

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS. 2002458 & 2011392  
BY BARCLAYS BANK PLC  
TO REGISTER TRADE MARKS IN CLASSES 16 & 36**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER  
NOS. 43493 & 44915  
BY CHEQUEPOINT EXPRESS INC**

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**BACKGROUND**

15 On 15 November 1994 Barclays Bank Plc applied to register the word TRANSPAY for a specification of goods and services which reads as follows:

Class 16

20 Printed matter; stationery; money orders; cheques, cheque books; bankers drafts; wallets, document folders, plastic cards.

Class 36

25 Banking and financial services; money exchange and transmission services; currency services; bureaux de change services.

The application is numbered 2002458.

30 On 17 February 1995 Barclays Bank Plc applied to register the following trade mark for a specification of goods and services which reads as follows:



40 Class 16

Printed matter, stationery, wallets, document folders and plastic cards, all for use in relation to financial services and/or relating to financial services; money orders; cheques, cheque books, banker's drafts.

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Class 36

Banking and financial services; money exchange and transmission services; currency services; bureaux de change services.

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Both applications were accepted and published.

On 16 November 1995, Chequepoint Express Inc filed Notice of Opposition against application no. 2002458 and on 15 July 1996 they filed Notice of Opposition against application no. 2011392. In summary, the Grounds of Opposition against both applications are:

1. Under Section 3(1)(b) in that the trade marks are devoid of any distinctive character.
2. Under Section 3(3)(b) because the trade marks are of such a nature as to deceive the public.
3. Under Section 5(2)(b) in that the trade marks applied for are similar to the opponents' earlier trade marks and which are registered for the same or similar services as those covered by the respective applications.

Details of the opponents' earlier trade marks are as follows:

No.	Trade Mark	Class	Specification
1418118	TRANSCHEQ	16	Paper and paper articles; credit cards, debit cards, identity cards, cheque books; printed
1418119	TRANSCHEQ	36	Bureau de change services; issuing and redemption of travellers cheques; money transfer services; cashing of personal cheques; credit card services; all included in Class 36.

Both of these earlier trade marks have now expired. They were due for renewal on 15 February 1997 and in the absence of any request for renewal, late renewal or restoration and renewal the trade marks were removed from the Register and can no longer be restored (Section 43 and Rules 29 to 30 of the Trade Mark Rules 1994 (as amended) refer)

Both sides seek an award of costs and both filed evidence in support of their pleadings. The matter came to be heard on 7 September 1999 when the applicants were represented by Mr Richard Arnold of Counsel instructed by Messrs A A Thornton, their Trade Mark Attorneys and the opponents by Mr James Graham instructed by Marks & Clerk their Trade Mark Attorneys.

## Decision

5 As the applications by Barclays Bank Plc are in respect of very similar trade marks, and the grounds of opposition submitted by Chequepoint Express Inc are the same in respect of both applications (and the evidence filed by both sides in respect of each set of proceedings is also very similar) I see no reason to issue two separate decisions. The same considerations, in my view, apply in respect of each of the applications for registration in suit and therefore the decision below applies to both.

10 First of all, I do not consider that any of the evidence filed by the opponents supports the grounds of opposition based upon Section 3(1)(b) and Section 3(3)(b) of the Act and therefore I dismiss the oppositions insofar as they are based upon those grounds. I therefore need only consider the grounds of opposition based upon Section 5(2)(b) of the Act.

15 Before considering the substantive issues under Section 5(2)(b) I need first of all to determine whether a valid objection can be taken under this Section given that the earlier trade marks upon which the opponents rely have now lapsed and are beyond the timescale allowed for restoration and renewal. First of all Section 5(2)(b) states:

- 20 5.-(2) A trade mark shall not be registered if because -
- (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,
- 25 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

An earlier right is defined in Section 6 of the Act which reads as follows:

- 30 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)
- 35 of the priorities claimed in respect of the trade marks,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- 40 (c) a trade mark which, at the date of application for registration of the trade mark in question of (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.
- 45 (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to

its being so registered.

