

O-001-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3035455
BY INTUIT INC.
TO REGISTER THE TRADE MARK
MINT
IN CLASSES 9, 35 & 36
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER Nos. 402643 BY
THE ROYAL BANK OF SCOTLAND GROUP PLC**

BACKGROUND

1) On 18 December 2013, Intuit Inc. (hereinafter the applicant) applied to register the trade mark MINT in respect of the following goods and services:

Class 9: Computer software for personal and small business financial management; computer software for transaction management, financial planning, financial management, bill tracking and management, expense tracking and management, accounting, and taxable item tracking and management; computer software for creating reports and graphs; computer software for forecasting and analysis of data; computer software for data aggregation; computer software for providing alerts; computer software for enabling users to retrieve account balance and transaction information using mobile phones, smart phones, and mobile telecommunication networks.

Class 35: Business management; business administration; office functions; accounting; book-keeping; administrative accounting; business management advice and assistance; company and business information; compilation of statistics; price comparison services; compilation of information into computer databases; data search in computer files for others; economic forecasting; computerised file management; providing information, news, opinions and advice in the fields of accounting, tax preparation and planning, personal budgeting, household budgeting and consumer spending, including via computer or communication networks, the internet, social media and software applications; providing comparisons of the products and services of others, including through computer or communication networks, the internet, social media and software applications; providing economic forecasting and analysis, including through computer or communication networks, the internet, social media and software applications.

Class 36: Small business financial management services; personalised analysis of online banking transactions; transaction management; financial analysis; bill tracking; expense tracking; taxable item tracking; forecasting and analysis of financial data; financial data aggregation; providing information, news, opinions and advice in the field of banking including via computer or communication networks, the internet, social media and software applications.

2) The application was examined and accepted, and subsequently published for opposition purposes on 9 May 2014 in Trade Marks Journal No.2014/020.

3) On 7 August 2014 The Royal Bank of Scotland Group Plc (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

| Mark | Number | Filing & registration dates | Class | Specification relied upon |
|------|----------------|-----------------------------|-------|---|
| MINT | UK 2360715G | 13.04.04 19.12.08 | 9 | Publications, newsletters, magazines, periodical pamphlets and leaflets; all in electronic form supplied on-line from databases or from facilities provided on the Internet (including websites); publications, newsletters, magazines, periodicals, pamphlets and leaflets; all in digital or electronic format supplied on-line; DVDs, CD-ROMs and diskettes; all relating to financial, banking, credit, credit card, mortgage, savings, loan, insurance and travel agency services and promotional services including incentive schemes, loyalty cards, purchase group clubs and discount offers made in connection with financial, banking, credit, credit card, mortgage, savings, loan and insurance services; charge cards, cash cards, bank cards, cheque cards, credit cards, debit cards; magnetically encoded cards for carrying data; multi-function cards for |

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|------|----------------|----------------------|----|---|
| | | | | financial services; ATM (Automated Teller Machine) cards, access cards, identification cards, integrated chip cards and pre-paid cards and supporting systems related thereto; ATM machines, point of sale cards and readers; computer software; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web pages and websites); computer software and telecommunications apparatus (including modems) to enable connection to databases; parts and fittings for all the aforesaid goods; hand-held devices for payment and value exchange services and other personal information services; remote control devices; data carriers; computer software for the provision of credit card services, mortgage services, banking services and financial services; computer software providing information relating to credit, credit card services, mortgages, banking and finance; computer software to enable the searching of data relating to the foregoing. |
| | | | 16 | Printed matter; books, magazines, leaflets, periodical publications, newsletters, brochures, information materials and information packs; all relating to financial, banking, credit, credit card, mortgage, savings, loan, insurance and travel agency services and promotional services including incentive schemes, loyalty cards, purchase group clubs and discount offers made in connection with financial, banking, credit, credit card, mortgage, savings, loan and insurance services; gift vouchers, payment vouchers, discount vouchers, vouchers for travel by land, sea and air. |
| | | | 35 | Organisation, administration, operation and supervision of loyalty schemes and sales information on incentive schemes, buying group offers; organisation, operation, administration and supervision of discounts for goods and services; the bringing together for the benefit of others of a variety of alcoholic beverages, books, video cassettes, CDs and DVDs to enable customers to conveniently view and purchase those goods from a mail order catalogue, by telecommunication, from the Internet or by providing of auctions; information, advisory and consultancy services relating to all the aforesaid services. |
| | | | 36 | Banking services; mortgage services, automated banking services; payment and credit services; credit brokerage; insurance services; financial consultation services; financial information services; financial advisory services; advice and enquiries regarding credit; services for the provision of credit; mortgage services; consultancy, information and advisory services relating to all the aforesaid services. |
| MINT | CTM 3899333 | 24.06.04 03.11.05 | 9 | Charge cards, cash cards, bank cards, cheque cards, credit cards, debit cards; magnetically encoded cards for carrying data; multifunction cards for financial services; ATM (Automated Teller Machine) cards, access cards, identification cards, integrated chip cards and pre-paid cards and supporting systems related thereto; ATM machines, point of sale card readers; computer software; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web pages and web sites); computer software and telecommunications apparatus (including modems) to enable connection to databases; parts and fittings for all of the aforesaid goods; data carriers; computer software for the provision of credit card services, mortgage services, banking services and financial services; computer software to enable the searching of data relating to the foregoing; publications, newsletters, magazines, periodicals, pamphlets and leaflets, all in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); publications, newsletters, magazines, periodicals, pamphlets and leaflets, all in digital or electronic format or provided by CD-ROM or diskette. |
| | | | 36 | Financial services; credit card, debit card, charge card, cash card and bank card services; banking services; mortgage services; monetary transfer; payment services; automated banking services; bill payment services; payment and credit services; account debiting services; cheque encashment services; credit brokerage; automatic cash dispensing services, automatic teller machine services; insurance services; financial consultation services; financial analysis and providing reports; financial information services; financial advisory services; computerised financial services; advice and enquiries regarding credit; services for the provision of credit; acceptance of deposits; discounts of bills (notes); domestic remittance; travellers cheque services; providing loans and savings accounts services; providing savings bonds; managing saving and investments for others; providing savings accounts and services on-line; information services relating to credit, credit card services, mortgages, banking and finance; advisory, consultancy and information services relating to all of the aforesaid services. |
| MINT | CTM | 15.09.06 | 9 | Telecommunications, telephonic and communications apparatus and instruments; data communication apparatus and instruments; apparatus and |

