

O-127-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS 3109884, 3109883 AND 3109885 BY
ALPHA FINANCIAL MARKETS CONSULTING LIMITED TO REGISTER THE
FOLLOWING THREE TRADE MARKS**



IN CLASSES 9, 35, 36 AND 42

**AND IN THE MATTER OF OPPOSITIONS THERETO UNDER NOS 405643,
405718 AND 405719
BY ALPHA BANK A.E.**

Background and pleadings

1) Alpha Financial Markets Consulting Limited (“the applicant”) applied to register three trade marks in the UK on 21 May 2015. They were accepted and published in the Trade Marks Journal, the first on 11 September 2015 and the second and third on 25 September 2015. All three applications are in respect of the following identical list of goods and services:

Class 9: *Software; downloadable electronic publications.*

Class 35: *Business and organisational management; business and organisational administration; project and program management; business and organisational strategy; mergers, alliances and acquisitions; personnel management and recruitment; out-sourcing; human resource management; provision of contractors; product development and management; corporate benchmarking; business management, business advice and business implementation support relating to sales and client service; corporate benchmarking; information, advice, analysis, research and consultancy relating to the aforesaid.*

Class 36: *Insurance; investment banking; financial services; financial management; investment; fund management, asset management; investment management; wealth management; private client, discretionary wealth management; portfolio management; financial advice and information on mergers, alliances and acquisitions; information, advice, analysis, research and consultancy relating to the aforesaid.*

Class 42: *Design and development of software and IT; software and IT programming; software and IT installation, management and updating; product development and management; project and program management; information, advice, analysis, research and consultancy relating to the aforesaid.*

2) Alpha Bank A.E. (“the opponent”) opposes the applications on the basis of section 5(2)(b) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The section 5(2)(b) grounds are on the basis of its earlier UK mark 1309354 (against the applicant’s Class 36 services only) and earlier European Union (formerly Community) Trade Mark (“EUTM”) 5282918, against all of the applicant’s goods and services. The relevant details of these two earlier marks are:

Mark and relevant dates	Goods and services relied upon
1309354 ALPHA Filing date: 8 May 1987 Date of entry in register: 24 July 1992	Class 36: <i>Insurance and financial services; all included in Class 36.</i>
EUTM 5282918 ALPHA BANK Filing date: 29 August 2006 Date of entry in register: 4 August 2009	Class 16: <i>Printed matter, newspapers, books, journals.</i> Class 35: <i>Management of commercial affairs.</i> Class 36: <i>Financial affairs, monetary affairs, banking.</i>

3) The opponent argues that the respective services are identical or similar, that the ALPHA element of the applicant’s marks is dominant and that the respective marks are confusingly similar.

4) The section 5(4)(a) grounds are on the basis that use of the applicant’s mark would result in misrepresentation and damage of the opponent’s ALPHA and ALPHA BANK signs, where first use is claimed throughout the UK from 1 January 1989 in respect of “financial services and banking services”. In addition, use of the latter sign is also claimed in respect of “management of financial and monetary affairs (Class 35)” and “printed matter, newspapers, books and journals (Class 16)” The former sign is relied upon to challenge the applicant’s Class 36 services and the latter to challenge all of the applicant’s goods and services.

5) The applicant filed counterstatements denying the claims made (and requesting that the opponent provides proof of use of its two earlier marks).

6) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both sides also provided written submissions which will not be summarised but I will keep them in mind.

7) A Hearing took place on 5 March 2017, with the opponent represented by Jonathan Hill of Counsel, instructed by Franks & Co., and the applicant by Amanda Michaels of Counsel, instructed by MW Trade Marks.

Opponent's Evidence

8) This takes the form of a witness statement by William Lindsey Mackay, Chief Executive Officer of Alpha Bank London Limited (hereafter "ABL"), a wholly owned subsidiary of the opponent. He states that the facts in his statement come from his own personal knowledge or the records of the opponent, London Branch, ABL or Alpha Credit Group Plc (hereafter "ACG"). These are collectively referred to as the "Alpha London Group" or "the ALG". He also states that he is authorised to speak on behalf of the opponent.

9) Mr Mackay provides a history of the bank and its operations in the UK. He states that it was founded in Greece, in 1879 and that the "Alpha Banking Group" is an active in the international banking market with a presence in a number of countries including the UK. The bank operates in the UK through the London Branch, which is a member of the bank. The London Branch is, itself, registered at Companies House and was incorporated on 1 November 1989, but ABL can trace its origins in the UK back to 1922.

10) Mr Mackay states that the bank's trading name in the UK has changed various times over the years, and states that the London Branch "operated under the name of "Alpha Credit Bank A.E" or "Credit Bank" between 1989 and 1994 and ABL being adopted in 1995.

11) Mr Mackay also states that ABL operates under the name ALPHA PRIVATE BANK and has a number of subsidiary companies, in particular ABL Independent Financial Advisors Limited. It is now “largely a dormant company”, he states that “in the past” offered investment products. Another subsidiary is ACG.

12) Mr Mackay states that the earlier marks relied upon have been used by the London Branch, in the UK, “no later than 1992”, in respect of insurance and financial services, management of commercial affairs and printed matter.

