



BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2009808
2 September 2015

Opponent: **Guardian Financial Services Holdings UK Limited**
2nd Floor 80 Cheapside
EC2V 6EE London
United Kingdom

Representative: **Arnold + Siedsma (Amsterdam)**
Postbus 71720
1008 DE Amsterdam
Netherlands

Invoked right: **European registration 11071305**



against

Defendant: **Guardian Shared Services Limited**
No. 1 Guardian Drive
Westmoorings, South-East
Trinidad and Tobago

Representative: **Deterink N.V.**
Postbus 3
5600 AA Eindhoven
Netherlands

Contested trademark: **Benelux application 201367**



I. FACTS AND PROCEEDINGS**A. Facts**

1. On 27 August 2013 the defendant filed a trademark application in the Benelux for the combined



word/figurative mark , for services in classes 35 and 36. The trademark application was processed under number 201367 and was published on 27 February 2014.

2. On 24 April 2014 the opponent filed an opposition against the registration of this application. The opposition is based on the European registration 11071305 of the combined word/figurative mark



, filed on 25 July 2012 and registered on 30 August 2013 for services in classes 35 and 36.

3. According to the register the opponent is the actual holder of the trademark invoked.

4. The opposition is directed against all services of the contested application and is based on all services of the trademark invoked.

5. The grounds for opposition are those laid down in article 2.14, 1 (a) of the Benelux Convention on Intellectual Property (hereinafter "BCIP").

6. The language of the proceedings is English.

B. Course of the proceedings

7. The opposition is admissible and was notified to the parties on 30 April 2014.

8. The adversarial phase of the procedure started on 1 July 2014. The Benelux Office for Intellectual Property (hereinafter: "the Office") sent the notification of the commencement of the proceedings on 17 July 2014 to the parties, giving the opponent the opportunity to substantiate the opposition by submitting arguments and documents no later than 17 September 2014.

9. On 2 September 2014 the opponent submitted arguments to substantiate the opposition. These arguments were sent by the Office to the defendant on 21 October 2014, giving the defendant the opportunity to submit a reply no later than 21 December 2014.

10. The defendant filed a reply on 19 December 2014. This reply was sent by the Office to the opponent on 13 January 2015.

11. Each party filed its observations within the time limits imposed by the Office.

12. The Office has sufficient information to come to a decision on the opposition.

II. ARGUMENTS

13. The opponent filed an opposition at the Office under article 2.14, 1 (a) BCIP, in accordance with the provisions of article 2.3 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant marks and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

14. With regard to the similarity of the services, the opponent argues that the defendant's services are identical or similar to the services of the opponent.

15. According to the opponent, the verbal element Guardian is the distinctive element in both signs. The words Financial Services in the trademark invoked and the word Group in the contested sign are merely descriptive.

16. In the light of the fact that verbal elements are of more importance than figurative elements, the opponent also argues that the different figurative elements in both signs will not change the fact that the signs are similar.

17. With regard to the conceptual similarity, the opponent argues that the word Guardian is not an abstract word, but has a meaning. This increases the likelihood of confusion.

18. In the light of the identical or highly similar services and the similarity between the signs, the opponent concludes that there exists a likelihood of confusion.

19. The opponent requests that the Office should uphold the opposition.

B. Defendant's arguments

20. The defendant mentions several visual differences between the signs. Firstly, both signs have different figurative elements. The trademark invoked contains a black and white image of an owl. The contested sign contains a multi-coloured stylized graphic logo. Furthermore, the defendant states that the word elements are also different. The contested sign contains the word Group as well as the distinctive word Fatum, which refers to the defendant's previous name. The trademark invoked contains the words Financial Services. According to the defendant, the word Fatum has a visually dominant character due to its position and its bright colour pink. Another visual difference, according to the defendant, is the modern font (in the colour purple) used for the words Guardian Group compared to the more traditional font used in the trademark invoked. Lastly, the defendant points out that the trademark invoked is registered in black and white and the contested sign in colour.

