

O-247-20

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3325833
BY ARGENTA PROJECTS LIMITED
TO REGISTER AS A SERIES OF TWO TRADE MARKS:**

Argenta Projects Ltd

ARGENTA PROJECTS LTD

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 414078
BY ARGENTA SPAAARBANK OU EN ABRÉGÉ ASPA OU EN FRANÇAIS
ARGENTA BANQUE D'ÉPARGNE OU EN ALLENMAND ARGENTA SPARBANK
(SOCIÉTÉ ANONYME)**

Background and pleadings

1. On 19 July 2018, Argenta Projects Limited. (“the applicant”) applied to register, as a series of two, the trade marks **Argenta Projects Ltd** and **ARGENTA PROJECTS LTD**, under number 3325833. As nothing turns on the difference between these two marks, I will refer to them as “the contested mark”. The application was published for opposition purposes on 17 August 2018 in respect of the following services:

Class 35: Procurement services; consultancy services relating to the procurement of goods and services; procurement of goods on behalf of other businesses; procurement services for others [purchasing goods and services for other businesses]; business project management services.

2. The application is opposed by Argenta Spaarbank ou en abrégé ASPA ou en français Argenta Banque d’Épargne ou en allemand Argenta Sparbank (société anonyme) (“the opponent”). The opposition, filed on 17 October 2018, is brought under ss. 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and is, under both of these grounds, directed against all of the services in the application.

3. Under both ss. 5(2)(b) and 5(3), the opponent relies upon its European Union trade mark number 280354 **ARGENTA**. The mark was filed on 13 June 1996 and was entered in the register on 31 March 2004. It is registered for the following services, all of which are relied upon under both grounds:

Class 36: Insurance and finance.

4. The opponent claims under s. 5(2)(b) that the contested mark is similar to the opponent’s mark and that the goods at issue are identical or highly similar. It says that there is a likelihood of confusion, including the likelihood of association.

5. Under s. 5(3), the opponent claims that its mark has a reputation in the UK such that use of the contested mark would cause the relevant public to believe that there is an economic connection between the applicant and the opponent, where no such connection exists. It claims that use of the contested mark would confer an unfair advantage on the applicant, which would benefit from the reputation and power of attraction of the earlier mark without making any investment. It is asserted that there would be a transfer of the image and characteristics associated with the opponent's mark to the contested mark. The opponent further claims that there would be detriment to the reputation of the earlier mark if the services provided under the contested mark are of inferior quality or if the brand values of the applicant do not align with the values and ideology of the opponent. The opponent also claims that the use of the contested mark would lead to a dispersion of the identity of the earlier mark, diluting the distinctiveness of the earlier mark and resulting in consumers no longer relying on the opponent's mark as a guarantee of value.

6. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of its claims.

7. Given its date of filing, the opponent's trade mark qualifies as an earlier mark in accordance with s. 6 of the Act. In its notice of opposition, the opponent indicated that the mark has been used for all of the services upon which it relies. This statement is made because, as the mark had completed its registration process more than 5 years before the publication date of the application in suit, it is subject to the proof of use provisions contained in s. 6A of the Act. The applicant in its counterstatement indicated that it would require the opponent to provide evidence of use of its mark. The relevant period for genuine use under ss. 5(2)(b) and 5(3) is 18 August 2013 to 17 August 2018.

8. Both parties filed evidence. A hearing was held before me on 29 January 2020. The opponent was represented by Rachel Wilkinson-Duffy of Baker & McKenzie LLP. The applicant was represented by Silvana Rossi.

Evidence

Opponent's evidence

9. As Ms Rossi, very sensibly, accepted at the hearing that the opponent has used its mark in respect of banking services in Belgium, and that it has a reputation for those services, also in Belgium, it is not necessary for me to summarise all of the opponent's evidence. I will confine my comments to the key material.

Marc Lauwers' evidence

10. The bulk of the opponent's evidence is provided by Marc Lauwers. Mr Lauwers is the Chief Executive Officer of Argenta Bank- en Verzekeringsgroep NV, which is the holding company of the opponent.