13) Mr Mackay provides the following profit figures for ABL, obtained from its annual reports, relevant extracts of which are provided at Exhibit WLM1:

Year	Profit after tax (£s)
2009	1,449,000
2010	5,352,000
2011	4,002,000
2012	1,944,000
2013	3,064,000
2014	3,068,000
2015	2,614,000

14) In addition, Mr Mackay provides the following profits for ACG, obtained from annual reports provided at Exhibit WLM2:

Year	Profit after tax (€s)
2009	11,232,000
2010	5,807,000
2012	46,437,000
2013	359,000
2015	6,258,000

15) Mr Mackay states that the opponent’s marks are:

- operated and used by ALG in respect of financial and banking services, monetary affairs and commercial affairs. It currently has 2,500 customers in the UK with deposits held growing from nearly £209 million in 2009 to over £457 million in 2014, being the last full year before the relevant date in these proceedings;
- used in the documentation of various forms of bank accounts by ABL including 4000 current accounts, over 2000 fixed term deposit accounts and over 400 loan accounts. A copy of “the most recent” blank application form for a current account or fixed term deposit account is provided at Exhibit WLM3. The following appears at the top of each page:



- also used on other documentation such as mandates, appointment of bankers, company mandates and individual account mandates. Examples of these completed forms are provided at Exhibit WLM4 and are dated between 2009 and 2016. Up to 2011, the forms include ALPHA BANK LONDON LIMITED at the top of many pages. Later forms appear to have the same mark as shown in the previous bullet point.

16) At Exhibit WLM5, Mr Mackay provides a “personal tariff” from 2016 in respect of fees and charges levied in relation to banking services. It shows use of the ALPHA BANK mark appearing at the top of each page together with the device as shown in the second bullet of the above paragraph. The most recent “investment tariff” is also proved at Exhibit WLM6 showing use of the same marks.

17) Mr Mackay also explains that ALG also provides finance to its customers particularly in respect of residential and commercial property in the UK. He provides figures for shows that the amount of money lent that has been gradually reducing from over £337 million in 2009 to £192 million in 2014. He explains that the London Branch is the active participant in the syndicated lending market “and uses the Trade Marks in its activities in this market”.

18) Mr Mackay states that ABL provides its customers with a wide variety of investment products, all of which clearly show use of the earlier marks. However, he states that he is unable to provide samples of these products for reasons of commercial sensitivity, but refers to mentions of such products in the annual reports at Exhibit WLM2. These annual reports relate to ACG and refer to its raising of finance through the issue of Euro Medium Term Note Programmes. Mr Mackay states that these notes prominently display the earlier marks. Extracts of the “base prospectus” relating to this programme are provided at Exhibit WLM7. Seven examples are provided, one from 2016, being after the relevant date and one from each of the years 2009 to 2014. All contain the same header, as shown below:



19) Mr Mackay states that ABL sends a great deal of correspondence to its customers and other third parties, and that such correspondence is sent on its headed paper displaying the marks (a selection is provided at Exhibit WLM9). Mr Mackay also provides copies of employment contracts displaying the marks at Exhibit WLM10. Mr Mackay also states that ALG currently operates out of the City of London and has been on operation since 1995. A *Google Street View* photograph is provided at Exhibit WLM11 showing the signage above the building being ALPHA BANK LONDON. There is also a separate, over-the-pavement sign showing the opponent’s device mark that is also present in many of the exhibits. A copy of a planning application to erect this signage was made on 13 February 1995 and a copy of this is provided at Exhibit WLM12. It was granted on 24 March 1995.

20) Mr Mackay also provides information regarding the opponent's sponsorship activities and other advertising and marketing. At Exhibit WLM13 he provides a list of publications where advertisements have been placed but he states that the opponent does not retain copies of the advertisements. He also identifies other marketing undertaken such as drinks receptions, evening meals, an annual clay shooting day aimed at customers and advisors. No documentation is retained in respect of these events, but Mr Mackay states that he has been involved in a number of these activities and he can confirm that the documentation included the opponent's marks.

21) In addition, to industry publications, ALG also advertises in, and sponsors a wide variety of publications and charities. Supporting evidence for this is provided at Exhibit WLM14 and consists of:

- a list of 34 donations made to a range of bodies ranging from national charities to a single primary school, paid between 2009 and 2016;
- three documents sent to ALPHA BANK LONDON LTD and one to ALPHA BANK recognising the fundraising amount raised. Only two are dated, one in January 2013 and one in February 2013.

22) Mr Mackay states that AGL has its own IT and payment systems managed from the UK and provides customers with on-line payment facilities called ALPHA PRIVATE BANK and ALPHA E-BANKING. Screen prints from this payment system are shown at Exhibit WLM16 showing use of these marks.

Applicant's Evidence

23) This takes the form of two witness statements by Nicholas Baker, director and co-founder of the applicant, and Anne Wong, Registered Trade Mark Attorney with the applicant's representatives, MW Trade Marks.