21. With regard to the aural comparison, the defendant states that the pronunciation of the words on both signs only coincides in the word Guardian. The pronunciation of the other verbal elements differs completely.

22. The defendant argues that there is no conceptual similarity between the signs with regard to the distinctive word *Fatum*, which means 'fate' in Latin. Furthermore, the defendant states that the word *Guardian* has no or only very little distinctive character in the light of the services of the trademark invoked. According to the defendant, it is clear that by using the term 'guardian' for financial and/or insurance services, a company wishes to emphasize its reliability as well as the due care that it will take in relation to the provision of these services. In this respect, the defendant also refers to other trademark registrations which contain the word *Guardian* in relation to the goods and services in the classes 35 and/or 36. In the light of this, there is a limited scope for protection regarding the trademark invoked.

23. The defendant also points out that with regard to figurative trademarks, the assessment of the scope for protection includes all graphic elements and cannot be assessed in the same way as a purely verbal mark would be. The defendant concludes that in the light of the descriptive character of the word *Guardian*, the substantial differences between the signs cannot be neutralized by the similar element *Guardian*.

24. With regard to the similarity of the services the defendant argues that the services may (partly) be similar. However, according to the defendant, this does not constitute a likelihood of confusion due to the lesser degree of similarity between the signs.

25. Regarding the overall impression, the defendant states that the only dominant and distinctive element of the trademark invoked is the figure of an owl which clearly differs from the three equally dominant elements of the contested sign (being the words *Guardian Group*, the word *Fatum* and the graphic figure).

26. The defendant also argues that the services of the trademark invoked are directed at business professionals as well as the general public. With regard to the general public, the defendant states that the average consumer does not frequently enter into contracts with respect to these services. For this reason, the level of attention will be much higher which means that the likelihood of confusion between the signs will be low.

27. The defendant requests that the Office should reject the opposition, register the contested sign and order the opponent to pay the fees and full (legal) costs incurred by the defendant.

III. DECISION

A.1 Likelihood of confusion

28. In accordance with article 2.14, 1 BCIP, the applicant or holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from the publication of the application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.3 (a) and (b) BCIP, or may give rise to confusion with its well-known trademark within the meaning of Article 6*bis* of the Paris Convention.

29. Article 2.3 (a) and (b) stipulates that "*In determining the order of priority for filings, account shall be taken of rights, existing at the time of filing and maintained at the time of the litigation, in: a. identical trademarks filed for identical goods or services; b. identical or similar trademarks filed for identical or similar goods or services, where there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the prior trademark.*"

30. According to case law concerning the interpretation of Directive 2008/95/EG of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trademarks (hereinafter: "Directive") the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (CJEU, Canon, C-39/97, 29 September 1998, Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003; Brussels, N-20060227-1, 27 February 2006).

Comparison of the signs

31. The wording of Article 4, 1 (b) of the Directive (cf. article 2.3, (b) BCIP) "there exists a likelihood of confusion on the part of the public" shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (CJEU, Sabel, C-251/95, 11 November 1997).

32. Global assessment 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 (Sabel and Lloyd, already cited).

33. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (CJEU, Limonchello, C-334/05 P, 12 June 2007). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of these components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (EGC, Matratzen, T-6/01, 23 October 2002 and El Charcutero Artesano, T-242/06, 13 December 2007).

34. The signs to be compared are the following:

| Opposition based on: | Opposition directed against: |
|---|--|
|  |  |

Conceptual comparison

35. Both signs share the word element 'Guardian', which in English means, inter alia, a person who is a protector or a keeper, in other words, a person who watches over something (see Shorter Oxford English Dictionary, 16th edition). The Office considers that the relevant public will understand this English word.

