

O-259-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2376865
BY CUBE PUBLISHING LTD
TO REGISTER THE TRADE MARK:**

STANDARD LITE

IN CLASSES 9, 16 & 41

AND

**THE OPPOSITION THERETO
UNDER NO 93561
BY STANDARD LIFE INSURANCE COMPANY**

Trade Marks Act 1994

**IN THE MATTER OF Application No 2376865
by Cube Publishing Ltd
to register the trade mark:
STANDARD LITE
in Class 9, 16 & 41
and the opposition thereto
under no 93561
by Standard Life Insurance Company**

BACKGROUND

1. On 29 October 2004 Cube Publishing Limited, whom I shall refer to as Cube, applied to register the trademark STANDARD LITE, application no. 2376865, for the following goods and services.

Software; electronic publications; CD Roms; computer software and hardware to enable searching of data and connection to databases and the Internet; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; data processing equipment and computers; parts and fittings for all the aforesaid goods.


Paper, cardboard and goods made from cardboard; printed matter; printed publications; newspapers; magazines; supplements; posters; periodicals; books; brochures; leaflets; user guides and training manuals; maps; holiday and travel guides; calendars, diaries and stationery; bank cards and debit cards (other than encoded or magnetic).


Education and entertainment services; publishing services; publication of printed matter and printed publications; publication services; electronic publishing services; providing on-line electronic publications [not downloadable]; publication of electronic books and journals on-line; organisation of exhibitions and shows; provision of information relating to education, sporting, political, current events, cultural activities and entertainment; sports information services; organisation of competitions, quizzes, games and recreational and cultural facilities; news programme services for radio or television; all the aforesaid services also provided on-line from a computer database or from the Internet; information services relating to all the aforesaid services; electronic game services provided by means of the Internet; production of shows and radio and television programmes; cable television, television and radio entertainment services; providing digital music [not downloadable] from the Internet; providing digital music [not downloadable] from MP3 Internet web sites.

The above goods are in classes 9, 16 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The trade mark and specification were published for opposition purposes in the 'Trade Marks Journal' (no 6575) on 1 April 2005.

2. In a letter received at the Trade Marks Registry on 5 July 2005, Standard Life Assurance Company, whom I will refer to as SLAC, of Standard Life House, 30 Lothian Road Edinburgh, Scotland, filed notice of opposition to this registration on grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994, referred to hereafter as the Act. This opposition was based on 13 earlier trade marks owned by SLAC who seek refusal of the registration in its entirety and an award of costs.

3. Following correspondence between the opponent and the Trade Marks Registry, an amended statement of grounds dated 17 August 2005 was filed by SLAC which amended the basis of the opposition to refer to seven of the thirteen earlier trade marks for which use in the relevant period could be shown. These are:

Mark	Number	Effective Date	Class	Specification
STANDARD LIFE	CTM 496729	25.03.1997	35	Accounting, auditing and personnel services; payroll processing services; computerised database management services; provision of information relating to all the aforesaid services; provision of business statistical information; advisory and consultancy services all relating to the aforesaid services.
			36	Banking, financial, trust management, unit trust, trusteeship, fund investment management, insurance, financial investment, pension, financial management, personal loan financing, mortgage, real estate agency, real estate management and real estate leasing services; provision of finance or of credit; actuarial services; financial appraisal services; advisory, information and consultancy services all relating to the aforesaid services.
			42	Computer programming services; computer consultancy services; design of computer hardware; rental of computer hardware and computer software; leasing of access time to a computer database; all the aforesaid services being related to financial and insurance services; legal services; advisory, information and consultancy services all relating to the aforesaid services.
	UK 1505199	30.06.1992	35	Accounting, auditing and personnel services, all relating to pensions; payroll processing services; computerised data base management services; statistical information services; all included in Class 35.
			36	Banking, trust management, unit trust, trusteeship, fund investment management, insurance, financial investment, pension, financial

				management, personal loan financing, mortgaging, real estate agency, real estate management and real estate leasing services; provision of finance or of credit; all for real estate development; all included in Class 36.
			42	Computer programming services; computer consultancy services; design of computer hardware; rental of computer hardware and computer software; leasing of access time to a computer data base; legal services; advisory, information and consultancy services, all relating to all the aforesaid services; all included in Class 42.
STANDARD LIFE	UK 1272922	01.10.1986	35	Legal, accounting, auditing and personnel services, all relating to pensions; payroll processing services; computerised data-base management services; statistical information services for business purposes; all included in Class 35.
STANDARD LIFE	UK 1272923	01.10.1986	36	Banking, trust management, unit trust, trusteeship, fund investment management, insurance, financial investment, pension, financial management, personal loan financing, mortgaging, real estate agency, real estate management and real estate leasing services; provision of finance or of credit, all for real estate development; all included in Class 36.
	UK 1276787	01.10.1986	42	Computer programming services; computer consultancy services; design services for computers; computer hardware and software rental services; services for leasing access time to a computer data base; legal services; all included in Class 42.
STANDARD LIFE	UK 1276788	01.10.1986	42	Computer programming services; computer consultancy services; design services for computers; computer hardware and software rental services; services for leasing access time to a data base; legal services; all included in Class 42.
STANDARD LIFE HOMEPLAN	UK 1482606	13.11.1991	36	Banking; insurance services; mortgage services; all relating to homes; all included in Class 36.