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|--------|---------|----------|----|--|
| MOBILE | 5317102 | 18.06.10 | | instruments for the processing, transmission, reproduction, storage, display, logging, protection, reception and retrieval of data, information, sounds, images, text, audio, graphic images or video or combination thereof; encoded cards; smart cards; magnetic data carriers; cards bearing magnetic data media; media for storing information, data, images and sound; machine readable media; personal digital assistants; satellite receiving and transmission apparatus and instruments; adapters for use with telecommunications apparatus; telephones; mobile telephones; electronic personal organisers; pocket and laptop computers; downloadable ringtones and graphics for mobile phones; customised display screens downloaded to telecommunications apparatus; electronic publications (downloadable) provided on-line from a computer database, the Internet or other electronic network; charge cards, cash cards, bank cards, cheque cards, credit cards, debit cards; magnetically encoded cards for carrying data; smart cards, encoded cards and multifunction cards for financial transactions and financial services; ATM (Automated Teller Machine) cards, access cards, identification cards, integrated chip cards and pre-paid cards, and supporting systems related thereto; ATM machines, cash dispensers, apparatus for payment with encoded cards; automatic paying-in and deposit machines; point of sale card readers; computer software; computer programs; computer operating programs and computer operating systems; computer hardware; computers; computer software and hardware for managing voice mail; computer software and hardware for text messages, SMS (short message system) messages, MMS (multimedia messaging service) messages, MIM (mobile instant messaging services); EMS (enhanced messaging services) or mobile email; application software for mobile telephones; interactive and multi-media software, materials and equipment; calculating machines; data processing apparatus and equipment; software, data, text or images supplied by electrical or electronic means; computer software and publications in electronic or machine readable form; computer software and software upgrades supplied on-line from computer databases, computer networks, global computer networks or the Internet; electronic publications, newsletters, magazines, periodicals, pamphlets, leaflets, instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites); publications, newsletters, magazines, periodicals, pamphlets and leaflets, all in digital or electronic format or provided by CD-ROM or diskette; computer software for facilitating or enabling access to business services, financial services, information services and e-mail services; computer software for use in network communications; computer software for facilitating electronic communications; computer software and telecommunications apparatus (including modems) to enable connection to databases, computer networks, global computer networks and the Internet; computer software to enable searching of data; interactive computer software and interactive computer discs; software for interrogating a bank account by means of text message; compact discs; diskettes, CD-ROMs, DVDs; computer software to enable the searching of data; parts, fittings and software for all of the aforementioned goods. |
| | | | 16 | Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters, office requisites (except furniture); instructional and teaching materials (except apparatus); wrapping and packaging materials; plastic materials for packaging; printers' type; printing blocks; printed publications; advertising materials; brochures, vouchers, cheques, cheque books, paying-in books; bank cards, cash cards, cheque cards, debit cards, credit cards, charge cards; cheque book holders. |
| | | | 35 | Advertising; advisory, consultancy, information and helpline services relating to all of the aforementioned services; the aforementioned services also provided by a customer care network. |

- a) The opponent contends that its marks UK 2360715G and CTM 3899333 and the mark applied for are identical and that the goods and services for which its marks are registered are identical and/or similar to those applied for by the applicant. It contends that the application offends against Section 5(1) and (5)(2)(a) of the Act.
- b) The opponent contends that its mark CTM 5317102 and the mark applied for are similar and that the goods and services for which its mark is registered are identical and/or similar to those

applied for by the applicant. It contends that the application offends against Section 5(2)(b) of the Act.

- c) The opponent contends that it has reputation and goodwill in its mark UK 2360715G having used it in the UK since January 2004 in relation to financial services and related goods and services. Use of the mark applied for would take unfair advantage of the opponent's reputation. By their nature financial services depend upon consumers trust in the good reputation of the supplier, if the applicant provided an inferior service then the opponent would suffer damage. There is a high risk of misrepresentation as the marks and goods and services are very similar and/or identical. It contends that the application offends against Sections 5(3) and 5(4)(a) of the Act.

4) On 15 January 2015 the applicant filed a counterstatement, basically denying that the registrations are similar. The applicant requested proof of use other than on credit cards.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Both sides provided written submissions which I shall refer to as and when necessary in my decision.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 16 March 2015, by Richard Curtin the Head of Intellectual Property for the opponent. He states that the opponent used its MINT mark substantially since 2004 and as such acquired significant reputation and goodwill. The mark was used in the provision of financial, payment and credit card services. He states that there were three levels of credit card which depended upon income levels. These were MINT Classic, MINT Gold and MINT Platinum. He provides the following information:

| Year | Number of UK MINT customers | Number of transactions in the EU | Value of purchases in the EU £million | Number of balance transfers worldwide |
|------|-----------------------------|----------------------------------|---------------------------------------|---------------------------------------|
| 2007 | 1,217,000 | 507,000 | 45.1 | 262,000 |
| 2008 | 1,011,000 | 422,646 | 43 | 244,278 |
| 2009 | 768,000 | 280,367 | 28.7 | 86,292 |
| 2010 | 620,000 | 228,165 | 22.7 | 68,161 |
| 2011 | 472,000 | 156,202 | 15.6 | 58,445 |
| 2012 | 416,000 | 119,667 | 11.2 | 62,909 |
| 2013 | 381,000 | 104,923 | 10.1 | 42,458 |
| 2014 | 343,000 | 96,000 | 9.3 | 21,000 |

7) Mr Curtin states that the MINT credit card is well known because of its distinctive shape, having a curved bottom right-hand corner. He states that, since 2009, the opponent has not offered the MINT credit card to the general public instead it has only been offered to existing RBS customers. However, a re-launch to the general public at some point in the future has not been ruled out. The credit card is advertised by sending out mail shots with special offers to its customer base. In addition to paper statements customers can also receive SMS or email messages reminding them that payment is due. He also states that card membership also offered free online account management, travel accident insurance, travel discount services and, from 2004-2009, loans. He provides the following exhibits:

- RC1: A photograph of the MINT credit card showing its curved right-hand corner.
- RC2: Copies of press articles in UK national papers such as *The Daily Mail*; *Sunday Times*; *Times*; *Telegraph* and *Daily Mirror* from 2006 to 2007 which mention the MINT credit card.
- RC3: Copies of press articles in UK regional papers from 2008, such as the *Birmingham Post*, *East Anglian Times*, *Eastern Daily Press* and *Yorkshire Post* as well as additional articles from UK national newspapers, all of which mention the MINT credit card.
- RC4: Copies of press articles, dated 2009, from national and local papers such as *The Telegraph*, *Independent*, *Daily Record*, *Daily Mail*, *Daily Mirror*, *Daily Express* and *Sunday Times* in the UK which mention the MINT credit card. At pages 79 and 84 are articles, dated 4 April 2009 and 18 February 2009 respectively, both of which mention MINT loans.
- RC5: Screenshots from television advertisements for the MINT credit card said by Mr Curtin to be prior to 2009 but actually undated.
- RC6: Copies of letters advertising the MINT credit card to RBS customers sent between July 2011 and July 2014. During 2013 some 771,715 of this type of letter were sent out.
- RC7: An example of an undated paper set of terms and conditions sent to customers.
- RC8: Printouts, dated March 2015, from the RBS website showing use of the mark MINT in relation to credit cards.
- RC9: A copy of the Consumer Credit license, dated 2010, held by RBS allowing them to offer credit card and debt collecting services under the MINT mark in the UK. The license does not have an expiry date.
- RC10: A copy of the Financial Conduct Authority (FCA) record for RBS valid from April 2014.
- RC11: Copies of Notices of Variations sent to MINT customers advising them of changes to the terms and conditions pertaining to the MINT credit card. These are dated between November 2011 and June 2014.

APPLICANT'S EVIDENCE

8) The applicant filed a witness statement, dated 29 June 2015, by Melanie Worsdall the applicant's Trade Mark Attorney. She provides the exhibits listed below:

- MW1: A print out from www.techcrunch.com containing background details about the founding of Mint.com. This discusses the activities in the USA of "Mint" offering personal financial accounts.
- MW2: An undated print out from www.mint.com containing details of the funding of the Mint.com platform.
- MW3: Print outs from www.intuit.com containing details about the applicant's purchase of the USA based business called Mint.com and the 1.5 million American users as at 2010. The company is said to offer online personal finance services and is valued at US\$170 million.

- MW4: A print out from the United States Patent and Trademark Office website showing details of the trade mark MINT and leaf device, registration number 3526377. This was registered in November 2008.
- MW5: Print outs from www.investopedia (dated 17 December 2014), www.modestmoney.com (dated 25 June 2015), www.stevieawards.com (dated 25 June 2015) and www.techland.time.com (dated 25 June 2015) said to contain details of industry awards, ranking and feedback about the applicant's MINT offering. It merely has the title "50 best Android Apps for 2013". It mentions Mint.com but most of the sheet cannot be read as it is so poorly printed. It would appear to be sheet 25 of 52 but as only one sheet is provided it is difficult to judge what to make of this. All of these websites appear to be aimed at the market in the USA and discuss the performance of an American company in the USA.

OPPONENT'S EVIDENCE IN REPLY

9) The opponent filed a witness statement, dated 21 August 2015, by Mr Curtin who has provided evidence previously in this case. He repeats his earlier claim that his company offered travel accident insurance, emergency assistance, cash withdrawal, convenience cheques and loans under its MINT mark in the UK. He contends that such services would fall within a number of the terms for which the mark in suit is sought to be registered. He denies that his company is phasing out its services under the MINT mark. It is merely offered only to existing RBS customers at present. He states that it is possible that it may be launched to the general public at some point but it remains in use by a significant number of customers. He points out that the applicant offers to find customers better interest rates on their credit cards and amongst other information requires customers to provide details of bank and credit cards. This shows, he contends, that there is a clear link between the activities of the two parties.

10) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

11) The first ground of opposition is under section 5(2)(b) which reads:

"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."

12) An "earlier trade mark" is defined in section 6, the relevant part of which states:

"6.-(1) In this Act an "earlier trade mark" means -

(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.”

13) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The applicant requested that the opponent provide proof of use and, given the interplay between the date that the opponent’s marks were registered (UK 2360715G 19 December 2008 & CTM 3899333 3 November 2005) and the date that the applicant’s mark was published (9 May 2014), the proof of use requirement bites. However, in respect of the opponent’s mark CTM 5317102 this was only registered on 18 June 2010 and so the proof of use section does not apply. Section 6A of the Act states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

14) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its marks has been made. In the instant case the publication date of the application was 9 May 2014, therefore the relevant period for the proof of use is 10 May 2009 – 9 May 2014. In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

15) Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

16) Also in *Laboratoire de la Mer* Trade Mark [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Mummery L.J. stated that:

“31. After some hesitation I have reached a different conclusion from Blackburne J. on the application of the Directive, as interpreted in *Ansul* and *La Mer*, to the rather slender facts found by Dr Trott.”

32. Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of *consumers and end users* of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.

33. Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the LA MER mark were sold by Goëmar and bought by Health Scope Direct on that market in arm's length transactions. The modest amount of the quantities involved and the more restricted nature of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports by a single importer could suffice for determining whether there was genuine use of the mark on the market.

34. There was some discussion at the hearing about the extent to which Goëmar was entitled to rely on its intention, purpose or motivation in the sales of the goods bearing the mark to Health Scope Direct. I do not find such factors of much assistance in deciding whether there has been genuine use. I do not understand the Court of Justice to hold that subjective factors of that kind are relevant to genuine use. What matters are the objective circumstances in which the goods bearing the mark came to be in the United Kingdom. The presence of the goods was explained, as Dr Trott found, by the UK importer buying and the French manufacturer selling quantities of the goods bearing the mark. The buying and selling of goods involving a foreign manufacturer and a UK importer is evidence of the existence of an economic market of some description for the goods delivered to the importer. The mark registered for the goods was used on *that* market. That was sufficient use for it to be genuine use on the market and in *that* market the mark was being used in accordance with its essential function. The use was real, though modest, and did

not cease to be real and genuine because the extinction of the importer as the single customer in the United Kingdom prevented the onward sale of the goods into, and the use of the mark further down, the supply chain in the retail market, in which the mark would come to the attention of consumers and end users.”

17) Whilst Neuberger L.J. (as he then was) stated:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

18) When considering the evidence filed I take into account the comments in *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when

supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

19) I also look to the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, where Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

20) I now turn to consider what services the marks has been used upon and the specification they are entitled to rely on for the purposes of the comparison. Mr Justice Arnold (as he now is) in his judgments as The Appointed Person in *Nirvana Trade Mark BL O-262-06* and *Extreme Trade Mark BL O-161-07* comprehensively examined the case law in this area. His conclusion in *Nirvana* was that:

“(1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].”