24) Mr Baker states that the applicant was founded in 2003 and began use of its marks in the UK and elsewhere in 2005 in relation to asset and wealth management consultancy services. He states that the marks have been in use continually since

then. At Exhibit NB1, he provides screen shots of the applicant's website from the years 2009, 2011, 2013 and 2015. All show the following mark:



25) Mr Baker states that this was the first mark used by the applicant and was registered in the UK on 20 July 2006 under no. 2427683 (details of which are provided at Exhibit NB2). Some of the pages include a statement that “Alpha Financial Markets Consulting is a leading global provider of consulting, benchmarking and implementation services to financial institutions predominately within Europe and the USA. We particularly focus on the asset and wealth management industries and the companies that service them.” He further states that use of this mark was over a continuous ten year period and in that time the applicant received no objections.

26) Mr Baker states that the applicant's mark was rebranded in the second half of 2015 and this led to the three, now opposed, applications.

27) Ms Wong explains that during the seven years in which MW Trade Marks has represented the applicant, she has undertaken a trade mark watch service on the mark ALPHA and has reviewed every ALPHA mark revealed by such searches. Ms Wong states that this “runs into many hundreds if not thousands of ALPHA marks” and she concludes that it is in common use by third parties and that it is commonly used by different businesses in the financial industry.

28) Ms Wong has undertaken a Internet check and found a number of ALPHA names currently being used in the UK for various financial services and provides a list of twenty one businesses such as ALPHA WEALTH trading in Edinburgh since 2013, ALPHA FX (Berkshire, 2010), ALPHA FINANCIAL CONSULTANTS (Somerset, 2008) and other similar examples. Example archive pages from these businesses are provided at Exhibit AW1.

29) At Exhibit AW2, Ms Wong provides the following definition of ALPHA taken from the website www.investopedia.com: “Alpha is used in finance to represent two things: 1. A measure of performance on a risk-adjusted basis ... 2. The abnormal rate of return on a security or portfolio in excess of what would be predicted by an equilibrium model ...”

Opponent’s Evidence-in-reply

30) This takes the form of two further witness statements. The first is from Victor Paul Povid, Registered Trade Mark Attorney with Franks & Co Limited, the opponent’s representative. His statement addresses an apparent discrepancy between the name of the opponent and the proprietor of its earlier EUTM. Following evidence on this point, I do not understand it to still be an issue between the parties and I need say no more on the point.

31) The second statement is by Eleni Georgili, an attorney in law in the Legal Services Division of the opponent. At Exhibit EG1, Ms Georgili presents a copy of my earlier decision BL O-113-11, dated 25 March 2011, where the opponent was the same as in the current proceedings. At Exhibit EG4, Ms Georgili provides extracts of some of the Bank’s ‘Mazi’ publications from 2013 to 2015” showing use of the mark reproduced at the second bullet point of paragraph 15, above.

32) At Exhibit EG5 are screenshots from various websites showing information regarding the opponent, ABL and the London Branch. The first appears to be an extract of a “Bank Directory” from an unknown website and lists ALPHA BANK LONDON LTD and shows the mark reproduced at paragraph 15, second bullet point, above. It lists the following countries under the heading “European Presence”: Bulgaria, Cyprus, Greece, Romania, Serbia and United Kingdom. The second is taken from the website of *Bloomberg* and it provides the following company description of “Alpha Bank AE (ALPHA: Athens)”:

“ALPHA BANK A.E. provides banking, corporate and retail banking, investment banking and brokerage insurance, and financial services in

Greece. The company also engages in the real estate management and hotel activities. Segments: Retail banking. This includes all individuals (retail banking customers) of the company, professionals, small and very small companies operating in Greece and abroad except the south-eastern Europe countries. The company, through its branch network, offers various types of deposit products, such as deposits/savings accounts, working capital/current accounts, investment facilities/term deposits, repos, and swaps; loan facilities, such as mortgages, consumer, corporate loans, and letter of guarantees; and debit and credit cards to the customers. Corporate Banking: This segment includes all medium-sized and large companies, corporations with international activities ...operating in Greece and abroad except from south-eastern Europe countries. The company offers working capital facilities, corporate loans, and letters of guarantees. This segment also includes the leasing products which are offered through Alpha Leasing A.E. and factoring services to third parties through ABC Factors A.E. Asset Management/Insurance. This segment consists of a range of asset management services through the company's private banking and Alpha Asset Management A.E. D A K Investment Banking/ Treasury. This segment includes stock exchange, advisory, and brokerage services relating to capital markets, and also investment banking facilities, offered either by the bank or specialized Group companies, such as Alpha Finance AEPEY, and Alpha Ventures A.E. It also includes activities of the Dealing Room in the interbank market."

DECISION

Genuine Use

33) The relevant statutory provision is section 6A of the Act:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) 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, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

34) Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

35) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

36) The relevant date for assessing genuine use is either the 11 September 2015 or 25 September 2015, being the publication dates of the contested applications. The opponent must, therefore, demonstrate that it has made genuine use of its marks between 12 September 2010 and 11 September 2015 or 26 September 2010 and 25 September 2015. The short period of time between these two dates has no consequences for my conclusions.

37) Genuine use needs to be shown in the UK in respect of the earlier UK mark and in respect of the EU in respect of the earlier EUTM.

