

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2109228
BY ABERDEEN TRUST PLC
TO REGISTER A DEVICE MARK
IN CLASSED 35 & 36

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47078
NY UEBERSEEBANK AG

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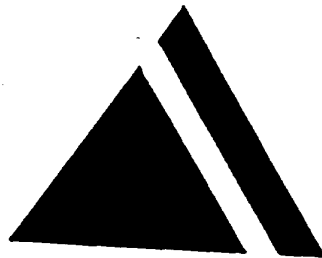
IN THE MATTER OF APPLICATION No 2109228
by ABERDEEN TRUST PLC
5 TO REGISTER A TRADE MARK IN CLASSES 35 & 36

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47078
10 by UEBERSEEBANK AG.

DECISION

BACKGROUND

15 On 31 August 1996, Aberdeen Trust Plc of 10 Queens Terrace, Aberdeen AB10 1QG applied under the Trade Marks Act 1994 for registration of the trade mark shown below:



In respect of the following goods in Class 35:

30 “Company administration and secretarial services; operation and management of companies. .”

And in Class 36:

35 “Investment fund management and advice; unit trust management services; operation and management of investment trusts; private portfolio investment management and advice services; insurance underwriting advisory services; pension fund management; personal equity plans and management services.”

40 On the 19 June 1997 Ueberseebank AG filed notice of opposition to the application. The grounds of opposition are:

45 i) that the opponents are the registered proprietors of the trade mark application number 2056672 Triangle Device series of two (colour / black and white) in Class 36 filed on 12 February 1996 in respect of “services of banks and credit institutes, investment funds, trusteeships”. On 30 April 1997 a TM12 form was filed to divide the series and the colour version was accepted by the Registrar, whilst the black and white version is still pending. The triangle device is in use in the UK in

both variations.

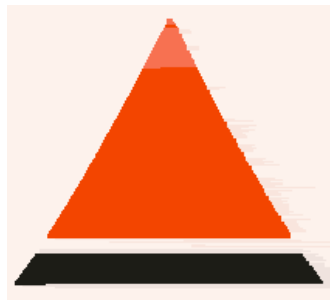
5 ii) The device constituting application number 2109228 in Classes 35 and 36 is essentially the same device as that of 2056672 rotated by 120 degrees and was filed on 31 August 1996. Further, the services of 2109228 within Class 36 are identical or similar to those of 2059228 and those of 2109228 within Class 35 are similar or are associated services. Therefore, since application 2109228 postdates that of the opponents it was accepted in error by the Registrar. Registration of the application would be contrary to Section 5(1) of the Trade Marks Act 1994.

10 iii) Since the marks are identical or at least very similar and since the services of interest to 2109228 are the same as or similar services to those in respect of which the opponents' trade mark is applied for and used, registration of the application would be contrary to Sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994.

15 iv) Registration of the application would be contrary to Sections 5(3), 5(4)(a), 5(4)(b) and 3(6) of the Trade Marks Act 1994.

20 The opponents further requested that the Registrar refuse application number 2016569 in the exercise of her discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

25 Following the filing of the opposition the opponent's black and white mark was withdrawn, leaving only the colour mark registered. It is this mark that I shall therefore refer to in my decision when comparing the opponent's mark to the applicant's mark. The mark is reproduced here for ease of reference:



35

40 The applicants subsequently filed a counterstatement denying all of the grounds of opposition, but did not file any evidence. Both sides ask for an award of costs. Neither side wished to be heard. My decision will therefore be based on the pleadings and the evidence filed.

OPPONENTS' EVIDENCE

45 This takes the form of a statutory declaration by Mr Peter Zimmerman, dated 25 November 1997, who is the Treasurer of Umberseebank AG the opponents in these proceedings.

At exhibit PZ1 Mr Zimmerman provides copies of forms used by his company which show use of the opponents mark. The three forms provided all have the opponents mark at the foot of the page. At exhibit PZ2 he provides a copy of a leaflet describing the Managed Fund Account. The form is dated 1 April 1992 and again shows the opponents mark on the front and back covers of the leaflet.

At exhibit PZ3 are what appears to be copies of the front covers from brochures, which Mr Zimmerman states were available in the UK. The titles shown are:

- UeberseeBank 1989
- Banking in Switzerland (hand written date of 1991)
- Asset Management (hand written date of 1997)
- Private Banking (hand written date of 1991)
- The Managed Fund Account
- Your Partners for a Secure Future
- UBZ Diversified Strategies Fund (hand written date of 1994)
- Asia Growth Convert Fund (hand written date of March 1993)
- Mutual Funds and Actively Managed Investment Strategies: 1 June 1996
- US Value Growth Fund

Each of the copies has the opponents triangle device mark at the foot of the page.

At exhibit PZ4 copies of promotional materials are provided. This consists of what appears to be four advertisements which have the opponents name and trade mark shown prominently.

