

O/1004/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003875506

BY 11 ASSET HOLDINGS LTD

TO REGISTER THE TRADE MARK:

11 ASSET HOLDINGS LIMITED

IN CLASS 36

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 441159

BY ELEVEN IP HOLDINGS, LLC

BACKGROUND AND PLEADINGS

1. On 7 February 2023, 11 ASSET HOLDINGS LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 3 March 2023. The applicant seeks registration for the following services:

Class 36 Fund management and advisory services relating thereto; Fiduciary services; Asset management; Asset and portfolio management; Investment asset management; Financial asset management; Property asset management services; Portfolio management; Financial Services; Property portfolio management; Management of investments; Management of investment portfolio; Financial portfolio management; Management of property; Property management; Advisory services relating to financial asset management; Asset allocation; Estate management; Provision of financial information for professionals in the field of portfolio management, for portfolio management; Wealth management; Wealth management and wealth management services; Financial management of funds; Financial trust management; Fund management for private clients; Management of corporate finances; Management of securities; Investment portfolio management services; Financial management; Stock investment management; Fund investment management; Investment fund management; Investment management services; Mortgage investment management; Pension investment management; Asset management for third parties; Risk management consultancy [financial]; Financial risk management; Financial advisory services relating to assets management; Financial management and planning; Financial consultancy in the field of risk management; Capital fund management; Management of transferable securities; Management of portfolios of transferable securities; Financial management of collective investment schemes; Hedge fund management; Financial loss management; Unit trust management; management of capital investment funds; Financial management of companies; provision of secured and unsecured credit to individuals and

corporations; international stockbroking relating to equities, fixed income stocks and derivatives; custody of securities; corporate finance advice; Financial management of holding companies; Corporate holding of share capital services; Financial nominees services for the holding of properties for others; Management of private equity funds; capital investments; monetary affairs; securities transactions; Information, consultancy and advisory services relating to the aforesaid services.

2. The application was opposed in full by Eleven IP Holdings, LLC (“the opponent”) on 5 June 2023 based upon section 5(2)(b) of the Trade Marks Act (“the Act”), and the opponent relies upon the following mark:

ELEVEN

UK registration no. UK00003427765

Filing date 11 September 2019; Registration date 31 January 2020.

Relying upon all of the services for which the earlier mark is registered, namely:

Class 36 Financial services; wealth management services; investment banking services; high end vacation property and real estate listing services provided via an interactive website; high end vacation property and real estate rental services provided via an interactive website.

Class 42 Software as a service [SaaS] featuring software platforms for wealth management, financial services and property management.

3. The opponent claims there is a likelihood of confusion because the applicant’s services are identical or similar to the opponent’s class 36 services and the distinctive and memorable element of the applicant’s sign (that being the number 11), is phonetically and conceptually identical to the opponent’s earlier mark.

4. The applicant filed a counterstatement admitting that “there exists overlap and some similar terms in the respective specifications of services” and that “11 is the numerical

form of the word ELEVEN” and therefore “conceptual similarity exists” between the marks. However, the applicant denied the phonetic and conceptual identity of the distinctive and memorable elements, and the likelihood of confusion.

5. The opponent is represented by Dehns and the applicant is represented by Novagraaf UK. Both parties filed evidence in chief, and the applicant filed written submissions during the evidence rounds. Neither party requested a hearing but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

6. 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.

EVIDENCE

7. The opponent’s evidence consists of the witness statement of Alexandra Nott dated 17 October 2023. Ms Nott is a Chartered Trade Mark Attorney and Associate at Dehns, the representatives for the opponent. Ms Nott’s statement is accompanied by 3 exhibits (AN1-AN3).

8. The applicant’s evidence consists of the witness statement of Luke David Portnow dated 18 December 2023. Mr Portnow is a Chartered Trade Mark Attorney at Novagraaf UK, the representatives for the applicant. Mr Portnow’s statement is accompanied by 3 exhibits (LDP1-LDP3).

9. Whilst I do not propose to summarise them here, I have taken all of the evidence and the parties’ submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

10. Section 5(2)(b) reads as follows:

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

(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.”