4. The amended statement of grounds also narrowed the Section 5(2)(b) objection to some of the goods of the registration and not all of them as before. SLAC is opposing

(a) registration of the following class 9 goods:

“Software; electronic publications; CD Roms; computer software and hardware to enable searching of data and connection to databases and the Internet; data processing equipment and computers; parts and fittings for all the aforesaid goods”

because they are similar and confusing with the following class 42 services of UK registration nos. 1276787 and 1505199:

“Computer programming services; computer consultancy services; design services for computers; computer hardware and software rental services; services for leasing access time to a data base; legal services; all included in Class 42”, and

with the following services in class 42 of CTM 000496729:

“Computer programming services; computer consultancy services; design of computer hardware; rental of computer hardware and computer software; leasing of access time to a computer database”

(b) registration of the following class 16 goods:

“printed matter; printed publications; newspapers; magazines; supplements; posters; periodicals; books; brochures; leaflets; user guides and training manuals”

which, if referring to business, financial, legal, personal, public relations, advertising, real estate or computer related topics would be similar and confusing with the services in classes 35, 36 and 42 in all seven SLAC trade marks registrations identified above.

5. The Section 5(3) objection is maintained against all the goods and services of the application.

6. On 5 October 2005, Cube filed a notice of defence and counterstatement refuting both grounds of the opposition, seeking registration of the mark and costs in their favour. Cube admitted that SLAC was the registered proprietor of the above earlier trade marks but put SLAC to strict proof regarding the use of these marks.

7. Only SLAC filed evidence.

8. Cube requested a hearing on 16 November 2006. The case was heard before me on 1 February 2007. The Applicant, Cube was represented by Mr Martin Krause of Haseltine Lake, Patent & Trade Mark Attorneys. The opponent SLAC was represented by Ms Karen Veitch of Kennedy’s Patent & Trade Mark Attorneys. Written submissions were received from both sides.

EVIDENCE

Evidence of Opponent – Standard Life Assurance Company (SLAC)

9. The opponent’s evidence comprised of a witness statement by Mr Patrick Haslett and 8 associated Exhibits (PH1-PH8). Mr Haslett is a Senior Solicitor in the Legal Commercial Department of SLAC and he has held this position for 5 years. He is authorised to speak

on behalf of SLAC and his evidence comes from his own personal knowledge and belief and from the books and records of the company.

10. Standard Life Insurance Company (SLAC) is the parent company and it operates in the United Kingdom as a provider of life insurance, pensions, savings plans and investment bonds. It was founded in 1825 (see 2003 Annual Report in Exhibit PH1). Its UK subsidiaries include Standard Life Bank Limited, founded in 1998, which handles Mortgages, Home Insurance and Savings; Standard Life Investments Limited, also founded in 1998 which handles Retail Savings and Investments (e.g., ISAs) and Institutional Investments; and Standard Life Healthcare Limited, which handles private healthcare, medical and dental insurance. Mr Haslett refers to this business as the provision of financial solutions and he explains that SLAC currently provides financial solutions to over 5 million people, with assets under management in excess of £100 billion.

11. Mr Haslett states that SLAC began trading in 1832, and has traded under the name of STANDARD LIFE since that date, with the STANDARD LIFE mark having “been used actively and continuously in trade from then until the present date”. The company head office is in Edinburgh, and it operates throughout Great Britain and Northern Ireland via branch offices. In addition, SLAC has international offices in the Republic of Ireland, Germany, India, China and Canada. Mr Haslett also refers to the fact that the company has used UK and other national and international trade marks as a way to protect the reputation it has built up in the mark STANDARD LIFE. However, other than the trade marks listed above, he provides no further details

12. Exhibit PH 1 comprises print outs from SLACs Annual Report & Accounts for the years 2001-2004 which Mr Haslett states are available from SLACs website (see paragraph 6a of Mr Haslett’s statement). I am however only able to take account of the extracts from these reports which Mr Haslett has entered into evidence. I note that these Annual Report & Accounts refer to the worldwide performance of SLAC as well as providing information on the situation in the UK. I have considered these extracts in some detail and the information presented in Table 1 below summarises the data I have identified from these extracts as a means to compare year on year performance in the UK in different parts of SLACs business. It was not possible to identify comparable figures for all four years. However, the table does indicate that SLAC provides a significant amount of business in the UK financial services sector.

13. Exhibit PH 2 is a print from the website of the Scotsman Newspaper of an article published on 18 November 2005 describing The Scotsman Business 250, a list of the top 250 businesses in Scotland. Standard Life is listed in third position, and the article refers to its 'pivotal role in Scotland's economy'. This article appeared more than 12 months after the relevant date, the date of application for the STANDARD LIFE trade mark, 29 October 2004. This article does not provide any further explanation as to what is the pivotal role of SLAC in Scotland or the reasons how or why it was ranked as No3 (was it based on turnover, number of employees, annual profit, more than one criterion etc.). The article does state that finance and energy are the two dominant industrial sectors in Scotland. Standard Life operates in the financial sector. There is no information provided regarding its position in the financial sector in the UK as a whole or in other parts of the UK (Wales, England, Northern Ireland).