36. Generally, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003). The word element 'Financial Services' in the trademark invoked clearly refers to the services at hand and is therefore descriptive. From an economic point of view, the word 'group' in the contested sign is often used to indicate that different businesses belong to the same holding company (see Shorter Oxford English Dictionary, 16th edition). Regarding the word Fatum, the Office is of the opinion that part of the public may understand this as the Latin/Dutch word for fate. In the light of the descriptiveness of the word elements "financial services" and "group", the public will attach more importance to the distinctive words "Guardian" and "Fatum".

37. For the reasons mentioned above and considering the shared word 'Guardian', which is identical, the Office has concluded that, despite the different meaning of the other word elements, to a certain extent, there is an overall conceptual similarity.

Visual comparison

38. The trademark invoked and the contested sign are both combined verbal/figurative marks. The trademark invoked is a black and white sign consisting of the words "Guardian Financial Services". The words "Financial Services" are positioned below the word "Guardian" and are displayed in a smaller and different font than the word Guardian. On the left of the word Guardian, the sign shows a stylized image of an owl.

39. The contested sign consists of the words "Guardian Group" in the dark colour purple, as well as the word "Fatum" in the colour fuchsia positioned below the words Guardian Group. The word "Fatum" is smaller than the words "Guardian Group". Above the words Guardian Group, the sign shows an abstract figure consisting of multiple coloured small squares.

40. Both signs include the word element Guardian. The other word elements and figurative elements are different.

41. In complex signs (verbal and figurative elements), word elements often have a greater impact on the public than figurative elements. This is because the average consumer will not always analyse the signs and will often refer to a sign by using the word element (see EGC, Selenium-Ace, T-312/03, 14 July 2005). This is also applicable in the present case. Although both signs include a figurative element which will not be ignored by the public, this does not alter the fact that the word Guardian in the trademark invoked and the words Guardian Group in the contested sign have a clear and central position. The other word elements in both signs are displayed less strikingly and are therefore visually of minor importance.

42. It is also of importance that the consumer normally attaches more value to the first part of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004). In this case, the first word of the contested sign is identical to the most dominant word element of the trademark invoked. Due to this, the Office considers that, to a certain extent, there is an overall visual similarity.

Aural comparison

43. With regard to the aural comparison, it must be remembered that, in the strict sense, the phonetic reproduction of a complex sign corresponds to that of all its verbal elements, regardless of any specific graphic features, which fall more within the scope of the analysis of the sign on a visual level (EGC, PC Works, T-352/02,

25 May 2005 and Thai Silk, T-361/0821, April 2010). Both signs include the word 'Guardian' which is pronounced identically. The other word elements are pronounced differently.

44. With complex signs, the Office points out that, when referring to a trademark, the average consumer will not pronounce a caption or legend (EGC, Green by Missako, T-162/08, 11 November 2009) and a trademark comprising a number of terms will generally be abbreviated in order to make it easier to pronounce (EGC, BROTHERS by CAMPER, T-43/05, 30 November 2006). For this reason the Office considers that the public, when it aurally refers to the signs, will not pronounce the words 'Financial Services' and 'Fatum'.

45. In the light of the descriptiveness of the word 'Group', the Office considers that the aural attention will be focused on the word 'Guardian'. Furthermore, as mentioned above (paragraph 42), consumers generally take more note of the beginning of a sign than of its end (Mundicor, already cited). The first word of both signs is identical and has the same pronunciation.

46. For the reasons mentioned above, the Office considers that the signs are aurally similar.

Conclusion

47. Trademark and sign are aurally similar. Conceptually and visually, to a certain extent, there is a similarity.

Comparison of the services

48. In assessing the similarity of the goods and services concerned, all the relevant factors relating to these goods or services themselves should be taken into account. These factors include, inter alia, their nature, their end-users and their method of use and whether they are in competition with each other or are complementary (Canon, already cited).

49. With the comparison of the services of the trademark invoked and the services against which the opposition is filed, the services are considered only on the basis of what is expressed in the register or as indicated in the trademark application.