11. The earlier mark has not completed its registration process more than five years before the relevant date (the filing date of the applicant’s mark). Accordingly, the use provisions at section 6A of the Act do not apply. The opponent may rely on all of the services it has identified without demonstrating that it has used the mark.

Section 5(2)(b) case law

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

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

- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

13. The applicant's services are contained in paragraph 1 of this decision, and the opponent's services are contained in paragraph 2 of this decision.

14. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

15. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

Wealth management; Wealth management and wealth management services.

17. While expressed slightly differently, the applicant’s above services are self-evidently identical to “wealth management services” in the opponent’s class 36 specification.

Financial services.

18. The above term appears identically in the parties’ class 36 specifications.

Fund management and advisory services relating thereto; Fiduciary services; Asset management; Asset and portfolio management; Investment asset management; Financial asset management; Portfolio management; Management of investments; Management of investment portfolio; Financial portfolio management; Advisory services relating to financial asset management; Asset allocation; Estate management; Provision of financial information for professionals in the field of portfolio

management, for portfolio management; Financial management of funds; Financial trust management; Fund management for private clients; Management of corporate finances; Management of securities; Investment portfolio management services; Financial management; Stock investment management; Fund investment management; Investment fund management; Investment management services; Mortgage investment management; Pension investment management; Asset management for third parties; Risk management consultancy [financial]; Financial risk management; Financial advisory services relating to assets management; Financial management and planning; Financial consultancy in the field of risk management; Capital fund management; Management of transferable securities; Management of portfolios of transferable securities; Financial management of collective investment schemes; Hedge fund management; Financial loss management; Unit trust management; management of capital investment funds; Financial management of companies; provision of secured and unsecured credit to individuals and corporations; international stockbroking relating to equities, fixed income stocks and derivatives; custody of securities; corporate finance advice; Financial management of holding companies; Corporate holding of share capital services; Financial nominees services for the holding of properties for others; Management of private equity funds; capital investments; monetary affairs; securities transactions.

19. The applicant's above services fall within the broader category of "financial services" in the opponent's class 36 specification. The services are, therefore, identical on the principle outlined in *Meric*.

Property asset management services; Property portfolio management; Management of property; Property management.

20. I consider that the applicant's above services are all types of real estate management services, and are therefore similar to the opponent's class 36 "high end vacation property and real estate listing services provided via an interactive website" and "high end vacation property and real estate rental services provided via an interactive website". I consider that the services overlap in nature and user, and that the same undertakings usually provide property management as well as real estate services. Therefore the services will overlap in trade channels. However, the services

are neither in competition nor complementary. I therefore consider that they are similar to a medium degree.

Information, consultancy and advisory services relating to the aforesaid services.

21. With regard to the applicant's above information, advisory and consultancy services, to the extent that I have found identity or a medium degree of similarity between the parties' services in paragraphs 17 to 20 above, then the services will overlap in user and trade channels, and they will be complementary. Consequently, there will be no more than a medium degree of similarity between the applicant's information, advisory and consultancy services and the opponent's above forementioned financial and real estate services.

The average consumer and the nature of the purchasing act

22. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

23. The average consumer for the services will be members of the general public or businesses. The cost of the services in question is likely to vary. I consider that the majority of the services will be purchased relatively infrequently by members of the general public, but relatively frequently by businesses. However, the average

consumer will take various factors into consideration such as the cost and commission rate, customer service standards, reliability, type of services offered and the suitability of those financial services to the consumer's needs. I also consider that as the services provided are financial in nature, or relate to property and relate estate, all of which could involve significant sums of money, that between a medium and high degree of attention will be paid during the purchasing process.

24. The services are likely to be purchased from financial undertakings, estate management undertakings, or their online equivalents. Alternatively, the services may be purchased following perusal of signage on physical premises, advertisements or inspection of a business directory. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase which, as highlighted by the applicant, might involve discussions with brokers and financial advisors.

Comparison of the trade marks

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

26. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

27. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
ELEVEN	11 ASSET HOLDINGS LIMITED

28. The opponent's mark consists of the word "ELEVEN". There are no other elements to contribute to the overall impression which lies in the word itself.

