, management and rental of properties and land (estates). In my experience it is not uncommon for an estate agent to arrange a mortgage on behalf of a buyer and/or to offer advice in respect of related life and buildings insurances. The applicant's specification in class 36 includes the term 'mortgage and protection advice'.



27. Both parties' services may be used by members of the public or professional individuals/companies and enable one to borrow money for the purchase of real estate. The trade channels for these services will likely overlap. The parties act as brokers ensuring that the purchaser has access to the mortgage which meets their individual or business requirements. Consequently, the mortgage providers may be same. Similarly, the associated protection services such as life insurance and buildings insurance may be provided by the same lenders. The services are in competition in so far as the average consumer could seek a mortgage through their estate agent or a third party financial advisor. Taking all of these factors into account these services are highly similar.

28. The remaining term in the application is 'financial services'. This is a very broad term which covers a wide range of services. In accordance with Avnet, the core meaning of the services is that they are all in some way related to money. There will be a degree of similarity between these services and those of the opponent in circumstances where they are services which are related to the selling, purchasing or renting of real estate. Mortgages are included within financial services as well as a number of other services such as insurances relating to property.

29. Clearly, within such a broad term there will also be a number of financial services which are unrelated to the opponent's estate agency services. For example services such as, inter alia, banking, pensions, hedge-fund management may be similar to a low degree or dissimilar to the opponent's services in class 36.

Comparison of marks

30. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
	

31. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁸, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

32. The opponent's mark consists of the word 'KEYSTONE' followed by the words 'INDEPENDENT ESTATE AGENTS'. The words are presented on a black rectangular background and are placed above a dashed line. The dashes are coloured alternately green and white. It is presented in a standard serif type face in upper case. The letter 'K' at the start of the mark is enlarged and coloured green with its leg descending to touch the dashed line below the words. The stylization of the letter 'K' does not prevent the word from being seen as the word 'KEYSTONE'.

33. The dashed line is decorative and is unlikely to be given any trade mark significance by the average consumer. The words 'INDEPENDENT ESTATE AGENTS' describe the nature of the services being provided and are non-distinctive. The word 'KEYSTONE' is the first word of the mark and is the dominant and distinctive element of the applicant's mark.

34. The applicant's mark consists of three elements. The first is a circular device made up of a yellow section to the left and a red section to the right. A slight shadow of the device can be seen reflected below it in pale grey. It is the first part of the mark, being placed before the words which accompany it. This is followed by the word KEYSTONE, which is the largest word of the mark and is presented in a standard serif font in block capitals. It rests on a line which fades as it approaches the circular device at the start of the mark. Below the line, also in capitals, are the words 'WEALTH MANAGEMENT LTD'. These are considerably smaller than the word KEYSTONE and are placed below it. The 'W' of 'wealth' falling below the 'Y' of KEYSTONE.

⁸ *Sabel v Puma AG, para.23*

35. The circular device is a distinctive element of the mark and has a prominent position within the mark as a whole. However, the word 'KEYSTONE' is also a distinctive element and is the part of the mark which will be articulated.

36. The words 'WEALTH MANAGEMENT LTD' simply describe a type of company which provides 'wealth management'. It is non-distinctive for the services at issue and would be afforded no trade mark significance by the average consumer.

37. There is a general principle that words in trade marks "speak louder" than devices which, whilst not a rule of law, is an important factor to be kept in mind. In my view, the word 'KEYSTONE' is a distinctive element and the dominant element of the applicant's mark.

Visual similarities

38. The opponent states that the applicant's mark "*looks similar and uses an almost identical font*".

39. The applicant states:

"[The opponent's] logo uses the colours green, white and black whilst [the applicant's] logo uses red, yellow, grey and white. Whilst the font could be construed as similar the layout and wording of each logo do not imply that they are the same company or provide similar services."

40. The colouring in the words does not have a bearing on the issue of similarity as neither party's mark is limited to any particular colour. The matter must be assessed on the similarity between the respective marks without regard to colour.⁹

41. The visual similarity between the marks rests in the common word, which is the dominant and distinctive element of both, namely the word 'KEYSTONE'. The applicant's mark also includes the circular device which will not go unnoticed in the mark as a whole. Taking all of these factors into account, I find the degree of visual similarity to be fairly high.

