

O/0960/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF APPLICATION FOR
TRADE MARK NO UK00003601685**

IN CLASS 36

AND

**THE REQUESTS FOR PROTECTION IN THE UK FOR THE INTERNATIONAL
REGISTRATIONS WO0000001592665 AND WO0000001602823**

IN CLASSES 35 AND 36,

AND

WO0000001592584

IN CLASS 36

BY SOMPO JAPAN INSURANCE INC

**AND THE OPPOSITIONS THERETO UNDER NUMBERS 427847, 427846, 429825
AND 427850, RESPECTIVELY, BY LICHTBLICK SE**

Background and Pleadings

1. On 26 February 2021, Sompo Japan Insurance Inc. ('SJI') filed an application to register the following trade mark:

UK00003601685



For the following services:

Class 36:

Insurance, including claims handling services and agencies for claims handling services; financial affairs; monetary affairs; real estate affairs; excluding from all of the foregoing, the provision of banking services, the 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.

The application was published for opposition purposes on 30 July 2021.

2. On the same date, SJI applied for protection in the UK for the following three International Registrations:

WO0000001592665



AGRISOMPO

Mark Description: The mark consists of a circle design with a ring design superimposed partially on top of the circle with the stylized wording "AGRISOMPO" below.

International Registration date: 4 March 2021

Designation date: 4 March 2021

Priority date: 26 February 2021

TM from which priority claimed: 90548672 (United States of America)

For the following services:

Class 35:

Insurance administration; insurance claims administration.

Class 36:

Reinsurance underwriting for all types of reinsurance, namely, property, casualty, agriculture, and specialty reinsurance; reinsurance underwriting and administration; reinsurance actuarial services; reinsurance claims administration; processing of reinsurance claims and payment data; financial evaluation for reinsurance purposes; reinsurance consultation services; claims adjustment in the field of insurance; electronic processing of insurance claims and payment data; financial evaluation for insurance purposes; insurance actuarial services; insurance brokerage; insurance agency and brokerage; insurance brokerage in the field of property and casualty insurance; insurance carrier services; financial management of insurance claims; insurance claims processing; insurance consultation; insurance premium rate computing; insurance services, namely, writing property and casualty insurance; insurance subrogation and salvage; insurance underwriting in the field of property, casualty, and agriculture insurance; insurance underwriting consultation; providing information in insurance matters; financial risk management in the field of weather risk management; 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.

The request for UK protection was published for opposition purposes on 30 July 2021.

WO0000001602823



Mark Description: The mark consists of a circle design with a ring design superimposed partially on top of the circle with the stylized wording "AGRISOMPO" to the right and a quadrilateral banner below "AGRISOMPO".

International Registration date: 4 March 2021

Designation date: 4 March 2021

Priority date: 26 February 2021

TM from which priority claimed: 90548607 (United States of America)

For the following services:

Class 35:

Reinsurance administration; reinsurance claims administration.

Class 36:

Reinsurance underwriting for all types of reinsurance, namely, property, casualty, agriculture, and specialty reinsurance; reinsurance underwriting; reinsurance actuarial services; processing of reinsurance claims and payment data; financial evaluation for reinsurance purposes; reinsurance consultation services; claims adjustment in the field of insurance; electronic processing of insurance claims and payment data; financial evaluation for insurance purposes; insurance actuarial services; insurance brokerage; insurance agency

and brokerage; insurance brokerage in the field of property and casualty insurance; insurance carrier services; financial management of insurance claims; insurance claims processing; insurance consultation; insurance premium rate computing; insurance services, namely, writing property and casualty insurance; insurance subrogation and salvage; insurance underwriting in the field of property, casualty, and agriculture insurance; insurance underwriting consultation; providing information in insurance matters; financial risk management in the field of weather risk management; 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.

The request for UK protection was published for opposition purposes on 1 October 2021.

WO0000001592584



Mark Description: The mark consists of a circle design with a ring design superimposed partially on top of the circle with the stylized wording "AGRISOMPO" to the right.

International Registration date: 4 March 2021

Designation date: 4 March 2021

Priority date: 26 February 2021

TM from which priority claimed: 90548662 (United States of America)

For the following services:

Class 36:

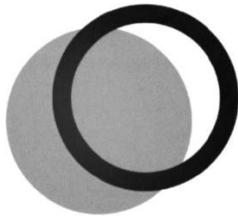
Reinsurance underwriting for all types of reinsurance, namely, property, casualty, agriculture, and specialty reinsurance; reinsurance underwriting and administration; reinsurance actuarial services; reinsurance claims administration; electronic processing of reinsurance claims and payment data; financial evaluation for reinsurance purposes; reinsurance consultation services; claims adjustment in the field of insurance; electronic processing of insurance claims and payment data; financial evaluation for insurance purposes; insurance actuarial services; insurance administration; insurance agency and brokerage; insurance brokerage in the field of property and casualty insurance; insurance carrier services; insurance claims administration; insurance claims processing; insurance consultation; insurance premium rate computing; insurance services, namely, writing property and casualty insurance; insurance subrogation and salvage; insurance underwriting in the field of property, casualty, and agriculture insurance; insurance underwriting consultation; providing information in insurance matters; financial risk management in the field of weather risk management; electronic payment processing services for payments in the field of insurance; 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.

