

O-319-03

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No. 749365
AND A REQUEST BY STEVEN R A VAN EIJCK AND
MATHEW M FAWCETT TO PROTECT A TRADE MARK IN CLASS 36**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 70773
BY CERTIFIED FINANCIAL PLANNER BOARD OF STANDARDS INC**

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**IN THE MATTER OF International Registration No. 749365
and a request by Steven R A van Eijck and Mathew M Fawcett
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**IN THE MATTER OF Opposition thereto under No. 70773
by Certified Financial Planner Board of Standards, Inc**

BACKGROUND


1. On 10 August 2000 Steven R A van Eijck and Mathew M Fawcett, on the basis of a Benelux registration, requested protection in the United Kingdom for the following trade mark in respect of 'financial consultancy':

European Financial Planner €FP

2. The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

3. On 19 March 2002 Certified Financial Planner Board of Standards, Inc filed notice of opposition to the conferring of protection on this international registration. Following amendment to the statement of grounds the only remaining ground of opposition is under Section 5(2)(b) of the Act. For this purpose the opponents rely on the following UK and Community Trade Mark registrations, all of which constitute earlier trade marks within the meaning of Section 6(1)(a) of the Act:

NO	MARK	CLASS*	SPECIFICATION*
2017731	CFP	36	Banking, insurance and investments services; financial advisory services; financial appraisal services; financial consultation services; provision of financial information; financial management; financial planning; preparation of financial reports and analysis; financial research.

2011168		36	Banking, financial, insurance and investments services; financial advisory services; financial appraisal services; financial consultation services; provision of financial information; financial management; financial planning; preparation of financial reports and analysis; financial research.
344176	CFP	36	Banking, financial, insurance and investments services; financial advisory services; financial appraisal services; financial consultation services; provision of financial information; financial management; financial planning; preparation of financial reports and analysis; financial research.

*(Most relevant class and specification only)

4. The opponents submit that the parties respective marks are similar and that identical and/or similar goods are covered by the specifications concerned such that there is a likelihood of confusion within the meaning of the Section.

5. The international registration holders (hereafter applicants for ease of reference) filed a counterstatement denying the above ground. In doing so they set out their submissions on the issue of similarity. I will deal with these below.

6. Neither side filed evidence but both sides asked to be heard on the matter. A hearing was set down for 7 October 2003 when the applicants were represented by Mrs M Gurney of Phillips & Leigh and the opponents by Mr P Houlihan of fj Cleveland.

7. The only ground of objection is under Section 5(2) of the Act. This reads:

“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
- (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.”

8. Sub-paragraph (b) applies here. The marks relied on by the opponents are all earlier trade marks within the meaning of Section 6(1)(a) of the Act.

9. At the hearing I was referred to, and I accept that I must take account of, the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77. I was also referred to the Appointed Person’s decision in *Flextech Television Limited v IPC Magazines Limited (UK Living)*, O/53/03 regarding the correct way to conduct the comparison.

Comparison of services

10. At the hearing Mr Houlihan based his submissions on CTM 344176. This has in its specification (inter alia) “financial consultation services”. The applicants concede that this term must for practical purposes be taken to mean the same thing as “financial consultancy” which is the specification of services for the applied for mark. I regard the respective services as being identical.

Comparison of marks

11. The distinctive and dominant components of the respective marks is a factor that must be taken into account (*Sabel v Puma*, paragraph 23). The opponents’ mark consists of the letters CFP. I am not aware that it has any descriptive connotations in relation to the services concerned. I assume it is an abbreviation derived from the opponents’ name (Certified Financial Planner Board of Standards, Inc). Mr Houlihan accepted that three letter marks do not enjoy a particularly high degree of distinctive character. That may be so given that the use of initials and abbreviations is relatively common. I regard CFP as having a modest degree of distinctive character when used in relation to the services at issue.

12. The applied for mark is:

European Financial Planner €FP

13. The E of European is replaced with the euro symbol and that same symbol is repeated and forms the first letter of the letter combination that follows the words. The words European Financial Planner appear to me to have a low to negligible capacity to contribute to the distinctive character of the mark. If there is a spark of distinctiveness in the words it must be in the fact that the third word is Planner rather than Planning. But that would at best be a weak claim. The letters that follow the words will inevitably be seen as an abbreviation of the words. EFP is not to the best of my knowledge an accepted or known abbreviation. As a standalone mark it would carry a degree of distinctive character comparable to the opponents’ mark. However, the impact of the letters is somewhat reduced when they are presented as an

abbreviation of words which are themselves descriptive in character. But the mark is not EUROPEAN FINANCIAL PLANNER EFP it is that combination of words and letters with the initial E replaced by the euro symbol. Use of the euro symbol is not in itself particularly distinctive in relation to financial consultancy services (it is a symbol that now enjoys a high degree of public recognition in my view – I note, for instance, that it appears on my computer keypad). Using it to replace a letter E shows some but, certainly not a high degree of, invention. The distinctive character of the applied for mark is best seen as residing in the combination of features which individually are of low to modest distinctive character. If consumer attention is focussed on particular aspects of the mark it is more likely to be the letters and use of the euro symbol rather than the words. But that is not to say that the words will be discounted.