21) The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 (“Aladdin”)* held that:

“43. Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44. With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is

impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

22) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as Appointed Person summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

23) The opponent's marks are registered for a wide range of goods and services. The applicant accepted that the opponent had used its mark in respect of credit cards. I shall first consider the use of UK 2360715G. Although, at exhibit RC4, there is evidence of loans being offered this is prior to the relevant date. There is evidence of credit balance transfers being offered within the period set out above and these I believe could be regarded as a loan as they are intended to pay off another lender and offer lower interest rates for a set period, thereby reducing the monthly outgoings. There is no corroborative evidence in respect of the other services claimed to have been offered. The evidence of Mr Curtin was challenged in the submissions filed by the applicant along with the applicant's evidence. Although Mr Curtin reiterated the claims he offered no exhibits showing actual use of the marks on the services claimed such as travel insurance. Such claims would have been relatively easy to back up with leaflets or advertisements from the period concerned. The absence of such detail when the opponent has provided considerable detail on credit card services dating further back than five years, when the applicant had already conceded that the opponent had used its mark on such services leads one to doubt the claims of Mr Curtin. The opponent has not shown that it provided printed matter other than letters to customers, which I do not believe shows use on any of the goods in class 16, nor the printed matter goods in class 9. Whilst the opponent provided its customers with credit cards and so these goods in class 9 have been shown to have been used in relation to the mark MINT, no use has been shown in respect of ATM machines or cards. I accept that most credit cards these days can retrieve cash from an ATM but I am not sure if this was the case in the relevant period and without evidence I am unwilling to assume such use. In the provision of credit cards to customers the opponent can be said, in my opinion, to have used its mark on a number of the services listed in Class 36. It is clear that in considering whether it should issue credit cards to clients the opponent had to provide a payments service, it would also consider the credit worthiness of clients prior to issuing cards and indeed thereafter. I have listed the services I consider relevant at paragraph 30 below.

24) Turning to the issue of CTM3899333. I am aware of the conflict between recent cases regarding use of a CTM in one member state. Where there are conflicting decisions of the EU and UK courts the tribunal will normally follow the case law of the EU courts where this interprets the terms of the Trade

Mark Directive. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), Judge Hacon considered the judgment of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, and what is now required in order to show genuine use of Community trade marks (“CTMs”). The key part of the judgment of the national court is as follows:

“26. If I am right about the effect of the Court's judgment, it means that there is a distinction between national marks and Community marks when it comes to assessing genuine use. For national marks the geographical extent of use is a factor to be taken into account, but it is apparently of no great weight – see *Sunrider*. In respect of Community marks the geographical extent of use is, in the general run, crucial: it must extend at least beyond the boundaries of one Member State. By way of a non-exhaustive exception to the general rule, this does not apply where the market for the goods or services is confined to one Member State.” (emphasis added)

25) OHIM has not interpreted the CJEU’s judgment in *Leno Merken* as introducing a default requirement that use of CTMs must cross national boundaries in order to be considered as genuine use in the Community. Further, in *Now Wireless Ltd v OHIM*, Case T-278/13, the General Court of the EU accepted that use of a CTM for internet and computing services provided in London and the Thames valley constituted genuine use of the CTM in the Community. In the course of doing so the General Court expressly rejected a requirement for use of CTMs to cross national boundaries (see paragraphs 44 to 53 of the judgment). This case does not appear to have been drawn to the attention of the national court in *The Sofa Workshop* case. Further, the General Court repeated its interpretation of *Leno Merken* in its subsequent judgment in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment).

26) Section 3(1) of the European Communities Act 1972 requires national courts and tribunals to interpret EU instruments (such as the Trade Mark Directive) in accordance with the decisions of the European courts. Further, national courts and tribunals are required to interpret national law in accordance with underlying EU law, so far as possible: *Marleasing S.A. v La Comercial Internacional de Alimentación S.A.*, CJEU, Case C-106/89. Subject to further judicial clarification, the Registrar will therefore follow the interpretation of *Leno Merken* adopted by the General Court rather than the interpretation adopted by the national court in *The Sofa Workshop* case.

27) Consequently, in trade mark opposition and cancellation proceedings the Registrar will, subject to further guidance from the courts, continue to entertain the possibility that use of a CTM in an area of the EU corresponding to the territory of one Member State may be sufficient to constitute genuine use of a CTM. This will apply even where there are no special factors, such as the market for the goods/services being limited to that area of the EU.

28) This should not be understood to mean that use in an area of the EU corresponding to the territory of one Member State will always be accepted as sufficient to show genuine use of a CTM. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the CTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the EU during the relevant 5 year period. In making such assessments the Registrar is required to consider all relevant factors, including:

- i) The scale and frequency of the use shown;
- ii) The nature of the use shown;
- iii) The goods and services for which use has been shown;

- iv) The nature of those goods/services and the market(s) for them;
- v) The geographical extent of the use shown.

29) It cannot therefore be ruled out, particularly where the scale and frequency of the use of a CTM is limited, that showing the full geographical extent of the use of the CTM in the EU could be decisive. Those practicing before the IPO should bear this in mind when deciding what evidence is required in order to establish genuine use of a CTM in national trade mark opposition and cancellation proceedings.

30) In the instant case the opponent has provided figures showing the number of transactions in the EU and the value of such transaction in Euros. Other than this all of the evidence points to use in the UK. The result is that I accept that the opponent has shown use of its CTM upon credit cards and associated services. The wording of the CTM specification is slightly different from the UK trade mark. To my mind the opponent has shown use of its marks as follows:

| | |
|-------------|---|
| UK 2360715G | In class 9: Credit cards. In Class 36: Payment and credit services; credit brokerage; advice and enquiries regarding credit; and services for the provision of credit; consultancy, information and advisory services relating to all the aforesaid services. |
| CTM 3899333 | In Class 9: Credit cards. In Class 36: Financial services credit card, monetary transfer; payment services; payment and credit services; credit brokerage; advice and enquiries regarding credit; services for the provision of credit; information services relating to credit, credit card services, |

31) When considering the issue under section 5(2)(b) I take into account the following principles which are 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

32) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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. 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.”

