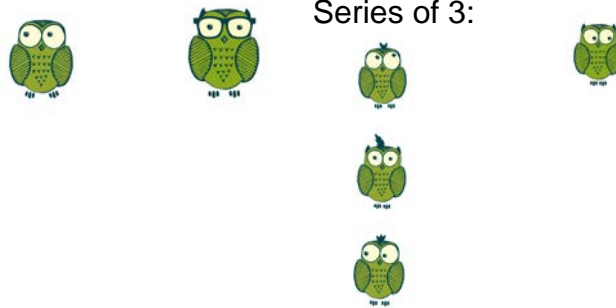


O-340-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. 3161841, 3159324, 3161765, 3160919
BY M & G LIMITED TO REGISTER THE TRADE MARKS**



IN CLASS 9, 36 AND 42

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 406791, 406793,
406794 AND 406795
BY BE WISER INSURANCE SERVICES LIMITED**

AND

**IN THE MATTER OF REGISTRATION NO 3144933 IN THE NAME OF M & G
LIMITED IN RESPECT OF THE TRADE MARK**





IN CLASSES 9, 36 AND 42

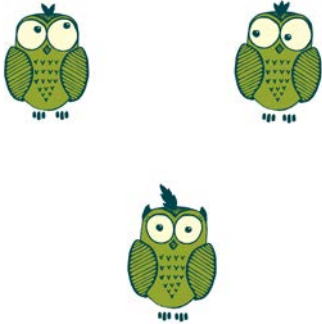
**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 501209 BY BE WISER INSURANCE SERVICES LIMITED**


Background and pleadings

1) M & G Limited ("M & G") applied to register the following marks in the UK:

3161841
Mark:

Filing date: 28 April 2016 Date of publication: 20 May 2016

3159324
Mark:

Filing date: 13 April 2016 Date of publication: 29 April 2016

3161765
Mark (series of 3):

Filing date: 27 April 2016 Date of publication: 20 May 2016

3160919
Mark:

Filing date: 22 April 2016 Date of publication: 29 April 2016

2) They were accepted and published in the Trade Marks Journal in respect of the following identical list of goods and services:

Class 9: *Software in the nature of a mobile application; computer programs; computer software for use in accessing, tracking, managing, analysing, downloading and dashboard reporting of financial information and investments; computer software for delivering updates and notifications; software platform to enable users to make financial transactions.*

Class 36: *Financial services; financial management; asset and fund management; investment services; capital investment; financial advisory and consultancy services; financial analysis and research services, financial forecasting; financing and funding services.*

Class 42: *Providing a platform for initiating and handling financial investments; providing temporary on-line use of downloadable computer software for accessing, tracking, managing, analysing, downloading and dashboard reporting of financial information and investments; providing a website featuring non-downloadable software for use in database management, compiling and tracking information and data; providing a website featuring non-downloadable software for presenting a user dashboard of custom information; technical support services; maintenance and updating of computer software; maintenance of databases.*

3) Be Wiser Insurance Services Limited (“BWIS”) opposes the marks on the basis of section 5(2)(b), of the Trade Marks Act 1994 (“the Act”). It is based upon a claim that M & G’s marks are similar to earlier marks in the name of BWIS and are in respect of identical or similar goods and services. It relies upon the following two earlier marks:

3068430



Filing date:
13 August 2014

Date of entry in register:
12 December 2014

Class 9: *Computer games; computer software; publications in electronic form; downloadable electronic publications; protective helmets for sports; protective helmets for motorcyclists; safety boots for motorcyclists; safety gloves for motorcyclists; fireproof motorcycle racing suits; protective clothing for motorcyclists; protective suits for motorcyclists; back protectors; knee guards; should and knee protectors; eyewear; protective eyewear; eyeglasses; sunglasses.*

Class 14: *Precious metals and their alloys; jewellery; horological and chronometric instruments; watches.*

Class 16: *Stationery; printed matter; printed publications; instructional and/or teaching materials; packaging materials; writing implements; paper; cardboard; packaging containers and bags; envelopes (stationery); books and magazines; manuals and handbooks; calendars; clip boards; printed matter; photographs; pictures; posters; stickers; stickers for vehicles; stickers for clothing; flags (of paper); stationery; office requisites; document holders, files and pads (stationery); plastic materials for packaging; signboards of paper or cardboard; self-adhesive plastic films for decorative purposes; writing and drawing implements.*

Class 18: *Leather and imitations of leather; animal skins, hides; trunks, cases and travelling bags; umbrellas; and parts and fittings for the aforesaid goods.*


