

**O-448-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3106738  
BY IKON FINANCIAL GROUP LIMITED TO REGISTER THE TRADE  
MARK**



**IN CLASS 36**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 404918  
BY TOTAL SA**

## Background and pleadings


1) IKON Financial Group Limited (“the applicant”) applied to register the following mark in the UK on 1 May 2015:



2) It was accepted and published in the Trade Marks Journal on 22 May 2015 in respect of the following services in Class 36:

*Financial services; foreign exchange services; commodity trading [financial services].*

3) Total SA (“the opponent”) originally opposed the mark on the basis of section 5(3) and section 5(4)(b) of the Trade Marks Act 1994 (“the Act”). The latter was based upon an earlier registered Community design right. Later, the opponent sought, and was granted leave to add grounds based upon section 5(2)(b) and another section 5(4)(b), the latter this time based on a claim to copyright. The section 5(2)(b) and section 5(3) grounds are based upon its earlier European Union (formerly Community)/ International Trade Mark (“EUTM”) 3071561. The relevant details of this earlier mark are shown below:

Mark and relevant details	Services relied upon
<p>Mark:</p>  <p>Filing date: 3 March 2003 Date of entry in register: 11 October 2004</p>	<p><b>In respect of section 5(2)(b):</b></p> <p><b>Class 36:</b> <i>credit services; payment card and credit card services and the corresponding financial services; loyalty card services; issuing of cards for automatic refuelling in service stations.</i></p> <p><b>In respect of section 5(3):</b></p> <p><b>Class 4:</b> <i>Petroleum (crude and refined), petroleum derivatives and petroleum-based preparations; liquids, solid and gaseous fuels; motor fuel; gas and liquid petroleum gas; lubricants; industrial oils and greases; paraffin and waxes; illuminants; non chemical additives for motor fuel, fuels and lubricants</i></p> <p><b>Class 37:</b> <i>Vehicle service stations (services)</i></p>

4) It claims that the respective marks are similar and the respective services are similar and that, as a result, there is a likelihood of confusion under section 5(2)(b). It also relies upon section 5(3) of the Act, claiming that because of the similarity between the respective marks, a link will be established in the minds of the consumer and use of the applicant's mark would "dilute its logo and so be detrimental to its reputation." It also claims that if the consumer purchases services under the applicant's mark (in the belief that it is the opponent's mark) and then has a disappointing experience, the reputation of the opponent's logo and business will suffer.

5) In respect of the grounds based upon section 5(4)(b), the opponent relies upon an earlier Registered Community Design (“RCD”) shown below:

Community Design 96433-0001



6) The design was applied for on 3 November 2003 and registered. It was published on 12 March 2004. The design is in the colours light blue, dark blue, red and orange. Its Lucarno classification is 99.00 (Miscellaneous) and therefore, not limited to any particular type of product.

7) The opponent also relies on a claim to ownership of copyright in its logo. It claims that the original designer, Laurent Vincenti of A&Co was commissioned to design the logo in January 2003. It is claimed that Mr Laurent assigned the copyright to A&Co who assigned the copyright to the opponent in around March 2003. It relies on section 16, Copyright, Designs and Patents Act 1988 that permits copyright holders to prevent third party copying without consent.

8) The applicant filed a counterstatement denying the claims made (and requesting that the opponent provides proof of use of its earlier trade mark).

9) Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

10) Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

### **Opponent's Evidence**

11) This takes the form of a witness statement by Stephanie Polselli, Head of Trade Marks of the opponent and further evidence provided in reply to submissions provided by the applicant. This further evidence consists of a second witness statement by Ms Polselli. The relevant points that come out of this evidence are as follows:

- The opponent is a French multinational oil and gas company whose business covers the entire oil and gas chain from exploration and production to marketing petrol products to consumers;
- The company rebranded in 2003, at which time its logo “was launched”;
- The logo was created by Laurent Vincenti in or around January 2003 in his role as managing director and creative director of a company called A&Co. It is stated that he subsequently assigned the copyright in the logo to A&Co (he provides an affidavit to that effect at Exhibit SP9) and that A&Co then assigned the copyright to the opponent;
- Its Total UK Limited subsidiary uses the logo in relation to its goods and services;
- In 2014, 2260 people were employed in the UK and total turnover was £10 billion (supported by an extract from the opponent’s publication “Total in the UK: Environment and Social Responsibility Report 2014, an extract of which is provided at Exhibit SP9);

- The opponent “operates in the field of lubricants, including greases, fuels, motor oils and base oils” and until recently also operated in the field of retail of fuel. Turnover figures relating to the UK are provided at Exhibit SP10 for the years 2009 to 2014 and were in the region of £34 million to £47 million a year in respect of antifreeze, greases, lubricants, fuels, “Adblue”, motor oils and base oils. In addition retail fuel sales for 2009, 2010 and 2011 were in the region of £1 million;
- Total UK has spent nearly £39 million on marketing and advertising between 2006 and 2014 and the opponent’s logo has been used extensively since its adoption in 2003. Exhibit SP12 contains examples of advertisements featuring the opponent’s mark;
- The opponent sponsors a number of events in the UK and Europe including awards shows and car races;
- The opponent’s mark is used in Europe for payment and credit card services and the corresponding financial services. Exhibits SP26 and SP27 provide leaflets from in French and German and show the mark in use on cards that customers can use in every petrol station run by the opponent in France and Germany;
- Details of loyalty card services offered in Europe are provided at Exhibit SP28. The scheme is called TOTAL CLUB and the opponent’s mark is used prominently;
- Ms Polselli states that the opponent’s mark is also used in respect to cards for automatic refuelling at service stations. As an example, she refers to a scheme called “Air Total Cards” which allows pilots to refuel across France and UK pilots can apply for this card. Use of the mark in respect of these services is shown at Exhibits SP30 being extracts from the opponent’s UK website and Exhibit SP31, being copies of promotional material in German;

- Ms Polselli states that the opponent's mark is used in respect of repair and maintenance services. Exhibit SP32 consists of an extract from the opponent's UK website where it describes a service offered by its retail establishments called "Total Quartz Rapid Oil Change". The service has been available in Derby since August 2015;
- Ms Polselli states that the opponent's mark is used in respect of vehicle service stations and a photograph is provided at Exhibit SP34 showing two French service stations branded as TOTAL and with the opponent's mark being prominently used together with the word TOTAL;

## **DECISION**

### **Proof of use**

12) Section 6A of the Act reads as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),  
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)  
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed  
before the start of the period of five years ending with the date of  
publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13) Section 100 of the Act states that:



“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (“*London Taxi*”), Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as

a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

15) The relevant period in which use must be shown is between 23 May 2010 and 22 May 2015. The applicant, in its written submissions, concedes that the opponent's evidence demonstrates use in respect of certain goods and services. In respect of these, goods and services and as a result of this concession, I need make no comment on whether the evidence is sufficient to demonstrate use. The concession relates to the following goods and services:

**Class 4:** *Petroleum, petroleum derivatives and petroleum based preparations; liquid, solid and gaseous fuels, motor fuels, gas and liquid petroleum gas (and as claimed by Ms Polselli at paragraph 17 of her witness statement)*

**Class 36:** *Fuel payment card services; loyalty card services for the purchase of gifts, trips and gasoline; issuing of cards for automatic refuelling in service stations.*

**Class 37:** *Repair and maintenance services relating to oil changes for motor vehicles.*

16) When cross-referencing these concessions against the goods and services relied upon by the opponent (see the table in paragraph 3 above), it is accepted that the opponent has used its mark in respect of the following Class 4 goods:

**Class 4:** *Petroleum (crude and refined), petroleum derivatives and petroleum-based preparations; liquids, solid and gaseous fuels; motor fuel; gas and liquid petroleum gas*

17) However, there is no specific concession regarding the opponent's *lubricants; industrial oils and greases; paraffin and waxes, illuminants; non chemical additives for motor fuel, fuels and lubricants* but insofar as they are *petroleum derivatives or petroleum-based preparations*, they are covered by the concession. It is not necessary for me to consider use in respect of these goods because reliance upon them by the opponent will not improve its case over and above the Class 4 goods as detailed in the above paragraph.

