TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 9614
BY GAN MINSTER INSURANCE COMPANY LTD
FOR A DECLARATION OF INVALIDITY
IN RESPECT OF TRADE MARK NUMBER 1546358
GANN RESPOND
STANDING IN THE NAME OF GANN MANAGEMENT LTD

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DECISION

Trade mark registration No 1546358 covers "Financial information services and financial analysis services, all relating to financial stock markets, financial bond markets, currencies and business; financial investment research services; all included in Class 36."

The registration with effect from 1st September 1993, is in the name of Gann Management Limited. The mark itself is **GANN RESPOND**.

By an application dated 11 June 1997 Gan Minster Insurance Company Limited applied for a Declaration of Invalidity under the provisions of Section 47 of the Act. The grounds are:

> i) The applicant is the registered proprietor of UK Trade Mark Registrations numbers 1482989 **GAN MINSTER** and 1482994 **gan minster and device** which have been registered in relation to insurance services since 20 November 1991.
>
> ii) The Registered Proprietor's trade mark (number 1546358) was registered in breach of Section 5(2) of the Act and therefore offends against the provisions of Section 47(2)(a) thereof in that it is similar to the earlier registered trade marks belonging to the applicant and it is registered for services similar to those for which the earlier trade marks are protected.

The registered proprietor filed a counterstatement claiming that:

- that the marks are dissimilar;
- that both the applicant's marks contain non disclaimed matter which is not present in its mark;
- that the applicant's mark 1482994 is subject to a colour limitation;
- that its mark contains additional matter which although disclaimed substantially affects the character and identity of the trade mark;
- that although both marks are registered for services in Class 36, the applicant offers insurance services whereas they offer services related to analysis and prediction of stock bond and currency markets.

Both sides ask for an award of costs. Only the applicant filed evidence in these proceedings, and the matter came to be heard on 3 April 2000 when the applicant was represented by Mr Hickey from Trade Mark Agents Castles. The registered proprietor was not represented.

APPLICANT'S EVIDENCE

The applicant filed two statutory declarations. The first, dated 16 December 1998, is by Mr Anthony Philip Lancaster the Chairman and Chief Executive of GAN Insurance Company Limited (formerly known as GAN Minster Insurance Company Limited).

Mr Lancaster states that he has held his current position since 1991, and that his declaration is from his personal knowledge or taken from the records and files of his company. He states that the company changed its name on 1st January 1995 from GAN Minster Insurance Company Limited to GAN Insurance Company Limited. A copy of the Certificate of Incorporation on Change of Name is provided at exhibit APDL1.

Mr Lancaster states that his company "has conducted general business under the trade mark GAN since 1992 when it changed its name from Minster Insurance Company Limited to GAN Minster Insurance Limited." He also states that the applicant is one of a number of subsidiaries operating in the UK which are owned (via holding companies) by GAN S.A. Mr Lancaster claims that the GAN group is one of the world's leading financial services organisations. Trading figures and other information on the GAN group is provided but is all after the relevant date of 1 September 1993.

Mr Lancaster claims that his company has offices throughout the UK and refers to a brochure providing the office addresses dated 1994. He states that the principal business of the applicant under the trade marks GAN MINSTER and GAN is the underwriting of general insurance business and investment fund management under the name GAN Fund Managers. He claims that the applicant is authorised to carry out general insurance business in the following classes:

	INSURANCE CLASS		INSURANCE CLASS
1	Accident	10	Motor vehicle liability
2	Sickness	11	Aircraft liability
3	Land vehicles	12	Liability for ships
4	Railway rolling stock	13	General liability
5	Aircraft	14	Credit
6	Ships	15	Suretyship
7	Goods in transit	16	Miscellaneous financial loss
8	Fire & natural causes	17	Legal expenses
9	Damage to property	18	Assistance

At exhibit APDL4 Mr Lancaster provides a copy of a DTI certificate authorising the applicant to deal in these classes. The certificate is dated 17 April 1997.

Mr Lancaster states that services are offered direct to clients via brokers and other intermediaries and that "sister companies" provide other financial services under the GAN trade mark. Figures for

advertising and promotion are provided for the years 1994 - 1997, figures prior to the relevant date are not available.

Mr Lancaster states that "In practice the word Gan is seen as the most important element of that mark and the principal point of reference for customers." He claims that there are two main reasons for this. Firstly, that as the first part of the mark GAN enjoys a high visual and auditive profile. Secondly, by virtue of the emphasis placed on the word Gan by the various companies in the GAN group. He claims that GAN MINSTER has been referred to simply as GAN for some time and is a practice that has been nurtured by the applicant. He refers to the promotional evidence filed as exhibits at APDL6. With one exception all the items are dated after the relevant date. The exception being an article in "Lloyd's List " dated October 1991. When referring to the applicant the article provides the full name "GAN Minster" but also refers to the parent company initially as "Groupe des Assurances Nationales " and thereafter as GAN.

Mr Lancaster states that copies of the actual advertisements have not been kept but he provides at exhibit APDL7 copies of invoices. The invoices are dated throughout 1994 but none provide details of the content of the advertisement. He also claims to have sponsored a rider in the 1994 Tour De France.

Mr Lancaster repeats his assertion that the essential element of the applicant's mark is the word GAN and that this is distinctive in relation to both insurance and financial services. He claims that:

> "GAN is phonetically identical and visually near identical to the GANN element of GANN RESPOND. In view of the relatively non distinct nature of the word RESPOND, the word GANN within registration 1546358 is the part of the mark which is most easily recollected."

