BL O/0730/25

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF THE REQUEST FOR PROTECTION FOR INTERNATIONAL TRADE MARK NUMBERS 1,592,665, 1,592,584 AND 1,602,823 IN THE NAME OF SOMPO JAPAN INSURANCE INC

AND IN THE MATTER OF OPPOSITIONS UNDER NUMBERS 427,846, 429,825 AND 427,850 BY LICHTBLICK SE

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF RHEA MORRIS (O/960/24) DATED 8 OCTOBER 2024

DECISION

Introduction

1. This is an appeal from the decision of Rhea Morris, for the Registrar, dated 8 October 2024 (O/960/24). Lichtblick SE opposed the request by Sompo Japan Insurance Inc to claim protection in the United Kingdom for three marks (Nos 1,592,665, 1,592584 and 1,602,823) under section 5(2)(b) of the Trade Marks Act 1994. The opposition was unsuccessful against all three marks and Lichtlick appeals.

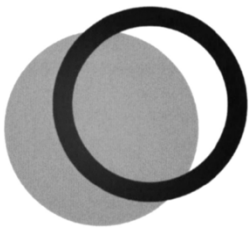
2. There was a fourth opposition (No 427,847) before the Hearing Officer, but this has not been pursued on appeal and need not be considered further.

3. Sompo sought protection for the following figurative mark in Classes 35 and 36 (No IR 1,592,665):

4. It also sought protection for the following figurative mark in Classes 36 only (No IR 1,592,584):

5. Finally, it sought protection for the following figurative mark in Classes 35 and 36 (No IR 1,602,823):

6. Lichtblick opposed the claim for protection in respect of the three marks based on the following figurative mark (IR No 1,582,315):



7. This mark is protected in relation to a range of goods and services, but the opposition is based only upon the following services in Class 36:

> Project planning and building contractor services [except planning and installation of lighting facilities], namely preparation and implementation of building projects for others with regard to financial matters; financing of energy transmission systems, energy distribution systems and energy generating plants; real estate affairs; all aforementioned services not pertaining to electronic payment solutions, in particular all aforementioned services not pertaining to credit, debit, banking or other payment cards.

8. The Hearing Officer found all the services covered by the Appellant/Opponent's Mark to be dissimilar to any services covered by the Respondent/Holder's Mark. The Hearing Officer therefore did not go on to consider whether the marks were similar or not.

Standard of appeal

9. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that the Hearing Officer has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer's findings were rationally insupportable. The principles to be applied were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch), [24] and in terms of evaluative decisions the Supreme Court's guidance in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8, [49] is important where it stated that:

> …on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.

10. Subsequently, in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc* [2025] UKSC 25 the Supreme Court held, [93] and [94]:

> The question whether there is a trade-mark infringement under section 10(2)(b) of the Act is a classic example of what has come to be known as a multi-factorial assessment. It involves the finding of primary facts, the application of relevant principles or rules of law to those facts and

> the evaluative decision whether, thus considered, something has happened which falls within (here) a statutory definition.…It is perhaps obvious, and certainly an inevitable conclusion drawn from experience, that reasonable minds, and in particular reasonable judicially trained minds, each faithfully applying the relevant law and principles, will come to different conclusions about the answer to these multifactorial questions…

11. In *Extreme Networks Ltd v Extreme E Ltd* [2024] EWCA Civ 1386, [31], Arnold LJ highlighted the need to exercise appellant modest in relation to a hearing officer's comparison of goods at services:

> It is common for hearing officers when assessing the similarity of goods or services to express their reasoning in highly compressed form. There are a number of reasons for this: first, their extensive experience in the field; secondly, comparison of goods or services is a routine exercise for them to have to undertake when writing decisions; thirdly, it is frequently necessary for them to have to undertake multiple comparisons in each decision; and fourthly, it is often the case that no evidence has been adduced by either party (leaving the hearing officer to rely upon their own knowledge and experience as a consumer) and that the parties have addressed the issue quite briefly in their submissions

12. When considering this appeal, and applying these principles, it is important to remember the high bar set.

Ground of appeal

13. The Appellant challenges the Hearing Officer's findings that the services covered by its mark are dissimilar to those covered by the Respondent's marks. Mr Collins, for the Appellant, submits that the Hearing Officer only compared "real estate affairs" with the services covered by the Respondent's marks when she should have compared these services to all the Class 36 services covered by the Appellant's mark.