11. The opponent is a Belgian company established in 1956 and has had the company name "ARGENTA" since 1958, which has been used ever since.¹ The opponent is a member of "the Argenta Group", all of the companies in which are said to have used "ARGENTA" as a trade mark in Belgium.² One of these is Argenta Assuranties, which was established in 1974 "to provide life and fire insurance", with further insurance products added later.³

12. Mr Lauwers states that the two main activities of the Argenta Group are insurance and banking.⁴ The opponent is said to have over 550 offices in Belgium, where it is the fifth largest bank in terms of customer numbers; the Argenta Group has over 1.7 million customers.⁵ The opponent was, at 14 February 2019, the eighth-largest bank in terms of revenue and market share.⁶ Reports dated 1 January 2016 and 2018 record the

¹ Lauwers, §§ 3, 6 and exhibit ML1.

² Lauwers §§6, 11.

³ Lauwers, §8.

⁴ Lauwers §12.

⁵ Lauwers §12.

⁶ ML2.

designation of the opponent as a “systemically important institution” in Belgium, a status which appears to have been conferred because of its important market share in deposits and/or loans in Belgium.⁷

13. UK and EU sales figures are provided, said to relate to products sold under the ARGENTA brand.⁸ The UK sales are said to relate to financial and investment services. They are for the period 2008 to 2013 and are not broken down by year. Sales in the EU for Argenta Spaarbank (i.e. the opponent) are in excess of €440 million each year from 2013. These figures are not broken down into categories.

14. Annual reports for the opponent from 2013 to 2016 are in evidence.⁹ They are said to include use of the mark in relation to a variety of retail banking, insurance and financial services, including investments, loans and mortgages, and to detail matters such as “total insurance premium collections”. Precisely where this information is revealed is not obvious, nor is it stated: the reports include, for example, references to “assets” or “commissions” but no further detail. There are significant figures for assets in the shape of loans and receivables to and from both credit institutions and “other clients”. I also note lower and more variable figures for “derivatives, hedge accounting”. Liabilities include significant deposits from credit institutions and other clients, as well as “debt certificates, including bonds”. A financial statement for 2017 gives figures for financing activities including the proceeds from the issue of subordinated liabilities (2016: €497,950,000) and bonds (2017: €1,213,080,000).¹⁰ The opponent’s net profit in each of 2016 and 2017 was over €130 million.¹¹

⁷ ML3 (p. 20); ML4 (p. 25).

⁸ Lauwers §15.

⁹ ML5.

¹⁰ ML6.

¹¹ Lauwers §18 and ML7.

15. Mr Lauwers exhibits half-year statements for the 2016 and 2017 financial years which show that between 2.9% and 3.5% of the opponent's investments were in the UK.¹² This is said to amount to at least €220 million from the second half of 2016.

16. Figures for 2017 are given in which UK risk exposure is over €300 million.¹³ Mr Lauwers says that this demonstrates the "considerable sums lent in the UK".¹⁴

17. The securitisation policy sections of the 2015 and 2017 annual statements are in evidence.¹⁵ These appear to relate to the securitisation of portfolios of Dutch residential mortgages involving a company called Green Apple. Two of the transactions predate the relevant period; a further securitisation transaction took place in 2017. Mortgage-backed securities exposure in the UK is between €7.5 million and €14.8 million in this period. A prospectus for a bond issue in June 2018 for Green Apple is in evidence. It is not clear, and it is not explained, how this relates to the opponent, which is not mentioned.¹⁶

18. A press release dated 17 May 2016 reports a bond issue of the opponent.¹⁷ 39% of the bond allocation was in the UK. Asset managers were the largest group across the bond issue (74%), followed by insurance and pension funds (16%) and banks (9%). Further bond issues for mortgage-backed notes and subordinated class C notes are evidenced, dated 3 October 2017 and 22 June 2018, in which the opponent is identified as the seller.¹⁸ I note that the portfolio information and documentation at ML16 refer to mortgage loans and the Dutch residential market. The latter document is also highlighted by Mr Lauwers as referring to the risk of Brexit adversely affecting the opponent's bonds.