Table 1: Comparison of Sales & Performance Facts & Figures for SLAC for period 2000-2004 (figures taken from extracts from SLAC Annual Reports & Accounts in Exhibit PH1)¹

Business Activity		Million £'s				
		2000 [#]	2001	2002	2003	2004
New Business premiums in UK	Individual Pensions	-	1,992 (32%):	3093 (42%)	(17%)	nf
	Group Pensions & Annuities	-	2,057 (33%),	2243 (30%)	(45%)	nf
	Life Insurance, Savings and Protection	-	1,721 (27%)	2,021 (28%)	(36%)	nf
	Other	-	547 (8%)	-	(2%)	nf
	Total	3,589	6,317	7,357	-	nf
Banking	Mortgages under Management	5,488	5,552	7,188	8,700	10,200
	Customers Saving Accounts	4,314	4,623	4785	4562	nf
Healthcare	Premium Income	157	164	174	194	nf
	New Business	19.9	17.9	22.7	28.3	33
Assets Under Management		-	80,300	83,000	94,000	108,000
UK Market Share	Life & Pensions	6.5%	11.5%	13.3%	10.9%	8.0%
	Net Lending	-	nf	2.2%	1.6%	nf

¹ n/f = not found, unable to identify a corresponding figure

[#] Figures for 2000 taken from Extracts from 2001 and 2002 Annual Report & Accounts

14. Exhibit PH 3 is a list of awards won by Standard Life in the period 1996 to 2005, in respect of the services provided in the financial sector by SLAC and its subsidiary companies. I take note of the awards for the years 1996-2004 but not those for 2005 as they relate to activity after the relevant date, 29 October 2004. These awards are provided by various publications and organisations working in the financial services field and include for example, a Guardian & Observer Consumer Finance Award in 2003 as Overall Winner for Personal & Stakeholder Pension Provider. I note that nearly all of these awards are for pension products, e.g., individual or personal pensions, group pensions, stakeholder pensions. There is one award for Health Insurance in 2004

15. A screen-shot of SLAC's homepage ([www. standardlife.co.uk](http://www.standardlife.co.uk)) is provided as Exhibit PH4 to show the various service areas in which SLAC and its subsidiary companies provide financial solutions. These areas of activity are identified on the website as mortgages, pensions, healthcare, insurance and savings & investments and a number of options are offered under each of these areas. No further details are provided. This confirms the areas of business SLAC operates in as summarised in Table 1.

16. Exhibits PH 5, PH6 and PH7 show various publications provided by SLAC and its subsidiary companies which describe various products that they offer and some of their key features.

- (i) Exhibit PH5 is a copy of publication produced by SLAC on the subject of pensions, entitled 'What is Pensions Simplification?'. Mr Haslett states [see paragraph 6e] “The leaflet clearly shows the STANDARD LIFE Mark on page 1, thus the origin of the printed publication is clear. This publication is targeted at the average pensions customer, and is typical of the printed matter produced by my company under the STANDARD LIFE Mark”. I note that the form of the trade mark used is the word + device mark that is the subject of UK registration no.1505199. This publication is copyright Standard Life in August 2005 and so was in use after the relevant date.
- (ii) Exhibit PH 6 is a copy of publication produced by SLAC describing the key features of the Standard Life Homeplan policy, an endowment type policy used to provide a lump sum to pay off a mortgage that is no longer in use. This publication Mr Haslett states was produced in June 1998 [see paragraph 6f]. Mr Haslett also states that “this publication is targeted at the average endowment policy customer, and is typical of the type of publication produced by my company under the STANDARD LIFE Mark” The trade mark shown on the first page of this publication is that same as that shown on Exhibit PH5, (the word + device mark that is the subject of UK registration no.1505199).
- (iii) Exhibit PH 7 included extracts from 4 SLAC publications which Mr Haslett states were produced in 2003 as is confirmed by the copyright date on the final page of each document. The first is entitled “Lifetime Protection Plan”; the second is entitled “Small Self Administered Scheme (SSAS)”, the third is an Employers Guides entitled “Group Personal Pension from Standard Life: Employer Guide – can you cater for all your employees’ pension needs”; and the fourth is entitled “Lifetime Protection Series – protecting you and your family”. All four publications show the same STANDARD LIFE word and device trade mark as that shown on Exhibits PH5 and PH6. These publications clearly bear the STANDARD LIFE Mark and are aimed at a wide variety of customers, including employers and directors of private limited companies.

17. Exhibit PH 8 comprises two printouts of articles from the internet relating to the Loch Lomond golf tournament sponsored by Standard Life. The BBC Sport article, dated 6 July 2000, clearly shows the Standard Life name on the results board used for the tournament. Mr Haslett states that the second article from GolfWeek provides the final scores of the players who took part in the tournament in 2000. This list does contain the names of many well known golfers from around the world including the USA, UK and Europe.

18. In paragraph 8 of his statement Mr Haslett states that, based on 2004-2005 figures, SLAC spends a minimum of approximately £8 million annually in promoting and advertising “the Mark”. He also states that the gross media spend is £3 million, and that a further £5 million is spent on the production of all promotional printed materials. However, this gross

media spend does fluctuate and has been as high as £12 million in the recent past (2003-2004).