14. The visual, aural and conceptual similarities of the marks are to be assessed by reference to the overall impressions created by those marks, bearing in mind their distinctive and dominant components. *Sabel v Puma*, paragraph 23. Mr Houlihan submitted that, whilst the first parts of trade marks have traditionally been held to be of particular importance, this was not so here. In his view the applied for mark consists of two distinct elements with the second element dominant such that the mark is likely to be truncated to €FP. He distinguished the circumstances here from *COMFORT AND JOY* [1997] ETMR 577 (where the totality of the mark applied for was held to conjure up a different idea to JOY on its own). In my view that is only partially the case. There is a certain synergy in the applied for mark resulting from the use of the euro symbol though I agree the reason is somewhat different to Comfort and Joy.

15. The high point of the opponents' case must be that the second element of the mark, taken on its own, has some visual similarity to the letters CFP. In my view even that is straining matters somewhat. The average consumer is unlikely to be so careless in his or her appreciation of the respective marks/elements that such a mistake will be made. In any case it is not permissible to dissect the applicants' mark in this way. Even accepting that €FP may attract particular attention it will still be in the context of the first element European Financial Planner. The elements of the applied for mark reinforce each other. I find the visual similarities between the marks to be at a low level.

16. Mr Houlihan attached some importance to phonetic considerations because, in his view, word of mouth recommendations and references would be likely to play a part in the purchasing process. That may be so but I have no evidence on the point one way or the other. I would have thought it equally if not more likely that consumers would respond to visual references in advertisements etc. Mr Houlihan suggested that E and C are very similar sounds with F and P being identical. I am not persuaded that the difference between an E and C sound would not be clearly noted in a short three letter combination and, again, that basis of comparison involves dissection of the applicants' mark. Taking the marks as wholes and the context in which €FP is used I find a low level of similarity.

17. Conceptually the opponents say that the distinctive elements of both marks would be seen as abbreviations or initials. It is not enough to say that the marks consist of abbreviations. All abbreviations would have that point in common. The opponents'

mark is a meaningless three letter combination. The abbreviation in the applied for mark is given meaning by the words that precede it. I can see no conceptual similarity.

Likelihood of confusion

18. This is to be appreciated globally taking account of all relevant factors (*Sabel v Puma*, paragraph 22). The level of attention of the average consumer is one of the factors to be borne in mind. Mr Houlihan acknowledged that consumers are likely to pay more attention where financial consultancy/advice is concerned than when, say, purchasing goods in a supermarket but suggested that attention would not be as great as when, for instance, buying a luxury car. Mrs Gurney argued that financial consultancy was a sophisticated marketplace where customers would be more discerning. Whilst financial consultancy no doubt covers a range of subjects (with some requiring more attention than others) I think it is unlikely that the average consumer (who may be an individual or a corporate customer) will enter into it without a good deal of care and attention. I have little hesitation in concluding that such a person is unlikely to be confused if faced with the marks at issue here. I reach that view in the full knowledge that identical services are involved and making due allowance for the possible effect of imperfect recollection. Accordingly, the opposition fails.

Costs

19. The applicants are entitled to a contribution towards their costs. Mrs Gurney referred me to two amendments that had been made to the opponents' statement of case. These involved withdrawal of a ground based on Section 5(4)(a) and a request to introduce CTM 344176 as an earlier trade mark. So far as the first of these points is concerned, as no evidence has been filed by either side, I cannot see that the applicants have been materially inconvenienced. Their involvement has been restricted to a denial in their counterstatement and putting the opponents to proof of their claim. So far as the second point is concerned the opponents were successful in having their CTM registration brought into their statement of case. The fact that it has not benefited them in terms of the outcome of the opposition is reflected in my costs award and does not call for any additional award to either side. I order the opponents to pay the applicants the sum of £750. This sum is 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.

Dated this 21st day of October 2003

M REYNOLDS
For the Registrar
the Comptroller-General