¹² ML8 to ML11. I note that the heading at ML8 indicates that the figures relate to the second half of 2016 but the presentation title slide shows second half 2017, which is consistent with Mr Lauwers' statement, and different 2016 second half figures (with a consistent title slide) appear at ML11.

¹³ ML12.

¹⁴ Lauwers §23.

¹⁵ ML14, ML13.

¹⁶ ML15.

¹⁷ ML16; Lauwers §27.

¹⁸ ML17 and ML18. Part of the 2018 prospectus also appears at ML15.

19. Various agreements are exhibited which are said to relate to loans, including a mortgage and credit agreement.¹⁹ They are not in English. Those at ML24 are dated between February 2014 and May 2019, with the majority in the relevant period. “ARGENTA” is visible in a stylised form in the letterhead, as well as in a plain typeface as part of the company name.

20. Advertising and marketing spend is said to be over €1.5 million per year.²⁰ It is said that the opponent’s website, www.argenta.be, received 433,473 hits from the UK between July 2009 and December 2018.²¹ Various prints from the website are in evidence.²² None is in English. Only two are clearly in the relevant period (ML26G, ML26K), which are said to relate to bond commodities and investment services; Mr Lauwers states that another of the advertisements, said to relate to personal and home insurance, was disseminated in 2013 (ML26I). An advertisement for car insurance is attributed to the “beginning of 2013” and therefore does not appear to fall within the relevant period (ML26J). Screenshots of videos present on YouTube are provided, said to be in the relevant period and to have attracted around 30,000 views each. The videos have “Argenta” in the title but are not in English and it is not explained what they advertised.

21. Press reports concerning the opponent are in evidence but they are from January 2019 (i.e. outside the relevant period).²³ I note that the opponent is referred to in these exhibits as a “Belgian bank” or as active in Belgium and the Netherlands, and that the article at ML31 specifies that banking services are provided by Argenta Spaarbank and insurance activities by Argenta Assuranties.

¹⁹ ML19 to ML24. Mr Lauwers’ witness statement indicates that exhibits ML19 to ML23 include English translations. This discrepancy was drawn to the attention of the opponent prior to the hearing. At the hearing, Ms Wilkinson-Duffy confirmed that the opponent did not seek to file any additional evidence.

²⁰ Lauwers, §30.

²¹ Lauwers, §31.

²² ML26A to ML26M.

²³ ML29 to ML32.

22. There are, in addition, web prints which report awards and endorsements won by the opponent between 2016 and 2018.²⁴ These are said to be for its banking, savings account and checking account services but only ML34 is in English. That report is described in the exhibit itself as follows: “In 2016, the Benchmark Company measured the brand strength of the most important market players of the banking sector, the insurance sector [...]”. It places the opponent top for banking services in 2016. The report also indicates that it compared the fifteen insurance companies with the most offices in Belgium for its analysis of the brands in that sector. Sixteen companies are listed, of which the opponent is one. There is also said to be an article in which the opponent was profiled for professionals in the insurance industry.²⁵ The article is not, however, in English.

Rachel Wilkinson-Duffy's evidence

23. Ms Wilkinson-Duffy is a Chartered Trade Mark Attorney at the opponent's professional representatives.

24. Ms Wilkinson-Duffy exhibits undated prints from the websites of Willmott Dixon, Tétris and Morgan Lovell and Trevor Blake.²⁶ These are said to be UK companies offering both design and financial services. The prints, however, are in relation to design and fit-out services. I have noted references to costing at RWD2, a “financial stability checklist” at RWD3 and, under the “project management” heading, “budget evaluation reports” at RWD4.

25. There is also an undated print from the Business Lending Authority about its loans to interior design businesses.²⁷ It does not assist.

²⁴ ML34 to ML36.

²⁵ ML38

²⁶ RWD1 to RWD4.

²⁷ RWD5.