18) In respect to the Class 36 services relied upon by the opponent, the applicant's concession does not extend to *credit card services and the corresponding financial services; loyalty card services* in general. It is necessary that I consider in more detail the issue of proof of use in respect of these services.

19) Section 100 of the Act requires that the opponent must show use of its mark. This is not a light requirement. Mr Daniel Alexander QC, sitting as the Appointed Person in *GUCCI Trade Mark*, BL O-424-14 commented on this requirement in the context of non-use revocation. The requirement is no different in issues of genuine use of earlier marks in opposition. He commented as follows:

“1. In *La Mer Technology v. Laboratoire Groemar*, the Court of Appeal emphasised the importance of dotting the i's and crossing the t's in the evidence of use in proceedings where a mark is challenged on the grounds of non-use. This case emphasises the importance [...] of doing that [...]”

20) Mr Alexander QC, went on to observe that the proprietor of the challenged mark in those proceedings adopted a less than effective approach to its evidence of use and discussed the evidence in more detail:

41. Mr Volpi's evidence about this class, which might be thought to be of key importance to the proprietor's business, covers just two paragraphs and 1 exhibit. Those paragraphs are as follows:

“19. I refer to EXHIBIT 7 which is a copy of the various look books showing use of the mark in relation to bags and other Class 18 goods.

20. The sales of Class 18 products featuring the mark from 1996 to July 2012 are as follows [there follows a table simply setting out compendious sales in given years (e.g. Year 2011 - Turnover in £ sterling 1.914.418)].”

42. The “look books” referred in the exhibit and which were said to be available in stores in the United Kingdom to do not relate to the relevant

period of non use. It is fair to say that there is a tiny amount of additional evidence relating to handbags in the latter part of his witness statement where, in paragraph 28, he says: “examples of advertising campaigns are shown at EXHIBIT 8 which is an extract from the UK edition of Vogue (April 1982)” showing the mark prominently on a handbag.

43. Any tribunal assessing this evidence would be bound to conclude, especially given the nature of the proprietor in question, the alleged importance of the mark and the fact that the proprietor was represented by legal advisors of repute that a diligent and careful search had been made for relevant documents proving use and this was the best that could be found.

44. That impression would be re-inforced by two further points: (i) first, the submission on behalf the proprietor, when an application was made to adduce further evidence, to the effect that only limited further evidence was to be adduced and (i) the fact that the proprietor was content to have the matter decided on the papers.

45. Indeed, had the proprietor set out to give the impression that the mark had not been used in the relevant period in relation to the relevant goods in the United Kingdom and that its thin evidence was submitted as a try-on in the hope that the Hearing Officer would not notice, the proprietor’s submissions could hardly have done a better job. In the event, the Hearing Officer did notice. She pointed out the following in para. [41] of the main decision:

“However:

(i) a combination of turnover figures about which there is no statement that they relate to UK sales, and

(ii) no breakdown at all as to the types of goods, and

(iii) no invoices at all, and

(iv) no indication as to number of goods (of any type) sold, and

(v) no packaging and no advertisements other than one from 1981, and

(vi) a loose collection of pages, many undated, showing a very scant range of goods, does not present me with a picture of genuine use when I put the pieces together.”