38) At the hearing, Ms Michaels stated that the applicant did not dispute that the opponent was involved in providing banking services in the UK, but it was a question of exactly what banking services and by what marks these were identified. I concur with Ms Michaels when she categorised the opponent’s evidence as being “not terribly good”, however, I note that:

- ALPHA BANK LONDON has had a branch in the City of London since 1995;
- ALG has 2,500 customers in the UK;
- By 2014, it held £457 million on deposit;

- ABL has 4000 current accounts, 2000 fixed term deposit accounts and over 400 loan accounts;
- Finance has been provided by ALG in respect of UK property to the value of £192 million in 2014 and this was higher in preceding years;
- Mr Mackay states that ABL provides a wide variety of investment products. ACG's annual reports from between 2009 and 2015 (shown at Exhibit WLM2) refer to its Euro Medium Term Note Programme. Extracts from the base prospectus show ACG as "the issuer".

39) In the majority of exhibits, the mark under which these services are provided is ALPHA BANK (and device), but there is also use shown in respect of ALPHA BANK LONDON being the signage used above the branch premises. In respect of payment systems, website extracts at Exhibit WLM16 show the opponent's online banking sign in page and information pages about its "web banking" and "mobile banking". They are undated but were printed on 16 June 2016, after the relevant date. Nevertheless, in light of the longstanding practice for banks to provide online/mobile banking services as part of their retail banking offerings, I am prepared to infer that this further supports a finding that taken together, the evidence illustrates that the opponent undertakes trade in the UK in respect of various banking services, property loans and an investment product and this trade is identified by the marks referred to earlier in this paragraph.

40) Use in respect of *insurance services* is contested by the applicant, and certainly in a far as use in the UK is concerned, there is no evidence. Further, it is my view that the single reference to *brokerage insurance* in the *Bloomberg* listing for the Greek parent bank at Exhibit EG5 is wholly inadequate in demonstrating genuine use. This is the sole piece of evidence in respect of these services. There is no information regarding the scope or size of the activity or to what mark such services are provided under.

41) I consider that the Class 36 specification of the earlier EUTM is wholly contained within the term financial services covered by the specification of the earlier UK mark. Consequently, for procedural economy, note withstanding the issue of use of variant

marks (that I will return to below), I will consider use of the earlier EUTM (“ALPHA BANK”) only in respect of the claimed use that extends beyond what would otherwise be described as financial services.

42) In that respect, in addition to Class 36, the earlier EUTM also covers various goods in Class 16 and *management of commercial affairs* in Class 35. In respect of Class 16, Mr Hill identified the supporting evidence in the form of the opponent’s “Mazi” publication, but it was established at the hearing that this evidence is only in respect of an electronic publication. He conceded that if use in respect of electronic publications is insufficient to show use in respect of the goods listed in Class 16, then there is no use demonstrated. I find that this is the case. Class 16 covers only publications in printed form. Electronic publications are proper to Class 9. Therefore, I conclude that there is no genuine use of the earlier EUTM has been shown in respect of any Class 16 goods.

43) In respect to the services in Class 35, Mr Hill conceded that there is little evidence. This evidence is limited to a reference on the *Bloomberg* website provided at Exhibit EG5 where it is stated that the opponent “engages in the real estate management and hotel activities” in Greece. This single reference is wholly inadequate for demonstrating genuine use because it provides no context in terms of scope of use of such services, the size of such use or whether the marks relied upon are used to identify such services. I find that there is no genuine use shown.

Use of the marks as registered

44) Having reached these conclusions on what use is shown in the opponent’s evidence, it is necessary for me to consider whether use of the marks shown in the evidence constitutes acceptable variant use of the earlier marks, as registered. Once again, for the purposes of procedural economy, I will focus upon whether such use is acceptable for demonstrating genuine use of the opponent’s earlier UK mark ALPHA.

45) Ms Michaels submitted that the addition of the device element results in the distinctive character of the mark being altered and that consequently, the use shown cannot be taken as acceptable variant use of the mark ALPHA (or ALPHA BANK).

46) In considering this submission, I am mindful of the following guidance of the Court of Justice of the European Union (“the CJEU”) in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark:

“32. ..., as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1). (emphasis added)

47) There are also examples of this guidance being applied by the General Court (“the GC”). One of these is *Castellblanch SA v OHIM, Champagne Louis Roederer SA*, T-29/04, where it found that use of the word mark “Cristal” on a neck label of a bottle of champagne alongside the denomination “Louis Roederer” and a device, this still qualified as genuine use of the mark “Cristal”.

48) The opponent submits that the device is a separate mark that is used as a stand-alone mark and also alongside its word mark. I concur with this. The evidence illustrates the device mark set to the left but separate from the words ALPHA BANK. To see this as use of two separate marks appears to be wholly consistent with the guidance provided by the CJEU in *Colloseum* and the application of this guidance in the GC’s decision in *Castellblanch*.

49) Having concluded this, I also need to address the question as to whether use of ALPHA BANK is an acceptable variant of the mark ALPHA in respect of the various banking services for which I have found that the opponent has demonstrated use. I have considered a near identical issue before in *A Alfa-Bank Trade Mark*, BL O-113-11 that was subsequently appealed to the High Court ([2011] EWHC 2021 (Ch)). I had found that use of ALPHA BANK LONDON and ALPHA BANK AE qualified as acceptable variant uses of the mark ALPHA. I reproduce Mr Justice Briggs’ comments on the issue in full, below:

“12 I am wholly un-persuaded by that submission, for two reasons. First, it is wrong to regard the three stage analysis in the Nirvana case as tantamount to some statutory code which must be followed slavishly in every case. It is a perfectly sound and authoritative unpicking of the test laid down in section 6(A)(4)(a) of the Act and, for that purpose, a good servant, but not a master. There are bound to be cases, and the present is in my view one of them, where it is clear that, whatever the distinctive character of a word mark as registered, the addition of a further word or words would not alter it. The Hearing Officer’s examples of ltd or plc illustrate that point precisely.