Hearing Officer's findings

14. It is necessary to begin by setting out the relevant findings of the Hearing Officer. She first substantively discussed the term "real estate affairs" at [24]:

> ...My view is that the term 'real estate affairs' is very broad and will, as a plain reading of the term suggests, encompass services which are specific to real estate. To my mind, it will include not only estate agency services, but services such as, inter alia, valuation services, auctioneering services. 'Insurance' is also a broad term, encompassing insurance matters in any field. I have considered whether 'real estate affairs' can be taken to encompass insurance services specific to real estate matters. My view is that, although, strictly speaking, 'real estate insurance' or insurance services specific to the purchase of property, are, strictly speaking, matters which can be said to be matters of real estate, it would be inappropriate for me to find 'insurance' (to the extent that it covers 'real estate' insurance) to be encompassed by the term 'real estate affairs'. Although there may be crossover in terms of the field of activity, it does not necessarily follow that one service encompasses the other. …I find the parties' services to be dissimilar.

15. The Hearing Officer also adopted reasoning similar to that of another Hearing Officer *Axis Bank* (O/37/20), [69]. This was followed a few paragraphs later when she compared "insurance administration" to "real estate affairs" at [28]:

> I consider 'insurance administration' to encompass the administrative tasks performed by businesses whose field of activity is insurance services. My view is that the breadth of the term is such that a vast array of activities will be included; from 'lower level' tasks such as addressing envelopes containing hard copy insurance documents, for example, to 'higher level' tasks such as processing claims. Administration is, in my view, concerned with the processes associated with running a business, rather than the 'substance' of the business. Therefore, 'analytical' tasks

> such as evaluating risk when drafting insurance policies will not be covered; such activity being proper to class 36 of the NICE classification system. I compare SJI's services to LBS' real estate affairs in Class 36. The purpose of the services encompassed by 'real estate affairs' is, broadly speaking, the facilitation of sales/rental of property and land. The purpose of 'insurance administration' is very different; i.e. to enable the delivery of insurance services. Users will overlap to the extent that both will be engaged by the general public. I recognise that insurance administration services are more often used by the insurance companies themselves, but I acknowledge that some services will be used by the general public; for example, a system whereby alerts are sent to policyholders in advance of policies expiring. However, such general user overlap will have little weight. Trade channel overlap is, in my view, unlikely. The parties' offerings will entail different acts of service. I find the services to be neither competitive nor complementary, neither being substitutable or necessary/important for each other. All things considered, I find the services to be dissimilar. LBS' limitation term does not prevent this finding. I do not consider comparison with any other of LBS' services to improve its case.

16. While the Appellant initially challenged the Hearing Officer's assessment of the similarity between "real estate affairs" and "insurance", at the Hearing, Mr Collins ultimately accepted the finding. While neither the parties nor the Hearing Officer cited the case, it appears that the conclusion of the Hearing Officer in these paragraphs is consistent with the General Court's conclusion in T-514/13 *AgriCapital Corp v OHIM*, EU:T:2015:372, [44]. In short, Mr Collins was right to make the concession that he did and I need not consider the comparisons between the Respondent's services and "real estate affairs" any further.

17. In relation to the other services covered by the Appellant's mark, the Hearing Officer (when considering that part of the Opposition which ultimately was not appealed) found at [25] that:

> 'Financial affairs', put simply, entails the management of money in the commercial sense of, for example, providing or raising funds. I consider this broad term to encompass activities such as, inter alia: investing, borrowing, lending, budgeting and financial forecasting. I compare SJI's services to LBS' term financing of energy transmission systems, energy distribution systems and energy generating plants. Given that 'financing' is at the very core of LBS' service, I find that it will be encompassed by SJI's broader term Financial affairs…

18. In the next paragraph, the Hearing Officer compared "monetary affairs" with "financial matters" and made the following finding at [26]:

> …I consider 'financial' matters…to concern particular sums of money/funds and the management of those sums; for example, devising strategies to maximise the 'return' of a particular sum by way of investment or certain tax arrangements….'financial' relates to particular sums of money….