Applicant's evidence

26. This is provided by Janna Walker, Principal Consultant for the applicant. I have read all of Ms Walker's evidence. However, for reasons which I will explain shortly, it is not necessary for me to summarise it in any particular detail. Suffice to say that the evidence includes various records from Companies House regarding the applicant company,²⁸ as well as evidence regarding the logo used by the applicant,²⁹ references for the company,³⁰ the applicant's Instagram page (undated),³¹ and an undated advertisement.³² There is also an undated presentation and a fee proposal, dated 7 August 2018, which detail some of the applicant's previous projects and its services.³³ These include references to the management of the tendering process and purchase orders/agreements as well as invoicing and financial record-keeping.

27. That concludes my summary of the evidence, to the extent I consider necessary.

Preliminary issue

28. As I explained at the hearing, the evidence which has been filed on behalf of the applicant is of limited use because the test under s. 5(2)(b) is a notional one. This was explained in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), where the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, my assessment must take into account only the applied-for mark (and its specification) and any potential conflict with the earlier trade mark. Any differences between the services provided by the parties, differences in their trading styles or indeed the actual marks

²⁸ Exhibits 2 to 19.

²⁹ Exhibits 1, 21.

³⁰ Exhibit 20.

³¹ Exhibit 22

³² Exhibit 23.

³³ Exhibits 25, 26.

used by the parties are irrelevant unless those differences are apparent from the applied-for and registered marks.

Proof of use

29. The relevant statutory provisions are as follows:

“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 Community 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 Community.

(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”.

30. Section 100 of the Act is also relevant, which reads:

“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”.

31. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use has been subject to a number of judgments. In

Walton International Ltd & Anor v Verweij Fashion BV [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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]”.

32. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use”.

33. It went on:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark”.

34. It further stated:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

35. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial

borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity".

36. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

"228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's

challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

37. The General Court restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

38. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

39. The correct approach to assessing the opponent's evidence is to view the picture as a whole, including whether individual exhibits corroborate each other: *New Yorker SHK Jeans GmbH & Co. KG v Office for Harmonisation of the Internal Market (OHIM)*, Case T-415/09, EU:T:2011:550.

40. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Daniel Alexander Q.C. sitting as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public”.

41. He added:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted”.

42. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Geoffrey Hobbs Q.C. sitting as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use”.

43. The applicant does not appear to dispute that such use as there has been has been under the earlier mark. Mr Lauwers' evidence that the opponent has used ARGENTA as a trade mark since 1958 is unchallenged and "Argenta" is used throughout the evidence, including by third parties to describe the opponent. There is nothing to suggest that the opponent operates under a different mark. For the record, the stylised form of the mark which appears in places in the evidence is, in my view, an acceptable variant under s. 6A(4)(a): the typeface is only very slightly stylised and the distinctiveness of the word "ARGENTA" is unaffected.³⁴ Further, it is no barrier to genuine use that the earlier mark has been used in conjunction with a device: *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, EU:C:2013:253, at [32]-[35].

44. It is accepted that there has been genuine use of the earlier mark in relation to banking services in Belgium. The evidence shows that the opponent is no minnow in the Belgian banking sector; on the contrary, it is so important in terms of its retail banking market share that it is a systemically important institution. EU-wide sales figures for the opponent are significant and sustained. Even without a breakdown by country, the level of use demonstrated is sufficient to establish that there has been genuine use of the earlier mark in the EU in relation to banking services during the relevant period.

45. The opponent claims to have used the mark not only in relation to banking services but for finance services at large. The UK figures provided by Mr Lauwers are, however, global figures for the period 2008 to 2013. With no breakdown by year, I am left to speculate as to how much of the sales figures was attributable to the final four-and-a-half months of 2013 (i.e. in the relevant period). There are annual reports in evidence from the relevant period which, although they do not explain in particular detail the services offered by the opponent, do identify certain assets and liabilities. These include loans and deposits as well as "debt certificates" (bonds and retail savings certificates) and "subordinated liabilities". There is further evidence of a bond issue in 2016. Given the figures involved and what appears to be consistent activity during the relevant

³⁴ See *Nirvana Trade Mark*, BL O/262/06 at [33]-[34].

period, I consider that there is sufficient evidence to establish genuine use in relation to loan and deposit services, debt certificates and subordinated liabilities.