13 My second reason is that, having taken the trouble to cite the three stage analysis in Nirvana in full, the analysis reflected in paragraphs 41 to 45 of the

Decision was, on its face properly compliant with it, and discloses no error or principle. The Hearing Officer first looked at the distinctive character of the mark as registered, then at the different forms of the mark as used, and then asked whether they altered the distinctive character of the mark as registered. 14 I would add, although it is by no means necessary to my decision, that I have found the Hearing Officer's analysis to be persuasive, and regard it as correct. The additional words BANK LONDON and BANK AE are descriptive in the way that the Hearing Officer describes. To an average customer seeking banking services, it seems to me that the addition of BANK adds nothing. LONDON merely describes the actual geographical location of the Respondent's main places of business in the UK. For the reason given by the Hearing Officer, the expression AE adds nothing of substance either."

50) In light of this, I have little difficulty in concluding that use of ALPHA BANK in respect of certain various services is also an acceptable variant use of the earlier mark ALPHA.

51) I should record here that Ms Michaels submitted that the addition of the word BANK needs to be assessed differently for different goods and services. I accept this point and also that the addition of the word BANK may have a greater impact upon the distinctive character of the mark if it were used in respect of goods and services unrelated to banking. However, in light of my finding regarding the services for which genuine use has been demonstrated as all being banking or closely related services, this argument appears to have no purchase in this case.

Fair specification

52) In light of my conclusions regarding the breadth of services for which I have found genuine use, I must also consider what would be a fair description for such services.

53) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

54) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of

the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

55) I have concluded that the evidence illustrates use in respect of current accounts, fixed term deposit accounts and loan accounts and collectively, I take the view that these may be described as *retail banking services* or *personal banking services*. I will select the former of these two terms as a fair description of these services.

56) I also accept that the issuing of the note programmes is an example of an *investment banking service* and I find that this is a fair description of the category of these services.

57) Finally, there is evidence of genuine use in respect of finance for residential and commercial property. I consider that this may be categorised as *property loans*.

Conclusion regarding genuine use

58) In conclusion, I find that the mark ALPHA has been genuinely used in respect of services that can be fairly described as *retail banking services; investment banking services; property loans*. I will proceed to consider the opposition based upon section 5(2)(b) on this basis.

Section 5(2)(b)

59) Sections 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Similarity of goods and services

60) In the judgment of the Court of Justice of the European Union 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”.

61) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- 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.

Class 9

62) In respect of *software*, Mr Hill submitted that insofar as such software is targeted at financial field, they are similar to the opponent's services. Ms Michaels submitted that there is no similarity, suggesting that the high point of the opponent's case is its provision of a banking application software provided to permit its customers to make payments. Ms Michaels further submitted that this will be seen as providing a banking service and not software. As Ms Michaels also contended, you would not go to a bank to purchase software and therefore the trade channels are different. Further, there is no similarity in terms of nature, intended purpose or methods of use and neither is there complementarity in the sense that there is a close connection between the respective goods and services in such a way that customers will believe that the responsibility for both lies with the same undertaking (see *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06) even where the software is related to banking. I conclude that there is no similarity.

63) Similarly, in respect to *downloadable electronic publications* the considerations are analogous to the above. Generally, the trade channels are different and there is no similarity in terms of nature, intended purpose, methods of use nor is there complementarity and the respective goods and services are not in competition. I conclude there is no similarity.

Class 35

64) Similarly to the arguments put forward in respect of the applicant's Class 9 goods, Mr Hill submitted that there is a medium level of similarity where the applicant's services are provided in the context of the banking sector. I dismiss this. As far as I am aware, it is not normal for a banking institution to provide such services, nor for companies providing business management type services to also provide banking services. Consequently, I conclude that the respective trade channels are different. The nature, intended purpose and methods of use are also different with one being management of a business, the other the safe keeping of monies, and products to increase the value of investments. Further, they are not in competition nor are they complementary. I conclude that there is no similarity with the majority of the applicant's services.

65) The exception is the applicant's *mergers, alliances and acquisitions and information, advice, analysis, research and consultancy relating to* [the same]. Company mergers and acquisitions have a financial perspective because it will involve assessing the value of a company and is also likely to involve some sort of financing of the purchase. Therefore, there is some connection with such financial services. The opponent has made no submissions regarding this issue and I have no evidence on the point, but from my perspective as a lay man, it would appear likely to me that such financing is a specialist service that would fall within the remit of investment banking. Therefore, there may be some connection between the applicant's services and financial services and share some similarity of intended purpose and nature. I find that there is a medium level of similarity.

