

O-505-15

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NOS 2636150, 2636147, 2635608,
2635606, 2645394, 2640679, 2645406 AND 2645408
FOR THE TRADE MARKS**

Goodman Investment Counsel Inc.



GOODMAN PRIVATE CLIENT

GOODMAN PARTNERS

Goodman Investments

Goodman Wealth

Dundee Goodman Private Wealth Solutions

AND

Dundee Goodman Private Wealth

**IN CLASSES 35 AND 36
IN THE NAME OF DUNDEE CORPORATION**

AND

**THE OPPOSITIONS THERETO UNDER NOS. 400190, 400163,
400302, 400299, 400366, 400191, 400111 AND 400095
BY GOODMAN LIMITED**

Background and pleadings

1. This decision concerns the oppositions by Goodman Limited (“the opponent”) to eight trade mark applications filed by Dundee Corporation (“the applicant”), shown below:

(i) 2636150

Goodman Investment Counsel Inc.

Classes 35 and 36

Filing date: 26 September 2012; priority date (Canada) 7 June 2012

Published: 8 February 2013

(ii) 2636147



INVESTMENT COUNSEL INC.

Classes 35 and 36

Filing date: 26 September 2012; priority date (Canada) 17 September 2012

Published: 25 January 2013

(iii) 2635608

GOODMAN PRIVATE CLIENT

Class 36

Filing date: 21 September 2012; priority date (Canada) 25 April 2012

Published: 22 February 2013

(iv) 2635606

GOODMAN PARTNERS

Class 36

Filing date: 21 September 2012; priority date (Canada) 25 April 2012

Published: 22 February 2013

(v) 2645394

Goodman Investments

Class 36

Filing date: 12 December 2012; priority date (Canada) 14 November 2012

Publication: 8 March 2013

(vi) 2640679

Goodman Wealth

Class 36

Filing date: 2 November 2012; priority date (Canada) 31 October 2012

Publication: 8 February 2013

(vii) 2645406

Dundee Goodman Private Wealth Solutions

Class 36

Filing date: 12 December 2012; priority date (Canada) 14 November 2012

Publication: 18 January 2013

(viii) 2645408

Dundee Goodman Private Wealth

Class 36

Filing date: 12 December 2012; priority date (Canada) 14 November 2012

Publication: 18 January 2013

2. The opponent claims that there is a likelihood of confusion under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") with its two earlier registered Community trade marks ("CTMs") in classes 36 and 37, shown below. The specifications are identical for the two trade marks. Both were filed on 10 May 2007, claiming priority from Australia from 23 April 2007. Their respective registration procedures were completed on 26 August 2008 and 8 July 2008.

(i) 5889464

GOODMAN

(ii) 5889514



Class 36: *Financial services; financial management services; investment services, including but not limited to investments in direct and indirect commercial/industrial real estate portfolios; capital investment services; property investment services; property investment banking services; wholesale and retail investment management services; capital raising services; debt and transaction restructuring; financing services; financial advisory services; financial management services; compliance and risk management services; valuation services; risk advisory services; funds management services; real estate services; real estate management services; real estate agency services; rental of property; real estate brokers; rent collection services; management of commercial/industrial real estate assets; management of listed and unlisted property trusts or specialised funds.*

Class 37: Property development of commercial/industrial real estate assets.

3. Additionally, the opponent claims that the marks should be refused under section 5(3) of the Act. The thrust of the pleadings under this ground is that the claimed similarity between the earlier marks and the applications will cause the relevant public to believe that they are used by the same undertaking or think that there is an economic connection between the parties.

4. The applicant denies the grounds. In its brief counterstatements, the applicant does not refer to whether the services are identical or similar, but it does contend that the marks are not similar and so there would be no likelihood of confusion. The applicant also denies that the opponent's marks have a reputation and denies the section 5(3) ground.

Evidence

5. The opponent's evidence comes from Julia Timms, who has been the opponent's UK Marketing Director since 2008. She states that the opponent provides investments services under the Goodman marks in Europe, and provides a sample list of funds managed at exhibit JT-1. The relevant dates in these proceedings are the filing dates of the applications, so evidence of the current use of the marks is unlikely to be helpful in establishing whether there was reputation or enhanced distinctiveness in 2012, which is when the opposed applications were filed.