33) To my mind, the average consumer for the goods and services applied for by the applicant would be the general public including businesses. The goods and services vary enormously in terms of complexity and price. Some of the items of software could be sold in retail outlets or via the internet, whilst a number of the services would require the purchaser to provide information to the service provider necessitating a conversation be it face to face, over the telephone or on-line. A lot of the goods and services are based around financial information and would usually be considered by those aged eighteen years or older as well as businesses. Even if the goods or services require the provision of information the initial selection is likely to take place from advertisements online, in printed advertisements or from a compendium of information such as yellow pages, although I must

also take into account word of mouth recommendations. Therefore, I consider the visual aspect as being the most important in selection although aural considerations also apply. Any good or service concerned with financial issues, particularly where the customer has to provide personal information is likely to be very carefully considered, whereas a piece of software will be considered to ensure it is suitable for the computer owned by the customer but to a lesser level. **Overall the average consumer for these types of goods and services is likely to pay a medium to high degree of attention to the selection of such items.**

Comparison of goods and services

34) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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”.

35) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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

36) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

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

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

38) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

39) Whilst on the other hand:

".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

40) The goods and services of the two parties are:

| Applicant's goods and services | Opponents' goods and services |
|---|--|
| Class 9: Computer software for personal and small business financial management; computer software for transaction management, financial planning, financial management, bill tracking and management, expense tracking and management, accounting, and taxable item tracking and management; computer software for creating reports and graphs; computer software for forecasting and analysis of data; computer software for data aggregation; computer software for providing alerts; computer software for enabling users to retrieve account balance and transaction information using mobile phones, smart phones, and mobile telecommunication networks. | UK 2360715G: In class 9: Credit cards. CTM 3899333: In Class 9: Credit cards. CTM 5317102: Telecommunications, telephonic and communications apparatus and instruments; data communication apparatus and instruments; apparatus and instruments for the processing, transmission, reproduction, storage, display, logging, protection, reception and retrieval of data, information, sounds, images, text, audio, graphic images or video or combination thereof; encoded cards; smart cards; magnetic data carriers; cards bearing magnetic data media; media for storing information, data, images and sound; machine readable media; personal digital assistants; satellite receiving and transmission apparatus and instruments; adapters for use with telecommunications apparatus; telephones; mobile telephones; electronic personal organisers; pocket and laptop computers; downloadable ringtones and graphics for mobile phones; customised display screens downloaded to telecommunications apparatus; electronic publications (downloadable) provided on-line from a computer database, the Internet or |

other electronic network; charge cards, cash cards, bank cards, cheque cards, credit cards, debit cards; magnetically encoded cards for carrying data; smart cards, encoded cards and multifunction cards for financial transactions and financial services; ATM (Automated Teller Machine) cards, access cards, identification cards, integrated chip cards and pre-paid cards, and supporting systems related thereto; ATM machines, cash dispensers, apparatus for payment with encoded cards; automatic paying-in and deposit machines; point of sale card readers; computer software; computer programs; computer operating programs and computer operating systems; computer hardware; computers; computer software and hardware for managing voice mail; computer software and hardware for text messages, SMS (short message system) messages, MMS (multimedia messaging service) messages, MIM (mobile instant messaging services); EMS (enhanced messaging services) or mobile email; application software for mobile telephones; interactive and multi-media software, materials and equipment; calculating machines; data processing apparatus and equipment; software, data, text or images supplied by electrical or electronic means; computer software and publications in electronic or machine readable form; computer software and software upgrades supplied on-line from computer databases, computer networks, global computer networks or the Internet; electronic publications, newsletters, magazines, periodicals, pamphlets, leaflets, instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites); publications, newsletters, magazines, periodicals, pamphlets and leaflets, all in digital or electronic format or provided by CD-ROM or diskette; computer software for facilitating or enabling access to business services, financial services, information services and e-mail services; computer software for use in network communications; computer software for facilitating electronic communications; computer software and

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|--|--|
| | <p>telecommunications apparatus (including modems) to enable connection to databases, computer networks, global computer networks and the Internet; computer software to enable searching of data; interactive computer software and interactive computer discs; software for interrogating a bank account by means of text message; compact discs; diskettes, CD-ROMs, DVDs; computer software to enable the searching of data; parts, fittings and software for all of the aforementioned goods.</p> |
| <p>Class 35: Business management; business administration; office functions; accounting; book-keeping; administrative accounting; business management advice and assistance; company and business information; compilation of statistics; price comparison services; compilation of information into computer databases; data search in computer files for others; economic forecasting; computerised file management; providing information, news, opinions and advice in the fields of accounting, tax preparation and planning, personal budgeting, household budgeting and consumer spending, including via computer or communication networks, the internet, social media and software applications; providing comparisons of the products and services of others, including through computer or communication networks, the internet, social media and software applications; providing economic forecasting and analysis, including through computer or communication networks, the internet, social media and software applications.</p> | <p>CTM 5317102: Advertising; advisory, consultancy, information and helpline services relating to all of the aforementioned services; the aforementioned services also provided by a customer care network.</p> |
| <p>Class 36: Small business financial management services; personalised analysis of online banking transactions; transaction management; financial analysis; bill tracking; expense tracking; taxable item tracking; forecasting and analysis of financial data; financial data aggregation; providing</p> | <p>UK 2360715G: In Class 36: Payment and credit services; credit brokerage; advice and enquiries regarding credit; and services for the provision of credit; consultancy, information and advisory services relating to all the aforesaid services.</p> <p>CTM 3899333: In Class 36: Financial services credit card, monetary transfer;</p> |

| | |
|---|---|
| <p>information, news, opinions and advice in the field of banking including via computer or communication networks, the internet, social media and software applications.</p> | <p>payment services; payment and credit services; credit brokerage; advice and enquiries regarding credit; services for the provision of credit; information services relating to credit, credit card services.</p> <p>CTM 5317102: Class 16: cheques, cheque books, paying-in books; bank cards, cash cards, cheque cards, debit cards, credit cards, charge cards; cheque book holders.</p> |
|---|---|

41) I shall first consider the position under UK 2360715G. In Class 9 there are no identical or highly similar goods to the opponent's "credit cards". The nearest that the goods of the applicant get to the goods of the opponent is "computer software for transaction management" which would be required for the provision of credit card services, but if one were simply producing credit cards for others to issue then these goods are not similar, nor are they complementary. **To my mind, the goods of the two parties in Class 9 are not similar.** Moving onto the applicant's services in class 35, **I do not consider any of the goods or services of the opponent under this mark to be similar to the applicant's class 35 services.** Lastly, turning to the services in Class 36 whereas all of the opponent's services revolve around the issue of credit the applicant's services do not mention credit at all. It is clear that in order to provide a credit service the opponent must carry out "transaction management". But it is not obvious that it offers this service to its customers. In order to offer credit one must be licensed and subject to considerable regulation, whereas offering an analysis of transactions or tracking does not require, as far as I am aware, a licence. To my mind, the class 36 services of the two parties are not similar nor are they complementary in the sense that they are indispensable to each other.