Class 36

66) In respect of the applicant's *investment banking; financial services; financial management; investment; fund management, asset management; investment management; wealth management; private client, discretionary wealth management; portfolio management; information, advice, analysis, research and consultancy relating to the aforesaid*, these are all covered by either the opponent's *retail banking*

services or *investment banking services* or vice-versa and are therefore identical (see the guidance the GC in *Gérard Meric v OHIM*, T-133/05, paragraph 29)

67) In respect of the applicant's *financial advice and information on mergers, alliances and acquisitions* and *information, advice, analysis, research and consultancy relating to* [these services], whilst I have no evidence on the point, it strikes me as likely that such services are a subset of investment banking because the act of assisting companies involved in mergers and acquisitions strikes me as no more than a specialist investment service. Consequently, I find these services are identical to the opponent's *investment banking services*.

68) Finally, in respect of the applicant's *Insurance*, Ms Michaels submitted that such services are "very different" from banking services because banks do not normally provide insurance but rather put clients in contact with brokers. I do not agree with Ms Michaels' conclusions. *Insurance* has a different purpose to banking services and *property loans* because the former consists in accepting liability for certain risks and respective losses and providing monetary compensation where these risks are realised. The latter covers a wide range of services all related to the management and lending of money and the management of investments. Nevertheless, it is clear from the purpose of *insurance* that they are financial in nature. In respect of trade channels, many banks offer insurance or act as agents for insurance companies, with which they are often economically linked. Thus, although *insurance* and banking and property loan services have different purposes, they are similar in nature, they may be provided by the same undertaking or related undertakings, they may share the same channels of distribution and may be used in combination with each other. As such, I find that *insurance* shares a high level of similarity to the opponent's services.

Class 42

69) In respect of the applicant's Class 42 services, Mr Hill submitted that where the subject matter of these services relates to the banking sector then there will be a medium level of similarity. It is not normal for design and development of software etc to be a service offered by a bank, even where the software relates to the banking

sector. Such services are normally obtained by banks from specialist software developers and not from other banks. Consequently, I do not agree with Mr Hill. The trade channels are likely to be different, the respective services are also self-evidently different in nature, intended purpose and methods of use and neither are they in competition with each other. Whilst there may be some complementarity in the sense expressed in *Boston Scientific* because the existence of banking services is an important factor for the existence of development of software for that field, this creates no more than a very low level of similarity between the services.

Comparison of marks


70) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

71) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

72) Considering the applicant's three marks, application 3109889 appears to provide it with its best case because of the addition of the words “Technology Services” that appear to be unrelated to the goods and services of the opponent. If the applicant

can successfully defend the opposition in respect of this mark, it will also do so in respect of its other two marks. Consequently, I will undertake my comparison of marks only in respect of this mark. The respective marks are shown below:

Opponent's mark	Applicant's marks
ALPHA	 The logo for Alpha Technology Services. It features a stylized 'A' icon consisting of a grey circle with an orange dot in the center. To the right of the icon, the word 'Alpha' is written in a bold, black, sans-serif font. Below 'Alpha', the words 'Technology Services' are written in a smaller, grey, sans-serif font.

73) The distinctive character of opponent's earlier mark resides totally in the single word ALPHA. In its written submissions, the applicant concedes that ALPHA is the dominant element of its mark. I note this and record my view that the device element is also a distinctive element of the mark. In respect of the words "Technology Services", these will be perceived as descriptive by the consumer and also by virtue of being smaller scale compared to the other elements of the mark, their contribution to the distinctive character of the mark is minimal. In summary, taking all of this into account, I concur with the applicant and find that the word ALPHA is the dominant and distinctive element of its mark.

74) Visually, the marks share similarity by virtue of both including the word ALPHA. It must be kept in mind that the "word only" form of the opponent's mark will permit use in lower case form with a capital first letter and that this will be virtually identical form to how the word appears in the applicant's mark. The remaining elements of the applicant's mark are absent from the opponent's mark. Taking all of this into account, I conclude that the respective marks share a medium degree of visual similarity.

75) Aurally, the applicant's mark is likely to be referred to as ALPHA with the additional words and device not normally being referred to. With this in mind the respective marks are aurally identical.

76) The device element of the applicant's mark does not contribute to its conceptual identity, being abstract in nature and not conveying any conceptual message. The words "Technology Services" create a conceptual element, but as I have already noted, this is descriptive in nature. The element ALPHA, common to both marks, is most likely to be understood by the average consumer as a reference to the first letter of the Greek alphabet, but I note that it has a couple of specialist meaning in the field of finance and, insofar as the consumer will perceive such a meaning, it is equally likely in respect of both marks. Taking all of this into account, when considering the respective marks as a whole, I conclude that, conceptually, they are distinctively similar to a high degree.

Average consumer and the purchasing act

77) 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*.

78) 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."

79) The specifications of both parties include financial services that can be aimed at the ordinary members of the public and/or to the more specialised institutional investor. Even if I am wrong in my assessment of the opponent's services and its

consumers are limited only to customers of retail banking services, they may still be the same or at least overlap with the applicant's consumers because the applicant's services include retail banking and because the customers of more specialised financial services will also be users of retail banking services. I conclude that the average consumer of the respective services is either the same or has a significant overlap.

