

O-056-18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3113026
IN THE NAME OF FALCON COFFEES LIMITED

AND

OPPOSITION THERETO UNDER NO 405316
BY FALCON PRIVATE BANK LTD

Background

1. Application No 3113026 stands in the name of Falcon Coffees Limited (“the applicant”) and seeks registration of the trade mark FALCON. It has a filing date of 12 June 2015 and was published in the *Trade Marks Journal* on 24 July 2015.

Following amendments to the specification, it now seeks registration in respect of goods and services in classes 30, 31, 35, 39 and 42.

2. A notice of opposition was filed by Falcon Private Bank Ltd (“the opponent”). Whilst originally relying on multiple grounds and directed to each of the applicant’s goods and services, the opposition is now founded on a single ground under section 5(2) of the Trade Marks Act 1994 (“the Act”). In support of this, the opponent relies on the following International Registration (“IR”) and UK trade mark for goods and services which I set out later in this decision:

Mark	Dates
IR 1035241 FALCON PRIVATE BANK	International registration date: 17 July 2009 Date of designation in the EU: 10 July 2012 Priority date: 20 January 2009 (Switzerland)
2650101 FALCON PRIVATE WEALTH	Filing date: 26 January 2013 Date of entry in register: 25 October 2013

3. The opponent claims the similarities in marks, goods and services would lead to a likelihood of confusion.

4. The applicant filed a counterstatement admitting there is similarity between some of the respective services. I will return to this later in this decision. It otherwise denied the grounds of opposition.

5. Neither party filed evidence nor did they file written submissions in lieu of evidence. The matter came before me for a hearing, by telephone, on 14 December 2017. The applicant did not attend but its professional representatives filed written

submissions in lieu of attendance. Claire Lazenby, the opponent's professional representative, appeared on its behalf.

6. For completeness, I should point out that when completing the notice of opposition, Ms Lazenby marked a box on the Form TM7 to indicate the objections were being brought under the provisions of section 5(2)(a) of the Act (i.e. on the basis that the respective marks are identical). Ms Lazenby submitted that this was done in error and went on to say that it is clear from the explanation of grounds attached to the notice of opposition that the objection was intended to have been brought under section 5(2)(b) of the Act (i.e. on the basis that the respective marks are similar). I accept that she made an error in completing the relevant part of the form. The respective marks are clearly not identical and the accompanying statement of grounds makes clear that the objection is brought under section 5(2)(b) of the Act. The applicant has addressed the objection under this ground in its submissions, so is not prejudiced by the error. I proceed on the basis that the opposition is brought under section 5(2)(b) of the Act.

7. I should also point out that at the hearing, Ms Lazenby made a passing reference to the opponent relying on three earlier marks and, in her skeleton argument filed in advance of the hearing, she referred to "FALCON PRIVATE BANK and FALCON PRIVATE WEALTH [both with and without the falcon device]". As I indicated above, the opponent initially relied on other grounds. Those other grounds included objections which relied on rights which included a device element but, following amendment of the grounds of opposition, the only marks still relied upon and specified by number in the notice of opposition and accompanying statement of grounds are the two set out in paragraph 2 above. I proceed on that basis noting that IR1035241 has not yet achieved registration and that neither mark is subject to the requirements set out in section 6A of the Act that proof of their use should be shown.

Decision

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

"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”.

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

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

10. At the hearing, Ms Lazenby indicated that the opponent was no longer submitting any arguments against any of the applicant's goods and services in classes 30, 31 or 39. Furthermore, the objection to the applicant's retail and wholesale services in class 35 was also withdrawn. I take this into account.

11. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, 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”.

12. The relevant factors for assessing similarity identified in the *Treat* case, [1996] R.P.C. 281 are:

- 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.

13. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, it was stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

15. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

16. In its written submissions filed in lieu of a hearing, the applicant refers to the businesses of the two parties and concludes that “[t]he respective entities are very different businesses, providing very different services to a very different base of

clients and customers.” Whatever the actual trading activities of the respective parties, in comparing the respective goods and services, I have to do so on a notional basis based on the goods and services as applied for or registered. Following the amendments outlined above, the goods and services which are now subject to opposition or relied upon and which I have to compare are as follows:

Earlier marks' specifications	Applicant's specification
<p>Class 9 (1035241) Downloadable electronic publications and information; downloadable data recorded on data media; magnetic, optical and electronic recording media and data media, credit cards, debit cards, bank cards, mice (data processing equipment), mouse pads; electronic apparatus for payment services</p> <p>Class 16 (1035241) Printed matter; journals; magazines; pamphlets; books; manuals; instructional or teaching material (except apparatus); paper, cardboard and goods made from these materials not included in other classes; calendars; photographs; pictures; stationery; office requisites (except furniture), advertising material, namely stickers, posters and transparencies</p> <p>Class 35 (1035241) Business management services, commercial management, office functions, secretarial services; business management and organization consultancy; consultancy regarding business transactions; business investigations; advice for companies in connection with the development of new services; preparation of information for trade and industry; provision of business information via global computer networks or via telematic networks; efficiency surveys and appraisal in connection with business; evaluation and analysis of company</p>	<p>Class 35 ...database management and compilation; business networking services; business project management; business management consultancy and advisory services; business risk management; business management consultancy and advisory services relating to beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; business management consultancy and advisory services relating to the buying and selling of coffee, coffee beans, cocoa, tea and agricultural crops and products; provision of business information; provision of business information relating to the commodities market of beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; business services; business planning; writing of business plans and reports; compilation of statistical information; provision of business and market reports; market research and market research analysis; economic forecasting and analysis of emerging trends; economic forecasting and analysis of emerging trends to identify threats and opportunities; economic forecasting and to advise in relation to future development, potential partners, collaborators and acquisition opportunities; arranging of buying and selling contracts for third parties; arranging of buying and selling</p>

structure and operation; efficiency experts and activity reports; statistical information and publications; marketing research; economic forecasting services; collection, processing, systematization and administration of data in data banks; tax preparation; marketing; advertising including online advertising; awarding of advertising mandates; rental of advertising surfaces and materials; rental of advertising time in media; public relations; telephone answering services for others; organization and conducting of exhibitions and trade fairs for trade and industry; organization and conducting of exhibitions and trade fairs for economic and advertising purposes; accounting and consultancy concerning accounting; auditing; personnel recruitment; employment agencies; personnel management consultancy; payroll preparation; document reproduction; cost price analysis; all the above-mentioned services excluding related services in the aeronautical field.

Class 36 (1035241)

Financial affairs; monetary affairs; financial management; banking; home banking (e-banking); services provided by a distributing representative and a depository bank for investment funds; purchase and sale of securities; securities brokerage; stock exchange dealing for one's own account and for third parties including trading of securities, derivatives and currencies; administration and safekeeping of securities and objects of value; currency trading and trading of precious metals (financial operations); coupon collection; financial consultancy; financial operations; execution of financial and banking transactions via global computer networks (the Internet); financial information; financial analysis; financial analysis and evaluation of companies; financing services; hire-purchase financing; investments in the

contracts for third parties in relation to beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; arranging of trading transactions and commercial contracts; mediation and negotiation of contracts for purchase and sale of products; mediation of contracts and sale of beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; commercial administration of the licensing of the goods and services of others; information, advisory and consultancy services relating to all the aforesaid services.

Class 42

Scientific and technological services and advice, analysis, research and design relating thereto; scientific consultancy services; technical consultation and research; provision of scientific reports and technical analysis; scientific and technical consultancy services relating to beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; scientific and technical consultancy services relating to blend development, profiling, roasting, harvest processes and cupping, processing, preparation, packing, storage and movement of beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; scientific project management; management of scientific projects (for others); technical project management; technical project management relating to beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; research and development services; research and development for others; product

monetary market; issuance of credit and debit cards; surety services; issuance of securities and participation in such issuances; safe deposit box rental; tax consulting; financial consultancy in inheritance matters; financial evaluation; financial sponsorship.

Class 41 (1035241)

Education and training; courses and teaching by correspondence; entertainment; sporting and cultural activities; ticket agency services (entertainment); organization and conducting of seminars, conferences and training workshops; organization of exhibitions for cultural or educational purposes; desktop publishing; providing electronic publications (not downloadable); publication of books; publication of texts (other than advertising texts); digital imaging services; electronic publication of books and periodicals on line; organization of competitions (education and entertainment).