19. It is important to note that with the two exceptions of "financial risk management in the field of weather risk management" (considered at [46]) and in relation to the services falling squarely within the disclaimer (examined at [54]), the Hearing Officer did not compare "planning and building contractor services…with regard to financial matters" or "financing of energy transmission systems…" to any other of the Respondent's Class 36 services.

The disclaimer

20. Before considering the main argument of the Appellant, it is submitted by Mr Collins that the Respondent's marks all have a limitation in Class 36, namely "excluding from all of the foregoing, the provision of banking services, the marketing, distribution,

provision and issuance of payment cards, bank cards, debit cards, credit cards, telephone calling cards, prepaid-cards services, automated teller machines ("ATM") and ATM services, and electronic payment services for payments other than in insurance, nursing care, and healthcare services." He submits that this limitation suggests that the Respondent's services are sufficiently related to finance to require the limitation and so the services must be similar.

21. Without having any indication from the Respondent why this limitation exists and because it was not limited during proceedings in the United Kingdom, it is not open to me to make assumptions as to the reason for this limitation.

Financial matters and financing

22. Mr Collins submits that in relation to all the services covered by the Respondent's marks, the Hearing Officer failed to compare "project planning and building contractor services [except planning and installation of lighting facilities], namely preparation and implementation of building projects for others with regard to financial matters" or "financing of energy transmission systems, energy distribution systems and energy generating plants" rather the comparison was only made with "real estate affairs". He submits that one or both of these services is closer to those of the Respondent's services than "real estate affairs".

23. Mr Collins referred me to *FIL Ltd v Fidelis Underwriting Ld* [2018] EWHC 1097 (Pat) at [90] where Arnold J held that "insurance services" are within the core of the ordinary meaning of "financial services". There are other cases addressing the issue which were not referenced by the parties (but were by Arnold J) which are also relevant.

24. In T-58/16 *Apax Partners v EUIPO*, EU:T:2016:724 at [55] and [56], the General Court stated:

> insurance services are of a financial nature. In that regard, clearly, first, insurance companies are subject to, in relation to licensing, supervision and solvency, rules similar to those of financial institutions and, second, the undertakings offering financial services can also offer insurance services, either directly, or by acting as agents for insurance companies to which they are, in some cases, economically linked.
>
> In those circumstances, the Board of Appeal rightly considered that 'insurance' services were similar to 'financial affairs' services.

25. In T-209/16 *Apax Partners UK v EUIPO*, EU:T:2017:240 at [39], the General Court found "insurance" to be similar to "financial services".

26. Finally, Arnold J cited with approval the comments of Jessie Roberts in her book *International Trademark Classification: A Guide to the Nice Agreement* (OUP, 4th ed, 2012), p 224 (the book is now in 5th ed):

> Insurance services are a significant factor in the investment industry, therefore, these services are properly classified in Class 36. The purchase of insurance is a monetary investment. … Furthermore, the investment industry is dependent on insurance funds for its very existence.

27. Mr Collins's case in relation to all the goods is that the various "insurance" services covered by the Respondent's mark are either a sub-set of, or at least similar to "project planning …financial matters" or "financing of energy transmission systems…". He does not dispute the Hearing Officer's finding that financial matters relate to sums of money and funding things (see paragraphs 17 and 18 above), but his position is that insurance was a necessary component of finance and so the services should be seen as at least similar.

28. Ms Neil, for the Respondent, submits that "project planning and building contractor services, namely….with regard to financial matters" is far narrower than "financial services" and likewise so is "financing of energy transmission systems…". She also points out that "project planning and building contractor services…" are qualified by the "…financial matters" and so the primary service is planning and building, not finance.