> "It is clear from the submissions I have made in this declaration and the evidence exhibited thereto that our marks GAN MINSTER and Gan Minster plus Device are commonly referred to and recognised by the public and the trade as "GAN" simpliciter. In view of this, when comparing the marks successively in terms of notional fair use, I believe that there is sufficient similarity between our marks and GANN RESPOND such that there is a likelihood of confusion which includes a likelihood of association. Furthermore, to the extent that it may be relevant, the repute attributable to GAN which carries through to GAN MINSTER in my view enhances the likelihood of confusion."

The second statutory declaration, dated 16 February 1999, is by Mr Anthony Michael Baker. Mr Baker is the Deputy Director General and Head of Public Affairs of the Association of British Insurers, a position he has held for five years. He has worked in the insurance industry for twenty eight years.

Mr Baker states:

> "My attention has been drawn to the registration as a trade mark of GANN RESPOND. Upon sight of same, my initial reaction was that GANN RESPOND was in some way linked to Gan Insurance Company Limited. My assumption would be that it was a direct response arm of the company."

"Furthermore, I believe that given the reputation of Gan Insurance Company Limited in the GAN name in respect of insurance services, other consumers and members of the trade, upon seeing GANN RESPOND in respect of a financial services product, are likely to be confused as to origin."

That concludes my review of the evidence. I now turn to the decision.

DECISION

The application is made under Section 47(2)(a) of the Trade Marks Act 1994, which reads as follows:

47. - (2) The registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain.

I must also consider the question of onus. Section 72 of the Trade Marks Act 1994 states:

"In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it."

It is well established that on an application to remove a mark from the Register the onus is on the applicant, reflecting the usual approach under English law that he who asserts must prove.

The sole ground of application is based on section 5(2), which reads:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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 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."

An earlier right is defined in Section 6(1)(a) which states:

"6.-(1).....

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks."

I have to determine whether there exists a likelihood of confusion on the part of the relevant public. In deciding this issue I rely on the decision of the Court of Justice of the European Communities (ECJ) in the Sabel v Puma case C251/ 95 - ETMR [1998] 1-84. In that case the court stated that:

> *"Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion 'depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified'. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.*
>
> *Global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - "there exists a likelihood of confusion on the part of the public" - shows that the perception of the marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.*
>
> *In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.*"

I also have regard to the approach adopted by the European Court of Justice in Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. (case C-39/97) (ETMR 1999 P.1) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

> *"A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified."*

Further, I take account of the following guidance of the European Court of Justice in Lloyd Schuhfabrik Meyer & Co (1999 ETMR 690) in which the court held that:

" For the purposes of ... global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998]ECR 1-4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should be also 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."

In order to make the global assessment on the similarity of the marks, it is necessary to consider individual aspects of the question. I propose to firstly consider the similarity of the goods of the two parties.

For the purposes of the comparison I shall be considering the applicant's trade mark registration number 1482989 GAN MINSTER, and it was accepted at the hearing by Mr Hickey that if he could not succeed with this registration then he would also fail under registration number 1482994.

The registered proprietors mark has a specification of "financial information services and financial analysis services, all relating to financial stock markets, financial bond markets, currencies and business; financial investment research services; all included in Class 36". Whilst the applicant's specification is "Insurance services; all included in Class 36".

Whilst not identical I consider the specifications to be somewhat similar as, at the relevant date, it is a matter of judicial note that companies offering insurance services also offered a range of financial type products, including assurance services and products

Considering the two marks, GANN RESPOND and GAN MINSTER, visually the first words are almost identical differing only by the additional "N". They both consist of two words and are of similar length. Clearly the second words in each mark are dissimilar.

Phonetically, the first word in each mark is identical. The second words of each of the marks are totally dissimilar, other than the fact that they are both consist of two syllables.

Conceptually the marks differ in that the first word of each mark (GANN or GAN) is meaningless to the majority of the public. Whilst a few members of the public may know that it is an acronym for Groupe des Assurances Nationales, the majority I believe will be unaware of this meaning. The second words RESPOND and MINSTER conjure up completely different images. These images that will remain in the public's mind. I agree with the applicant's views, as outlined at the hearing by Mr Hickey, that the word RESPOND is descriptive in that it conveys the impression of an action. In contrast the applicant's mark has as it's second part a word which means a large church or cathedral and as such conveys an image of solidity and substance (attractive images for a financial institution).

The applicant has filed a great deal of evidence relating to it's reputation under the word GAN. However, I note that most of the exhibits are after the relevant date of 1 September 1993, and that up until 1992 the company traded as Minster Insurance Company Limited. From 1992 to 1995 it traded as GAN Minster Insurance Company Limited, and it is only since 1995 that it has trade as GAN Insurance Company Limited.

The evidence of Mr Baker was given in 1999, some six years after the relevant date and four years after the applicant started trading under GAN Insurance Company Limited. In the absence of any qualifying statement in his declaration I cannot assume that the comments on the trade marks represented his views in 1993. I do not accept that the applicant had any reputation under the single word GAN at the relevant date.

At the hearing Mr Hickey made the point that there is a significant body of case law in which greater importance is attached to the first word in a mark. Whilst I agree that this is so, the marks have to be considered as wholes, and the position assessed as it stood at the relevant date.

It is my belief that the average consumer is attentive when purchasing services of this nature. Notwithstanding that the first words are similar both visually and phonetically, and the similarity between the services offered I believe that when considering the global position that the average consumer will not be confused. The strong nature of the second word of the applicant's mark and the image it conveys is the dominant feature of the applicant's mark. The imperfect picture in the consumer's mind will strengthen the distinction between the applicant's mark and that of the registered proprietor.

As the Registered Proprietor has successfully defended their mark they are entitled to a contribution towards their costs. I order the applicant to pay them the sum of £235. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19 day of May 2000

George W Salthouse
For the Registrar
The Comptroller General