The request for UK protection was published for opposition purposes on 30 July 2021.

3. LichtBlick SA, the Opponent ('LBS'), filed respective oppositions to the applications/requests for UK trade mark protection as follows:
 - Oppositions 427846, 427847 and 427850, filed on 1 November 2021;
and
 - Opposition 429825, filed on 25 April 2023.
4. All four oppositions are based on section 5(2)(b) of the Trade Marks Act ('the Act'); and are directed against the respective applications/requests for UK trade mark protection in their entirety.

5. For all four oppositions, LBS relies upon the following two earlier rights, both International Registrations with protection in the UK:

i) WO0000001582315



Colours claimed: Grey, black

Date of protection of the international registration in UK: 22 July 2021

Designation date: 10 December 2020

International registration date: 10 December 2020

Office of origin: Germany

Priority date: 25 June 2020

Priority claimed from registration 30 2020 013 575

Registered for goods and services in classes 4, 7, 9, 11, 12, 35, 36, 37, 38, 39, 40, 41, 42 and 45, only the following of which are relied upon:

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.

ii) WO0000001560860



Colours claimed: black, orange.

Date of protection of the international registration in UK: 16 March 2021

International registration date: 06 August 2020

Designation date: 06 August 2020

Office of origin: Germany

Priority date: 07 February 2020

Priority country: Germany

TM from which priority claimed: 30 2020 002 643

Registered for goods and services in classes 4, 7, 9, 11, 12, 35, 36, 37, 38, 39, 40, 41, 42 and 45, only the following of which are relied upon:¹

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 related to electronic payment solutions, in particular all the aforementioned goods not related to credit, debit, bank or other payment cards.

¹ The full specification for WO0000001560860 is set out in Annexe 2 to this decision.

(The specification in respect of which the earlier right ii) is relied upon is, in essence, the same as that for earlier right i), albeit the limitation in i) contains the wording 'pertaining to' instead of the synonymous 'related to').

6. LBS' pleading is essentially the same for each opposition: the parties' marks are highly similar; and the respective goods/services are similar; leading to a likelihood of confusion.
7. SJI filed defences and counterstatements for all four oppositions, denying the claims against it in their entirety.
8. LBS is represented by Irwin Mitchell LLP;² SJI is represented by AA Thornton IP LLP. Neither party filed evidence. No hearing was requested. Only SJI filed written submissions in lieu of a hearing, to which I will refer, where appropriate, in my decision. The following decision has been made after careful consideration of the papers before me.

RELEVANCE OF EU LAW

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Relevant legislation

10. Section 5(2)(b) of the Act states:

'5(2) A trade mark shall not be registered if because –

² I note that Oppositions 427846, 427847 and 427850 were filed by White and Case LLP as LBS' then legal representative. The fourth opposition was filed by Irwin Mitchell LLP, which now represents LBS for the consolidated proceedings.

(a) ...

(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.'

Earlier marks

11. In accordance with section 6 of the Act, LBS' marks are earlier marks by virtue of their priority dates which fell before the filing/priority dates of the applied-for marks.

Section 5(2)(b) case law

12. The following principles are derived from the decisions of the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG*, Case C-251/95; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98; *Matratzen Concord GmbH v OHIM*, Case C-3/03; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of services

13. Section 60A of the Act provides:

(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the 'Nice Classification' means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.

14. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties' goods and services must be taken into account:

'[23] 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'.

15. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

‘...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.’

16. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281³, identified the following factors for assessing similarity of the respective goods and services:

- (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.

17. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

‘The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.’

³ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

18. In making an assessment between the competing services, I bear in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*.⁴ The General Court held to the effect that goods and services can be considered as identical when the goods and services designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

19. Case law establishes that ‘... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise’ but ‘Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.’⁵

20. LBS’ argument on the matter of the parties’ services is, essentially, the same for each of the four oppositions; i.e. that the class 35 and 36 services applied for ‘all fundamentally relate to insurance’ which is ‘closely allied to financial services’ having similar users, users and trade channels.⁶ LBS has argued that ‘to the extent the insurance services specified in the application relate to land, property and agriculture; such services are similar to the real estate affairs services specified in the earlier registration’.⁷ For the applied-for services other than the ‘insurance’ services, LBS has not identified where the particular points of similarity lie. For those services, I have no alternative but to identify which of LBS’ terms are the best comparators based on my own understanding of the terms.