Class 25: *Clothing, footwear, headgear and gloves; leather clothing, footwear, headgear and gloves; clothing, footwear, headgear and gloves all adapted for use with motorcycles.*

Class 28: *Games, toys and playthings; model vehicles; scale model vehicles; toy vehicles; radio-controlled scale model vehicles; radio-controlled toy vehicles; scale model kits; soft toys; knee guards; elbow guards; shin guards; protective pads and protective gear for use in connection with sporting activities; sports gloves and sporting articles.*

Class 35: *Advertising; business management; business administration; office functions; price analysis services; price comparison of the goods and services of other vendors, enabling customers to conveniently view and compare the goods and services of those vendors; advertising of the goods or services of other vendors, enabling customer to conveniently view and compare the goods and services of those vendors.*


Class 36: *Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage, financial services; financial affairs; travel insurance brokerage; breakdown insurance and membership brokerage.*

Class 41: *Organisation of events and cultural and sporting activities; organisation of motorsport events and races; organisation of motorcycle events and*

	<p><i>races; entertainment, sporting and cultural activities; participation in motorsport events and races; participation in motorcycle events and races; provision of motorsport services; provision of motorcycle racing services; education and training services; education and training services relating to motorsport and motorcycles; informative, advisory and consultancy services relating to all the aforesaid services.</i></p>
<p>2545853</p>	
 <p>Filing date: 22 April 2010</p> <p>Date of entry in register: 06 August 2010</p>	<p>Class 35: <i>Advertising; business management; business administration; office functions; price analysis services; price comparison of the goods and services of other vendors, enabling customers to conveniently view and compare the goods and services of those vendors; advertising of the goods or services of other vendors, enabling customer to conveniently view and compare the goods and services of those vendors.</i></p> <p>Class 36: <i>Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage, financial services; financial affairs; travel insurance brokerage; breakdown insurance and membership brokerage.</i></p>

4) M & G filed counterstatements denying the claims made and, at paragraph 8, putting BWIS to proof of use of its earlier mark 2545853 “in relation to all the services covered by the registration”.

5) M & G is also the proprietor of the following mark and in respect of the following list of goods and services:

Mark and relevant dates	List of goods and services
<p data-bbox="188 253 320 286">3144933</p>  <p data-bbox="188 734 432 808">Filing date: 18 January 2016</p> <p data-bbox="188 846 536 920">Date of entry in register: 13 May 2016</p>	<p data-bbox="639 253 1366 510">Class 9: <i>Software in the nature of a mobile application; computer programs; computer software for use in accessing, tracking, managing, analysing, downloading and dashboard reporting of financial information and investments; computer software for delivering updates and notifications; software platform to enable users to make financial transactions.</i></p> <p data-bbox="639 573 1394 786">Class 36: <i>Financial services; financial management; asset and fund management; investment services; capital investment; financial advisory and consultancy services; financial analysis and research services, financial forecasting; financing and funding services.</i></p> <p data-bbox="639 846 1390 1335">Class 42: <i>Providing a platform for initiating and handling financial investments; providing temporary on-line use of downloadable computer software for accessing, tracking, managing, analysing, downloading and dashboard reporting of financial information and investments; providing a website featuring non-downloadable software for use in database management, compiling and tracking information and data; providing a website featuring non-downloadable software for presenting a user dashboard of custom information; technical support services; maintenance and updating of computer software; maintenance of databases.</i></p>


6) BWIS also applied for the registration to be declared invalid on the grounds that it offends under section 5(2)(b) of the Act. These grounds are identical to those set out above in respect of the opposition proceedings.

7) All four oppositions were subsequently consolidated with the invalidation proceedings and each party filed a single set of evidence in respect of all five proceedings.

8) BWIS subsequently requested to add a further ground to its pleaded case in all proceedings. This request was allowed and grounds based upon section 5(4)(a) of the Act were added. It claims that it enjoys significant goodwill in its owl devices and

that as a result of the fact that the respective marks are visually highly similar and conceptually identical, the public are likely to be led to believe that M & G's goods and services are those of BWIS or that that they are, in some way, associated with BWIS. As a result, it claims that it is likely to suffer damage to its significant reputation and goodwill.