Class 35 (2650101)

Business management services; commercial management; office functions; secretarial services; business organization and management consultancy; consultancy relating to business transactions; business investigations; advice for companies in connection with the development of new services; preparation of information for trade and industry; provision of business information via global computer networks or via telematic networks; assessment and efficiency surveys in business affairs; evaluation and analysis of company structure and operation; efficiency experts and business reports; statistical information and publications; marketing research; economic forecasting services; collection, processing, systematization

development; product development for others; product development consultancy services; testing, inspection and research in relation to beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; design, development, and testing services for others in the fields of new food and drink products; scientific and technological information, advice and consultancy services relating to food labelling and specifications, food safety hazard analysis and food safety critical control points; food safety testing; testing, authentication and quality control; quality control support and development services; quality control of raw materials; quality control of beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; quality control services in relation to sustainability and traceability of beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; information, advisory and consultancy services relating to all the aforesaid services

and administration of data in data banks; tax declaration preparation; marketing; advertising including online advertising; awarding advertising agency contracts; rental of advertising surfaces and materials; rental of advertising space; rental of advertising time in media; arranging for the rental of advertising time in media and advertising space; public relations; telephone answering services for third parties; organization and conducting of exhibitions and fairs for trade and industry; organization and conducting of exhibitions and fairs for economic and advertising purposes; accounting and consulting concerning accounting; auditing; personnel recruitment; employment agencies; personnel management consultancy; payroll preparation; document reproduction; cost price analysis.

Class 36 (2650101)

Financial affairs; monetary affairs; financial management; banking; home banking (e-banking); banking services provided online and via the Internet; financial services provided by a distributing representative and a depository bank for investment funds; purchase and sale of securities; securities brokerage; stock exchange dealing for one's own account and for third parties including trading of securities, derivatives and currencies; administration and safekeeping of securities and objects of value; currency trading and trading of precious metals (financial operations); financial consultancy; financial operations; execution of financial and banking transactions via global computer networks (the Internet); financial information; financial analysis; financial analysis and evaluation of companies; financing services; hire-purchasing financing; investments in the monetary market; issuance of credit and debit cards; surety services; issuance of

securities and participation in such issuances; safe deposit box rental; tax consulting; financial consultancy in inheritance matters; financial evaluation; financial sponsorship.	
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The applicant's services in class 35

17. To the extent that the applicant's specification in class 35 remains opposed, the opponent puts its case as follows:

"All of the applicants' services in class[-] 35 [-] are identical to those of the Opponents in that they are expressly listed in the Opponents' specification, or synonymous with them, or included in a more general category in the Opponents' marks...Alternatively, they all share a very high degree of similarity. This is to be expected, of course, given that both parties are in the financial/business management services sector, and [this class is] the most apposite for this sector."

18. In its counterstatement, the applicant admits that the vast majority of the still opposed services in class 35 are similar to those of the opponent in the same class. The only services it does not specifically admit are similar are its *information, advisory and consultancy services relating to all the aforesaid services*. Its submissions were filed before the opponent withdrew its objection to the applicant's retail and wholesale services. Its information, advisory and consultancy services would have included those relating to the retail and wholesale services so it is perhaps not surprising it did not make an admission in relation to them. To the extent it has admitted the respective services are similar, I find the information, advisory and consultancy services relating to those services also to be similar.

The applicant's services in class 42

19. As regards the applicant's services in class 42, and for completeness, I should mention that in her skeleton argument and at the hearing, Ms Lazenby made a suggestion for a possible limitation to be made to the applicant's specification in this class "in an effort to settle this matter". Settlement negotiations are, of course, a matter for the parties but any request to amend the specification of an application

(whether or not as a result of such negotiations) is a matter for the applicant to make. The applicant has not made any such request and I say no more about Ms Lazenby's proposal.

20. Whilst the applicant denies there is any similarity between its services in class 42 and the opponent's goods and services, in her skeleton argument Ms Lazenby maintains each of the services are similar or identical. Attached to her skeleton argument is a table which she submits has been arranged "according to the Meric principles" and in which she lists the parties' services she regards as identical. She submits:

"As for class 42, the technological, technical, scientific and development services, if their subject matter is financial – for example the development of a computer programme which predicts the best time for purchase of futures contracts for coffee - will be similar to the Opponents' services in classes 36 and 35. Another example: scientific project management in class 42 will be similar to any business project management services in class 35 (which are in turn encompassed within business management and organisational consultancy). And there is also similarity of these class 42 services with the goods in the Opponents' class 9 specifications, in particular downloadable data recorded on data media – the services for creating the data is obviously similar to the medium on which that data is recorded."