21. I will deal with each opposition in turn.

Opposition 427847

22. The services to be compared are as follows;

⁴ Case T-133/05

⁵ *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch).

⁶ At Q5 of LBS’ Statements of Grounds.

⁷ As above.

Earlier marks:	Contested mark:
<p>i) WO0000001582315</p> <p>Class 36: <i>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.</i></p>	<p>UK3601685</p> <p>Class 36: <i>Insurance, including claims handling services and agencies for claims handling services; financial affairs; monetary affairs; real estate affairs; excluding from all of the foregoing, the provision of banking services, the 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.</i></p>
<p>ii) WO0000001560860 (The specification is essentially the same as that for i) above)</p>	

Contested services: *real estate affairs; excluding from all of the foregoing, the provision of banking services, the 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.*

23. The term *real estate affairs* is present in both SJI's specification and those for each of the earlier marks. The parties' services are, therefore, unequivocally identical. The limitations present in the parties' respective specifications do not prevent this finding. The limitation to SJI's specification, in my view, excludes services that would not ordinarily be encompassed by 'real estate affairs' anyway.

Contested services: *Insurance, including claims handling services and agencies for claims handling services; excluding from all of the foregoing, the provision of banking services, the 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.*

24. I consider the word 'including' after 'insurance' to indicate that the services that follow, i.e. 'claims handling services' and 'agencies for claims handling services' are examples of services that are encompassed by the broad term 'insurance services'. The limitation, to my mind, has little or no effect on the contested term because it excludes services that would not ordinarily be encompassed by it. I will compare SJI's services to LBS' term *real estate affairs* (present in both specifications), which I consider to be the most appropriate comparator. SJI has submitted that 'real estate affairs' are dissimilar to insurance services and has pointed to past decisions of this tribunal which have made such a finding;⁸ Decisions O/601/20 and O/037/20. In the former decision, the particular terms compared were not 'real estate affairs' at large but the narrower terms: 'real estate agency services', 'real estate brokerage', 'real estate appraisal' and 'real estate management'.⁹ The term at stake in the instant case is, in my view, more broad. I have noted that in the latter decision, the term 'real estate affairs' was found to be dissimilar to 'insurance'.¹⁰ I remind myself that I am not bound to accept that finding. 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.

⁸ Written submissions of SJI, [22].

⁹ Decision O/601/20, [38]

¹⁰ Decision O/037/20, [69].

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. For the reasons set out by the Hearing Officer in the aforementioned decision O/037/20, I find the parties' services to be dissimilar.

Contested services: *financial affairs; excluding from all of the foregoing, the provision of banking services, the 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.*

25. '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*. The parties' services are, therefore, identical according to the principle in *Meric*. The limitation present in LBS' specifications does not prevent this finding.

Contested services: *monetary affairs; excluding from all of the foregoing, the provision of banking services, the 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.

26. In the absence of any guidance from the parties on what services this broad term will encompass, I will apply my own understanding of the term. My view is that 'monetary affairs' are not synonymous with 'financial affairs', although both, of course, are concerned with money in some sense. I understand that 'monetary' relates to money in the general sense: i.e. currency; the supply of money in general (in a given country); and its rate of growth, the setting of interest rates and matters such as quantitative easing and inflation. I consider 'financial' matters, on the other hand, 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.¹¹ In short, 'monetary' relates to money 'en masse', whereas 'financial' relates to particular sums of money. The 'financing' of a project, therefore, is not a 'monetary' matter. With that distinction in mind, I will apply the usual 'Treat' factors. I compare the contested services to LBS' term *financing of energy transmission systems, energy distribution systems and energy generating plants*. It is my view that taking into account the purposes, users, methods of use, trade channels and natures of the services, together with the matters of competition and complementarity, there is no similarity between the parties' services. Although financial and monetary matters all relate to money in some way, given the distinctions that I have identified, I find the parties' services to be dissimilar.

Opposition 427846

27. The services for the earlier registrations have been set out above at [22]. The contested services are:

Class 35:

¹¹ Tax avoidance as opposed to tax evasion. Tax avoidance being the making of arrangements, which are entirely legal, for funds such that certain taxation liabilities will not apply. Tax 'evasion' being the failure to fulfil tax obligations which legally apply to a certain sum of money.

Insurance administration; insurance claims administration.