19. I note that throughout his witness statement, Mr Haslett frequently refers to ‘the Mark’ or to the ‘STANDARD LIFE MARK’ but he does not specify which ‘Standard Life Mark’ he is referring to or if he is referring to more than one. SLAC have listed seven registered trade marks in their notice of opposition, 6 word marks and 1 word + device mark. The common element in all these marks are the words STANDARD LIFE.

20. Mr Haslett makes a number of submissions on the relative merits of these proceedings. Whilst I have read and will take these into account as appropriate in my determination of this case, I do not consider it appropriate to summarise them as evidence.

21. This completes my summary of the Evidence

DECISION

22. The objection under Section 5(3) is against all the goods for which registration is sought whereas the objection under Section 5(2)(b) is against specific goods in classes 9 and 16. I will consider the Section 5(3) objection first, and then go to consider the Section 5(2)(b) to the extent required.

SECTION 5(3) – UNFAIR ADVANTAGE OR DETRIMENT

23. Section 5(3) of the Act, by virtue of regulation 7 of the Trade Mark (Proof of Use, etc) Regulations 2004, has been amended from its original form and now reads:

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

Guiding Principles

24. The scope of this Section of the Act has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572; *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767; *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42; *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484; *Valucci Designs Ltd v IPC Magazines (Loaded)* BL/455/00 and, more recently *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited and Coinworld Limited and others* [2004] EWHC 1498 (Ch).

25. In order to establish if an earlier trade mark has a reputation, I take account of the guidance laid down in the *Chevy* case:

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

26. This case also provides guidance on the nature of the test to be applied in determining whether there is unfair advantage or detriment and the standard of proof that is called for. The Advocate General said:

“43. It is to be noted in particular that Article 5(2), in contrast to Article 5(1)(b), does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: “**takes unfair advantage of, or is detrimental to**” (emphasis added). Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say, properly established to the satisfaction of the national court: the national court must be satisfied by evidence of actual detriment, or of unfair advantage. The precise method of adducing such proof should in my view be a matter for national rules of evidence and procedure, as in the case of establishing likelihood of confusion, see the tenth recital of the preamble.”

27. More recently in *Mastercard International Incorporated and Hitachi Credit (UK) Plc* Mr Justice Smith dealt with a submission by Counsel for the Appellant (on appeal from a Registry opposition decision) that Section 5(3) was concerned with possibilities rather than actualities. Commencing with the above passage from *Chevy*, the judge reviewed the leading cases dealing with the point including observations by Pumfrey J in the *Merc* case and Patten J in *Sihra*. He concluded that the Registry Hearing Officer had been right to conclude that there must be “real, as opposed to theoretical, evidence” that detriment will occur and that the Registry Hearing Officer was “right to conclude that there must be real possibilities as opposed to theoretical possibilities”.

28. I should just add that, whilst the above extract refers to real evidence of the claimed form of damage, this cannot mean that there must be actual evidence of damage having occurred. In many cases that come before Registry Hearing Officers the mark under attack is either unused or there has been only small scale and recent use. No evidence of actual damage is possible in such circumstances. I, therefore, interpret the above reference to mean that the tribunal must be possessed of sufficient evidence about the use of the earlier trade mark, the qualities and values associated with it and the characteristics of the trade etc that it is a reasonably foreseeable consequence that use of the other side’s mark will have the claimed adverse consequence(s).

29. If it is accepted that there will be damage, it must be more than simply of trivial extent as is evident from the following passage from *Oasis Stores Ltd’s Trade Mark Application* [1998] RPC 631:

“It appears to me that where an earlier trade mark enjoys a reputation, and another trader proposes to use the same or similar mark on dissimilar goods or services with the result that the reputation of the earlier mark is likely to be damaged or tarnished in

some significant way, the registration of the later mark is liable to be prohibited under Section 5(3) of the Act. By ‘damaged or tarnished’ I mean affected in such a way so that the value added to the goods sold under the earlier trade mark because of its repute is, or is likely to be, reduced on scale that is more than de minimis”.

30. I note too the following from Mr Geoffrey Hobbs QC (sitting as a Deputy Judge) in *Electrocoin Automatics and Coinworld*:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.” (footnotes omitted).

Due Cause by Applicant

31. In considering the issue under Section 5(3), I have also to consider whether the applicant had due cause to use the mark it seeks to register. The applicant, Cube, has filed no evidence in this case. Cube is silent as to why this particular mark was chosen, and why it is seeking to register it for the goods and services specified. The applicant cannot therefore gain relief under this provision of the Section.

Evidence of Use

32. SLAC cites seven earlier trade marks registrations as the basis of this opposition. The most relevant of these for the current proceedings are CTM 496729 and UK 1505199. CTM 496729 for the word mark STANDARD LIFE without any device elements covers all the goods and services also covered by the 6 other (UK) registrations. UK 1505199 is registered in the same three classes as CTM 496729 but for a narrower range of goods in class 36 where it is limited to real estate services. Also this UK mark has a noticeable device element, a two tone ribbon symbol set at right angles to the words STANDARD LIFE, as shown in paragraph 3 above. However, the words STANDARD LIFE are clearly distinguishable in this mark and remain, in my opinion, the dominant element of the mark. I am satisfied that use of the mark in this form falls within the use defined by Section 6A(4) of the Act where “use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”.