21. Whilst Ms Lazenby also refers to some of the principles set out in the case law above, she has not provided any other specific submissions to explain why, in light of those principles, the opponent considers the respective goods and services to be similar or identical.

22. I can see no way in which the opponent's goods in class 9 are similar to the applicant's services in class 42 as per Ms Lazenby's submissions. Many businesses use e.g. downloadable data recorded on data media. Whilst providers of e.g. consultancy, technical or scientific services may use such goods to provide their clients with information, this does not mean, of itself, that the users and nature of the services are the same or even overlap. The trade channels of the respective goods

and services differ and they are not in competition nor are they complementary. I find them to be dissimilar. For similar reasons, I can see no similarity between the applicant's services in class 42 and the opponent's goods in class 16.

23. Comparing the applicant's services in class 42 with the opponent's services as registered in class 35, Ms Lazenby refers me to the decision in *Alpha* BL O-127-17 and submits that the Hearing Officer found in that case that "investment banking has a *very low level of similarity*" with product development." This is not, in fact, what the Hearing Officer said in the quoted case. Ms Lazenby also refers me to the decision of the First Board of Appeal in *Axis Corporate SL v Axys Consultants* Case R 1997/2015-1 which I take into account as appropriate.

24. In her table, Ms Lazenby submits that the applicant's *scientific project management; management of scientific projects (for others); technical project management* are included within and therefore identical to the opponent's *Business management services*. The principal object and therefore the core meaning of *business management services* in class 35, as the explanatory notes to the relevant part of the *Nice Convention* make clear, is the provision of help in the working, management, commercial functions or business affairs of a commercial undertaking. This differs from the core meaning of the applicant's named services which each relate to the provision of services to manage scientific or technical projects. The services are not ones with which everyone will be familiar. The opponent has chosen not to file evidence to show any general overlap in the services nor has it filed any evidence to show the extent to which the respective services may be in competition or complementary. Absent such evidence, I find they are dissimilar services.

25. The opponent's *advice for companies in connection with the development of new services* are advisory services relating to the business itself. It could be argued there is a degree of overlap with the applicant's *research and development services; research and development for others; product development; product development for others; product development consultancy services; testing, inspection and research in relation to beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; design, development, and testing services for others in the fields of new food and drink*

products; in that both are intended to assist businesses be more effective or successful. As before, however, the opponent has chosen not to file evidence to show that any general overlap in the services leads to them being similar services in terms of users, natures or trade channels nor has it filed any evidence to show the extent to which the respective services may be in competition or complementary. Absent such evidence, I find they are dissimilar services.

26. Absent any specific submissions or evidence regarding the remainder of the applicant's services in class 42, I can see no way in which those services are similar to the opponent's services in class 35.

27. In its statement of grounds the opponent's submits that the applicant's services in class 42 will be similar "if their subject matter is financial" to the opponent's services as registered in class 36". Many of the applicant's services in class 42 are specifically directed to those relating to beverages, foodstuffs and agricultural crops. Even where they are not so directed but are more general, absent specific submissions or evidence to the contrary, I can see no way in which the respective services are similar.

28. As for the opponent's claimed conflict between the applicant's services in class 42 and the opponent's services in class 41, the only submission on this is given in the table attached to Ms Lazenby's skeleton argument by which she submits that the opponent's *education and training*" services "encompass[-] all education and training on the subject matter of all the applicants' class 42 services". Self-evidently, education and training services provide instruction and knowledge in particular topic areas. The opponent's education and training services are not limited and so would include such services in relation to any particular topic areas including e.g. scientific and technological matters, quality control, product development or food safety testing. Whilst this could potentially lead to a degree of overlap in the users of the parties' respective services, the natures of the respective services differ. In terms of trade channels, there is no evidence that providers of the services specified in class 42 routinely or commonly provide education or training relating to their services nor is there any evidence that they are competitive or complementary services. I find the

applicant's services in class 42 to be dissimilar to the opponent's services in class 41.

The average consumer and the nature of the purchasing process

29. 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*.

30. 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.”

31. The respective goods and services are wide-ranging but all are most likely to be used by businesses or other commercial organisations. Suppliers are likely to be identified through e.g. trade connections, trade magazines, direct marketing or internet research and bought with a fair, though not the highest, degree of consideration.