Class 36:

Reinsurance underwriting for all types of reinsurance, namely, property, casualty, agriculture, and specialty reinsurance; reinsurance underwriting and administration; reinsurance actuarial services; reinsurance claims administration; processing of reinsurance claims and payment data; financial evaluation for reinsurance purposes; reinsurance consultation services; claims adjustment in the field of insurance; electronic processing of insurance claims and payment data; financial evaluation for insurance purposes; insurance actuarial services; insurance brokerage; insurance agency and brokerage; insurance brokerage in the field of property and casualty insurance; insurance carrier services; financial management of insurance claims; insurance claims processing; insurance consultation; insurance premium rate computing; insurance services, namely, writing property and casualty insurance; insurance subrogation and salvage; insurance underwriting in the field of property, casualty, and agriculture insurance; insurance underwriting consultation; providing information in insurance matters; financial risk management in the field of weather risk management; 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.

Class 35

Contested services: *Insurance administration*

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.

Contested service: insurance claims administration; 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.

29. The contested term entails the provision of administration specifically to enable insurance claims to be dealt with. For analogous reasons to those above at [28], I find the parties' services to be dissimilar.

Class 36

Contested services: *Reinsurance underwriting for all types of reinsurance, namely, property, casualty, agriculture, and specialty reinsurance; reinsurance underwriting [...]; 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.*

30. I construe the contested term to encompass reinsurance underwriting at large. The addition of the word 'namely' followed by a list of insurance types is, to my mind, unnecessary (and arguably contradictory, unless the list happens to enumerate every possible type of insurance). It is my understanding that 'reinsurance' is the process according to which an insurer transfers all or part of the risk that it bears (in its capacity as insurer) to another insurer. In simple terms, the insurer 'purchases' insurance from another insurer to indemnify it against losses which might exceed its capacity to pay out on the claims made to it as an insurer. An example is 'catastrophe insurance' where a particular insurer might not have capacity/or want to make such extensive payouts in the event of a flood which precipitates a large number of claims. This type of insurance would be purchased exclusively by insurers. I compare the contested term to LBS' *real estate affairs*. I consider the distance between these competing terms to be even greater than that between 'insurance' and 'real estate affairs'. Therefore, for reasons similar to those set out above at [24], I find the parties' services to be dissimilar.

Contested services: *reinsurance consultation services; 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.*

31. For similar reasons to those provided above at [24], I find the parties' services to be dissimilar.

Contested services: *reinsurance [...] administration; reinsurance claims administration; processing of reinsurance claims and payment data; 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.*

32. Broadly speaking, the contested terms concern the administrative aspect of reinsurance. Bearing in mind the purposes, users, trade channels, methods of use, and nature of the acts of service, together with the matters of competition and complementarity, I do not find any similarity between the parties' services – they are dissimilar.

Contested services: *reinsurance actuarial services; financial evaluation for reinsurance purposes; 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.*

33. 'Actuarial services', in essence, entail calculating the cost of risk in the insurance and financial industries in order to evaluate future payouts should the risks in question eventuate. The contested services therefore entail calculating the cost of risk specifically in reinsurance matters. Bearing in mind the purposes, users, trade channels, methods of use, and nature of the acts of service, together with the matters of competition and complementarity, I do not find any similarity between this term and LBS' services – they are dissimilar.

Contested services: *financial management of insurance claims; 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.

34. 'Financial management of insurance claims' will, in my view, entail devising and implementing financial strategies for insurers to deal with payouts. One such strategy is reinsurance. For reasons similar to those set out above at [24], I find the parties' services to be dissimilar.

Contested services: insurance subrogation and salvage; 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.

35. It is my understanding that 'insurance subrogation' is the recovery, by the insurer, of costs from the party responsible for the damage/injury to the insured party in respect of which the insurer has paid out. 'Insurance salvage' entails the insurer using the value from the sale of the damaged property (a car, for example) to 'offset' the amount paid out to the insured party. Bearing in mind the purposes, users, trade channels, methods of use, natures of the acts of service, together with the matters of competition and complementarity, I do not consider there to be any similarity between this term and any of LBS' services – they are dissimilar.

Contested services: providing information in insurance matters; insurance consultation; insurance underwriting consultation; 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.

36. Broadly speaking, the contested services entail the provision of information, and, in the case of the 'consultation' services, advice and expertise, in the fields of

insurance. For reasons similar to those set out above at [24], I find the parties' services to be dissimilar.

Contested services: electronic processing of insurance claims and payment data; insurance claims processing; 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.

37. Processing of insurance claims, in my view, is a purely administrative function. Bearing in mind the purposes, users, trade channels, methods of use, natures of the acts of service, together with the matters of competition and complementarity, I do not consider there to be any similarity between the parties' services – they are dissimilar.