33. I note that all of the evidence of use provided by Mr Haslett relates to use of the mark in the form as registered in UK 1505199, see for example,

- first page of the 2001, 2002 , 2003 & 2004 Annual Report & Accounts in Exhibit PH1 (part 1 & part 2)
- list of awards from the SLAC website in Exhibit PH3
- extract from SLAC website in Exhibit PH4
- examples of publications in Exhibits PH5, PH6 and PH7.

34. As both CTM 496729 and UK 1505199 have been registered for a period of more than five years, it is necessary for SLAC to show what use has been made of these marks. In determining whether the opponent has shown genuine use of the earlier mark I am guided by the principles laid down in *Ansul* (Case C40/01, *Ansul BV v Ajax Brandbeveiliging BV*, [2003]

R.P.C. 40) and *Laboratoire de la Mer* (Case C259/02, *LaMer Technology Inc. v Laboratoires Geomar SA*, [2004] F.S.R. 38).

35. From the evidence of Mr Haslett, I am satisfied that the opponent has shown use of the earlier mark in relation to all the goods as registered in class 36. These services describe all the activities reported by SLAC in their annual reports (see Exhibit PH1 and Table 1) and cover provision of financial solutions to institutions and companies as well as retail services to individuals.

36. I am also satisfied that use has also been established in relation to the services in classes 35 and 42 in so far as they are required to provide the services in class 36. The services referred to in classes 35 and 42 of the registration are provided by SLAC to its customers as part of the class 36 services it provides. For example, provision of advisory and consultancy services is part of the provision of financial investment services; provision of payroll processing services allows, for example, a customer's pension or healthcare contributions to be collected; computer programming services are necessary to put in place arrangements to provide customers with statistical information on their investments, or employers with information on the state of their group employee pension scheme etc. This limitation is clearly acknowledged in the class 42 registration which explicitly refers to services related to financial and insurance services. There is no evidence to suggest that SLAC carries out any of the services mentioned in classes 35 and 42 in general, for example, the SLAC companies do not provide computer consultancy services in general.

37. Mr Krause argued that the Opponent has not shown use in relation to the goods in class 35 or 42 and that the evidence filed shows use only in relation to 'banking, fund investment management, insurance, financial investment, pension and mortgages' in class 36. I do not agree with Mr Krause. His analysis in relation to class 36 does not, in my opinion, take account of the fact that if use of the earlier mark has been shown in relation to certain goods then for the purposes of opposition proceedings the proprietor of the earlier registration is entitled to a penumbra of protection that includes similar goods and services.

38. At the Hearing, Miss Veitch submitted that, as the extracts from the Annual Reports and Accounts provided in Exhibit PH1 contains information compiled for official purposes and has been reviewed by independent auditors, this evidence should be weighted accordingly. Mr Krause accepted that this information was a fair reflection of the performance of SLAC. However, both sides disagreed as to the conclusion that could be drawn from this information regarding the reputation of the STANDARD LIFE mark.

Reputation of the Earlier Mark

39. As illustrated in Table 1 above, the information from the Annual reports & Accounts in Exhibit PH1 confirms that SLAC is a significant provider of financial services in the UK. At the hearing, Mr Krause conceded that the mark STANDARD LIFE does have a reputation in relation to its 'long-standing services, i.e. pensions and life insurance'. I agree. Standard Life is 3rd in the top 10 companies in Scotland (see Exhibit PH2) which is a significant part of the UK in terms of geographical size and population. The Annual Reports in Exhibit PH1 indicate that SLAC has consistently held around 10 % of the Life and Pensions market in the UK and it has £108.000 million worth of assets under management. SLAC has been providing life insurance and pensions products since its founding in the 1820's and 30's. Much of this work involves the collection and investment of moneys to provided funds for the future, for

example to pay a mortgage, to pay for future healthcare, to provide an income for retirement or if one is unable to continue working. As shown in Exhibit PH3, the majority of the prizes that SLAC received in the period 1999 to 2004 were for its pension services. Given that newspapers such as the Guardian and the Observer have UK wide circulation, I am satisfied that the trade mark STANDARD LIFE is recognised throughout the UK in relation to financial products provided by SLAC such as pensions, investments and life insurance.

40. Recognition of the STANDARD LIFE mark amongst the public as an indicator of trade origin has been achieved in the minds of those who are interested in financial solutions. This includes individuals seeking a mortgage or banking facilities or healthcare insurance for themselves or their families as well as those responsible for putting financial arrangements in place for companies and institutions. SLAC spends upwards of £8 million annually on promoting its products and services in the UK, and upwards of \$5 million of this is for promotional printed material explaining the products for individuals and institutions as shown in Exhibits PH5-7.

41. SLAC has also promoted the STANDARD LIFE mark by sponsorship of a golf tournament in Loch Lomond in 2000. This is a very popular game in Scotland and in UK as a whole and will have also helped to establish the STANDARD LIFE mark firmly in the mind of the wider public. Sponsorship of sporting events such as a major golf tournament which attracts a high level of national and international media interest is commonly used as a means to gain greater recognition for a company's goods and/or services with the wider public of potential or future customers. Financial services providers commonly use this approach as a way to promote their services and gain recognition of their name, for example Barclays Bank sponsorship of Soccer Football, Investec Sponsorship of Rugby Football.