6. The opponent entered the UK market in 2005. It now encompasses fund management services, property investment and property services. Ms Timms states that the opponent's UK fund is not run under the opponent's name but, instead, is run under the name Arlington Business Parks Partnership. However, Ms Timms explains that the promotional and marketing materials for the Fund regularly feature the opponent's marks, referring to exhibit JT-4 which comprises extracts from the Fund's annual reports from the years, 2009, 2010 and 2011 (those from 2013 and 2014 are after the relevant dates). The only mention of Goodman (that I can see) is on the front cover, where it appears in a format corresponding to CTM 5889514, alongside a Legal and General trade mark.

7. Ms Timms states that the opponent manages the Fund to invest in the purchase and development of UK land sites. The opponent invests in the acquisition, development and ownership of industrial property (logistics) and business space, and its customers include Amazon, the Co-Op, and the Daily Mail. Examples of press reports of the opponent's logistics property deals are included in exhibit JT-6, where the mark Goodman is referenced in two local and national newspaper articles from 2008 and 2009. Exhibit JT1-10 comprises marketing reports for 2009 and 2010 (also 2014) which also features various press cuttings about the opponent's UK business park, science park and logistic site property deals. Exhibit JT-11 includes commercial property press cuttings from 2011, relating to the sale of 28 acres of residential land in Coventry to Barratt Homes; and from 9 November 2012 relating to the signing of a logistics site with Hobbycraft. Also included in the exhibit is a copy of the opponent's press release from May 2012, relating to the joint acquisition of a 146,491 sq ft Hobbycraft warehouse and distribution centre in Rugby; and from June

2012 relating to planning consent for a new 231,000 sq ft development at Hatfield Business Park. Exhibit JT-7 comprises brochures featuring the details of the opponent's ten business parks, but these appear to be current rather than before or at the relevant dates.

8. Exhibit JT-12 contains press cuttings of various awards which the opponent has won (I have only included those in or before 2012):

- Landlord of the Year – The Office Awards October 2010
- Gold Award in Best Business Park – Northumbria in Bloom Awards, October 2011
- Grounds Maintenance of Private and Business Areas – British Association of Landscape Industries (BALI), October 2011
- Best Commercial and Industrial Effort – Sunderland in Bloom Civic Awards, December 2011
- Best Corporate Workplace – British Council for Offices' Northern Awards, May 2012.

9. Ms Timms provides figures showing the financial performance of the opponent's UK property investment and development services for the years 2010 to 2014. I have only shown the figures for 2010, 2011 and 2012, as the applications were all filed in 2012. These are also shown in the annual reports in exhibit JT-8.

Year	2010 A\$M	2011 A\$M	2012 A\$M
Total income	136.9	157.6	135.2
Total assets	1,553.8	1292.6	1372.8
Profit	72.4	67.2	64.6

Decision

10. Section 5(2)(b) of the Act states that:

“(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.”

11. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson*

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 be dominated by one or more of its components;
- (f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

12. The specifications of the opponent's two earlier marks are identical. Neither are subject to proof of use because they had been registered for less than five years at the date on which the applications were published. The earlier marks, therefore, can be considered across the breadth of the specifications, which are:

Class 36: Financial services; financial management services; investment services, including but not limited to investments in direct and indirect commercial/industrial real estate portfolios; capital investment services; property investment services; property investment banking services; wholesale and retail investment management services; capital raising services; debt and transaction restructuring; financing services; financial advisory services; financial management services; compliance and risk management services; valuation services; risk advisory services; funds management services; real estate services; real estate management services; real estate agency services; rental of property; real estate brokers; rent collection services; management of commercial/industrial real estate assets; management of listed and unlisted property trusts or specialised funds.

Class 37: Property development of commercial/industrial real estate assets.

13. Two of the applications (2636150 and 2636147) include services in class 35 which are almost identically worded:

Investment product promotion services; investment fund promotion services.

The applicant's class 36 specifications can be grouped into two; within the groups there are minimal variations in wording which do not affect the comparison. The grouped specifications are:

2636150, 2636147, 2635608 and 2635606:

Asset management services; third party and proprietary asset management focusing on real estate, infrastructure, energy, resources and agriculture sectors; investment services; direct and indirect investment in, and ownership of, real estate, infrastructure, energy, resources, agriculture and financial services assets and companies; investment advisory services; full-service securities brokering, financial planning and investment management services; capital markets services; investment banking services and the sale of securities through the public and private offerings and financial advisory services relating to mergers and acquisitions, divestitures, restructurings and stock exchange listings; sales and trading services; the selling, purchasing and trading of equity, equity-related and fixed income securities on a proprietary basis and on behalf of retail and institutional clients; investment research services; the preparation of research reports and opinions for investors and institutional clients; investment product development, sale and distribution services; investment fund development, sale and distribution services.