Contested services: financial evaluation for insurance purposes; 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.

38. It is my understanding that 'financial evaluation' entails the financial assessment of a situation, especially an aspect of business. An example would be analysing a company's profitability by looking at its capacity to generate revenue alongside its ability to satisfy its debts. In the instant case, such an exercise is performed for the purposes of insurance. ('Evaluation' is distinct from 'valuation' which concerns estimating the value of an object or piece of land as opposed to a situation.) Bearing in mind the purposes, users, trade channels, methods of use, natures of the acts of service, together with the matters of competition and complementarity, I do not consider there to be any similarity between the parties' services – they are dissimilar.

Contested services: *insurance actuarial services; 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.*

39. The contested services entail calculating the cost of risk specifically in insurance matters. Bearing in mind the purposes, users, trade channels, methods of use, and nature of the acts of service, together with the matters of competition and complementarity, I do not find any similarity between this term and LBS' services – they are dissimilar.

Contested services: *insurance brokerage; insurance agency and brokerage; insurance brokerage in the field of property [...] insurance; 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.*

40. It is my understanding that 'brokering' is an intermediary service according to which the 'broker' connects parties to facilitate them to transact with one another. Examples include connecting: buyers with sellers; borrowers with lenders; and parties seeking insurance with insurers. The ultimate purpose of these particular services is, therefore, the facilitation of transactions between businesses or individuals seeking insurance and insurance carriers. For reasons similar to those set out above at [24], I find the parties' services to be dissimilar.

Contested services: *insurance services, namely, writing property [...] insurance; insurance underwriting in the field of property [...] insurance; insurance carrier services; 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.

41. The contested terms entail the drafting and underwriting of insurance policies for property matters. Underwriting, in simple terms, involves an insurer agreeing to bear the financial risk of a loss/damage for a fee. It is my understanding that 'property' insurance is a broad term for various policies insuring for, *inter alia*: buildings and their contents; loss of rent for landlords. For reasons similar to those set out above at [24], I find the parties' services to be dissimilar.

Contested services: insurance underwriting in the field of [...] agriculture insurance; 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.

42. Agricultural insurance encompasses insurance services specifically for farmers and owners of smallholdings. I compare the contested services to LBS' *real estate affairs*. For reasons similar to those set out above at [24], I find the parties' services to be dissimilar.

Contested services: insurance brokerage in the field of casualty insurance; insurance underwriting in the field of [...] casualty insurance; insurance services, namely, [...] casualty insurance; 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.

43. 'Casualty insurance' is an umbrella term for many types of policy whose function is to protect the insured party against liability claims against them for damage/loss

caused to property or the person. Examples include, *inter alia*: car insurance; professional liability insurance. Bearing in mind the purposes, users, trade channels, methods of use, natures of the acts of service, together with the matters of competition and complementarity, I do not consider there to be any similarity between the parties' services – they are dissimilar.

Contested services: *claims adjustment in the field of insurance; 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.*

44. It is my understanding that a claims adjuster investigates insurance claims, on behalf of the insurer, to determine the scope of the insurer's 'liability' in terms of making a payout for that claim, in relation to, for example, property damage or road traffic accidents. I will compare the contested services to LBS' *real estate affairs*. The respective services will have distinct purposes. User overlap is, to my mind, unlikely, given that claims adjustment services are likely to be engaged exclusively by insurers. Trade channels will be separate. The acts of service and methods of use will differ. The services are neither competitive nor complementary; neither being substitutable or necessary/important for each other. I find the parties' services to be dissimilar.

Contested services: *insurance premium rate computing; 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.*

45. I compare the contested services to LBS' *real estate affairs*. The contested term covers premium rate computing for insurance. For reasons similar to those set out above at [24], I find the parties' services to be dissimilar.

Contested services: *financial risk management in the field of weather risk management; 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.*

46. It is my understanding that the contested services entail the calculation of financial risk for businesses in the event of certain weather events/conditions. I compare these services to LBS' *financing of energy transmission systems, energy distribution systems and energy generating plants.* LBS' services, to my mind, entail the devising and implementation of financial strategies for operating energy systems/plants effectively. The specific purposes are, therefore, different. User overlap is possible, but unlikely commonplace; some professionals operating energy systems/plants might also engage weather risk management services to calculate financial risks affecting their business. I consider trade channel overlap to be unlikely, but not impossible. The services will be different in terms of the acts of service and methods of use. I find the services to be neither competitive nor complementary; neither being substitutable or necessary/important for the other. All things considered, I find the parties' services to be dissimilar. Although both offerings concern finance, it is my view that this general common 'thread', without more, is insufficient to give rise to a finding of similarity.

Opposition 429825

47. The contested services are:

Class 35:

Reinsurance administration; reinsurance claims administration.