- 5 (3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.

10 Mr Graham, for the opponents, submitted that as the earlier trade marks were on the register at the time the applications for registration were made (a fact Mr Arnold did not dispute), they are earlier marks within the meaning of the Act and it was irrelevant that they had subsequently lapsed. In his view matters must be considered as of the date of application because that is the date from which any rights accrue in respect of any subsequent registration. In submitting this view Mr Graham said that the Act, and the Directive<sup>1</sup> upon which it is based, sets out, exhaustively, in relation to relative grounds, the provisions upon which registration must be refused, where it is established that an earlier trade mark or marks exist. These provisions all relate to the position at the date on which an application for registration is made. There was, in his view, no provision for consideration of matters after that date in either the Act or the Directive.

20 Mr Arnold, for the applicants, submitted that, as a matter of common sense, where the foundation for any objection under Section 5(2) objection disappeared, in particular where the earlier trade mark was allowed to lapse, then this latter event should be taken into account in determining whether to accept an application for registration. In his view that was right not only as a matter of common sense but also on the basis of the construction of the Trade Marks Act 1994. In that connection he took me to a line of authorities in respect of the Trade Marks Act 1938 which, in his view, established the proposition that in considering the same question under Section 12 of the Trade Marks Act 1938, (which dealt with the prohibition to registration of identical and resembling trade marks) the fact that a registration relied upon by the opponent had lapsed when an opposition based upon Section 12 came to be heard was something which could and should be taken into account by the Tribunal. Both Mr Graham and Mr Arnold also drew to my attention the Trade Mark Registry's Work Manual which sets out in some detail what a Trade Mark Examiner should do when he or she encounters as a result of their search, an earlier trade mark which has the status expired.

35 The authorities upon which Mr Arnold relied (in the matter of an application by the Texas Company, RPC 1915 442, Palmolive 1932, Exel 1X RPC 269, Polymat [1968] RPC 124, Keraion [1997] RPC 588, Runner [1978] RPC 402), conclude that the Registrar can take account of events after the date of filing of an application in order to determine whether or not to place a trade mark the subject of the application on the register. This was because the words "shall not be registered" which formed part of the provisions of Section 12(1) of the Trade Marks Act 1938 referred to the act of placing the trade mark in question on the register and hence the position as of the date of a decision to do so was later than the date of filing the

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<sup>1</sup>FIRST COUNCIL DIRECTIVE of 21 December 1988  
to approximate the laws of the Member States relating to trade marks.

application. These authorities are not binding on me as they relate to earlier legislation. I have nevertheless given them due consideration in reaching my decision in respect of the position of lapsed registrations under the Trade Marks Act 1994 in terms of their effect upon the provisions of Section 5(2).

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It is clear from the provisions of Section 6 (set out earlier in this decision) that a registered trade mark having a date of application earlier than an application in respect of the same or similar trade mark covering the same or similar goods or the services must be a bar to the acceptance for registration of the later filed application. However, it seems to me that such an approach can not be absolute and account must be taken of events concerning the earlier registered trade mark which occur after the date of application and before the final decision whether or not to accept an application for registration. To do otherwise would result in a great deal of unfairness and inconvenience to the respective owners of trade mark rights. For example, if the Registrar could only consider matters as of the date of application then it would not be possible for the parties to negotiate the part-cancellation of the goods and services covered by an earlier trade mark which might otherwise allow the later filed application to proceed (because the same or similar services which had caused the conflict had been removed). Similarly full cancellation of an earlier registered trade mark after the date of application for an otherwise conflicting trade mark would not affect matters, nor could the subsequent assignment of the earlier trade mark from the registered proprietor to the applicant for registration. Mr Graham for his part suggested that all of those actions would be deemed to be 'consent' and therefore fall under the provisions of Section 5(5), which enables later filed applications for registration to proceed where the proprietor of the earlier trade mark consents to its registration. I do not consider that part-cancellation, full-cancellation or indeed assignment can be termed consent as envisaged by Section 5(5).