2645394, 2640679, 2645406 and 2645408:

Asset, portfolio and investment management services, namely creating, managing and administering mutual funds, investment funds, third party assets, tax assisted investments, real estate and resource assets and proprietary assets and investments; financial advisory services, namely financial planning and investment management services; administering life, accidental death and health insurance policies; administering banking, financial and estate planning services; capital markets services, namely investment banking services and underwriting of the sale of securities to the public, private placements and investment advisory services related to mergers and acquisitions, divestitures, restructurings and stock exchange listings, institutional sales and trading services namely the selling, purchasing and trading of equity and equity related securities and fixed income securities; investment research services namely the preparation of research reports and opinions to individual investors and institutional clients in connection with investment decision making, investment and exploration services relating to oil, gas and mining resources; private equity and merchant banking services relating to resources and real estate.

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-33/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. The opponent’s *financial services* cover all of the class 36 services in all of the applications which are all forms of financial services.

16. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the Court of Justice of the European Union (“CJEU”) stated, at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

17. ‘Complementary’ was defined by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

“82 It is true that goods are complementary if 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 think that the responsibility for those goods lies with the same undertaking...”.

18. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“Treat”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

19. The applicant’s class 35 services, *investment product promotion services; investment fund promotion services* are similar to a good degree to the opponent’s *investment services, including but not limited to investments in direct and indirect commercial/industrial real estate portfolios*. They are highly complementary, the applicant’s services promoting the services covered by the opponent’s specification. They would be provided by the same undertaking, to the same customers.

Average consumer

20. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

21. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

22. Within the parties’ specifications, there is room for a wide variety of financial services. Whilst some may be high-net-worth, experienced investors who take great care in deciding upon financial investments, whatever the type of service, I consider that an above average level of attention will be paid to the service provider owing to the importance of ensuring that one’s money is safe, has a good level of return, and so on. Primarily, the average consumer’s encounter with the parties’ marks will be on a visual level, such as signage on premises, newspapers, journal advertisements and reports, and website use. However, the potential for oral use must also be recognised for various types of financial services, such as oral recommendation and use over the telephone.



Comparison of marks

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

24. The respective marks are:

Earlier marks	Applications
<p>GOODMAN</p> 	<p>Goodman Investment Counsel Inc.</p>  <p>GOODMAN PRIVATE CLIENT</p> <p>GOODMAN PARTNERS</p> <p>Goodman Investments</p> <p>Goodman Wealth</p> <p>Dundee Goodman Private Wealth Solutions</p> <p>Dundee Goodman Private Wealth</p>

25. Goodman/GOODMAN is the dominant and distinctive component of the first six of the applicant’s marks. The other words are descriptive/non-distinctive in the context of financial services. The rectangle in the second mark would be seen

merely as background so that the white word GOODMAN is visible. A similar component, albeit a square background, is contained in one of the earlier marks, along with a very small plus sign. The dominant and distinctive component of the second earlier mark is also the word Goodman. GOODMAN is the only element of which the first earlier mark is comprised. In relation to the earlier marks and the first six applications, the overall impression is that they are Goodman/GOODMAN marks.

26. The first six of the applications and the earlier marks share a high degree of visual, aural and conceptual similarity. Goodman/GOODMAN is the first word in all the marks, and the other elements are either non-distinctive or descriptive. Goodman/GOODMAN will be seen as a surname in all the marks; the plus sign creates no concept to detract from the surname, and all the other words describe the services on offer from a person or entity called Goodman. There is a high degree of similarity overall between the earlier marks and the first six of the applicant's marks.