29. The applicant's mark consists of the number "11" followed by the words "ASSET HOLDINGS LIMITED". I note that the number 11, whilst at the beginning of the mark, forms a very small part of it as a whole. I also note that the number "11" is unremarkable, mundane and not particularly distinctive for financial services. The words "ASSET HOLDINGS" is highly allusive of the applicant's services, and the word "LIMITED", as noted by the opponent, "will be readily understood by consumers as a reference to the company".¹ I also remind myself that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.² Therefore, I consider that the overall impression of the of the mark lies in the combination of all these elements. However, if I am wrong in this finding, I consider that "11 ASSET HOLDINGS" will only play a slightly greater role in the overall impression of the mark, with the word "LIMITED" playing a lesser role.

30. The opponent refers to decision BL O/130/13, whereby the marks "Viewone" and "VIEW1" were found visually similar to a high degree because *"it has become increasingly commonplace in advertising and branding for numerals to be used in place of their equivalent word to the extent that the average consumer may not even notice any difference"*. However, every case is decided on its own facts, and in the above case, the services were "advertising and branding" (which clearly differ to the

¹ BL O/1081/22

² *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97

financial services within this decision). I also note that in that case both marks began with the word “VIEW” which would have significantly contributed to their visual similarity.

31. Moreover, I am not bound by the previous decisions of the Tribunal and I also bear in mind that visual similarity is assessed on the marks before me. On this basis, regardless of whether the word “eleven” is the word equivalent of the number “11”, the word and number are not visually similar. The applicant’s mark also contains the words “ASSET HOLDINGS LIMITED” which are not visually similar to the opponent’s word “ELEVEN”. On this basis, I find the marks are visually dissimilar.

32. Aurally, the applicant acknowledges that “ELEVEN” is the verbal form of the number “11”, and therefore these elements are aurally identical. However, the applicant’s mark ends in the ordinary dictionary words “ASSET HOLDINGS LIMITED”, which will be given their usual pronunciation.

33. In their submissions in lieu, the opponent argues that “ASSET HOLDINGS LIMITED” will not be pronounced as they are descriptive, and therefore the marks are aurally identical. I also note that the opponent specifically has referred to the cases BL O/1018/22 and O/614/19 in which the found the word “LIMITED” would not be articulated by some consumers (due to its lack of distinctiveness). I bear in mind that in *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22) Mr Phillip Harris, as the Appointed Person, set out that just because a word may be descriptive, it does not mean that it is aurally invisible. I therefore consider that the words “ASSET HOLDINGS LIMITED” will likely be pronounced by the average consumer. Consequently, whilst the beginning of the marks are aurally identical, a position to which the consumer pays more attention,³ I still consider that they are only aurally similar to between a low and medium degree.

34. Firstly, I note that when assessing the conceptual similarity of two marks this is usually done without reference to the services in question.⁴ Secondly, as

³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

⁴ Mr Philip Johnson, sitting as the AP in *Viñedos Emiliana SA v Consorzio Tutela Vini Emilia*, (2) Chiarli 1860 – Pr.I.V.I Srl And (3) *Medici Ermete E Figli Srl O/054/22*.

acknowledged by the applicant, “ELEVEN” is the verbal form of the number “11”, and therefore these elements are conceptually identical. However, in the applicant’s mark, the number 11 is presented next to the ordinary dictionary words “ASSET HOLDINGS LIMITED”. “Assets” are items of property that are regarded as valuable, “holdings” are types of financial assets and, as noted above, “limited” will be seen as a reference to the company. Therefore, as a whole, I consider that “11 ASSET HOLDINGS LIMITED” will be understood by the average consumers as a holdings company that has 11 assets. On this basis, whilst the marks overlap in the concept of ELEVEN/11, the meaning of this number in the applicant’s mark is qualified by the words “ASSET HOLDINGS” and thus designates the number of assets held by the applicant. On this basis, the marks are only conceptually similar to between a low and medium degree.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

36. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

37. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

38. The opponent’s “ELEVEN” mark consists of an ordinary dictionary word which will be recognised as the word form of the single, mundane and unremarkable number 11.