46. She was amply justified in her view. This was an inevitable finding in relation to the majority of the goods in respect of which use was sought to be proved on the hopeless evidence provided

21) The opponent’s evidence in the current proceedings, in respect of services in Class 36, is afflicted with many of the same shortcomings. No turnover figures are provided, neither generally or in respect of the services covered by each term, there are no invoices, nor any indication as to the scale of use. Some promotional material is provided, obtained from its UK and German national websites but these are undated and, consequently, it cannot be determined if they relate to the relevant period. Whilst there is limited information that may contribute to creating a picture of genuine use, such as promotional material at Exhibits P26 and SP27 indicating that the opponent’s corporate credit card can be used in up to 17 countries, this is undermined by being undated.

22) Keeping in mind the comments of the Appointed Person in *GUCCI Trade Mark*, I find that this evidence fails to demonstrate that the opponent has made genuine use of its mark in respect of services in Class 36 during the relevant five year period.

23) In respect to the Class 37 services, the earliest dated reference to the opponent providing such services in the UK appears in Exhibit SP33. It refers to a Total Quartz Rapid Oil Change centre in Derby that opened in August 2015. This is after the relevant period for demonstrating use. Therefore, there is no evidence that genuine use has been made of the earlier mark in respect of these services. I reject the claim of genuine use in respect of these services.

24) In summary, for the purposes of this decision, I will continue on the basis that the opponent's goods and services are:

**Class 4:** *Petroleum (crude and refined), petroleum derivatives and petroleum-based preparations; liquids, solid and gaseous fuels; motor fuel; gas and liquid petroleum gas; lubricants, industrial oils and greases, paraffin and waxes, illuminants, non chemical additives for motor fuel, fuels and lubricants, all being petroleum derivatives or petroleum-based preparations*

**Class 36:** *Fuel payment card services; loyalty card services for the purchase of gifts, trips and gasoline; issuing of cards for automatic refuelling in service stations.*

#### **Section 5(2)(b)**

25) The opponent relies upon the Class 36 services covered by its earlier mark. Only the following services have survived the issue of proof of genuine use (by virtue of the concession by the applicant):

*Fuel payment card services; loyalty card services for the purchase of gifts, trips and gasoline; issuing of cards for automatic refuelling in service stations.*

26) I will consider the grounds based upon section 5(2)(b) based upon only these services.

27) Sections 5(2)(b) of the Act reads as follows:

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

(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”.

## ***Comparison of goods and services***

28) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

29) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.



30) I also take account of the guidance of the General Court (“the GC”) in *Gérard Meric v OHIM*, T-133/05 (“*MERIC*”):

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

31) The respective services are:

Opponent’s services	Applicant’s services
<i>Fuel payment card services; loyalty card services for the purchase of gifts, trips and gasoline; issuing of cards for automatic refuelling in service stations</i>	<i>Financial services; foreign exchange services; commodity trading [financial services].</i>

32) Applying the guidance in *MERIC*, it is self-evident that all of the opponent’s services are covered by the applicant’s *financial services* and they are, therefore, identical.

33) In respect of the applicant’s *foreign exchange services*, whilst the respective services are all “financial services”, the similarity ends there. Whilst the financial industry includes a number of very large companies that provide a very broad range of services, it would be wrong to conclude that it is normal for the respective services to share trade channels. It is not normal in trade to obtain fuel payment cards and automatic refuelling cards from the same undertaking as foreign exchange services.

The former are likely to be accessed via specialist providers of those services whereas the latter are normally accessed via banks, post offices, travel agents or specialist foreign exchange operators. I conclude that the respective trade channels are different. Their intended purpose is different; a means to pay for fuel on the one hand and a means to exchange currency on the other. They are not in competition, nor are they complementary 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” (*Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06). I conclude that any similarity is very low.

34) In respect of the applicant’s *commodity trading [financial services]*, once again, the only similarity is that the respective services may be described, in the broadest sense, as being financial services. However, in the same way discussed in the previous paragraph, they have a different intended purpose, different trade channels and are not in competition nor are they complementary. I conclude that any similarity is very low.