Mr Zimmerman states that the opponents have been active in the UK for eight years and is, he says, well known as a private bank. He claims that the exhibits “show that within the specialised sphere of banking, the Ueberseebank Device Mark is distinctive and recognised as a trade mark and has been used as such for a considerable time”.

Mr Zimmerman states that the opponents filed their trade mark six months earlier than the applicants and therefore, he claims, has prior rights at the Registry and in the marketplace.

Mr Zimmerman states that:

“The applicant’s trade mark application is for a trade mark identical with that of the opponents, as are also the services for which the trade mark is applied. Specifically, the trade mark applied for by The Aberdeen Trust Plc is essentially the same equilateral triangle as the Ueberseebank trade mark with a trapezium shaped stripe next to one side, the only difference being that the applicant’s is rotated through 120 degrees. Further, the services of interest to the Aberdeen mark in Class 36 include broad services in the sphere of banking and so are identical or at least similar.”

Lastly, Mr Zimmerman claims that the opponents have, due to their extensive use of the mark, acquired a considerable and extensive reputation in the trade mark in suit.

That concludes my review of the evidence. I now turn to the decision.

DECISION

I first turn to the grounds of opposition under Sections 5(1) and (2) which are as follows:

5 5. - (1) *A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the services for which the earlier trade mark is protected.*

10 5.- (2) *A trade mark shall not be registered if because -*

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

15 *(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 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.”

20

An earlier right is defined in Section 6, the relevant parts of which state

25 6. - (1) *In this Act an ‘earlier trade mark’ means -*

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

30 *(b)...*

(c)

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

The marks are clearly not identical. The opposition under Section 5(1) therefore fails.

40 I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding whether the two marks are similar I rely on the decision of the Court of Justice of the European Communities (ECJ) in the *Sabel v Puma* case C251/ 95 - ETMR [1998] 1-84. In that case the court stated that:

45 “*Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on*

5 numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified'. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

10 Global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - "there exists a likelihood of confusion on the part of the public" - shows that the perception of the marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

15 In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public."

20 I also have regard to the approach adopted by the European Court of Justice in Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. (case C-39/97) (ETMR 1999 P.1) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

25 "A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified."

30 Further, I take account of the following guidance of the European Court of Justice in Lloyd Schuhfabrik Meyer & Co (1999 ETMR 690) in which the court held that:

35 "For the purposes of ... global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has

kept in his mind. It should be also 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."

5 In order to make the global assessment on the similarity of the marks, it is necessary to consider individual aspects of the question. I propose to firstly consider the similarity of the services of the two parties.

10 The opponent's registration for Class 36, "Services of banks and credit institutes, investment funds, trusteeships", is clearly similar to the applicant's services in the same class "Investment fund management and advice; unit trust management services; operation and management of investment trusts; private portfolio investment management and advice services; insurance underwriting advisory services; pension fund management; personal equity plans and management services". At the relevant date, 31 August 1996, banks commonly provided the range of services set out in the applicant's specification.

15 I also regard the opponent's services particularly those provided under "trusteeships" to be similar to the applicant's services in Class 35 "Company administration and secretarial services; operation and management of companies".

20 I turn therefore to consider whether taking into account the fact that the services covered by the application are the same or similar to the services of the opponents, the trade marks themselves are similar.

25 Both parties' marks consist of an equilateral triangle. The opponent's mark has a line drawn parallel to the base line connecting the two sides. Below this line the mark is coloured black, the line itself is white with the remaining portion above the line being coloured red. The applicant's mark has a similar dividing line but this runs parallel to the right hand side of the triangle. The applicant's mark is filed in black and white and has no colour limitation. The dividing line in the opponent's mark is slightly narrower than that in the applicant's mark.

30 The opponent has claimed that the applicant's mark is exactly the same as its own mark except that it has been rotated through 120 degrees. This is an accurate statement and in my opinion the mere act of rotating a basic geometric shape by 120 degrees does not create a radically different trade mark. There is nothing in applicant's mark to orientate the viewer as to which is the "top" or "bottom" of the mark.

35 The applicant's mark is not restricted to black and white, they would therefore be entitled to use any colours for the different parts of the mark if they desired. I have to have regard to normal and fair use of the mark and this would include use in any colour.

40 I also have to consider the concept of imperfect recollection. The only difference between the marks is the side along which the break in the triangle runs. This is the sort of detail that is likely to be poorly recollected in the "imperfect picture" that the average consumer keeps in his mind.

45 In my view the similarities between the marks and the goods are such that there is a likelihood that the average consumer would be confused. The opposition under Section 5(2) succeeds.

As this finding decides the matter I do not need to consider the other grounds of opposition.

5 The opposition having succeeded the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £535

10 This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

15 Dated this 9 day of May 2000

20 George W Salthouse
For the Registrar
The Comptroller General