42) I next turn to consider the position under CTM 3899333. In Class 9 there are no identical or highly similar goods to the opponent's "credit cards". The nearest that the goods of the applicant get to the goods of the opponent is "computer software for transaction management" which would be required for the provision of credit card services, but if one were simply producing credit cards for others to issue then these goods are not similar, nor are they complementary. To mind the goods of the two parties are not similar. Moving onto the applicant's services in class 35, **I do not consider any of the goods or services of the opponent under this mark to be similar to the applicant's class 35 services.** Lastly, turning to the services in Class 36 the opponent's services are all concerned with the provision of credit cards, and banking services such as "monetary transfer; payment services". Whilst some of the services of the applicant touch on banking issues such as "personalised analysis of online banking transactions" these are not similar and nor are they complementary in the sense that they are indispensable to each other.

43) Lastly I consider the position under CTM 5317102. To my mind the following goods in Class 9 are similar to at least a medium degree:

- Applicant's goods: "Computer software for personal and small business financial management; computer software for transaction management, financial planning, financial management, bill tracking and management, expense tracking and management, accounting, and taxable item tracking and management" and the Opponent's goods: "computer software for facilitating or enabling access to business services, financial services, information services and e-mail services".

- Applicant’s goods: “computer software for enabling users to retrieve account balance and transaction information using mobile phones, smart phones, and mobile telecommunication networks” and the Opponent’s goods “Telecommunications, telephonic and communications apparatus and instruments; apparatus and instruments for the processing, transmission, reproduction, storage, display, logging, protection, reception and retrieval of data, information, sounds, images, text, audio, graphic images or video or combination thereof”.
- Applicant’s goods: “computer software for creating reports and graphs; computer software for forecasting and analysis of data; computer software for data aggregation; computer software for providing alerts” and the Opponent’s goods: “data communication apparatus and instruments; computer software; computer programs; computer operating programs and computer operating systems; computer hardware; computers; computer software and hardware for managing voice mail; computer software and hardware for text messages, data processing apparatus and equipment; software, data, text or images supplied by electrical or electronic means; computer software and publications in electronic or machine readable form; computer software and software upgrades supplied on-line from computer databases, computer networks, global computer networks or the Internet; computer software and telecommunications apparatus (including modems) to enable connection to databases, computer networks, global computer networks and the Internet; computer software to enable searching of data; interactive computer software and interactive computer discs”.

44) **All of the applicant’s goods in Class 9 are similar to at least a medium degree to the goods of the opponent.** I am fortified in this belief by the applicant’s failure to comment on this issue in its sixteen page highly detailed submissions. **It is equally clear that the class 35 services of the two parties are not similar.** To my mind, none of the opponent goods or services under its mark CTM 5317102 are similar to the class 36 services of the applicant nor are they complementary as none are indispensable or important for the use of the other as the applicant is not seeking to register credit or banking facilities.

Comparison of trade marks

45) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, 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.”

46) It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

| | |
|------------------------------|-------------------------------|
| Opponents’ trade mark | Applicant’s trade mark |
|------------------------------|-------------------------------|

| | |
|----------------------|------|
| 2360715G: MINT | MINT |
| 3899333: MINT | |
| 5317102: MINT MOBILE | |

47) Clearly the opponent's marks 2360715G and 3899333 are identical to the mark in suit.

Moving onto the opponent's mark 5317102 this has, as its first word the identical word to that of the mark in suit. The only difference is that the opponent's mark has a second word "MOBILE". In relation to the goods and services for which mark 5317102 is registered it is likely that this word will be seen by the average consumer as indicating that the goods and services are available via their mobile phone. However, just because it is, at least allusive, does not mean that it can be ignored. It will clearly be viewed by the average consumer and as it does not, in my view, form a unit with the first word the marks of the **two parties can be said to be only similar to a medium degree.**

Distinctive character of the earlier trade marks

48) 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 C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

49) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out".

50) Two of the opponent's marks consist of the well known English word MINT, which has a number of meanings from the name of a herb, to the name of a place where money is coined or meaning that something is new. None of these are allusive of any of the goods and services for which they are registered other than indicating they are new. The mark is inherently distinctive to a medium degree. The opponent's other mark consists of two words and again although they have an allusive meaning the mark is distinctive to a medium degree for the goods and services for which it is registered. The opponent has shown use of its mark MINT upon credit cards and related goods and services set out in paragraph 30 above. The number of consumers in the UK over the five years 2009-2013 averaged approximately 531,000 per annum and it also had a residual goodwill from the considerable amount of publicity it received in the years just prior to 2009. **To my mind, the opponent's marks UK 2360715G and CTM3899333 are inherently distinctive to a medium or average degree and benefit from enhanced distinctiveness as the opponent has shown that it has a significant reputation in the UK and EU. The opponent's mark CTM 5317102 is also inherently distinctive to an average degree but cannot benefit from any enhanced distinctiveness as the opponent has not shown any use of the mark in its evidence.**

Likelihood of confusion

51) In determining whether there is a likelihood of confusion, 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 goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the goods by predominantly visual means, although not discounting aural considerations and that the degree of care and attention they pay will vary depending upon cost but they are likely to pay a medium to high degree of attention to the selection of such items.
- None of the goods and services which form part of the comparison test in relation to the opponent's marks UK 2360715G or CTM 3899333 are similar to the goods and services which are applied for under the mark in suit. In relation to the opponent's mark CTM 5317102 all of the goods in class 9 of the two parties are similar to at least a medium degree. However, none of the class 35 or 36 services applied for are similar to any of the goods or services for which the opponent's mark is registered.
- trade marks UK 2360715G and CTM 3899333 are identical to the applicant's mark; whilst the opponent's mark CTM 5317102 is similar to the mark in suit to a medium degree.
- the opponent's earlier trade marks UK 2360715G and CTM 3899333 have an average level of inherent distinctiveness in relation to all the goods and services and benefit from an enhanced

distinctiveness through use. However, whilst CTM 5317102 has an average level of inherent distinctiveness in relation to all the goods and services it cannot benefit from an enhanced distinctiveness through use.