Class 36:

Reinsurance underwriting for all types of reinsurance, namely, property, casualty, agriculture, and specialty reinsurance; reinsurance underwriting; reinsurance actuarial services; processing of reinsurance claims and payment data; financial evaluation for reinsurance purposes; reinsurance consultation services; claims adjustment in the field of insurance; electronic processing of insurance claims and payment data; financial evaluation for insurance purposes; insurance actuarial services; insurance brokerage; insurance agency and brokerage; insurance brokerage in the field of property and casualty insurance; insurance carrier services; financial management of insurance claims; insurance claims processing; insurance consultation; insurance premium rate computing; insurance services, namely, writing property and casualty insurance; insurance subrogation and salvage; insurance underwriting in the field of property, casualty, and agriculture insurance; insurance underwriting consultation; providing information in insurance matters; financial risk management in the field of weather risk management; 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.

Class 35

Contested services: *Reinsurance administration; reinsurance claims administration.*

48. I consider the contested terms to encompass the administrative tasks performed by companies whose business is reinsurance. By analogy with my earlier comments on at [28], I find the parties' services to be dissimilar.

Class 36

49. SJI's class 36 specification is identical to that opposed in opposition number 427846. My findings at [28] to [46] therefore apply here. The parties' services are dissimilar.

Opposition 427850

50. The contested services are:

Class 36:

Reinsurance underwriting for all types of reinsurance, namely, property, casualty, agriculture, and specialty reinsurance; reinsurance underwriting and administration; reinsurance actuarial services; reinsurance claims administration; electronic processing of reinsurance claims and payment data; financial evaluation for reinsurance purposes; reinsurance consultation services; claims adjustment in the field of insurance; electronic processing of insurance claims and payment data; financial evaluation for insurance purposes; insurance actuarial services; insurance administration; insurance agency and brokerage; insurance brokerage in the field of property and casualty insurance; insurance carrier services; insurance claims administration; insurance claims processing; insurance consultation; insurance premium rate computing; insurance services, namely, writing property and casualty insurance; insurance subrogation and salvage; insurance underwriting in the field of property, casualty, and agriculture insurance; insurance underwriting consultation; providing information in insurance matters; financial risk management in the field of weather risk management; electronic payment processing services for payments in the field of insurance; 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.

Class 36

Contested services: *insurance administration; insurance claims administration; 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.

51. I note that these services have been applied for under class 35 in Opposition 427846. My finding of dissimilarity at [28] and [29] also apply here.

Contested services: electronic processing of reinsurance claims and payment data; 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.

52. Following my finding at [37] in respect of 'electronic processing of insurance claims and payment data', I find the parties' services to be dissimilar.

Contested services: financial evaluation for insurance purposes; 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.

53. By analogy with my finding at [33], I find the parties' services to be dissimilar.

Contested services: electronic payment processing services for payments in the field of insurance; 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.

54. LBS has explicitly excluded the contested services by virtue of the limitations: *'all aforementioned services not pertaining to electronic payment solutions, in particular all aforementioned services not pertaining to credit, debit, banking or other payment cards (earlier mark i); and all aforementioned services not related to electronic payment solutions, in particular all the aforementioned goods not related to credit, debit, bank or other payment cards (earlier mark ii),* thus preventing any finding of identity. Bearing in mind the purposes, users, trade channels, methods of use, natures of the acts of service, together with the matters of competition and complementarity, I do not consider the contested services to bear any similarity to any of LBS' services – they are dissimilar.

Contested terms: Reinsurance underwriting for all types of reinsurance, namely, property, casualty, agriculture, and specialty reinsurance; reinsurance underwriting and administration; reinsurance actuarial services; reinsurance claims administration; financial evaluation for reinsurance purposes; reinsurance consultation services; claims adjustment in the field of insurance; insurance actuarial services; insurance agency and brokerage; insurance brokerage in the field of property and casualty insurance; insurance carrier services; insurance claims processing; insurance consultation; insurance premium rate computing; insurance services, namely, writing property and casualty insurance; insurance subrogation and salvage; insurance underwriting in the field of property, casualty, and agriculture insurance; insurance underwriting consultation; providing information in insurance matters; financial risk management in the field of weather risk management; 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.

55. The above-listed terms have been contested in opposition 427846 and already found to be dissimilar.

56. Some similarity between the parties' goods and services is essential in order to find a likelihood of confusion between the parties' marks. In the case of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

'49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover, I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity'.