46. There is some evidence from the annual reports of “derivatives, hedge accounting” involvement which is listed as both an asset and a liability. The figures involved are not insignificant but there is no explanation of how these figures relate to the opponent’s services. Whilst I accept that banks may be intermediaries or advisors in derivatives trading, they may also be end-users of derivatives, hedging their own liabilities. Given that these figures are presented as the bank’s own assets and liabilities, rather than profit (or loss) made from providing derivatives trading/investment services, it is more likely that these services relate to the opponent’s own investment strategy than that they concern services offered to third parties. That is particularly the case because the evidence as a whole points to the opponent being primarily a retail bank and not an institution with a significant investment arm.

47. Similar considerations apply to the evidence that the opponent was involved in a mortgage securitisation transaction. It is not clear to me that the purchase of mortgage debt in this transaction was entered into by the opponent as a service to any other individual or entity: more likely, in the absence of any clear evidence of the opponent providing investment services for others, is that the opponent entered into this transaction as an investment on its own behalf. I would add that there is nothing by way of explanation in the evidence to clarify the point. There is also no clear documentary evidence to support Mr Lauwers’ assertion that the opponent provides investment services per se, including advisory services, other than as part of its banking operation.

48. The applicant does not accept that there has been genuine use in relation to insurance services. Mr Lauwers states that insurance is one of the two main areas of the Argenta Group’s business. However, there are no sales figures which can with any degree of certainty be attributed to insurance services. Mr Lauwers’ narrative evidence of UK sales is almost all outside the relevant period and does not specify whether any, and if so what portion, of the services are insurance services. The figures concerning

the EU are for Argenta Spaarbank not Argenta Assuranties: both Mr Lauwers' narrative evidence and a press article provided by him suggest that it is the latter which offers insurance services. Mr Lauwers' evidence is that the financial reports include figures for a range of services but, again, the reports themselves are for the opponent company, not Argenta Assuranties or the group. As I have indicated above, while reasonable inferences can be made for some financial services, the reports themselves do not obviously relate to insurance services. In terms of the remaining evidence, there is only one advertisement, not in English, which potentially dates from the relevant period and relates to personal and home insurance services. There is also a reference in a press article to insurance services provided by Argenta Assuranties, outside the relevant period. Lastly, the opponent is included with other insurance companies in a report on successful brands dated 2016. There is, however, a discrepancy between the number of companies said to have been compared (fifteen) and the number of companies whose logos appear in the description (sixteen). I do not know which of these is accurate: the report itself is not exhibited and there is no corroboration elsewhere in the evidence. I acknowledge that use which is established in one Member State may be sufficient to qualify as genuine use throughout the EU, and that being among the top fifteen (or sixteen) in one Member State may justify a finding of use throughout the EU. However, the evidence as to whether the opponent was actually in this shortlist is inconclusive. Even if I were to accept that the opponent did feature, I do not know whether the opponent was nearer the top or the bottom of the list and there is little else to assist me in determining whether any use which has been made is sufficient to constitute genuine use in the EU. I cannot tell from the evidence how many insurance offices the opponent actually had in the relevant period. I do not know, for example, whether "offices" includes a presence in any or all of the opponent's 550 banks. The evidence does not show what market share or total sales may be attributable to the opponent, or whether any use by the opponent was in particular areas of the insurance sector. There is no information on the nature of the insurance market in Belgium. There is also no evidence regarding the size of the insurance sector in Belgium and how this would relate to the market in the EU as a whole. If insurance is indeed a principal activity of the opponent (or of Argenta Assuranties using the mark with the opponent's

consent), it ought to have been very straightforward for, at least, sales or turnover figures in relation to such services to have been provided. In the result, genuine use has not been established in relation to insurance services.

49. As regards a fair specification, in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Carr J 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".