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Section 6 does set out exhaustively what is an earlier trade mark but it also, in my view provides for a decision to be made on whether or not an earlier right is a bar to registration of a later filed application at a date other than at the date of application. This is because Section 6(2) states that regard may be taken of an earlier trade mark which is the subject of an application for registration and which, if registered, would be an earlier right by virtue of subsection (1)(a) or (b), subject to it becoming registered. That means, that the Registrar could take a view on an earlier trade mark which was the subject of an application at the date on which a later filed application was examined but the final decision on whether or not that earlier right was a bar to the registration of the later filed application could be taken at the stage at which the earlier filed application was so registered. That in effect means that the Act provides for a decision to be made in respect of applications for registration at a date later than the date of application and that some supervening events (registration) can be taken into consideration.

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Mr Graham in his submissions indicated that Section 6(3) set out earlier in this decision was not part of the Directive and was therefore a piece of home spun legislation. It could not therefore detract from the thrust of the Directive which was to require consideration of matters as at the date of the application for registration. He submitted that Section 6(3) applied if prior to the date of an application an earlier registered trade mark which might otherwise be a confusingly similar trade mark expired then that earlier trade mark could and should be cited against the later filed application. If it subsequently lapsed through the failure

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to renew or restore and renew then the later filed application could proceed to registration. However, if the earlier trade mark expired after the date of application it continued to be a fatal bar to the registration of the later filed application. I reject that submission because I do not consider that Section 6(3) can be construed in that way. It does not state that only those  
5 trade marks which have expired before the date of the later filed application should be considered. Moreover the subsection uses the term ‘A trade mark within subsection 1(1) or (b) whose registration expires .....’ suggests that there is an element of futurity in the matter and the position within the timescale for the consideration of the acceptance or otherwise of the application can be taken into account.

10 In addition I believe, that the construction of the Act points to the fact that acceptance for registration and the act of registration are two separate events. First of all, Section 37 deals with the examination of an application for registration and it states:

15 37.-(1) The registrar shall examine whether an application for registration of a trade mark satisfies the requirements of this Act (including any requirements imposed by rules).

20 (2) For that purpose he shall carry out a search, to such extent as he considers necessary, of earlier trade marks.

25 (3) If it appears to the registrar that the requirements for registration are not met, he shall inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to amend the application.

30 (4) If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application.

(5) If it appears to the registrar that the requirements for registration are met, he shall accept the application.

35 I seems to me that the Registrar (or more precisely her Examiners) have a duty to examine an application and to inform the applicant if it does not meet the requirement for registration (and give them time to put matters right) but if it appears to the Examiner that the requirements for registration are met then he or she shall *accept* the application. Subsequent provisions of the Act require details of the application to be published for the purposes of opposition  
40 proceedings and provision is also made for the receipt of observations by third parties on the acceptance of the trade mark for registration. Section 40 then makes provision for the *registration* of an application and it states:

45 **40.-** (1) Where an application has been accepted and -

(a) no notice of opposition is given within the period referred to in section 38(2), or

- (b) all opposition proceedings are withdrawn or decided in favour of the applicant,

5 the registrar shall register the trade mark, unless it appears to him having regard to matters coming to his notice since he accepted the application that it was accepted in error.

- 10 (2) A trade mark shall not be registered unless any fee prescribed for the registration is paid within the prescribed period.

If the fee is not paid within that period, the application shall be deemed to be withdrawn.

- 15 (3) A trade mark when registered shall be registered as of the date of filing of the application for registration; and that date shall be deemed for the purposes of this Act to be the date of filing of the application for registration; and that date shall be deemed for the purposes of this Act to be the date of registration.

- 20 (4) On the registration of a trade mark the registrar shall publish the registration in the prescribed manner and issue to the applicant a certificate of registration.