27. The position is slightly altered in relation to the final two marks of the applicant, the 'Dundee Goodman' marks. Here, Goodman is not the first component of the marks. However, it shares equal dominance and distinctiveness with Dundee. The other words describe the services offered. There is a good deal of visual and aural similarity between these marks and the earlier marks. Conceptually, Dundee Goodman Private Wealth Solutions and Dundee Goodman Private Wealth create the impression of financial services offered by an undertaking named after two individuals with the surnames Dundee and Goodman. If I am wrong that Dundee would be seen as a surname, it will be seen as a geographical name; although Dundee is absent from the earlier marks, the surnominal significance of Goodman is shared with the earlier marks. There is a good deal of similarity, overall, between the last two of the applicant's marks and the earlier marks.

Distinctive character of the earlier marks

28. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹ the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant

¹ Case C-342/97.

section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

29. Goodman is a surname. Consumers are accustomed to the use of surnames in trade as natural tools of differentiation. The earlier marks have a good level of inherent capacity to distinguish the opponent’s services from those of other undertakings. I cannot find that the opponent’s evidence to support the marks’ use on investment funds entitles it to claim that the marks are entitled to an enhanced level of distinctive character. This is because the mark which appears to have been used in relation to investment funds is Arlington Business Parks Partnership. The only instance of the earlier mark is its inclusion on the front cover of the Fund’s annual reports from 2009, 2010 and 2011, alongside a Legal and General trade mark. It is not apparent from this what role the opponent’s mark plays in relation to the services. It is certainly not sufficient to prove an enhanced level of reputation.

30. The matter is different in relation to the other evidence provided, which the customer (all large corporations) would describe as the provision of real estate services. These services are covered by the earlier marks. The scale and use of the marks in both their forms is on a large scale and the marks have enjoyed industry recognition in the form of awards and press coverage. However, an enhanced level of distinctiveness in relation to real estate services does not help to improve the opponent’s position (from an already good level of inherent distinctiveness for the financial services) because real estate services are not similar to financial services, as found by the GC in *Bankia, SA v OHIM*, case T-323/14:

“34 As regards the comparison of the ‘real estate services’ covered by the mark applied for and the ‘financial and banking services’ in Class 36 covered by the earlier mark, the Board of Appeal found, contrary to the Opposition Division, that those services were similar on the ground, in essence, that they shared distribution channels, end-users and also providers (see paragraph 16 above).

35 In that respect, it should be noted, first, that, as regards the nature, intended purpose and method of use of the services at issue, financial and banking services do not have the same nature, the same intended purpose or the same method of use as real estate services. Whereas financial services are provided by financial institutions for the purposes of managing their clients’ funds and consist of, inter alia, the holding of deposited funds, the remittance of funds, the granting of loans or the performance of various financial operations, real estate services are services connected with a property, namely, in particular, the lease, the purchase, the sale or the management of such a property. Secondly, as regards the fact that the services in question might be found in the same distribution channels, it is clear that real estate services are not, in principle, provided on the same premises as financial services (see, to that effect, judgment of 11 July 2013 in *Metropolis Inmobiliarias y Restauraciones v OHIM — MIP Metro (METRO)*, T-197/12, EU:T:2013:375, paragraphs 42 and 43).

36 In any event, it cannot be validly argued that financial and banking services and real estate services are offered to customers without distinction in the same agency or branch of a bank. In principle, real estate services are provided by separate branches of financial institutions, so that financial activities are separate from any real estate activities (see, by analogy, judgment in *METRO*, cited in paragraph 35 above, EU:T:2013:375, paragraphs 44 and 45).

37 Thirdly, as regards whether the services in question are complementary, the Board of Appeal having found, in essence, in paragraph 26 of the contested decision that they were complementary, it should be noted that, while financial and banking services may play a significant role in the purchase of a property, it cannot be inferred from that fact alone that consumers would be led to believe that the same undertaking was responsible for real estate services and financial services. It cannot be claimed that consumers looking for a property turn to a financial institution in order to carry out that task. On the contrary, in such cases, consumers generally turn, first, to a real estate agency to search for a property and, secondly, to a financial institution in order to fund the property transaction. To conclude otherwise would imply that any non-financial procedure which, on the basis of its scale or other criteria, depends upon the provision of financing is complementary to a financial service, even where the only link lies precisely in the need to obtain financing and where consumers would in no way assume that the same undertaking was responsible for those services (see, to that effect, judgment in *METRO*, cited in paragraph 35 above, EU:T:2013:375, paragraphs 46 to 49).