50. The applicant accepts use in relation to banking services and I have found, above, that there has been use in relation to loans and deposit services, debt certificates and subordinated liabilities. It seems to me that deposit and loan services are, in the absence of evidence to show otherwise, features of banking services. Subordinated liabilities include, as far as I understand it, types of bonds and loans. There is some, albeit limited, evidence that the opponent provided debt certificates including not only bonds but also retail savings certificates. However, all of these, in the absence of any evidence to explain the terms, appear to be services which would be provided by a bank. I do not consider it appropriate for the opponent to be permitted to rely on finance services at large. That is a very wide term and would, in my view, be too generous on the evidence, particularly in light of my findings regarding insurance services. A fair specification upon which the opponent may rely is "banking services".

Section 5(2)(b)

51. Section 5(2)(b) of the Act reads 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”.

52. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

53. The competing services are as follows:

Opponent's services	Contested services
Class 36: Banking services.	Class 35: Procurement services; Consultancy services relating to the procurement of goods and services; Procurement of goods on behalf of other businesses; Procurement services for others [purchasing goods and services for other businesses]; Business project management services.

54. When making the comparison, all relevant factors relating to the services in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“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”.

55. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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.

56. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

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

57. In *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. The same applies by analogy to services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, EU:T:2008:338, the GC stated that “complementary” means:

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

58. I also bear in mind the comments of Daniel Alexander Q.C., sitting as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13, where he warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

59. Ms Wilkinson-Duffy, on the basis of the opponent’s registered specification, submitted that the services at issue are all likely to be offered to the same and overlapping business users, and that the services are complementary. She submitted that the services have the same overall nature, as they are all intended to improve the purchaser’s financial position, primarily in a business context and that there is a direct

overlap, with financial and insurance services all forming part of an overall procurement offering. Ms Wilkinson-Duffy accepted that there is not a high degree of similarity but submitted that the services are similar to at least a moderate degree.

60. Although Ms Rossi focused rather more on the applicant's actual business than the specification for which registration is sought, she submitted that the services are completely different, with the applicant's services being the purchase of goods and furnishing of hotels/other projects on behalf of others.

Procurement services; Procurement of goods on behalf of other businesses; Procurement services for others [purchasing goods and services for other businesses]

61. Although the applicant's business may be focused on particular types of goods and services, the terms applied for are unrestricted. As part of the procurement process is likely to involve calls for tender or the assessment of different quotations, procurement services can, to that extent, be understood as including a financial aspect. It is apparent from the applicant's evidence that the procurement services offered by the applicant do include the management of the tendering process, raising of purchase orders and some financial record-keeping. It is reasonable to assume that this use is within the ambit of fair and notional use of the procurement services for which registration is sought.

62. The opponent's banking services concern the lending, borrowing and saving of money by a variety of means, from credit cards and personal loans to mortgages and bonds. They also include the provision of accounts, including saving accounts, as well as, for example, debit cards and cheque services for customers.

63. I accept that business users will be relevant consumers for both parties' services. The purpose of the contested services is to purchase goods and services for others, with providers taking decisions on suppliers and having responsibility for the completion of projects on time and on budget. The purpose of the opponent's services is to enable customers to borrow money, store it safely or increase its value through various

financial arrangements and instruments. Banks will offer a range of financial products and information concerning those products. Whilst procurement services will assess the cost and suitability of tenders and quotations, I do not think that this amounts to a meaningful overlap in nature or purpose with banking services. Nor do I consider that the raising of purchase orders, invoicing or financial record-keeping draws the services closer together: these are essentially administrative business services rather than financial services, notwithstanding the fact that they record monies spent/owed. I do not accept that a procurement service has as its purpose ensuring or improving the purchaser's financial position: selection of the most economic offer may be part of the considerations but it is by no means the only one (quality or ability to deliver in a particular timeframe may be preferred over price) and any increased financial stability/revenue as a result of the procurement of the goods/services is an indirect consequence rather than the purpose of the service itself. The way in which the services reach the end-users will be wholly dissimilar and there is no competition. As far as complementarity is concerned, I see no reason why the opponent's services would be used with procurement services in such a way that the customer would consider them to be provided by the same undertaking. Money is, of course, required for the purchase of goods or commissioning of a project but the same could be said of any transaction and the fact that funds are required to buy goods or engage a service provider is not a reason, without more, for a finding of similarity. These are, in my view, distinct sectors and the consumer is unlikely to attribute the provision of the contested services to a provider of banking services. I have not overlooked the opponent's evidence of UK companies said to offer financial services. I do not find it persuasive, for the same reasons as given above and because even if there were some overlap with financial services at large (as to which I make no findings) that is not the comparison before me. There is no similarity.