9) BWIS also added an extra earlier mark relied upon for the purposes of its section 5(2)(b) of the Act. The relevant details of this additional earlier mark are shown below:

2545849	
 <p>Filing date: 22 April 2010</p> <p>Date of entry in register: 06 August 2010</p>	<p>Class 35: <i>Advertising; business management; business administration; office functions; price analysis services; price comparison of the goods and services of other vendors, enabling customers to conveniently view and compare the goods and services of those vendors; advertising of the goods or services of other vendors, enabling customer to conveniently view and compare the goods and services of those vendors.</i></p> <p>Class 36: <i>Insurance services; brokerage advisory services relating to insurance for cars, motorcycles, vans, home and contents, motor caravans; insurance brokerage, financial services; financial affairs; travel insurance brokerage; breakdown insurance and membership brokerage.</i></p>

10) Both sides filed evidence. A hearing took place before me on 15 June 2017 where BWIS was represented by Charlotte Scott of counsel, instructed by Blake Morgan LLP and M & G was represented by Chris Aikens of counsel, instructed by HGF Limited.

BWIS's evidence

11) This takes the form of a witness statement by Andrew John Dunkerley, director of BWIS. He explains that BWIS was incorporated in 2007 and since that time it has used its owl device with either the words "Be Wiser Insurance" or "Be Wiser", the former being its earlier mark 2545853, subject to proof of use.

12) Mr Dunkerley states that BWIS is one of the fastest growing personal line brokers in the UK and has over 700 staff based in six offices. He states that for the year ending 31 May 2016, BWIS's gross written premium income was £123 million.

13) Mr Dunkerley states that BWIS acts for over 30 of the largest UK based companies such as Aviva Insurance, Axa Insurance, Royal and Sun Alliance and Zurich Insurance and offer car, van, motorbike and home insurance and currently (the witness statement was signed on 12 October 2016) has 210,000 clients. BWIS sells its products via the telephone or its website www.bewiser.co.uk.

14) Mr Dunkerley provides information regarding marketing activities, namely that since inception, BWIS has invested a total of nearly £53 million, including nearly £8.5 million in the year ending 31 May 2016. Such expenditure has been in respect to activities such as Internet campaigns, directory advertising, magazine and newspaper advertising, T.V., radio and bill board advertising and sport sponsorship.

15) Mr Dunkerley states that in July 2016, the Insurance Post ranked BWIS as the 26th largest broker in the UK and this is shown in an extract on page 20 of Exhibit AD1 and also records BWIS's total revenue in 2015 as being £20 million to £30 million.

16) Mr Dunkerley states that BWIS's website demonstrates that it offers various types of insurance brokerage services and refers to page 24 of his exhibit that consists of an undated screenshot from its website showing its '849 mark and a drop-down menu listing the following: Travel insurance, Breakdown Cover, Helmet & Leathers cover, Car Warranty, Van Warranty, Bike Warranty, Income Protection

Insurance, Private Medical Insurance and Life Insurance. He also refers to the copies of the undated advertisements provided at pages 2 to 14 of his exhibit.

M & G's evidence

17) This takes the form of a witness statement by Cathal Patrick Dowling, Head of Marketing Services of M & G. He explains that he is responsible for managing advertising and sponsorship. He provides evidence that its contested marks comply with the colours that are integral to M & G's branding strategy and are likely to be instantly recognised as promoting the services of M & G.

18) Mr Dowling states that M & G's representative, HGF Limited, conducted enquiries into the use of owl devices in the financial and insurance sector and Exhibit CPD8 consists of examples of third party use of such marks before the date of M & G's earliest filed mark. There are 18 examples varying from actual photographs of owls to highly stylised cartoon-style owl characters all being used in respect of various financial, insurance and property services.

19) Mr Dowling states that an owl device was chosen because it was considered to reflect the desired characteristics of knowledge and know-how. At Exhibit CPD7 is a copy of an internal e-mail sent to Mr Dowling on 26 September 2016 showing use of an owl mark by "Boring Money".

20) Mr Dowling also makes a number of submissions that I will keep in mind, but not detail here.

BWIS's evidence-in-reply

21) This takes the form of a second witness statement by Mr Dunkerley. He states that BWIS has instructed its legal representatives in respect of enforcement action against a number of third parties including successful actions against two of the third parties identified in Mr Dowling's Exhibit CPD8.

DECISION

Proof of Use

22) For the purposes of my considerations, I will assume that BWIS has genuinely used its mark to the extent that it is entitled to rely upon all of the goods and services listed in its earlier registrations.

Section 5(2)(b)

23) Section 5(2)(b) of the Act is 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, or 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

24) Once again, for the purposes of my considerations I will assume that the parties' goods and services are identical.