25 It seems to me that it is this section which requires the Registrar to *register* a trade mark provided all opposition proceedings have been settled in favour of the applicant (or where no notice of opposition has been filed) unless it appears to the Registrar, having regard to matters coming to her attention since the application was accepted in error. That, it seems to me, points to the fact that there is another stage in the process following the acceptance of an application for registration whereby the Registrar can on the basis of information which has  
30 come to her notice following the earlier acceptance of the trade mark cause a notice of refusal to register to issue at that stage. Thus acceptance of an application does not mean its registration. Before placing on the register the trade mark the subject of the application the Registrar has the duty to consider or reconsider the earlier acceptance in some cases. Conversely, it seems to me that at that stage, on the basis of information which was not  
35 available at the earlier date a trade mark which might otherwise be refused could be accepted.

In summary it seems to me that having regarding to the earlier authorities under the Trade  
40 Marks Act 1938 (and earlier Act) and the construction of the Trade Marks Act 1994, there is a two stage process through which all applications for registration must go. The first is an application for registration must be examined under the provisions of Section 3 and 5 of the Act, in particular, to ensure that there are no objections on absolute or relative grounds and that if objections are raised then under the provisions of Section 37 the Registrar must give the applicant the opportunity to put matters right. In addition to the ability to amend an application for registration which is provided for by Section 38 of the Act it seems to me as a  
45 matter of practical common sense that the Act must have regard to any event which occurs in relation to any earlier trade mark on the basis of which an objection under Section 5 arises, such that the objection itself falls away. That means that if the proprietor of the earlier trade

mark seeks to limit the specification of goods and services such that the conflict between the two marks is removed, or applies to have the registration cancelled or the applicant applies to have the earlier trade mark assigned to him (all event which occur after the date of application) then the Registrar (and her Examiners) should take them into account in assessing or reassessing the acceptance or otherwise of an application for registration. Such an assessment may also, it seems to me, take place in the course of opposition proceedings and in particular where an opponent bases an opposition on an earlier trade mark which subsequently lapses. Then the Hearing Office, like the Trade Mark Examiner is bound, in my view, to take that matter into consideration.

In this case the earlier trade marks upon which the opponents rely, registration nos. 1418118 and 1418119 in respect of the trade mark TRANSCHEQ registered in Classes 16 and 36, expired on 15 August 1997 and no request for renewal having been received it was removed from the register on 15 February 1997. No subsequent request for late renewal or restoration and renewal as provided for under the Act having been received within the following six months it is no longer possible to put that mark back on the register (other than by filing a new application for registration). In the circumstances, the opponent's earlier trade marks no longer exist as registered trade marks and they have therefore ceased to be earlier trade marks under the provisions of Section 6. In those circumstances the provisions of Section 5(2) can not be employed by the opponent in respect of these applications and the opposition is dismissed accordingly.

In the event that I am wrong in holding that the earlier trade marks upon which the opponents rely are no longer earlier trade marks within the meaning of the Trade Marks Act 1994 I go on to consider the matter under the provisions of Section 5(2). First of all, both sides accepted that the same or similar goods and services were involved and therefore I only need to consider whether the applicants' and the opponents' trade marks are the same or similar. For the purposes of this comparison I do not consider that there is any significant difference between the applicants' application for the word TRANSPAY and the second application for the word TRANSPAY which has the letters TRANS on a black background and the letters PAY on a white background all enclosed within a rectangular border. Both trade marks are in my view in respect of the word TRANSPAY and the public would not see or perceive them to be any different.

I propose to consider the matter on the basis of the approach adopted by the European Court of Justice in SABEL v. PUMA 1998 RPC 1999. The Court considered the meaning of Article 4(1)(b) of the Directive (EC Directive 104/89) which corresponds to Section 5(2) of the Act and stated that:

“..... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the mark, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive- ‘ ..... there exists a likelihood of confusion on the part of the public .....’ - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”

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

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

Finally, the court gave the following judgement on the interpretation of Article 4(1)(b):

“On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.”