50. The services to be compared are the following:

| Opposition based on: | Opposition directed against: |
|--|--|
| Class 35 Business management; business administration; business research; office functions, namely collection, storage and processing of business and financial information, analysis of research and provision of reports; economic forecasting and analysis for business and financial purposes; payroll system consultancy and administration services; database management services; taxation services [accounting]; information, advisory and consultancy services relating to all the aforesaid; none of the aforesaid | Class 35 Advertising; business management; business administration; office functions; all the aforementioned services restricted to the field of insurances and financial affairs; all the aforementioned services not relating to the field of pharmaceutical, medicine, surgery, veterinary science and dentistry, sanitary emergencies, hospital and pre-hospital emergencies and orthopedic. |

| | |
|--|--|
| services relating to credit risk management, software solutions and data services. | |
| Class 36 Financial services; investment services; pension services; trusteeship services; management of pension funds, mutual funds, investment funds and unit trusts; actuarial services; insurance and assurance services; brokerage and valuation services; financial, pension and tax planning services; administration of pension funds; sale of annuities; mortgage and financial loan services; administration of insurance plans and claim adjustments; information, advisory and consultancy services relating to all of the aforesaid. | Class 36 Insurances and mediation in insurances; financial affairs; granting mortgages; monetary affairs; investments; capital investments; real estate affairs; advice on the aforementioned services; all the aforementioned services restricted to the field of insurances and financial affairs; all the aforementioned services not relating to the field of pharmaceutical, medicine, surgery, veterinary science and dentistry, sanitary emergencies, hospital and pre-hospital emergencies and orthopedic. |

Class 35

51. The services “*business management*”, “*business administration*”, “*office functions*” which are all restricted to the field of insurance and financial affairs are also part of the services for which the trademark invoked has been registered. According to established case law, if the goods and services of the earlier trademark also contain goods and services that are mentioned in the application for the contested sign, these goods and services are considered identical (see EGC, Fifties, T-104/01, 23 October 2002; Arthur et Félicie, T-346/04, 24 November 2005 and Prazol, T-95/07, 21 October 2008).

52. The contested sign is also registered for “*Advertising*” which is not similar to the services of the trademark invoked. Although the opponent might use advertising services as part of his activities, the essential difference is that the registration of advertising services for the contested sign in class 35 will be executed for the benefit of third parties. Furthermore, the nature and intended purpose of these services are different. In addition, these services are usually not performed by the same undertakings and the public will not consider these services to have the same origin. For these reasons, the mere fact that any undertaking develops similar advertising activities as part of its own business management does not mean that these activities are similar.

Class 36

53. The services “*insurances and mediation in insurance*” and “*advice on the aforementioned services*” all restricted to the field of insurances and financial affairs of the contested sign are identical or highly similar to the services “*insurance and assurance services*”, “*administration of insurance plans and claim adjustments*” mentioned in class 36 of the trademark invoked. The nature and purpose of these services are the same. Furthermore, these services will be offered by the same undertakings.

54. The foregoing also applies to the services “*financial affairs*”, “*monetary affairs*”, “*investments*”, “*capital investments*” and “*advice on the aforementioned services*”, all restricted to the field of insurances and financial affairs of the contested sign. These services are identical or highly similar to the services “*financial services*”, “*investment services*” and “*financial, pension and tax planning services*”, as well as the insurance services for which the trademark invoked is registered.

55. With regard to the services of “*granting mortgages*”, the Office considers that these services are identical to the services “*mortgage and financial loan services*” of the trademark invoked. The nature and purpose are the same and the services are offered by the same undertakings.

56. The Office considers that the services “real estate affairs” could relate to services which concern the process of acquiring a mortgage or any other type of financial loan service. The services are also offered by the same undertakings. For this reason these services are similar to the services “mortgage and financial loan services” mentioned in class 36 of the trademark invoked (see also BOIP, iZio, opposition decision 2002926, 30 September 2009).