80) The purchasing act for all the respective services will, in the vast majority of cases, involve a greater than average degree of attention because the average consumer is likely to be concerned with finding the most appropriate and safe home for his/her money.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

82) The opponent’s mark consists of the word ALPHA. This is likely to be understood as a reference to the first letter of the Greek alphabet. There is evidence from the applicant that it has two meanings in the field of finance. I note these, but both appear to relate to specialised activities, and it is not clear to me that either meaning would enter the minds of the consumer of the opponent’s services. As conceded by Mr Hill, the word may be perceived as an allusion to “first” or “most prominent”. I note the applicant’s evidence illustrating numerous other marks being used in the field of finance containing the word ALPHA. This, together with the previous points, leads me to conclude that the mark is endowed with a medium level of inherent distinctive character, neither low, nor high.

83) The opponent has demonstrated that it has an established single branch in London and that it has 2,500 UK customers. The average consumer of retail banking services and investment banking services will consist of a very large proportion of the adult UK population. When considered in this context, the operation of a single branch and only a few thousand customers will not result in the marks distinctive character being enhanced in the UK.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

84) The following principles are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

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

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

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

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

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

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

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

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

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

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

85) Ms Michaels submitted that it is not possible to ignore either the device element or the extra words that are present in the applicant's mark, citing both the *Bimbo* case and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch). In the latter, Arnold J. considered the impact of *Bimbo* on the court's earlier judgment in *Medion*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It

does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

86) I believe my analysis is consistent with this guidance. At all times, I keep in mind that I must consider the likelihood of confusion by factoring into the global appreciation the impact of the marks as a whole. In doing so, I have found that the dominant and distinctive element of the applicant's mark is the ALPHA element. The impact of this is that it has distinctive significance and its meaning is not changed by the addition of the device or the words “Technology Services”. I also acknowledge that it does not automatically follow that there is a likelihood of confusion as a result of ALPHA being present in the applicant's mark.

87) I keep all of the above in mind together with my findings that:

- the applicant's *mergers, alliances and acquisitions and information, advice, analysis, research and consultancy relating to* [the same] in Class 35 share a medium level of similarity and all of its Class 36 services are identical or highly similar;
- the respective marks share a medium level of visual similarity, a high level of conceptual similarity and that they are aurally identical;
- the purchasing process is likely to involve a greater than average degree of attention;

- the average consumers of the respective goods and services may be ordinary members of the public or more specialist institutional investors;
- the opponent's mark is endowed with a medium degree of distinctive character.

88) When considering all of these findings as part of the overall picture, I find that whilst the average consumer is likely to register the differences between the marks (and therefore there is no direct confusion), they are still likely to believe that the applicant's *mergers, alliances and acquisitions* and *information, advice, analysis, research and consultancy relating to* [the same] and all the services listed in its Class 36 specification provided under its marks originate from the same or linked undertaking as the services provided under the opponent's mark and I conclude that there is a likelihood of indirect confusion in respect of these services.

89) The grounds based upon section 5(2)(b) fail on respect of all of the applicant's remaining goods and services.

Concurrent use

90) Having found that a prima facie likelihood of confusion exists in respect of the applicant's *mergers, alliances and acquisitions* and *information, advice, analysis, research and consultancy relating to* [the same] in Class 35 and all of its Class 36 services, the only factor that can save this part of the application is the existence and effect of concurrent use. The applicant has provided evidence of claimed longstanding use of a very similar mark (see paragraph 23) to those now subject of its applications. This is a different mark to the three marks, the subject of its applications and leads me to conclude that the applicant cannot rely upon this different mark in advancing a concurrent use argument. However, in case I am wrong, I make the following comments.

91) For a defence of concurrent use to be successful, it is necessary for me to be satisfied that the parties have traded in circumstances that suggest consumers

have been exposed to both marks and have been able to differentiate between them without confusion as to trade origin (see to that effect the Court of Appeal in *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45 and Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18). Mr Justice Carr provided a summary of the law relating to concurrent use in *Victoria Plum Limited (trading as "Victoria Plumb") v Victorian Plumbing Limited and others*, [2016] EWHC 2911 (Ch). Mr Justice Carr summarised the principles as follows:

"73. The case law to which I have referred establishes the following principles:

- i) Where two separate entities have co-existed for a long period, honestly using the same or closely similar names, the inevitable confusion that arises may have to be tolerated.
- ii) This will be the case where the trade mark serves to indicate the goods or services of either of those entities, as opposed to one of them alone. In those circumstances, the guarantee of origin of the claimant's trade mark is not impaired by the defendant's use, because the trade mark does not denote the claimant alone.
- iii) However, the defendant must not take steps which exacerbate the level of confusion beyond that which is inevitable and so encroach upon the claimant's goodwill."

92) Therefore, for concurrent use to be of assistance to an applicant, I must be satisfied that the effect of concurrent trading has been that the relevant public has shown itself able in fact to distinguish between goods and services bearing the marks in question i.e. without confusing them as to trade origin. That implies that both parties are targeting an approximately similar, or at least overlapping, audience and that the use by the parties in nature, extent and duration of trade has been sufficient to satisfy me that any apparent capacity for confusion has been adequately tested and found not to exist. In the current case, I concluded

earlier that there is an overlapping consumer by virtue of the identity, high or medium similarity between the applicant's *mergers, alliances and acquisitions and information, advice, analysis, research and consultancy relating to* [the same] in Class 35 and all of its Class 36 services when compared to the opponent's services.