Comparison of marks

25) BWIS relies upon three earlier marks, however, for the purposes of procedural economy, I will focus my considerations based upon its 2545853 mark (shown in the table below) because it includes the device of an owl in a forwarding facing position and looking forward. This is the same position as the owl presented in M & G's 3144933 mark. In both these marks, the owls also have ears tufts and M & G's mark is without glasses. It is my view that the similarities between these respective marks are greater than when comparing any of the parties' other marks and if BWIS cannot succeed in its opposition against this mark, neither will it succeed against the other

marks. Therefore, I will restrict my considerations to the similarity between these respective marks:

BWIS's mark	M & G's mark
	

26) It is clear from the judgment of CJEU in *Sabel BV v Puma AG*, Case C-251/95 (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 CJEU 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.”

27) 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.

28) BWIS's mark consists of a line drawing of a reasonably life-like owl and the words “Be Wiser” and the word “insurance” appearing alongside, with the words “Be

Wiser” being larger and bolder than the word “insurance” that appears directly beneath the other two words. The impact of all of this is that the device of the owl and the words are two quite separate but distinctive elements of the mark, with neither being more dominant than the other. M & G’s mark consists of a single element, namely the humanised and cartoon-like device of an owl and it is, self-evidently, the dominant and distinctive element.

29) Visually, both marks share some similarity because of the presence in both marks of a forwarding facing owl sharing a feature not standard to all owls, namely ear tufts. However, the details are different in that one is a reasonably life-like interpretation of an owl whereas the other is drawn in a cartoon-style imparting human characteristics upon the owl, with over-sized eyes giving it a friendly demeanour. Further, wings are visible in M&G’s mark whereas they are not in BWIS’s mark. M & G’s owl is presented in a more child-like interpretation. Further, BWIS’s mark also contains three words, absent in M & G’s mark. Taking all of this into account, I conclude that the visual similarity is no more than at a medium level.

30) Aurally, there is no similarity between the marks because no attempt will be made by the consumer to articulate M & G’s device-only mark. For the same reasons, BWIS’s mark will be referred to only by reference to the word element that is absent in M & G’s mark.

31) Conceptually, there is some similarity between the marks because at a general level, the devices convey the same concept of an owl. However, conceptual differences are introduced when the nature of the owl devices are considered. In BWIS’s mark, the owl conveys characteristics associated with a real owl. On the other hand, M & G’s owl is a character drawing where the owl will not be mistaken for depiction of a real owl. Rather it is presented in a way that it conveys human characteristics. The conceptual distinction between a life-like owl and a cartoon character in the form of an owl will not go unnoticed by the average consumer. In addition, BWIS’s mark also includes the words “Be Wiser Insurance” that create a distinct concept absent in M & G’s mark, namely insurance that only wiser individuals will avail themselves to. Taking all of this into account, I conclude that the respective marks share medium level of conceptual similarity.

Average consumer and the purchasing act

32) 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.

33) 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.”

34) For the purposes of this decision, it is sufficient to note that both parties' marks include some identical services, such as “financial services”. This covers a wide spectrum of services to members of the general public including services aimed at general consumers such as retail banking. The level of care and attention when selecting such services is greater than that involved in the purchase of every day purchases, such as grocery goods, but not always particularly high. For example, automatic cash dispensing services provided where the consumer will pay limited attention to who is providing the services, with the focus being more on the proximity of accessing the service. Financial services aimed at the general public are normally promoted on T.V., radio or print advertising where visual and/or aural considerations are relevant.

Distinctive character of the earlier trade mark

35) 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).”

36) The earlier mark consists of a reasonably life-like depiction of an owl and the words “Be Wiser Insurance”. The owl, being generally perceived as being wise, compliments the meaning conveyed by the “be wiser” word element. Unlike in the case of invented words, BWIS’s mark, when viewed in its totality, is not endowed with the highest level of distinctive character because it creates a link between “wiseness” and BWIS’s services. Nevertheless, it has at least a medium level of inherent distinctive character.

37) It is a matter of contention between the parties regarding the extent of use made of the mark, but for the purposes of this decision I will assume that the mark benefits from an enhanced level of distinctive character. The consequence of this is that it is a factor that increases the likelihood of confusion.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

38) 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.

39) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case and in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

40) I have made the following assumptions:

- The respective services are identical;
- The medium level of inherent distinctive character of BWIS's mark has been enhanced through use.

41) I have also found that the respective marks share no more than a medium degree of visual similarity, no aural similarity and a medium level of conceptual similarity and that the purchasing process is both visual and aural in nature with the level of attention paid by the consumer during the purchasing process being more than for everyday purchases but not always particularly high;

42) Mr Dowling provided some evidence that owl devices were commonly used in the financial and insurance sectors and in his witness statement, Mr Dowling submitted that given the extent of third party use of owl marks in the sector, consumers will be accustomed to seeing such marks and will be more readily distinguish such marks. Whilst the evidence provides a number of examples, the owl representations used are varied and wide ranging, and whilst I am prepared to accept Mr Dowling's statement that owls are commonly used to create an association with wiseness, such use is so varied, it is difficult to see how their existence has any material impact upon these proceedings.