### ***Comparison of marks***

35) 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.”

36) It would be wrong, therefore, to artificially dissect the marks, although, 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.

36) The respective marks are shown below:

Opponent's earlier mark	Contested mark
	

37) Both marks are reasonably complex figurative marks where no one element dominates. In respect of both marks, their distinctive character resides in their totality with no one element dominating.

38) Visually, the respective marks both consist of very similar (but not identical) curved ribbon-shapes that give the impression of rotation around an axis. Both marks have three of these shapes that all have pointed ends. The colours red, orange and blue feature prominently in both marks. The opponent's mark also includes use of the colour navy. Some small differences exist, namely that the opponent's mark also includes the colour navy and the shapes in the mark create the impression of the shape of a ball. The shapes in the applicant's mark create the impression of the shape of three balls not quite completely overlapping. Further, the profile of the shapes is slightly different in each mark, being flat in the opponent's mark and slightly curved on the outer surface in the applicant's mark. However, these minor differences do not detract from both marks creating a highly similar visual impression.

39) Being device marks, neither have any aural characteristics. Conceptually, neither mark has any characteristics beyond the possibility that they will be perceived as having a concept of something rotating. Insofar that this concept will be perceived, it will be so in both marks.

***Average consumer and the purchasing act***

40) 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*.

41) 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.”

42) The average consumer of the types of financial services at issue can include both ordinary consumers and corporate customers. It is normal for there to be an increased level of care and attention paid during the purchasing act for financial services with attention being given to interest rates, borrowing limits etc. As such, I conclude that the level of care and attention is elevated to some extent over and above the care given to the purchase of more everyday purchases. I consider that visual impressions will dominate this process. Whilst I do not ignore the fact that aural considerations may play a part, I keep in mind that, in this case, neither mark is endowed with any aural characteristics.

## **Distinctive character of the earlier trade mark**

43) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 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).”

44) The opponent's mark consists of a coloured device that is likely not to be perceived as alluding to any concept other than perhaps something rotating. It possesses no allusive connection to the services relied upon by the opponent. It is therefore, endowed with a normal level of inherent distinctive character.

45) I must also consider if the mark benefits from any enhanced distinctive character because of the use made of it. To be of relevance to these grounds, use must be in the UK and in respect to the opponent's Class 36 services. The opponent claims that it has used its mark in respect to a range of financial services, but whilst I have found

the use shown in respect of some of these services to be sufficient to demonstrate genuine use, the evidence is not sufficient for me to assess the scale of use in the UK and, consequently, I conclude that its distinctive character is not enhanced through use.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion**

46) The following principles are gleaned from the decisions of the CJEU 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 Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

47) In *Specsavers International Healthcare Limited & Others v Asda Stores Limited*, Case C-252/12, the Court of Justice of the European Union held that:

“2. Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours with the result that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged

to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under that provision.

3. Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that the fact that the third party making use of a sign which allegedly infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign is relevant to the global assessment of the likelihood of confusion and unfair advantage for the purposes of that provision.”

48) I have found that the respective marks share a highly similar visual impression but, because they are both device marks, there are no aural considerations and that insofar as the marks may be endowed with a conceptual identity, this is the same in both marks. Such a high level of visual similarity when considered together with the identity of the applicant's *financial services* with those of the opponent, I find that whilst there will be an increased attention during the purchasing process, when imperfect recollection is factored in, a likelihood of confusion is inevitable. Consequently, the opposition based upon section 5(2)(b) of the Act succeeds against these services.

49) In respect of the applicant's remaining services, namely *foreign exchange services; commodity trading [financial services]*, I have found that if there is any similarity to the opponent's services, it is only very low. I find that this is sufficient to offset the high level of similarity between the marks and I conclude that it is not likely that the respective marks will be confused when used in respect of these services when factoring the increased level of attention during the purchasing process.

50) In summary, I conclude that the grounds based upon section 5(2)(b) succeed against the applicant's *financial services* but fails against its other services.