39. When assessing the distinctiveness of a number mark, I bear in mind *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-51/10 P) [2011] E.T.M.R. 34*.⁵ In this case, the sign “1000” was to be registered for “periodicals, including periodicals containing crossword puzzles”. The Fourth Board of Appeal of OHIM and the General Court found that the sign “1000” on a publication of that kind will be perceived as an indication that it contains 1,000 crossword puzzles. The Court of Justice of the European Union CJEU found that:

56. Where an application for registration refers, in particular, to a category of goods the content of which is easily and typically designated by the numeral indicating the number of units they contain, it is reasonable to believe that a sign composed of numerals – such as that at issue – will actually be recognised by the relevant class of persons as a description of that quantity and therefore as a characteristic of those goods.

⁵ This was an appeal case to the Court of Justice, whereby the owner of the sign “1000” (Technopol) was seeking to set aside the judgement of the General Court which dismissed its action for annulment of the decision of the Fourth Board of Appeal of OHIM (which upheld the examiners original findings that the sign “1000” did not have any distinctive character). The appeal was dismissed.

40. The Court of Justice therefore found it was open to the General Court to refuse the registration of the sign “1000” on the basis of its above finding.

41. I note that paragraph 56 of the judgement above only refers to “goods”, but I find that the same logic would also apply to services.

42. In this case, the opponent’s mark is already registered, and therefore, as per *Formula One Licensing BV v OHIM*⁶ must be considered to have at least some distinctive character. However, I also consider that opponent’s “eleven” mark would be understood by the average consumer as designating the number of financial services provided by the opponent. I note that it could also be seen as the number of founders or employees at the company, or it could even allude to the company’s ranking, that it’s the 11th best financial undertaking in the UK. In any event, all of these meanings are highly allusive of the opponent’s services.

43. Therefore, taking all of the above into account, I consider that the opponent’s mark is inherently distinctive to a low degree.

Likelihood of confusion

44. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct

⁶ Case C-196/11P, paragraphs 41 to 44

comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

45. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually dissimilar.
- I have found the marks to be aurally and conceptually similar to between a low and medium degree.
- I have found the earlier mark to be inherently distinctive to a low degree.
- I have identified the average consumer as members of the general public or businesses who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that between a medium to high degree of attention will be paid during the purchasing process for all of the services which are financial in nature, or relate to property and real estate.
- I have found the parties' services to be identical or similar to no more than a medium degree.

46. Taking all of the factors listed in paragraph 45 into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the parties' marks are unlikely to be mistakenly recalled as each other. This is particularly the case given that they are visually dissimilar and the fact that the purchasing process is predominantly visual. Consequently, I do not consider there to be a likelihood of direct confusion.

47. I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the

other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”





48. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria (O/219/16)*, where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

49. I note that the parties’ have both provided evidence in regard to whether brands interchangeably use numerical and verbal forms of their marks. However, all of the evidence provided alongside Ms Nott’s witness statement only has a print date of 27 September 2023, which falls after the relevant date. I also bear in mind that the evidence only shows one or two screenshots from each of the brands website page which I do not find compelling enough on its own to show that all of these brands consistently use numerical and verbal forms of their marks interchangeably. Regardless, I note the following from this evidence:

- a) The only branding which clearly uses both numerical and verbal forms is “Three” or “3” which is a phone, broadband and SIM company, which is clearly signposted by the glossary from an Ofcom booklet which has a publication date of 27 June 2018.
- b) The other two brands which may use both numerical and verbal forms is Twelve Architects & Master planners, which shows the number 12 on their website banner, and “Number 6” whose website is numbersixcobham.co.uk. However,

I note that these marks are not used on financial services which are provided by the parties' in this current decision.

c) I note that the remaining brands all use numerical and verbal forms on financial services, but alongside each other, as follows:

Website	Logos
14finance.co.uk	
Eighteenwealth.co.uk	
23-cap.com	
21Finance.com	

50. Ms Nott has also provided google search evidence in **exhibit AN2** whereby, for example, searching “capital 1 card” will come up with results including “capital one card”. However, I do not consider that this evidence has any weight to it as it purely shows how google as a search engine works, it does not show how brands themselves use the numerical and verbal forms of their marks interchangeably.