42. SLAC activities in banking and healthcare are more recent than its activities in pensions, life assurance and fund management. Standard Life Bank and Standard Life Healthcare were founded in 1998. However, given that these activities also require the management and investment of money to provide future income in the same way that monies paid into pensions need to be invested and managed to pay out future pension income, I am satisfied that the reputation of the STANDARD LIFE mark in the area of pensions and life insurance would also extend to other related financial services such as banking, mortgages, health insurance. A person seeing STANDARD LIFE in relation to an internet banking service or a mortgage provider would immediately think of the reputation STANDARD LIFE as a provider of pensions or life insurance. Similarly a person seeing the name STANDARD LIFE in association with a healthcare or medical insurance product would also be likely to bring the reputation of SLAC as a provider of life insurance to mind.

43. Taking account of all of the above I consider that earlier STANDARD LIFE mark has a reputation and has established sufficient recognition within the mind of UK consumers to be recognised in relation to the provision of financial and insurance services.

Similarity of the marks

44. Having considered the earlier mark and its use and reputation, I now turn to examine how similar the applied for mark is in relation to the earlier mark.

45. Both the applied for and the earlier registered mark contain the word STANDARD. This is a known dictionary word which has a number of meanings. As an adjective it is used

to indicate the level of some quality or thing that is expected or required. As a noun it can mean a flag or the ordinary or usual procedure without any extras. The context of its use dictates which meaning is appropriate.

46. The second word in the earlier marks LIFE is also a well known word meaning the state of being alive as a person. The second word in the applied for mark LITE is a known word that is most commonly used to refer to food or drink that is low in fat or sugar or calories. It is also a commonly recognised alternative form of the word 'light' which has a number of meanings, a source of illumination or light, something that is not heavy, something that is easy to carry or digest. It is more commonly used in American English and is a literal spelling of the word 'light'.

47. The words LIFE and LITE are both four letter words and differ only in their third letter (i.e. F v T). Visually and aurally they are almost identical. When both word marks are considered together in their entirety (STANDARD LIFE v STANDARD LITE), this one letter difference is very difficult to see or hear.

48. From a semantic point of view, following the usual rules of English language and sentence construction, the combination of STANDARD first and LIFE or LITE second, would usually be read as the first word is telling us something about the following word. Taken together, STANDARD and LIFE generate the idea or concept of the standard life – the level of living that is expected or required. While it is not a direct link, I do think that this idea does allude or bring to mind the idea of goods or services that can be put in place to provide the standard life, such as financial products or services.

49. The applied for mark, STANDARD first and LITE second does not so readily bring to mind one concept. Two ideas come to mind, firstly, where Lite implies a reduced burden or light-touch standard that does not have so many requirements as normal, i.e. where LITE is acting as an adjective. Secondly, a standard for a light weight quality, i.e., where LITE is acting as a noun. Neither of these concepts is brought to mind in any significant way by the goods in classes 9 and 16 or the services in class 41 being applied for. Also I do not think that either of these possible meanings would bring to mind the concept created by the earlier mark, i.e., the standard life expected or required. Thus, I consider that there is no link between the mark and goods applied for that help a person to distinguish the mark STANDARD LITE from the earlier registered STANDARD LIFE mark.

50. Section 5(3) of the Act is concerned with unfair advantage or detriment to the earlier mark. The occurrence of one or the other is sufficient to meet the grounds under this Section of the Act [see, for example, the discussion in *Kerly's Law of Trade Marks and Trade Names* (14th edition), paragraphs 9.113 to 9.121] In order for unfair advantage to occur, a link must be established between the earlier registered mark and the applied for mark that is likely to lead to a change in behaviour by the consumer when presented with it. Such a link is established if the earlier mark is fixed in the mind of the consumer to such an extent that when this consumer observes the applied for mark they bring to mind the earlier mark and consider that the goods covered by this applied for mark are from the same source as the goods associated with the earlier well established mark. This is often referred to as free-riding on the reputation of the earlier mark and means that the later mark is exploiting this reputation. For some marks, similarity between the marks alone is sufficient because the earlier registered mark is so well established in the mind of the consumer that irrespective of what goods they are used on they, the applied for mark will always bring to mind the earlier mark and result in

the consumer considering the applied for goods to be from the same source as the registered goods.

51. However, in some cases, the earlier mark is not so well established in the mind of the consumer that the similarity with the later applied for mark is sufficient to bring to mind the earlier mark, the goods/services it is registered for or the trade origin of the goods/services. The reputation of the earlier mark is the key to determining how well it is established in the mind of the consumer and how far the mark will stand on its own. Also, it is necessary to consider whether the consumer of the earlier goods/services who recognised the earlier mark is also likely to be a consumer for the goods/services of the applied for mark. If these goods/services are very different, then it is much less likely that a consumer seeing the applied for mark will bring to mind the earlier mark and be prompted to change his economic behaviour resulting in unfair advantage or detriment to the earlier mark, for example, though lost sales to the applicant for the later mark. An association in the mind of the consumer between the earlier and the applied for mark is not sufficient to meet the grounds under Section 5(3), the link once established must be likely to result in a change in behaviour of the consumer.