57. The opposition against the services that I have found to be dissimilar therefore fails at this point. The following three oppositions have, therefore, failed in their entirety:

Opposition 427846

Opposition 429825

Opposition 427850

58. Opposition 427847 remains live for the following services only:

Class 36:

Financial affairs; real estate affairs

Average consumer and the purchasing act

59. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word "average" denotes that the person is typical. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the

category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

60. The relevant services are: *Financial affairs; real estate affairs*

61. 'Financial affairs', put simply, entail the financing/funding of purchases/ventures and the management of funds. The purchasing act will be primarily visual, the services likely being first encountered online or having seen the premises in the street. There may be an aural aspect by way of 'word-of-mouth'/recommendations. I consider that the average consumer, whether general or professional, will likely demonstrate an appreciable level of care when engaging these services; 'money matters' being particularly important to everyday domestic and professional life. I find that a high level of attention would be paid during the purchasing process.

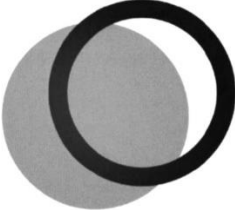


62. 'Real estate' matters involve the buying/selling or renting of property (land or buildings) and the rights and obligations associated with those undertakings. From the perspective of a member of the general public, property is typically the most valuable asset that might be purchased in a lifetime. This will often (although, not always) also be the case for the professional public. My observations regarding the purchasing act above at [62] also apply here. I consider that the average consumer, whether general or professional, would likely demonstrate particular prudence when engaging services to do with real estate. I find that a high level of attention would be paid during the purchasing process.

Comparison of the marks

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

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

64. The marks to be compared are as follows:

Opponent's marks:	Applicant's mark:
<p>i) WO0000001582315</p>  <p>ii) WO0000001560860</p> 	<p><u>OP 427847</u> UK00003601685</p> 

Overall impression of the marks

The earlier marks:

65. Each of the earlier marks comprises an infilled circle over which a black ring has been partially superimposed; the black ring occupying an upper right position relative to the underlying circle. In earlier mark i), the colour claimed for the circle is grey; in earlier mark ii) the colour claimed for the circle is orange. In both marks, the colour claimed for the rings is black. For each mark, I consider the ring and

circle to be seen as a unit, with neither component dominating. The overall impression, therefore, for each mark, resides in the mark as a whole.

The contested mark:

UK00003601685

66. The mark comprises word and figurative elements. The word element 'SOMPO' is rendered in a plain typeface, all characters in upper case. To the left of the word element, is an infilled red circle over which a ring has been partially superimposed; the ring occupying an upper right position relative to the underlying circle. The lighting and shading of the ring give it a metallic and bevelled appearance. The word element is much larger in size relative to the figurative element, occupying roughly five-sixths of the mark's surface area. Notwithstanding that the device appears at the beginning of the mark, I consider the 'SOMPO' component to dominate the mark, by virtue of its size and the fact that words generally 'speak louder' than figurative elements. I find that the presence of the figurative element will nevertheless be registered and that it will, therefore, play some role within the overall impression of the mark.

67. The specifications for the earlier marks are, for practical purposes, the same. (The slight difference in wording of the limitations is of no consequence to my findings regarding the similarity or otherwise of the parties' services). The only difference between the earlier marks resides in the colour of the circle component of the mark: orange versus grey. I consider it unnecessary to compare the opposed mark against *both* earlier marks. I will therefore use WO0000001582315 (grey circle) as a comparator.

Visual comparison

68. The earlier mark is wholly figurative whereas SJI's mark comprises a figurative element with a word element. SJI has conceded that the figurative element of its

mark is identical to the earlier mark.¹² SJI's subsequent submission that the shading and 'more 3D' character of the figurative element in the later marks serve as points of distinction for the average consumer is inconsistent with this concession and, therefore, not an argument open to them.¹³ Although the circle within SJI's mark is coloured red whereas LBS has claimed the colour grey for the circle element of the earlier mark, presentation of this part of SJI's mark in grey would amount to normal and fair use of its mark. This difference is, therefore, of no consequence. The main point of difference between the parties' marks is the presence of the word element 'SOMPO' in SJI's mark, which is absent from LBS' mark. My view is that, in spite of the identical figurative element, the marks are visually similar to no more than a low degree. This is because while the figurative element forms the entirety of the earlier mark, the figurative component of SJI's mark plays a secondary role to the word 'SOMPO', which, in my view, is the focal point of SJI's mark.

Aural comparison

69. Neither party has suggested that the earlier mark is capable of articulation. My view is that it is at least possible that some average consumers might articulate the mark as 'O', although they are likely few in number and would, to my mind, unlikely constitute a significant proportion. I consider that the vast majority of average consumers would not attempt to articulate the earlier mark. SJI's mark will likely be articulated 'SOM-POE'. If the earlier mark is not articulated, there will be no aural similarity between the parties' marks. My view is that even if the earlier mark is articulated (likely as 'O') the marks will be aurally dissimilar, or aurally similar to a very low degree.