43) I have considered the proceedings from BWIS's best possible case where the services are identical, the distinctive character of BWIS's mark has been enhanced through use, and taking the marks that are most similar. Despite this, I find that there is not a likelihood of confusion. To find otherwise would endow upon BWIS's mark a wider penumbra of protection than would be correct in light of the guidance referred to earlier. When comparing the marks, the differences in the device elements of the respective marks are such that the average consumer will not make a connection. The high point is that the existence of an owl in both marks may result in one of the marks bringing the other to mind, but I am not convinced even of this. It is my strong view that upon encountering the marks the average consumer is not likely to believe there is any business connection between the respective providers of the services.

The human characteristics endowed in the cartoon-style owl of M & G's mark endows it with characteristics absent in the much more life-like representation of an owl in BWIS's mark. These differences will be readily obvious to the consumer, even when factoring in imperfect recollection. Further, the word element present in BWIS's mark does nothing to bring the respective marks closer together.

44) In conclusion, I find that there is no likelihood of confusion. As I have based my findings on what, I believe, represents BWIS's best case, it follows that the BWIS's grounds based upon section 5(2)(b) of the Act also fail in all of the consolidated proceedings.

Section 5(4)(a)

45) Section 5(4)(a) states:

“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) by virtue of any 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) [.....]

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.”

46) Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

47) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

Relevant date

48) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of Section 5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is

unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

49) Therefore, in the absence of any evidence of use of M & G’s marks before the filing dates in January or April 2016, or of any counterclaim to an earlier goodwill, the relevant dates for the purposes of these proceedings are the various filing dates of the contested marks that are all in January or April 2016. Nothing turns on the slight differences between these dates.

Goodwill, misrepresentation and damage

50) At the hearing, Mr Scott submitted that BWIS’s grounds based upon section 5(4)(a) should succeed even if, as I have found, it fails in respect of the section 5(2)(b) grounds. The reasons put forward were that BWIS has used its owl device alone (and without the words “Be Wiser Insurance”) and these are relied upon for the purposes of section 5(4)(a) and because of the size of its goodwill being the 26th largest broker in the UK.

51) In respect of this first reason, whilst the words “Be Wiser Insurance” present in the marks relied upon in the section 5(2)(b) grounds were a point of difference that is absent in my considerations here, as I have found in paragraph 43 above, the differences present in the respective owl devices is sufficient for there to be no likelihood of confusion. The presence or absence of a word element does not materially change that finding.

52) Regarding the reliance upon the size of the goodwill, I do not make a judgement on the size and scope of the goodwill, but for the purposes of this decision, I take BWIS's claim at face value and that it enjoys a large goodwill and has a huge extent of trade. Nevertheless, the differences between the marks remain such that, even in the face of such goodwill, misrepresentation is not likely to occur, even where M & G's use is in the identical field where BWIS's goodwill exists.

53) I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires "a substantial number of members of the public are deceived" rather than whether the "average consumer are confused". However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here. Even accepting that BWIS has a large goodwill identified by its signs I, nonetheless, find that members of the public are unlikely to be misled into purchasing M & G's services in the belief that they are the services of BWIS. For the reasons set out earlier, I consider that the differences between the respective owl devices are so great that no economic connection will be made.

54) In conclusion, I find that BWIS's grounds, insofar as they are based upon section 5(4)(a), also fail.

55) BWIS's consolidated proceedings against all of M & G's marks fail in their entirety.

COSTS

56) M & G has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. At the hearing, Mr Aikens indicated that M & G were content for costs on scale to follow the event. However, he submitted that this should be enhanced to reflect that BWIS added grounds based upon section 5(4)(a) late in the process and its lateness was purely of BWIS's own making. He pointed out that this led to more costs for M & G because it was required to amend its counterstatement and evidence. I consider this point to

be a fair one and, consequently, I increase the award by £200. I also take account that both sides filed evidence and that a hearing was held. With this in mind, I award costs as follows:

Considering a statement and preparing the counterstatement	£300
Preparing evidence and considering other side's evidence	£900
Amending counterstatement and evidence	£200
Preparing for & attending hearing	£800
Total:	£2200

57) I order Be Wiser Insurance Services Ltd to pay M & G Limited the sum of £2200 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 19th day of July 2017

Mark Bryant
For the Registrar
The Comptroller-General