Aural similarities

42. Both marks will be articulated as the word 'KEYSTONE'. It is unlikely that the average consumer will pronounce the remaining words in either mark since in both cases they describe the nature of the services being provided and are unlikely to be given any trade mark significance. In my view the marks are aurally identical.

43. If the average consumer does pronounce the remaining words in the parties' marks the first word of each mark, and each marks' dominant and distinctive element, is the common word 'KEYSTONE'. Consequently, the marks are, at the lowest point, highly similar.

⁹*Specsavers International Healthcare Ltd v Asda Stores Ltd (No.2) [2011] FSR 1, Mann, J.*

Conceptual similarities

44. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹⁰ The assessment must be made from the point of view of the average consumer.

'KEYSTONE' is defined as:

“a central stone at the summit of an arch, locking the whole together.

the central principle or part of a policy, system, etc., on which all else depends: cooperation remains the keystone of the government's security policy.”¹¹

45. Whether or not the average consumer is aware of the exact dictionary definition of the word 'KEYSTONE' the word is made up of two common English words which will be well understood. Consequently, it is unlikely that the word will be considered to be invented. Whatever the conceptual message conveyed by the word, it will be the same for both marks.

46. The marks are conceptually identical.

Distinctive character of the earlier mark

47. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

48. The opponent has not filed any evidence to show that it has used its mark, so I have only the inherent position to consider. Whilst the words 'Independent Estate Agents' are descriptive in relation to the opponent's services, the mark as a whole must be considered. In addition to these words the first word of the mark is the word KEYSTONE, which is the distinctive and dominant element of the opponent's mark. This is not descriptive, nor allusive, of any of the services relied upon. The earlier mark, as a whole, has a good level of inherent distinctive character.

Likelihood of confusion

49. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.¹² I must also keep in mind the average consumer for the goods, the

¹⁰ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

¹¹ *Oxford English Dictionary*, Ed. Stevenson, Angus, 3rd Edition, Oxford University Press, 2010

¹² *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

50. I have found the marks to be highly similar visually and aurally and conceptually to be conceptually identical. I have found the earlier mark to have a good level of inherent distinctive character. I have found the parties' services to be highly similar in respect of mortgage and protection services and have identified that there will be term within 'financial services' which may be similar to the opponent's services. I have identified the average consumer, namely a member of the general public or a professional and have concluded that the level of attention paid to the purchase of the services at issue must be assessed at the lower level. i.e. that of a member of the general public. The level of attention paid will vary according to the cost and complexity of the services being purchased, but will be at least reasonable. I have concluded that the purchase may be visual or aural.

51. Taking all of these factors into account, in respect of mortgage and protection services, the similarity of the marks is such that in the context of highly similar services purchased, for the most part, visually, I find that there will be direct confusion (where one mark is mistaken for the other).

CONCLUSION

52. The opposition succeeds under section 5(2)(b) of the Act in respect of 'mortgage and protection services':

Revised specification

53. I have identified that the broad term of the applied for mark, 'financial services' includes some services which will lead to a likelihood of confusion but some services which will not. In the circumstances, I invite the applicant to file a revised specification and accompanying submissions detailing any types of services it wishes to register that:

- a) Fall within the ambit of "financial services";
- b) Fall within the scope of this decision in that the services so specified have no similarity to 'estate agency services';
- c) Do not fall foul of the guidance issued by the CJEU in the *Postkantoor* decision;

54. The applicant's written submissions should explain why it considers the terms to be within the scope of my decision. A period of 14 days from the date of this decision is permitted for such action. Upon receipt of the above, the opponent will be allowed 14 days to comment on any proposed terms and I will then issue a supplementary decision in which I will decide whether any proposed terms are free from objection. If the applicant puts forward no revised terms then I will issue a supplementary decision confirming that the broad term 'financial services' may include services

which are the same or similar as those contained in the opponent's specification. Consequently, there will be a likelihood of confusion.

55. The appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision.

Dated this 10th day of June 2014

**Ms Al Skilton
For the Registrar,
The Comptroller General**