### Section 5(3)

51) I will consider this ground of opposition insofar as it is directed at the applicant's services that have survived the opposition based upon the section 5(2)(b) grounds.

52) Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

53) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any

financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

### **Reputation**

54) The earlier mark is an EUTM, but for the purposes of my considerations it is its reputation in the UK that is relevant because I must consider the impact of the reputation from the perspective of the UK consumer and assess detriment or unfair advantage from this perspective. In *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), Geoffrey Hobbs QC, as a Deputy Judge of the High Court held that:

“76. Article 9(1)(c) provides protection for Community trade marks which have a reputation “in the Community”. Kenwood suggested that this means a reputation across the Community as a whole or at least a large area of it. I do not agree. In the case of a trade mark registered at the national level, protection of the kind provided by art.9(1)(c) can be claimed for trade marks which have a reputation in the sense that they are known by a significant part of the public concerned by the products or services covered by that trade mark in the territory of registration. Since the territory of registration is part of the Community, the trade mark has a reputation in the Community. The trade mark does not cease to have a reputation in the Community if the national registration is either subsumed within a Community trade mark registration under art.34(2) of the CTMR on the basis of a valid claim to seniority or duplicated by a Community trade mark registration. In principle, a Community trade mark should not receive less protection than a national trade mark with a reputation in the same territory. I think that the aim should generally be to prevent conflict occurring in any substantial part of the Community and that the United Kingdom can for that purpose be regarded as a substantial part of

the Community, with or without the addition of France and Germany. It thus appears to me that Whirlpool's Community trade mark has a reputation in the Community.”

55) The opponent claims that it has a reputation in respect of the following:

**Class 4:** *Petroleum (crude and refined), petroleum derivatives and petroleum-based preparations; liquids, solid and gaseous fuels; motor fuel; gas and liquid petroleum gas; lubricants; industrial oils and greases; paraffin and waxes; illuminants; non chemical additives for motor fuel, fuels and lubricants*

**Class 37:** *Vehicle service stations (services)*

56) The applicant, in its written submissions contends that because the opponent's mark is not used separately to its word mark TOTAL, then no reputation is attached to the device mark relied upon in these proceedings. I have already discussed this issue when considering genuine use. The use shown often shows the earlier mark in use next to, or in close proximity with the opponent's TOTAL word mark, but this does not prevent the earlier mark from functioning independently to identify the opponent's services. In fact the impression created by the uses shown is just that. I find that such use, in itself, is not a reason to conclude that no reputation can attach to the earlier mark (as opposed to attaching to the combination of the device and the word marks). Nevertheless, there are a number of other factors that I must consider in determining if the requisite reputation exists.

57) From the opponent's evidence it is possible to ascertain that its mark was launched in 2003, that it is a large French company operating in the field of lubricants, including greases, fuels, motor oils and base oils. Its turnover in the UK was between £34 million to £47 million a year in the period 2009 and 2014 and over that five year period it invested £39 million on marketing and advertising. Advertisements that appeared in publications such as the *Guardian*, the *Daily Telegraph*, the *Times* and the *Mail on Sunday* are provided at Exhibit SP12. Other promotional material is also provided at Exhibit SP13 relating specifically to

automotive publications. Further press releases provided at Exhibit SP19 relate to a number of awards from the UK relating to the opponent's products.

58) Taking all of the above into account, I conclude that the opponent benefits from a reputation in respect of its Class 4 goods.