52. The applicant has applied for goods in classes 9 and 16 and services in class 41. These, the applicant argues, are very different to the goods and services covered by the earlier STANDARD LIFE mark and there is little or no likelihood that a person purchasing such goods or services under the trade mark STANDARD LITE would make any connection with any of the goods and services sold under the trade mark STANDARD LIFE or consider that both sets of goods/services can come from the same trade origin. However, if any of the goods or services in classes 9, 16 or 41 were concerned with financial or insurance services or were being offered for sale in the part of a store or an internet site that dealt with such subjects, then I do consider that the public would bring to mind the earlier STANDARD LIFE mark. This would establish a connection with the earlier registered trade mark. I do consider also that a consumer, seeing the trade mark STANDARD LITE in use in relation to any goods and services that have a connection with financial or insurance products or services would immediately bring to mind the reputation of the STANDARD LIFE mark for such goods and services and would quite possibly think that these goods and services were being provided by the same company.

53. The consumer of the applied for goods and services in classes 9, 16 and 41 will in most cases be quite different to the consumer for the financial services signified by the earlier STANDARD LIFE trade mark. Most of these goods and services relate to media services and products, e.g. TV, sound, print, exhibitions, internet, rather than financial services, and I consider that a consumer of such goods will not make a link between STANDARD LITE and STANDARD LIFE that is likely to lead to them making a change in their economic behaviour. However, I do consider that if a consumer notes that some of the goods and services applied for deal with financial products or subjects or are being sold in the part of a store or internet site that has information on financial services, then this consumer would make a connection between products or services identified under the applied for STANDARD LITE mark and the earlier STANDARD LIFE mark. This applies equally to the software and computer related products in class 9, to the printed matter and related products in class 16, and to various education, entertainment, TV, internet services in class 41. Because of the visual and oral similarity and because of the conceptual link between the earlier mark and the financial services it designates, the consumer would be likely to think that such goods or products were from the same source as those from STANDARD LIFE. As this earlier mark

has a reputation as a provider of financial services, I do consider it likely that a consumer would purchase a book or software product or magazine, use a internet based information or search service, or listen to a TV or radio programme sold under the STANDARD LITE mark thinking that the information in it related to STANDARD LIFE products or services.

54. The applied for registration also covers '*bank cards and debit cards (other than encoded or magnetic)*' in class 16, and these goods would establish an even stronger or more direct link between the registered and applied for mark in the mind of the consumers of financial services than any of the other goods or services in the registration. I have little doubt that a bank card bearing the name STANDARD LITE would immediately bring to mind the earlier STANDARD LIFE mark.

55. It is not possible for me to determine if the goods that the applicant propose to sell under the applied for mark will be detrimental to the earlier mark as I have received no evidence on this point. The types of goods for which the applicant is seeking registration would appear to be goods which are much cheaper and require much less care in their selection than the type of financial products and services sold by SLAC under the STANDARD LIFE mark. Thus one might be prepared to accept that selling such goods under the STANDARD LITE mark would because of the close similarity of the marks, in effect, lead people to think that STANDARD LIFE has decided to extend its trading activities into much lower cost products. Thus, dilution of the repute of the STANDARD LIFE mark might result. However, it is not necessary for me to decide this point.

Conclusion

56. Thus, in so far as any of the goods or services in classes 9, 16 and 41 relate to financial or insurance services, I consider that use of the STANDARD LITE mark would take unfair advantage of the distinctive character or the repute of the earlier STANDARD LIFE mark.

57. Although the option to limit the specification sought for the goods and services in classes 9, 16 and 41 to exclude reference to financial and insurance services was available to the applicant in the course of these proceedings, no such option was pursued.

58. SLAC has been successful in making out the ground under Section 5(3) of the Act and the opposition succeeds in relation to entire specification.

SECTION 5(2)(b) - LIKELIHOOD OF CONFUSION

59. In case that the decision I have reached in relation to the grounds under Section 5(3) is found to be incorrect, I will now turn to consider the further grounds of opposition by SLAC under Section 5(2)(b) to registration of the applied for mark in relation to specific goods in classes 9 and 16 only.

60. According to Section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

61. Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

Guiding Authorities

62. In determining the question under section 5(2)(b) of the Act, I take into account the guidance provided by the European Court of Justice (ECJ) in:

(i) *Sabel BV v Puma AG* [1998] RPC 199;

(ii) *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117;

(iii) *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77;

(iv) *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723;

and

(v) *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM)* (case C-106/03 P) [2005] ETMR 23.

63. It is not required that actual confusion results between the marks in order for an opposition under Section 5(2)(b) to succeed. The test is the likelihood of confusion.

64. In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion in the mind of a consumer. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

65. The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will

depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C. in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

66. Thus, I must consider whether the mark that the opponent is relying upon has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it.

Analysis

67. The opposition under Section 5(2)(b) of the Act relates only to the specific goods listed in paragraph 4 above. I have already considered the similarity between the trade marks in relation to the ground of opposition under Section 5(3) (see above). All seven of the marks cited by SLAC are earlier marks under the definition of Section 6A(1) of the Act. I consider that the best case under Section 5(2)(b) is based on CTM 496729 as this registration covers all the goods and services covered by its other (UK) registrations and is for the word mark STANDARD LIFE without any device elements. The comparison between this mark and the applied for sign and the goods and services referred to are shown in Table 2.