52) In view of the above and allowing for the concept of imperfect recollection, in regard of the opponent's marks UK 2360715G and CTM 3899333 there is no likelihood of consumers being confused into believing that the goods and services applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails completely in relation to both marks.**

53) With regard to the opponent's mark CTM5317102 in view of the above and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the class 9 goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in relation to the class 9 goods. However,** there is no likelihood of consumers being confused into believing that the class 35 and 36 services provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails in relation to the class 35 & 36 services. The opponent has also pleaded section 5(1) and 5(2)(a) but will not be any more successful under those grounds than section 5(2)(b) and I therefore decline to consider them.**

54) I next turn to the ground of opposition under section 5(3) which reads:

"5-(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

55) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Addidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those

goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

56) The onus is upon the opponent to prove that its earlier trade marks enjoy a reputation or public recognition and it needs to furnish the evidence to support this claim. In its statement of grounds under section 5(2)(b) the applicant accepted that the opponent had used its earlier marks in respect of credit card services and did not put the opponent to proof of use. In relation to section 5(3) the applicant stated:

“The applicant denies the opponent's narrower claim [re credit card services] in respect of anything other than credit card services, and puts the opponent to proof of its reputation in relation to credit card services”.

57) This would appear to be contradictory. In its later submissions the applicant suggests that the opponent has been “phasing out its MINT business”. The applicant points out that recent mailshots have been sent to approximately 180,000 existing card holders, although this figure is after the relevant date, 18 December 2013. It is quite true that the number of card holders is declining, but in 2013 the opponent had 381,000 card holders in the UK. It was still advertising the card to other RBS customers, which given that RBS is one of the UK's largest banks would be a considerable number. However, even if one simply looks at the number of MINT credit card holders in the years prior to the relevant date it shows that they decline from 1.2 million in 2007 to 381,000 in 2013. The average

during this period was approximately 697,000 per annum. This is a substantial number of people who have a MINT credit card account. This type of reputation and goodwill does not cease immediately unless a company very publically goes out of business. This is clearly not the case here as the card is still available and is still being used by a substantial number of customers. The significant amount of advertising which took place in 2007-2009 will also resonate with customers today as will the very distinctive shape of the card, which was highly publicised. **To my mind, the opponent has easily satisfied the General Motors reputation requirement in relation to credit card services under its trade mark MINT.**

58) Once the matter of reputation is settled any opponent must then show how the earlier trade mark would be affected by the registration of the later trade mark. In the instant case the opponent alleges that the applicant is taking unfair advantage of its reputation and that it could damage that reputation if the goods and services offered were inferior. **The opponent's reputation is under the mark MINT which is clearly identical to the mark in suit.**

59) Although it is not necessary for the goods and services of the two parties to be similar under this ground of opposition it is a factor which I must take into account in determining whether the consumer will make a link between the marks of the two parties. It is clear from the evidence and indeed common knowledge that those offering credit services are heavily regulated by a variety of financial authorities. To be able to offer a credit card to the general public and which is accepted by establishments throughout the UK requires considerable financial and physical resources whilst the average consumer might be unaware of which bank is backing their credit card they will know that it will be a substantial business which meets stringent criteria. Whilst the applicant does not include credit card services amongst the goods and services it seeks to have its mark registered for, it does include a number of services involving financial advice and planning as well as business advice. These are the types of services for which such institutions are well known as being eager to sell to its customers.

60) To my mind, the following goods and services are ones which it would be reasonable to assume that a credit card provider would also offer or may expand into:

Class 9: Computer software for personal and small business financial management; computer software for transaction management, financial planning, financial management, bill tracking and management, expense tracking and management, accounting, and taxable item tracking and management; computer software for enabling users to retrieve account balance and transaction information using mobile phones, smart phones, and mobile telecommunication networks.

Class 35: Business management; accounting; book-keeping; administrative accounting; business management advice and assistance; economic forecasting; providing information, news, opinions and advice in the fields of accounting, tax preparation and planning, personal budgeting, household budgeting and consumer spending, including via computer or communication networks, the internet, social media and software applications; providing economic forecasting and analysis, including through computer or communication networks, the internet, social media and software applications.

Class 36: Small business financial management services; personalised analysis of online banking transactions; transaction management; financial analysis; bill tracking; expense tracking; taxable item tracking; forecasting and analysis of financial data; financial data aggregation; providing information, news, opinions and advice in the field of banking including via computer or communication networks, the internet, social media and software applications

61) To my mind, the following goods and services are not ones which it would be reasonable to assume that a credit card provider would also offer or may expand into:

Class 9: computer software for creating reports and graphs; computer software for forecasting and analysis of data; computer software for data aggregation; computer software for providing alerts.

Class 35: business administration; office functions; company and business information; compilation of statistics; price comparison services; compilation of information into computer databases; data search in computer files for others; computerised file management; providing comparisons of the products and services of others, including through computer or communication networks, the internet, social media and software applications.

62) Given that the marks are identical it is my view that the average consumer would form a link between the marks and would believe that the opponent has started to provide such goods and services as those identified at paragraph 60 above which the applicant seeks to register. Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that there would be confusion as to the origin of such goods and services. The likelihood of confusion means that the requirement for the link required by the case law is satisfied. A likelihood of confusion means that the applicant stands to benefit from associating itself with the opponent's reputation for credit card services. In any event, if there is confusion it will inevitably be detrimental to the distinctive character of the opponent's mark. **The opposition under Section 5(3) therefore succeeds in respect of the goods and services in paragraph 60 but fails for the goods and services identified in paragraph 61.**

63) In mitigation the applicant contended that it had due cause to adopt the mark in suit as it has traded in the USA under the mark MINT and device for a number of years. In *Leidseplein Beheer BV v Red Bull*, Case C-65/12, the CJEU held that:

"60. Consequently, it follows from all of the foregoing considerations that the answer to the question referred is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the proprietor of a trade mark with a reputation may be obliged, pursuant to the concept of 'due cause' within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith. In order to determine whether that is so, the national court must take account, in particular, of:

- how that sign has been accepted by, and what its reputation is with, the relevant public;
- the degree of proximity between the goods and services for which that sign was originally used and the product for which the mark with a reputation was registered; and
- the economic and commercial significance of the use for that product of the sign which is similar to that mark.