51. **Exhibit AN3** contains screenshots of how brands such as 7 up (the drinks brand), the 4 seasons hotel, and formula 1 have been written using the verbal forms of these numbers. However, this is all use on third party websites (such as the Guardian, Gest Reservations and Amazon), and again on goods and services that are not the same as the parties' in this decision. Taking all of the above into account, I do not find the

above evidence compelling to establish that before the relevant date, brands use numerical and verbal forms of their marks interchangeably for financial based services.⁷

52. Therefore without this evidence, I have to determine whether the consumer would assume that the applicant's "11 ASSET HOLDINGS LIMITED" mark and the opponent's "ELEVEN" mark comes from the same economically linked undertakings for a likelihood of indirect confusion to occur.

53. I bear in mind the decision *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) in which the court confirmed that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.

54. In this case, the common element that the parties' marks share, ELEVEN/11, is low in distinctiveness, and therefore the differences between the two marks take on a greater significance for the average consumer than they might have otherwise.⁸ Moreover, I note that the common element is not identically replicated in the parties' marks, and as noted above, I do not have any evidence before me to establish that financial undertakings use numerical and verbal forms of their marks interchangeably.

55. The addition of the words "ASSET HOLDINGS LIMITED" alludes to the applicant's financial services and the undertaking to which they originate from. Therefore, whilst they are "not very remarkable, the fact remains that these aspects are entirely different".⁹ As I have noted above, the words "ASSET HOLDINGS LIMITED" are not negligible, and therefore create visual, aural and conceptual points of difference between the marks. Moreover, the number "11" qualifies the words "ASSET HOLDINGS LIMITED" to evoke the concept of a holdings company that has 11 assets. On this basis, whilst ELEVEN vs 11 are conceptually identical, the overall concept and

⁷ For the sake of completeness, I also note that Mr Portnow's evidence in reply is not compelling either, on the basis that all of its exhibits are also undated, or are from Wikipedia, which is a platform which allows entries to be updated by the public, and therefore the information from it should be approached with a certain degree of caution.

⁸ *Nicoventures Holdings Ltd v. The London Vape Co Ltd* [2017] EWHC 3393 (Ch) Paragraph 36

⁹ *Nicoventures Holdings Ltd v. The London Vape Co Ltd* [2017] EWHC 3393 (Ch) Paragraph 36

impression conveyed by the parties' marks are significantly different. I therefore do not consider that the average consumer, paying a high degree of attention, would assume that the number "11" in the applicant's mark is a reference to the opponent's "ELEVEN" mark. Instead, they will just see it as normal use of the unremarkable number "11" to designate the number of assets held by the applicant.

56. Consequently, I do not think that the common element (which I note again is presented significantly differently in each mark) is of such a level of distinctiveness that the average consumer would believe that only one undertaking would use it in relation to financial services. It is more likely to be viewed as a coincidence, especially, as highlighted above, the average consumer does not dissect the mark, it will be viewed as a whole. I do not consider that the average consumer would think that the applicant's trade mark was connected with the opponent, and vice versa.

57. I find there is no likelihood of indirect confusion.

CONCLUSION

58. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

59. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023.

60. As noted above, the applicant's evidence did not assist the applicant. On this basis, I shall not be awarding any costs in relation to it. Consequently, I award the applicant the sum of **£950** as a contribution towards the costs of the proceedings.

61. The sum is calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£250
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Preparing and filing written submissions and submissions in lieu of a hearing	£350 ¹⁰
Considering the opponent's evidence	£350 ¹¹
Total	£950

62. I therefore order Eleven IP Holdings, LLC to pay 11 ASSET HOLDINGS LTD the sum of £950. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 22nd day of October 2024

L FAYTER
For the Registrar

¹⁰ I have awarded the applicant the lowest cost on the scale for their submissions as I note that they essentially repeat a lot of what they said in both sets.

¹¹ This figure has also been cut down as the opponent did not file a significant amount.