The opponents’ evidence in the form of a Statutory Declaration dated 16 August 1996 by Mr Gregory Paul Turner, the Group Solicitor for Chequepoint Express Inc states that their trade mark *TRANSCHEQ* has been used in the United Kingdom since March 1990 in relation to all of the goods and services covered by the registration. I am given no indication of the scale of this use. Though it is stated that goods and services under the trade marks are supplied at twenty *Bureaux de Change* in London alone there is no monetary value placed upon the goods and services so provided by those outlets. The promotion of the trade mark similarly is not detailed. In the circumstances I am unable to establish that the earlier registered trade marks have a reputation amongst the relevant public which might have been a factor to be taken into account in assessing the likelihood of confusion as between the respective trade marks. Similarly, the applicant’s evidence does not provide me with any information which would assist my deliberations. There are some Statutory Declarations by people “in the trade”. However, they seem to me to be so closely connected with the applicant that it would

be wrong of my to rely upon their statements that they would not be confused as between the two trade marks. In the circumstances I am left to form my own view. I should mention however that in both the applicants' and the opponents' evidence there is reference to a registered trade mark owned by a Girobank, which is for and includes the word  
5 TRANSCASH. The applicants rely upon this to indicate that the word TRANS is a common prefix within the financial services sector (meaning, presumably, transfer) and therefore the suffix becomes the important element amongst such trade marks. However, I have no other evidence before me that TRANS is a common element in respect of registered trade marks for these services.

10 As far as I am concerned the two trade marks I need to consider are the applicant's trade mark TRANSPAY and the opponent's trade mark TRANSCHEQ. Both are used on goods and services related to the provision of foreign currency or the transfer of money overseas. It is likely that a large number of people within the United Kingdom would avail themselves of  
15 such services either for sending money to siblings travelling overseas or in respect of obtaining foreign currency for their own travel, and for converting any monies left over back into Sterling on their return. By and large I would regard individuals using those sorts of services as reasonably informed and circumspect in their approach to identifying and using a service provider.

20 It seems to me that the respective trade marks of the applicants and the opponents do not have a highly distinctive character. Both are made up of terms which are readily identifiable within the particular service sector in which the marks are used. TRANS is likely to be perceived, quickly and easily in relation to the goods and services provided as meaning  
25 transfer and although the term CHEQ is without an E in the opponent's trade mark it is clear what the term means. Similarly the term PAY within the applicant's trade mark is not meaningless in terms of the services (and goods), covered by the specifications. Thus the two trade marks, prima facie consist of descriptive terms or at least terms which individually lack distinctiveness. The penumbra of protection each deserves is, therefore, in my view, very  
30 limited.

The difference between the two trade marks TRANSPAY and TRANS CHEQ are not insignificant. Whilst each has the same prefix TRANS, they have different suffixes. Given  
35 therefore the nature of the trade marks, the goods and services involved and the nature of the likely customers, I come to the view that there are sufficient differences between the respective trade marks, bearing in mind all of the factors set out in the above authorities, to make it likely that in use confusion and deception as between the two marks is unlikely to occur. In reaching this view I have also taken account of the submissions of Mr Graham that the terms PAY and CHEQ have similar connotations and therefore association of the  
40 respective trade marks may result. In my view that connection between the two terms in the minds of the public is a matter of conjecture and I am not prepared to accept that as a likely occurrence. In the circumstances I hold that the respective trade marks TRANSPAY and TRANSCHEQ are not confusingly similar within the meaning of Section 5(2) and therefore the opposition under that head falls.  
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The opposition having been dismissed under all heads, the applicants are entitled to a contribution towards their costs. I order the opponents to pay to the applicants therefore the sum of £1,700.

5     **Dated this    31     day of January 2000**

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**M KNIGHT**  
**For the Registrar**  
**The Comptroller General**

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