Consultancy services relating to the procurement of goods and services

64. Insofar as these services form part of procurement services, my comments above apply. For the avoidance of doubt, even if these are standalone services provided by

third parties who advise businesses on the suitability of providers of procurement services, I consider that there is an even greater distance between the respective services. I accept that both will involve business users but that is a relatively superficial point of similarity. In the absence of any other basis for similarity, I find that these services are not similar.

Business project management services

65. Project management services involve the planning, management and delivery of a particular project or goal. Given that these services are in class 35, the projects have a business objective, for example projects for updating a ledger system, business reorganisation or perhaps concerning market analysis. Again, whilst these services will share professional users with the earlier services, more is needed for overall similarity to be engaged. I cannot see any basis for such overall similarity. Business project management may include the assessment of bids or the analysis of the cost benefits of a particular action. However, these services would not include the provision of information on financial products or investments, which would generally be the preserve of financial institutions (and proper to class 36). The nature and purpose of the services differ, there is no overlap in channels of trade and the services are neither in competition nor complementary. They are not similar.

66. In order for there to be a likelihood of confusion, there must be some similarity between the services: see *Waterford Wedgwood plc v OHIM*, C-398/07 P, EU:C:2009:288 at [34]. As I have found that there is no similarity between the contested services and those upon which the opponent may rely, there can be no likelihood of confusion. The opposition under s. 5(2)(b) is dismissed.

Section 5(3)

67. Section 5(3) states:

“(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 European Union trade mark or international trade mark (EC), in the European Union) 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”.

68. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors* [1999] ETMR 950; Case 252/07, EU:C:2008:655 *Intel*, [2009] ETMR 13; Case C-408/01, EU:C:2003:582, *Adidas-Saloman*, [2004] ETMR 10; and C-487/07, EU:C:2009:378, *L’Oreal v Bellure* [2009] ETMR 55; and Case C-323/09, EU:C:2011:604, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial

compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

69. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

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.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it”.

70. As the earlier mark is an EUTM, I also keep in mind the guidance of the CJEU in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, EU:C:2009:611, at [20] to [30] and *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) at [69].

71. Ms Rossi accepted at the hearing that the opponent has a reputation in Belgium for banking services. It is clearly an important institution in Belgium. Sales figures throughout the relevant period and in the EU run to hundreds of millions of Euros. I am satisfied that the earlier mark was known by a significant part of the public in the EU and that it had, at the date of application, a strong reputation for banking services.

Link

72. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

73. The contested marks are **Argenta Projects Ltd / ARGENTA PROJECTS LTD**. The difference in case matters not: as word marks, notional and fair use would cover their use in title case, lower case or capital letters. My comments, therefore, apply equally to both marks. The earlier mark is **ARGENTA**. Whilst the contested mark will be read as a phrase, the words "Projects" and "Ltd" are non-distinctive, whilst "Argenta" is, as an invented word, highly distinctive and the most important individual component in the overall impression. All three words in the contested mark will be seen and articulated, resulting in a reasonably high degree of both visual and aural similarity.

74. The word "Argenta" will have no meaning for the average consumer. The words "projects" and "Ltd" will indicate that a particular company provides the services and

although these elements are non-distinctive, there is, therefore, a degree of conceptual difference.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

75. I have compared the respective services at paragraphs 61 to 65, above. Those findings are equally applicable here. The average consumer of the opponent's services will include both the general public and businesses. The contested services are business-to-business services. The services are likely to be purchased mainly visually, following inspection of websites, advertising material, brochures and service guides. There may also be an important aural component, as advice may be taken from other professionals or recommendations made orally. There will be some variation in the levels of attention which are paid to the selection of the services, depending, for example, on the amount of money to be invested or the size of the project. All of the services will, however, be selected with at least a reasonably high degree of attention.