### **The Link**

59) Having established the existence and scope of a reputation, I need to go on to consider the existence of the necessary link. I am mindful of the comments of the CJEU in *Intel* that it is sufficient for the later trade mark to bring the earlier trade mark with a reputation to mind for the link, within the meaning of *Adidas-Salomon and Adidas Benelux*, to be established. The CJEU also set out the factors to take into account when considering if the necessary link exists:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

60) I have found that the respective marks share a high level of visual similarity and that the opponent's mark has the requisite reputation in the UK in respect of its Class 4 goods. These are factors pointing towards the existence of a link. However, there are also factors that point against the existence of a link. There is no similarity between the opponent's goods and the applicant's services. I am mindful that there is no requirement for such similarity but it is, nonetheless, a relevant factor that I must keep in mind when assessing whether the necessary link exists (see *Premier Brands UK Limited v Typhoon Europe Limited* [2000] FSR 767).

61) In light of there being no similarity between the respective goods and services, there can be no likelihood of confusion. In fact there is a great distance between fuel and lubrication products in Class 4 and financial services of the kind surviving the opposition based upon Section 5(2)(b). Likelihood of confusion is not required for the finding of the necessary link, but rather it is one factor that I must take into account. However, there must be the creation of a link in the minds of the public. Taking account of the distance between the respective goods and services, I find that no such link exists. In the absence of such a link, there can be no detriment to, or unfair advantage taken of the opponent's mark.

62) In light of the above, the opposition based upon section 5(3) of the Act fails in respect of the applicant's services that survive my analysis of the section 5(2)(b) grounds.

#### **Section 5(4)(b)**

63) Section 5(4) reads as follows:

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented

(a) rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

### **RCD as an earlier right**

64) The Community Designs Regulation 6/2002 has direct effect in the UK. The relevant articles of this Regulation are as follows:

#### *Article 3 Definitions*

For the purposes of this Regulation:

(a) "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;

(b) "product" means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

(c) -.

#### *Article 10 Scope of protection*

1. The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.

2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

*Article 19 Rights conferred by the Community design*

1. A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

65) The relevant case law was conveniently set out by Birss J. in paragraphs 31 to 59 of his judgment in *Samsung v Apple* [2012] EWHC 1882 (Pat). The most relevant parts are re-produced below.

*“The informed user*

33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the *Court of Justice of the European Union in PepsiCo v Grupo Promer (C-281/10P) [2012] FSR 5* at paragraphs 53 to 59 and also in *Grupo Promer v OHIM [2010] ECDR 7*, (in the General Court from which PepsiCo was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* paragraph 46).

ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);



iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned (*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).

#### *Design freedom*

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* Arnold J. summarised that passage from *Grupo Promer* as follows:

“design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features common to such products and/or (iii) economic considerations (e. g. the need for the item to be inexpensive).”

#### *Effect of differences between the registered design and the design corpus*

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that: “as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will

automatically disregard elements ‘that are totally banal and common to all examples of the type of product in issue’ and will concentrate on features ‘that are arbitrary or different from the norm’.”

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate, but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

*The correct approach, overall*

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

58. How similar does the alleged infringement have to be to infringe?  
Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of “different overall impression” is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”

### ***The informed user***

66) Unlike when considering likelihood of confusion or damage under the Trade Marks Act where the assessment must be made from the perspective of the average consumer, here I am concerned with considering the position from the perspective of an informed user. Such an informed user is more knowledgeable and plays closer attention than the notional average consumer under the Trade Marks Act.

67) The opponent’s design is not limited to any particular type of product. It is a graphic symbol used for ornamentation rather than a product *per se*. As the design is a graphic symbol, which may be applied to any article, it is not straightforward to identify the informed user. It can be argued that it is the general public with an interest in graphic symbols or it can be argued that it is the user of the services. To my mind, the distinction is less important than acknowledging that the informed user, whether the user of the services or the general public with an interest in graphic symbols, they will both have the attribute of being particularly observant when it comes to the relevant field of design. The informed user will display a high level of attention and would not perceive the design as a whole, but rather will analyse its detail.

### ***Design freedom***

68) A design that is used merely for ornamentation, such as that of the opponent, is not constrained in any way and the designer is free to develop any design.

Therefore, I conclude that the designer has a wide degree of freedom.