Conclusion

57. The services are partly identical or highly similar and partly not similar.

A.2 Global assessment

58. When assessing the likelihood of confusion, in particular the level of attention of the relevant public, the similarity of the goods and services in question and the similarity of the signs are important factors.

59. The average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (Lloyd Schuhfabrik Meyer, already cited). It should 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 the present case, the services at issue are intended for all consumers, both the public at large and professionals in the field of financial services. The level of attention of professionals will be, in essence, higher than the average. Furthermore, the level of attention of the public at large with regard to the services of class 36 will also be high, since services are involved, which may have important financial consequences and are not sought on a frequent basis. The level of attention of the relevant public will therefore be higher than average with regard to the services of class 36. Regarding the services of class 35, the level of attention will be regarded as normal.

60. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors to be taken in account, particularly between the level of similarity of the signs and of the goods or services which they cover. A lesser degree of similarity between the relevant goods or services can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd Schuhfabrik Meyer, already cited). In this case some of the contested services are identical or highly similar to the services of the opponent.

61. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (Canon, Sabel and Lloyd Schuhfabrik Meyer, already cited).

62. The defendant argues that the signs lack distinctive character because the word Guardian is descriptive (paragraph 22). With regard to this argument, the Office considers that the word guardian does not characterize financial services such as (advice on) insurance, loans, mortgages and the management of business

affairs itself. On the contrary, these services may include strategies that put a (high) risk on a person's financial status which is the opposite of the main goal of a guardian, which is to keep something safe.

63. Furthermore, the trademark invoked as a whole has a normal distinctive character *per se*, because, contrary to the opponent's point of view (paragraph 22), it does not designate any characteristics of the services for which registration is sought.

64. Account must also be taken of the circumstance that normally, the average consumer perceives a mark as a whole and does not proceed to analyse its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance 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.

65. For this reason, the Office is of the opinion, notwithstanding the high level of attention of the public with regard to some of the services, that the relevant public might believe that these services come from the same undertaking or from economically-linked undertakings.

B. Other factors

66. With regard to the defendant's argument that the trademark invoked is descriptive, since it is also part of several other trademark registrations in relation to the goods and services in the classes 35 and/or 36 (paragraph 22), the Office considers that the possibility cannot be entirely excluded that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of confusion between two marks at issue. However, that possibility can be taken into consideration only if, at the very least, during the proceedings before the Office, the defendant duly demonstrated that such coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks upon which it relies and the opponent's earlier mark on which the opposition is based, and provided that the earlier marks concerned and the marks at issue are identical (see EGC Top iX, Case T-57/06, 7 November 2007 and Life Blog, T-460/07, 20 January 2010). However, in this case the evidence that coexisting registrations on the market were identical has not been submitted. Furthermore, the defendant has not shown that any coexistence was based on the absence of a likelihood of confusion.

C. Conclusion

67. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion for the identical and highly similar services.

IV. DECISION

68. The opposition with number 2009808 is partly justified.

69. Benelux application with number 201367 will not be registered for the following services which are similar.

- Class 35: Business management; business administration; office functions; all the aforementioned services restricted to the field of insurances and financial affairs; all the aforementioned services not

relating to the field of pharmaceutical, medicine, surgery, veterinary science and dentistry, sanitary emergencies, hospital and pre-hospital emergencies and orthopedic.

- Class 36 (*all services*)

70. Benelux application with number 201367 will be registered for the following services which are not similar.

- Class 35: Advertising; all the aforementioned services restricted to the field of insurances and financial affairs; all the aforementioned services not relating to the field of pharmaceutical, medicine, surgery, veterinary science and dentistry, sanitary emergencies, hospital and pre-hospital emergencies and orthopedic.

71. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP in conjunction with rule 1.32(3) Implementing Regulations, as the opposition is partly justified.

The Hague, 2 September 2015

Eline Schiebroek
(*rapporteur*)

Saskia Smits

Diter Wuytens

Administrative officer: Rudolf Wiersinga