The strength of the earlier mark's reputation

76. The earlier mark has a strong reputation in the EU for banking services.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

77. The earlier mark will be perceived as an invented word and is inherently highly distinctive. There is some evidence that the opponent had investments in the UK but this does not show that it offered investment services in the UK, only that some of its funds were invested there. There is evidence that 39% of one bond allocation in 2016 was in the UK but the final "book" covers 60 accounts and it is not clear if this is the number of investors. There is no other evidence concerning UK customers of the

opponent. The proportion of the UK sales figures attributable to the first few months of the relevant period cannot be determined on the evidence before me. Hits from the UK on the opponent's website total under 500,000 in eleven years and are not broken down by year. While not insignificant figures have been spent on advertising there is no evidence that this was even in English, let alone directed at the UK. Whilst the mark may enjoy enhanced distinctiveness on the continent, the evidence does not support a finding that its distinctiveness has been enhanced for the UK consumer.

78. In this case, the geographical location of the opponent's reputation is relevant to the assessment of whether there will be a link. In *Iron & Smith kft v Unilever NV*, Case C-125/14, EU:C:2015:539, the CJEU held that:

“If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

79. It is apparent from the court's judgment that “a commercially significant part of the [relevant] public” is intended to cover a lesser, but still significant, degree of recognition of the EUTM in the Member State where the same or a similar trade mark has been applied for by a third party. This is confirmed by versions of the judgment in other languages. The French version says that a “commercially non-negligible” part of the relevant public in the Member State must be aware of the earlier CTM (now: EUTM) and make a link with the later national trade mark.

80. It follows that where there is no awareness of the EU trade mark in the UK, or only a negligible level of awareness of it, the relevant UK public will not make the necessary 'link' between the EU mark and the later national mark. Consequently, the use of the national mark will not take unfair advantage of, or be detrimental to, the (EU) reputation and/or the distinctive character of the EU trade mark.

81. Ms Wilkinson-Duffy submitted that the use in the UK and the strong Benelux reputation means that the opponent has a reputation in the UK. If not, she said, it has a reputation among a commercially significant part of the relevant public. I do not agree. My comments in relation to enhanced distinctiveness also apply here: there is very little evidence of any transactions in the UK. Such evidence as there is of UK investment does not clearly support the contention that the opponent provided its services to customers in the UK, as distinct from having financial interests of its own located in the territory. Those transactions which appear to have taken place have too little detail for me to conclude that the opponent was known in the UK to any significant degree: I am unable to tell how many UK sales there may have been and, while 39% of purchasers in a bond issue may have been from the UK, the "book" covered only sixty accounts. There is no evidence to show that this in fact represented a higher number of investors: 39% of sixty customers does not, on its face, constitute a commercially significant portion of the relevant UK public.

82. Taking all of the above into account, I am not persuaded that a commercially significant part of the relevant UK public was aware of the earlier mark. As a consequence, I find that the relevant UK public will not make the link between the contested mark and the earlier EU trade mark. The opposition under s. 5(3) therefore falls at the second hurdle and the opposition under this ground is dismissed accordingly.

Conclusion

83. The opposition has failed. The application will proceed to registration.

Costs

84. The applicant has been successful and would ordinarily be entitled to an award of costs. However, the tribunal wrote to the parties on 8 November 2019 indicating that, as an unrepresented litigant, the applicant would be required to complete a costs pro-forma if an award of costs was sought. The letter stated that if the pro forma was not completed and returned, “no costs, other than official fees arising from the action [...] will be awarded”. No costs pro-forma has been filed. The applicant incurred no official fees. That being the case, I make no award of costs.

Dated this 21st day of April 2020

**Heather Harrison
For the Registrar
The Comptroller-General**