38 The conclusion must therefore be drawn from the above, as the Opposition Division noted, that there is no similarity between the services in question, since, even though financial and banking services may be necessary in order to use real estate services, they are not so necessary that consumers will consider that the same undertaking was responsible for those financial services and real estate services.

39 It follows that, as the applicant claims, the Board of Appeal erred in finding that there was similarity between the ‘real estate services’ covered by the mark applied for and the ‘financial and banking services’ in Class 36 covered by the earlier mark.”

31. As the services for which the earlier marks have an enhanced level of distinctiveness (real estate services) are not similar to the applicant’s services, the enhanced distinctiveness for real estate services will have no effect upon the likelihood of confusion assessment.

Likelihood of confusion

32. Deciding whether there is a likelihood of confusion is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*).

The parties' services are identical, or similar to a good degree. The high levels of similarity between the earlier marks and the first six of the applicant's marks (the Goodman/GOODMAN marks), together with the fact that Goodman is inherently distinctive to a good degree, mean that confusion is inevitable, despite an increased level of attention being paid during the purchasing process. The applicant's marks will be seen as variations on financial services specialisms, all under the umbrella mark Goodman/GODMAN. There is a likelihood of confusion between the earlier marks and

Goodman Investment Counsel Inc.



GOODMAN PRIVATE CLIENT,
GOODMAN PARTNERS,
Goodman Investments
and Goodman Wealth.

33. There is also a likelihood of confusion between the earlier marks and Dundee Goodman Private Wealth Solutions and Dundee Goodman Private Wealth. Whilst not directly mistaking one mark for the other, the average consumer will perceive the common presence of Goodman/GOODMAN in the parties' marks as indicating that these are marks which belong to the same or economically linked undertakings. This sort of confusion was described in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 by Mr Iain Purvis, sitting as the Appointed Person.

34. It is common to find one or more surnames used as trade marks in the service industries, such as in finance, real estate and in legal services. Goodman/GOODMAN retains an independent and distinctive role in the applicant's marks. The addition of Dundee does not create a different meaning. I find support for this view in *Aveda Corporation v. Dabur India Limited* [2013] EWHC 589 (Ch) and in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch). In the first case, Arnold J said, at paragraph 45:

"I entirely accept the basic proposition which the Court of Justice has repeated many times, namely that the assessment of likelihood of confusion must be made by considering and comparing each of the signs as a whole. As the Court of Justice recognised in *Medion v Thomson*, however, there are situations in which the average consumer, while perceiving a composite sign as a whole, will recognise that it consists of two signs one or both of which has a significance which is independent of the significance of the composite whole. Thus when the well-known pharmaceutical company Glaxo plc acquired the well-known pharmaceutical company Wellcome plc, the average consumer of pharmaceutical goods confronted with the composite sign GLAXO WELLCOME or GLAXOWELLCOME would perceive the significance of both the whole and its constituent parts and conclude that this was an undertaking which combined the two previously separate undertakings (see

Glaxo Group Ltd v Glaxowellcome Ltd [1996] FSR 388). The essence of the Court of Justice's reasoning in *Medion v Thomson* is that an average consumer of leisure electronic products confronted with the composite sign THOMSON LIFE could perceive both the whole and its constituent parts to have significance and thus could be misled into believing that there was a similar kind of connection between the respective undertakings.

35. In the second case, Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

36. The ground under section 5(2)(b) succeeds.

37. There is nothing to be gained from examining the section 5(3) ground of opposition, which was pleaded upon the basis that similarity between the earlier marks and the applications will cause the relevant public to believe that they are

used by the same undertaking or think that there is an economic connection between the parties. This is what I have already decided under section 5(2)(b) of the Act.

Outcome

38. The oppositions succeed under section 5(2)(b) of the Act. All eight of the applications are refused.

Costs

39. The opponent has been successful and is entitled to an award of costs according to the published scale in Tribunal Practice Notice 4/2007. I have made a minimum award for the evidence as it did not assist the section 5(2)(b) ground, but would have been necessary had I gone on to decide the section 5(3) ground. The award breakdown is:

Statutory opposition fees x 8	£1600
Filing the oppositions and considering the counterstatements (all essentially the same)	£500
Filing consolidated evidence	£500
Written submissions	£500
Total	£3100

40. I order Dundee Corporation to pay Goodman Limited the sum of £3100 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 28th day of October 2015

**Judi Pike
For the Registrar,
the Comptroller-General**