64) The applicant's submissions contend that the business known as mint.com was founded in 2007 and purchased by the applicant's in 2009. It is also clear that the mark MINT plus leaf device was registered in 2008 in the USA. It is clear that the mark has enjoyed success in the USA. However, no evidence has been provided to show that the mark has been used in the UK. Whilst the applicant might wish to expand into the UK it is clear that the mark MINT has been extensively used for some

considerable time prior to these dates in the UK by the opponent. The applicant cannot show that it had any reputation with the relevant UK public prior to the date it applied for its mark and so cannot seek relief from the due cause provision.

65) I now turn to the ground of opposition under section 5(4)(a) which reads:

Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

66) In deciding whether the marks in question offend against this section, I intend to adopt the guidance given by Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

67) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

68) The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP)

69) First I must determine the date at which the opponent’s claim is to be assessed; this is known as the material date. *In Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.'

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date

of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

70) The filing date of the application is, therefore, the material date. However, if the applicant has used its trade mark prior to this then this use must also be taken into account. It could, for example, establish that the applicant is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that the applicant’s use would not be liable to be prevented by the law of passing-off – the comments in *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer.

71) There is no evidence of use of the applicant’s mark in the UK; I shall therefore regard the relevant date as 18 December 2013.

72) The applicant has maintained that the opponent has not provided any evidence of goodwill. I take account of the comments in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

73) I also note that in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd’s Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

74) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent’s reputation extends to the goods comprised in

the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

75) I also note that in *Hart v Relentless Records* [2003] FSR 36, Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

76) However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

77) Earlier in this decision I found that the opponent had reputation and goodwill in credit card services in its MINT trade mark.

78) I now turn to consider the issue of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court’s reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

79) In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

80) In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge’s approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

81) In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in the a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff’s claim for want of this factor. This

was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case *Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

82) Earlier in this decision I found that the opponent had goodwill in credit card services and that the provision of, what can loosely be described as, “financial goods, advice and services” are a natural extension of the opponent’s services. I set this out in detail at paragraphs 60 and 61. I rely upon the same paragraphs now for goods and services where use of an identical mark will and will not cause misrepresentation.

83) I now move onto the issue of damage. In *Harrods Limited V Harroddian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

84) In the instant case given the identical nature of the marks of the two parties, and the closeness of their activities, if there is confusion about an economic connection, there is clear potential to damage the opponent’s goodwill and reputation for financial probity. **The ground of opposition under section 5(4)(a) succeeds in relation to the following goods and services.**

Class 9: Computer software for personal and small business financial management; computer software for transaction management, financial planning, financial management, bill tracking and management, expense tracking and management, accounting, and taxable item tracking and management; computer software for enabling users to retrieve account balance and transaction information using mobile phones, smart phones, and mobile telecommunication networks.

Class 35: Business management; accounting; book-keeping; administrative accounting; business management advice and assistance; economic forecasting; providing information, news, opinions and advice in the fields of accounting, tax preparation and planning, personal budgeting, household budgeting and consumer spending, including via computer or communication networks, the internet, social media and software applications; providing economic forecasting and analysis, including through computer or communication networks, the internet, social media and software applications.

Class 36: Small business financial management services; personalised analysis of online banking transactions; transaction management; financial analysis; bill tracking; expense tracking; taxable item tracking; forecasting and analysis of financial data; financial data aggregation; providing information, news, opinions and advice in the field of banking including via computer or communication networks, the internet, social media and software applications.

85) The ground of opposition under section 5(4)(a) fails in relation to the following goods and services.

Class 9: computer software for creating reports and graphs; computer software for forecasting and analysis of data; computer software for data aggregation; computer software for providing alerts.

Class 35: business administration; office functions; company and business information; compilation of statistics; price comparison services; compilation of information into computer databases; data search in computer files for others; computerised file management; providing comparisons of the products and services of others, including through computer or communication networks, the internet, social media and software applications.

CONCLUSION

86) The ground of opposition under section 5(2)(b) in regard of the opponent's marks UK 2360715G and CTM 3899333 failed completely. However, the section 5(2)(b) ground of opposition with regard to the opponent's mark CTM5317102 succeeded in relation to all of the class 9 goods but failed in relation to all of the class 35 and class 36 services.

87) The ground of opposition under section 5(3) and 5(4)(a) in regard of the opponent's mark UK 2360715G succeeded in relation to the following goods and services:

Class 9: Computer software for personal and small business financial management; computer software for transaction management, financial planning, financial management, bill tracking and management, expense tracking and management, accounting, and taxable item tracking and management; computer software for enabling users to retrieve account balance and transaction information using mobile phones, smart phones, and mobile telecommunication networks.

Class 35: Business management; accounting; book-keeping; administrative accounting; business management advice and assistance; economic forecasting; providing information, news, opinions and advice in the fields of accounting, tax preparation and planning, personal budgeting, household budgeting and consumer spending, including via computer or communication networks, the internet, social media and software applications; providing economic forecasting and analysis, including through computer or communication networks, the internet, social media and software applications.

Class 36: Small business financial management services; personalised analysis of online banking transactions; transaction management; financial analysis; bill tracking; expense tracking; taxable item tracking; forecasting and analysis of financial data; financial data aggregation; providing information, news, opinions and advice in the field of banking including via computer or communication networks, the internet, social media and software applications

88) The ground of opposition under section 5(3) and 5(4)(a) in regard of the opponent's mark UK 2360715G failed in relation to the following goods and services:

Class 9: computer software for creating reports and graphs; computer software for forecasting and analysis of data; computer software for data aggregation; computer software for providing alerts.

Class 35: business administration; office functions; company and business information; compilation of statistics; price comparison services; compilation of information into computer databases; data search in computer files for others; computerised file management; providing comparisons of the products and services of others, including through computer or communication networks, the internet, social media and software applications.

89) The application can therefore proceed to registration for the following goods and services

Class 35: business administration; office functions; company and business information; compilation of statistics; price comparison services; compilation of information into computer databases; data search in computer files for others; computerised file management; providing comparisons of the products and services of others, including through computer or communication networks, the internet, social media and software applications.

COSTS

90) As the opponents has mainly had a greater level of success it is entitled to a contribution towards its costs.

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| Expenses | £200 |
| Preparing a statement and considering the other side's statement | £300 |
| Preparing evidence and considering the other side's evidence | £800 |
| Preparing submissions | £600 |
| TOTAL | £1,900 |

91) I order Intuit Inc. to pay The Royal Bank of Scotland the sum of £1900. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of January 2016

**George W Salthouse
For the Registrar,
the Comptroller-General**