29. Turning first to Mr Collins's submission that the Hearing Officer only compared "real estate affairs" to the Respondent's services. I do not accept this submission is correct. The Hearing Officer in her reasoning at [24] explicitly says "I do not consider the comparison with other of LBS' services to improve the case". This is an express consideration of the other services covered by the Appellant's mark. She adopted her reasoning in [24] in many other places in her decision and so this reasoning permeates all those decisions. In other cases, the Hearing Officer said she did not see any similarity between a service covered by the Respondent's specification and the Appellant's services. This was once more a consideration of all the Appellant's services. Finally, there were two places where she explicitly considered the other services (see paragraph 19 above).

30. Mr Collins also submits that the Hearing Officer did not properly consider the services other than "real estate affairs". This is a more difficult issue to resolve. It does not appear that any of the cases referred to above were cited to the Hearing Officer and she did not mention them in her decision. Her discussion of what the other services comprised was very limited and was never in the context of insurance.

31. In strict terms, the finding of similarity between goods or services is an evaluative finding based on facts. And the facts will be different between cases. This is because the determination of similarity between different goods and services is being made on the date of the application (relevant date) and things (might) change between one application date and another. It might even be argued that a finding of similarity of goods or services by one tribunal is an expression of the fact finder's opinion and so is not admissible in different proceedings (in accordance with the rule in *Hollingworth v Hewthorn* [1943] KB 587 (also see *BANDIT* (O/197/23), [13] to [20]).

32. But each tribunal considering the similarity of goods and services afresh without any reference to earlier decisions on the same or very similar goods could lead to a multitude of inconsistent decisions and great uncertainty in applying the law. In this respect, the similarity of goods and services is different from the similarity between marks. As acknowledged by the existence of the Similarity Tool hosted by the EUIPO, earlier

decisions are important guidance for comparing goods and services and they should be considered by tribunals even where the decisions are not strictly binding.

33. It appears that the cases to date have given a wide meaning to the terms "finance" and "financial" and have found them to be at least similar to insurance. In light of this fact, it appears to me that "project planning and building contractor services, namely….with regard to financial matters" and "financing of energy transmission systems…" are closer to the Respondent's services than "real estate affairs". This seems to be the opposite position to that taken by the Hearing Officer.

34. So while the Hearing Officer cannot be criticised for not considering the cases when neither party cited them to her, it is my view that had the Hearing Officer considered the case law on "financial services" and "insurance" she would have analysed whether the narrower terms "project planning and building contractor services, namely…with regard to financial matters" and "financing of energy transmission systems…" were also identical or similar to the various insurance related services.

35. I am not expressing a view on whether these things are identical, similar or dissimilar. I am only identifying that it was an error for the Hearing Officer not to provide any reasoning for why she found no similarity between these services and the various insurance services covered by the Respondent's marks.

Disposal

36. Both the parties accepted that if I were to find that the Hearing Officer erred then I should remit the matter back to the registrar (to a different Hearing Officer). This is because there has been no assessment of the similarity of the marks or whether there might be a likelihood of confusion. I agree such a remittal is the correct course of action, and furthermore I think it makes sense for the Hearing Officer to consider whether the services not previously considered are similar or not.

37. Accordingly, a new Hearing Officer should determine whether the Appellant's services "project planning and building contractor services [except planning and installation of lighting facilities], namely preparation and implementation of building projects for others with regard to financial matters" and "financing of energy transmission systems, energy distribution systems and energy generating plants" are similar to the Respondent's services. If one of more of the services are found to be similar, then the Hearing Officer will need to complete the assessment as to whether there is a likelihood of confusion.

Costs

38. While the case is being remitted, the Appellant was successful on appeal and so is entitled to a contribution towards its costs of £1,500. The costs award below is discharged and no order as to costs is made in relation to that hearing as the relative success of the parties in the one part of that decision which is closed was more or less even. The sum of £1,500 is to be paid by the Respondent by 4pm on 26 August 2025.

PHILLIP JOHNSON

Representation:

For the Appellant: Marcus Collins (of Keystone Law)

For the Respondent: Sarah Neil (of Venner Shipley LLP)