### ***Design corpus***

69) There is no evidence before me to illustrate the current design corpus and I am unable to state whether designs of this nature are commonplace or otherwise.

### ***Colour in designs***

70) The Community design is registered in two shades of blue and the colours red and orange. The mark is also applied for in colours light blue, red and orange, even though no claim has been made to colour. However, the colour combination in which the mark applied for is shown is illustrative of one way the mark may be used and I conclude that the mark, as applied for, represents paradigm use of the mark. I will undertake a comparison based on the trade mark having, as a characteristic, the colours in which it was applied for.

71) In these circumstances colour should be taken into account in the assessment of whether the mark creates the same overall impression as the design. In this respect, I find that the overall colour schemes are very similar and the differences are likely to go unnoticed even with a particularly observant user. In making this finding, I take account that I am permitted to take into account imperfect recollection of the design, which the CJEU considered may be appropriate in some circumstances (see paragraph 57, *PepsiCo Inc. v Grupo Promer Mon Graphics and OHIM*, Case C-281/10).

### ***Comparison of the designs***

72) I will start by comparing the mark with the Community design.

73) The trade mark is similar to the design in that it contains three curved shapes creating an impression of a three-dimensional rotating ball. The both use the same (or at least very similar) colours, with two of the three curved shapes in both the design and the mark being red and light blue respectively. A pale orange colour also appears in both the design and the mark. There are also a number of differences. Firstly, the orange colour is used in the design to depict the reverse side of the curved shapes, whereas, in the mark it is the colour to the third curved shape. In the design the third curved shape is dark blue. Further, unlike the design which gives the impression of a single sphere shape, the curved elements of the applicant's mark give the impression of three spheres not quite overlapping totally. The result is that the mark alludes more to a clover-leaf type shape rather than a single sphere. Finally, the curved shapes present in the design give the impression of having a flat profile whereas, the curved shapes of the trade mark give the impression that their outer surface is curved.

74) In my judgment, the informed user of fuels and related products and also of financial services would notice both these similarities and differences. However, even taking account for the wide freedom of designs available to designers, the differences are sufficient for the trade mark to create a different overall impression on users compared to the impression created by the registered design.

75) It follows that use of the mark would not be contrary to the Community Design Regulation. The opposition based on the Community design therefore fails.

### **Copyright as an earlier right**

76) Section 5(4)(b) of the Trade Marks Act permits only holders of earlier rights to bring an opposition to an application. In the current case, the opponent claims that it is the owner of the copyright in the logo that its mark consists. In its grounds of opposition it is claimed that ownership lay with the original designer, Laurent Vincenti of a company named A&Co and that Mr Laurent assigned the copyright to A&Co that then, in turn, assigned the copyright to the opponent in around March 2003.

77) This is also stated by Ms Polselli at paragraph 8 of her witness statement. To support this claim she provides, at Exhibit SP8, a copy of a signed affidavit by Mr Vincenti attesting to creating the logo in 2003 and that he transferred the copyright to A&Co. At Exhibit SP7 is the copy of an article about the designing of the opponent's logo that appeared in what appears to be the opponent's own magazine "Energies" dated June 2003. This article recognises the instrumental role Mr Vincenti played in the design of the logo. However, this corroboratory evidence does not address the claim that A&Co subsequently assigned the copyright in the logo to the opponent. In the absence of this, I am unable to conclude that the opponent is the owner of this right. In light of the above, the opposition based upon a claim to copyright must fail.

78) The opposition based upon section 5(4)(b) fails in its entirety.

### **Outcome**

79) The opposition partially succeeds, but only in respect of the following services:

*Financial services*

80) The opposition fails in respect of the remaining services, namely:

*foreign exchange services; commodity trading [financial services].*

### **COSTS**

81) Both sides have achieved a measure of success and I direct that each side bears its own costs.

**Dated this 26<sup>th</sup> day of September 2016**

**Mark Bryant**  
**For the Registrar,**