Comparison of the respective marks

32. The marks to be compared are as follows:

The opponent's marks	The applicant's mark
FALCON PRIVATE BANK	FALCON
FALCON PRIVATE WEALTH	

33. The applicant's mark consists of the single word FALCON in plain block capitals and its distinctiveness rests in its whole. The opponent's marks are also presented in plain block capitals. Each consists of three words, the first of which is also FALCON. The remaining words are PRIVATE BANK or PRIVATE WEALTH, each of which form a unit and are non-distinctive of such services. Even where the goods/services offered under the mark are not those relating to private banking or private wealth, it is the word FALCON which is the dominant, distinctive element of each of the opponent's marks, a dominance enhanced because of its position at the start of the marks.

34. As the word FALCON forms the only or first word within the respective marks there are obvious visual and aural similarities between them. The words PRIVATE BANK/PRIVATE WEALTH in the opponent's marks, which have no equivalent in the applicant's mark, are obvious points of difference. I consider the respective marks are visually and aurally similar to a medium degree.

35. The applicant's mark brings to mind a bird of that name. The opponent's marks each bring to mind a business involved in the relevant financial sector known by the name FALCON.

The distinctiveness of the earlier marks

36. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated:

“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).”

37. The opponent has filed no evidence of any use of its marks. I therefore have only their inherent distinctiveness to consider. Whilst the words Private Bank and Private Wealth are non-distinctive of private banking or wealth services, the word Falcon has no meaning in relation to any of the goods and services for which it is registered though is an ordinary dictionary word which will be understood by the average consumer as being the name of a bird. The opponent’s marks each have an average degree of inherent distinctive character.

Likelihood of confusion

38. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive

character of the earlier trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

39. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

40. On this basis, where there is no similarity of goods and/or services, there can be no likelihood of confusion. The only services within the application which I have found to be similar to those of the opponent are its opposed services in class 35 (and which the applicant has admitted are similar) along with *information, advisory and consultancy services relating to all the aforesaid services* as opposed.

41. Taking all matters into account, I find that the similarities between the marks are such that there will be direct confusion where there is similarity of services. Even if I am wrong in this, I consider the similarities between them will lead the average consumer of the services which have been admitted or found to be similar come from the same or economically linked undertakings, i.e. there will be indirect confusion.

Summary

42. The opposition succeeds in respect of the following services in class 35:

Database management and compilation; business networking services; business project management; business management consultancy and advisory services; business risk management; business management consultancy and advisory services relating to beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; business management consultancy and advisory services relating to the buying and selling of coffee, coffee beans, cocoa, tea and agricultural crops and products; provision of business information; provision of business information relating to the commodities market of beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; business services; business planning; writing of business plans and reports; compilation of statistical information; provision of business and market reports; market research and market research analysis; economic forecasting and analysis of emerging trends; economic forecasting and analysis of emerging trends to identify threats and opportunities; economic forecasting and to advise in relation to future development, potential partners, collaborators and acquisition opportunities; arranging of buying and selling contracts for third parties; arranging of buying and selling contracts for third parties in relation to beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; arranging of trading transactions and commercial contracts; mediation and negotiation of contracts for purchase and sale of products; mediation of contracts and sale of beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made from coffee, cocoa or tea; commercial administration of the licensing of the goods and services of others; information, advisory and consultancy services relating to all the aforesaid services.

43. The opposition has been withdrawn in respect of the goods in classes 30, 31 and 39 and the following services in class 35:

Retail and wholesale services connected with the sale of beverages and foodstuffs, agricultural crops and products, coffee, coffee beans, cocoa, tea, and products made

from coffee, cocoa or tea and fails in respect of information, advisory and consultancy services relating to such services.

44. The opposition fails in respect of the services in class 42.

45. Subject to any successful appeal, the application may proceed to registration for all goods and services except those set out at paragraph 42 above.

Costs

46. Although both parties have achieved a measure of success, the applicant has been substantially more successful and is entitled to an award of costs in its favour to reflect that success. Given the date the opposition was filed, the scale of costs applicable is that set out in Tribunal Practice Notice ("TPN") 4/2007. Using that TPN as a guide and bearing in mind that neither side filed evidence, I make the award on the following basis:

For filing a counterstatement and reviewing the notice of opposition:	£200
For written submissions in lieu of attendance at a hearing:	£300
Total:	£500

47. I order Falcon Private Bank Ltd to pay Falcon Coffees Limited the sum of £500 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of January 2018

Ann Corbett
For the Registrar
The Comptroller-General