93) Ms Michaels pointed to the fact that neither party has evidence of confusion. I note this, but it is not, in itself, persuasive. I note that the opponent UK business consists of a single branch in the City of London and that it has 2,500 UK customers. When the self-evidently huge scale of the banking industry in the UK is taken into account, the opponent's small level of use, relative to the size of the industry is such that there has been little opportunity to test the proposition that the effect of concurrent trading has been that the relevant public has shown itself able in fact to distinguish between goods and services bearing the marks in question without confusing them as to trade origin.

94) In summary, there is insufficient evidence to demonstrate that any apparent capacity for confusion between the marks has been adequately tested in respect of the applicant's *mergers, alliances and acquisitions and information, advice, analysis, research and consultancy relating to* [the same] in Class 35 and all of its Class 36 services. In making such a finding, I have kept in mind that the parties have been targeting an overlapping audience and that the use by both is long standing. However, these factors are outweighed by the absence of persuasive evidence or a factual matrix that illustrates that the average UK consumer has been adequately exposed to both parties' marks and is not likely to confuse the marks.

95) In summary, I find that concurrent use of the respective marks is not such that my *prima facie* findings regarding the likelihood of confusion are disturbed.

Summary

96) The grounds based upon section 5(2)(b) succeed against all three applications in respect of the following of the applicant's services:

Class 35: *mergers, alliances and acquisitions; ... information, advice, analysis, research and consultancy relating to the aforesaid.*

Class 36: *Insurance; investment banking; financial services; financial management; investment; fund management, asset management; investment management; wealth management; private client, discretionary wealth management; portfolio management; financial advice and information on mergers, alliances and acquisitions; information, advice, analysis, research and consultancy relating to the aforesaid.*

97) The section 5(2)(b) grounds are unsuccessful against all three applications in respect of the other goods and services that the opposition was directed to, namely:

Class 9: *Software; downloadable electronic publications.*

Class 35: *Business and organisational management; business and organisational administration; project and program management; business and organisational strategy; ... personnel management and recruitment; out-sourcing; human resource management; provision of contractors; product development and management; corporate benchmarking; business management, business advice and business implementation support relating to sales and client service; corporate benchmarking; information, advice, analysis, research and consultancy relating to the aforesaid.*

Class 42: *Design and development of software and IT; software and IT programming; software and IT installation, management and updating; product development and management; project and program management; information, advice, analysis, research and consultancy relating to the aforesaid.*

Section 5(4)(a)

98) I will consider the opponent's grounds based upon section 5(4)(a) only insofar as it may improve its position over and above its grounds based upon section 5(2)(b).

Therefore, I will consider the grounds in respect of the applicant's surviving goods in Class 9 and services in Class 35 and Class 42.

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

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

Goodwill

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

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

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

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant

seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.'

101) Therefore, the relevant date for the purposes of this opposition is the filing date of the application, namely 21 May 2015. I keep in mind that other dates may be relevant.

102) Guidance on the meaning of goodwill was provided in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), where it was stated:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

103) In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

104) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

105) The opponent claims that its goodwill is identified by the signs ALPHA and ALPHA BANK and claims first use in 1 January 1989. In respect of both signs, the opponent claims use in connection to “financial and banking services, leasing and investment products (in Class 36)” and additionally in respect of the second sign, “management of financial and monetary affairs (Class 35) and on printed matter, newspapers, books and journals (Class 16)”. Previously in my decision I found there is no genuine use in respect of the Class 16 goods and the Class 35 services and it follows that neither sign identifies any goodwill in respect of such goods and services. Therefore, the opponent may rely upon goodwill identified by both these signs in respect of the identical list of services I identified when considering genuine use, namely *retail banking services, investment banking services and property loans*.

106) I further add that the addition of the word BANK in the second sign does not materially harm the opponent's case compared to that based upon ALPHA solus, I consider its case as based on this second sign. Whilst I found that such use was insufficient to result in the opponent's mark benefitting from any enhanced distinctive character, I am satisfied that this use is sufficient to illustrate that the opponent has goodwill in these services identified by the sign ALPHA BANK.

Misrepresentation and damage

107) In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in *Halsbury's Laws of England*, 4th Edition Vol. 48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper

emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

108) I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumer are confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here. I find that members of the public are unlikely to be misled into purchasing the applicant’s Class 9 goods or Class 35 and 42 services in the belief that they are the opponent’s goods and services. For the reasons set out in my earlier comparison of goods and services, I consider that the business areas of the respective goods and services are too far apart for any economic connection to be made.

109) I find that the opponent’s grounds insofar as they are based upon section 5(4)(a) is successful only to the same extent that the oppositions are successful under the section 5(2)(b). In respect of the applicant’s goods and services in Classes 9 and 42 and most of its Class 35 services, the oppositions fail.

Summary

110) The oppositions are successful in respect of the applicant’s *mergers, alliances and acquisitions; ... information, advice, analysis, research and consultancy relating to the aforesaid* in Class 35 and all of its Class 36 services, but fail in respect of its other goods and services.

COSTS

111) The opponent has been partially successful in all three oppositions. The extent of the success is roughly the same as the extent to which it has failed and accordingly I find that the parties should bear their own costs and I decline to make an award.

Dated this 21st day of March 2017

**For the Registrar,
The Comptroller-General**