Conceptual comparison

70. My view is that the earlier mark will be perceived merely as a 'circle and ring' arrangement or, perhaps, simply as 'circular shapes', with no particular concept

¹² SJI's written submissions in lieu of a hearing, [9]. This concession applies to the figurative element in all four contested marks.

¹³ As above, [12].

above and beyond those forms. SJI's mark will likely be perceived as an invented word placed beside a 'circle and ring' arrangement. There must necessarily be some conceptual nexus between the marks by virtue of the common figurative element being understood in the same manner in each party's mark. I find the marks to have a low level of conceptual similarity.

Distinctive character of the earlier marks

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)'.

72. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services,

it tends to be low. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

73. The earlier marks neither describe nor allude to the relevant services in respect of which they are registered. Each mark comprises the same simplistic ‘circle and ring’ arrangement which might be described as fairly bland. I find the earlier marks to have a level of inherent distinctive character of above ‘low’ but not quite reaching the threshold for ‘average’.

74. No evidence has been adduced by LBS. I am therefore unable to make a finding as to whether the earlier marks enjoy an enhanced level of distinctive character.

Likelihood of confusion

75. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*¹⁴. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹⁵, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their ‘mind’s eye’. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or an economically linked undertaking.

76. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [12]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater

¹⁴ Case BL O/375/10 at [16].

¹⁵ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

Opposition 427847

77. I have found two of SJI's services (*financial affairs* and *real estate affairs*) to be identical to those under the earlier marks. I have found the parties' marks to have a low level of visual similarity, the point of similarity residing in the fact that the earlier figurative mark is wholly replicated within SJI's composite mark. The absence of aural similarity for a significant proportion of average consumers, is, in the instant case, of little consequence because where one party's mark is exclusively figurative and more or less incapable of articulation, any aural comparison will necessarily be uninformative. Although the level of conceptual similarity is not high, it is, in my view, nevertheless significant because the conceptual overlap derives from the fact that the marks include an identical figurative element (the circle and ring arrangement) which will be understood in the same way for each party's mark.

78. I have borne in mind *Whyte and Mackay*¹⁶ in which it was held that where an average consumer perceives that a composite mark consists of two or more elements, one of which has a distinctive significance independent of the mark as a whole, confusion may occur as a result of the similarity/identity of that element to the earlier mark. The following dicta per Arnold J. (as he then was) are relevant to the instant case:

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

¹⁶ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271.

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

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

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

79. It is my view that the shared figurative element enjoys an independent distinctive character which is undisturbed by the presence of the invented word element ‘SOMPO’ in SJI’s mark. I have found the earlier mark to have a level of inherent distinctive character somewhere between ‘low’ and ‘average’. My finding that the word ‘SOMPO’ in SJI’s composite mark is the visually dominant element does not change the fact that the shared figurative element has a distinctive significance independent of the composite mark as a whole. I find that a significant proportion

of average consumers would, upon encountering one party's mark, presume that it originates from the same undertaking as the other party's mark. For example, the composite mark (i.e. with the word element beside the device) might be perceived as another 'version' of the earlier figurative mark showing the device only. It is, in my view, not uncommon for brands whose marks feature a device element to use renderings of the mark with or without the word element; a well-known example being the brand 'Nike' which uses the 'tick' symbol both accompanied and unaccompanied by the word 'Nike'. I find that there is a likelihood of indirect confusion. I find this to be the case even though the average consumer will likely pay high level of attention during the purchasing process.

Conclusion

80. Oppositions 427846, 429825 and 427850 have failed in their entirety. Opposition 427847 has succeeded in part, i.e. in respect of the terms *financial affairs* and *real estate affairs* only.

81. Subject to a successful appeal:

- UK protection is allowed for the following registrations in their entirety: WO0000001592665, WO0000001602823 and WO0000001592584;

and

- Registration is refused for UK3601685, only in respect of the terms *financial affairs* and *real estate affairs*. Registration is allowed for the remaining services.

COSTS

82. SJI has enjoyed the greatest level of success overall and is therefore entitled to a contribution towards its costs based on the published scale at Tribunal Practice Notice 2/2016. Accordingly, I award SJI the following the sum of £1,100 as follows:

Consideration of the Oppositions and preparation of Defence and Counterstatements (x 4 oppositions)	£800
Preparation of written submissions in lieu of a hearing	£300
Total:	£1,100

83.I therefore order Lichtblick SE to pay to Sompo Japan Insurance Inc. the sum of £1,100. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of October 2024

N. R. Morris
For the Registrar,
the Comptroller-General