

O/450/21

**TRADE MARKS ACT 1994
SUPPLEMENTARY DECISION**

IN THE MATTER OF APPLICATION NO. UK00003516667

BY KEYSTONE FINANCIAL LIMITED

TO REGISTER THE FOLLOWING MARK:



IN CLASS 36

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600001553**

BY KEYSTONE IEA LIMITED

1. On 10 May 2021, I issued a provisional decision in relation to this opposition. In the original decision, I concluded as follows:

“88. I am conscious that some of my findings to refuse certain services are based on broad terms, and that there may be services within the applicant’s broad terms that are not similar (or perhaps have just a low degree of similarity) to those of the earlier mark. The terms for which I am prepared to accept the mark illustrate my thinking. Consequently, I am prepared to allow the applicant twenty-eight days from the date of this decision to indicate any further distinct terms it wishes to register which: i) fall within the ambit of its current specification, and ii) are dissimilar (or are lowly similar) to the opponent’s specification. I trust that the extent to which I have made my findings thus far demonstrate what may or may not be acceptable. Following receipt of a revised specification, the opponent will be given twenty-eight days to comment on those terms, following which I will issue a supplementary decision, confirming the specification for which I will allow the application to proceed, and giving my order as to costs. The appeal period will run from the date of that supplementary decision. It should be noted that this is not an opportunity to provide further submissions on the merits of the case and my decision.”

2. In that regard, a response was received from the applicant on 28 May 2021. However, the applicant did not supply a revised specification in the form of notifying me of any further distinct terms that it wished to register. Rather, the applicant requested that part of a term in the original specification - *“Financial services, financial affairs and financial advice”* - be reinstated. It also reiterated some of its arguments put forward previously.
3. While the applicant no doubt wished me to re-visit my decision, this was not the purpose of my invitation. Having reached my findings, it is a matter for appeal should the applicant not be content with them. Given this, and as I do not consider that the applicant has supplied a revised specification, my provisional decision stands as follows:

“CONCLUSION

86. The opposition has succeeded in relation to the following services, for which the application is refused:

Class 36 Financial services, financial affairs, financial advice, financial analysis and consultancy; monetary affairs; mortgage services; brokerage services; financing; insurance, assurance and reinsurance; insurance brokerage; provision of funds; advisory, consultancy and information services relating to all of the aforesaid.

87. The application will proceed to registration, subject to appeal, in respect of the following services:

Class 36 Investment services; fund, asset, unit trust and investment management services; portfolio management; pension services; financial management services; financial risk assessment, analysis and management; financial appraisal; provision of financial information; economic financial research services; financial investment research services; financial research; financial evaluation; monitoring of financial portfolios; administration of financial affairs; preparation of financial reports and analysis; investment research; advisory, consultancy and information services relating to all of the aforesaid.”

COSTS

4. The applicant has succeeded in relation to roughly two thirds of the terms that it has applied for. As the applicant has achieved the greater degree of success, it is entitled to a contribution towards its costs. However, I have taken the fact that the opponent has only succeeded in part into account when deciding the amount to be awarded.

5. Given that costs in fast track oppositions are capped at £200 for considering a notice of opposition and filing a counterstatement, as per Tribunal Practice Notice 2 of 2015, I award the applicant £150.

6. I order Keystone IEA Limited to pay Keystone Financial Limited the sum of £150. This sum is to be paid within twenty-one days of the expiry of the appeal period, which begins from the date of this supplementary decision, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of June 2021

JOHN WILLIAMS
For the Registrar