68. The objection to registration of the sign STANDARD LIFE for the goods in class 9 is based specifically on the similarity of such goods to the services in class 42 for which the mark STANDARD LIFE is already registered. The objection to the goods in class 16 is a more general one in the sense that if any of the goods applied in class 16 under the sign STANDARD LIFE were to refer to financial or insurance services, such as those provided by SLAC under the mark STANDARD LIFE, then a consumer could be confused into thinking that these goods were being provided by the same company.

69. As indicated above, I am satisfied that the opponent has provided sufficient evidence to show use of the earlier marks in relation to goods in class 42 in so far as they are related to financial and insurance services. I am satisfied that there is sufficient similarity between the goods in class 9 for which registration is sought and these services in class 42 that a consumer would expect these to be provided by the same undertaking.

70. The STANDARD LIFE mark is registered in relation to advisory, information and consultancy services in relation to all the services that these marks are registered for in relation to class 36 and class 42. I consider that advisory, information and consultancy services would include the provision of training and user guides. However, this is only in relation to financial and insurance services. The registration sought by Cube in class 16 is for

printed matter in general. The evidence provided by Mr Haslett shows that mark STANDARD LIFE has been used on a number of printed publications which describe various financial and insurance products provided by SLAC. Producing such an explanation or guide to their financial products is an integral part of providing such services. It is part of the promotion and sale of such products. However, SLAC does not have to be a producer of printed materials in general in order to be able to provide printed material explaining its products or comparing how they work in relation to other products. Nothing in the evidence suggests that SLAC is in the business of producing printed material in general or of providing printing services that produce such matter. Mr Krause made this point in his submissions and I accept it. The use shown by SLAC is only in relation to printed materials describing its financial products.

Table 2: Comparison of the Marks and Goods/Services at Issue.

Opponent	Applicant	
STANDARD LIFE	STANDARD LITE	
CTM496729	Application 2376865	
<p>Class 35 Accounting, auditing and personnel services; payroll processing services; computerised database management services; provision of information relating to all the aforesaid services; provision of business statistical information; advisory and consultancy services all relating to the aforesaid services.</p>		<p>Class 16 “printed matter; printed publications; newspapers; magazines; supplements; posters; periodicals; books; brochures; leaflets; user guides and training manuals”</p>
<p>Class 36 Banking, financial, trust management, unit trust, trusteeship, fund investment management, insurance, financial investment, pension, financial management, personal loan financing, mortgage, real estate agency, real estate management and real estate leasing services; provision of finance or of credit; actuarial services; financial appraisal services; advisory, information and consultancy services all relating to the aforesaid services.</p>		
<p>Class 42 Computer programming services; computer consultancy services; design of computer hardware; rental of computer hardware and computer software; leasing of access time to a computer database; all the aforesaid services being related to financial and insurance services; legal services; advisory, information and consultancy services all relating to the aforesaid services.</p>	<p>Class 9 Software; electronic publications; CD Roms; computer software and hardware to enable searching of data and connection to databases and the Internet; data processing equipment and computers; parts and fittings for all the aforesaid goods</p>	

71. The services provided by SLAC under the mark STANDARD LIFE are such that a potential customer will exercise great care when choosing such goods. Financial products such as a pension, a mortgage, a life insurance or healthcare policy all require a certain degree of study and consideration to determine if they are a useful product for the customers needs. This will usually involve reading and studying the printed or electronic guides or descriptions of these products. They will often involve use of the internet, or financial advisers to compare and contrast potential products. They usually involve making a regular financial commitment and putting in place arrangements to transfer money. As a consequence, a consumer interested in such products is likely to become very familiar with the types of products available and leading providers of these products. This will result in the consumer becoming very familiar with the names of the providers of such services and the trade marks or names they use.

72. As indicated above, the earlier STANDARD LIFE mark enjoys a reputation in relation to life insurance and pensions products that is sufficient to identify this mark clearly in the minds of consumers in relation to financial and insurance services. There is a conceptual link between the STANDARD LIFE mark and the goods it is registered for in classes 35, 36 and 42. I do not consider that the reputation of the STANDARD LIFE mark extends any further than financial and insurance services.

Conclusion

73. Taking all of the above into account and bearing in mind imperfect recollection, I consider that on balance, a consumer seeing printed matter or the other applied for goods in class 16 bearing the mark STANDARD LITE and dealing with financial goods or services would be likely to bring to mind the mark STANDARD LIFE. Thus there is a likelihood of confusion. However, by the same token, I did not think that a consumer seeing such goods bearing the mark STANDARD LITE and describing matters other than financial goods or services would be likely to be confused. I also consider that a consumer seeing software, CD ROMs or the other applied for goods in class 9 bearing the mark STANDARD LITE and dealing with financial goods or services would be likely to think that these came from the same source as the services sold under the mark STANDARD LIFE in class 42.

74. SLAC has successfully made out the opposition on the grounds of Section 5(2)(b) to the registration of the trade mark STANDARD LITE in relation to certain goods in class 9 and 26

COSTS

75. SLAC having been successful is entitled to a contribution towards their costs. I order Cube to pay SLAC the sum of **£1000**. 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 5th day of September 2007

**Dr Lawrence Cullen
For the Registrar,
the Comptroller-General**