

BL O/0710/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3736490

BY

KEVIN HO

TO REGISTER THE FOLLOWING TRADE MARK:

MetaBank

AND

OPPOSITION NO. 433506 THERETO

BY

SIMON ADRIAN ALEXANDER SQUIBB

Background and pleadings

1. On 24 December 2021, Kevin Ho (the “Applicant”) applied to register in the UK the trade mark **MetaBank** for goods and services in classes 9, 36 and 42.
2. The contested application was accepted and published for opposition purposes in the Trade Marks Journal on 18 February 2022.
3. On 16 May 2022, Simon Adrian Alexander Squibb (the “Opponent”) opposed all of the goods and services in the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
4. For the purposes of this opposition, the Opponent relies upon all of the goods and services for which the following earlier United Kingdom Trade Mark (UKTM) is registered in classes 9, 36 and 42 (see **Comparison of the goods and services**).

UKTM 3711482

METVERSE BANK

THE METVERSE BANK

(Series of 2)

Filing date: 18 October 2021

Registration date: 14 January 2022

5. Since the filing date of the earlier mark predates that of the contested application, the Opponent’s mark is considered to be an “earlier mark” in accordance with Section 6 of the Act. However, as the mark had not been registered for a period of five years or more before the filing date of the application it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon any or all of the goods and services for which the earlier mark is registered without having to show that it has used the mark at all.

6. The Opponent submitted that the contested mark is phonetically, visually and conceptually highly similar to the earlier mark. The Opponent also submitted that the goods and services at issue are highly similar.

7. On 4 July 2022, the Applicant filed a counterstatement in which it denied that the marks are similar and submitted that the parties operate in different fields. In particular, the Applicant argued that the earlier mark METAVERSE BANK indicates that the Opponent intends to operate a bank in the Metaverse or “Web 3”, whereas the Applicant exists in the real world and uses metadata.

8. Only the Applicant filed evidence of fact, consisting of the witness statement of Mr Kevin Ho, which was accompanied by the exhibits KH1 – KH6. The evidence shall not be summarised here, rather it will be referred to and called upon as and where appropriate during this decision.

9. Neither party requested a Hearing, and neither party filed evidence in lieu of a Hearing. I shall therefore make a decision based upon a careful consideration of the papers before me.

10. The Opponent is represented by Trademark Brothers Ltd. The Applicant is without legal representation.

Decision

11. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Section 5(2)(b)

12. Section 5(2)(b) of the Act is as follows:

“(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”.

13. The following principles 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 might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the goods and services

Earlier mark	Contested mark
Class 9: <i>Credit cards; electronic machines for reading credit cards; software for facilitating secure credit card transactions; credit card encoding machines; credit card terminals; magnetic credit cards; encoded charge cards; encoded magnetic cards; chip card readers; encoded electronic chip cards; electronic chip cards; data processing programs; electronic data</i>	Class 9: <i>Financial management software.</i>

carriers; data processors; secure terminals for electronic transactions; computer software relating to the handling of financial transactions; automated teller machines (ATM); electronic cash registers; automatic cash sorting and counting machines; cash cards [encoded]; computer software; computer hardware; software for mobile phones; application software; downloadable software; computer terminals for banking purposes; electronic databases; computer databases; application software for mobile phones and other portable electronic devices; computer software for authorising access to databases; software for card readers; computer software relating to financial history; computer software designed to estimate costs; computer software for producing financial models; software for ensuring the security of electronic mail; computer programmes relating to financial matters; encoded cards for use in relation to the electronic transfer of financial transactions; banking cards [encoded or magnetic].

Class 36: Financial and monetary services; banking services; merchant banking; international banking; electronic banking; private banking; online banking; provision of banking

Class 36: Financial valuations; Financial advice; Financial consultancy; Financial research; Financial leasing; Financial affairs; Financial services; Financial banking; Financial consultation;

<p>services via a website; electronic banking services; electronic banking via a global computer network [internet banking]; automated banking services; computerised banking services; ATM banking services; card accessed banking services; computerised information services relating to banking and financial matters; banking services for the deposit of money; banking services for the withdrawal of money; banking services provided for paying bills by telephone and online; automated banking services relating to charge card transactions; automated banking services relating to credit card transactions; banking services relating to the transfer of funds from accounts; banking services in relation to the electronic transfer of funds; information services relating to finance, provided on-line from a computer database or the Internet; electronic payment services; electronic funds transfers; electronic debit transactions; electronic cash transactions; electronic money transfer services; electronic fund-transfer services; electronic funds transfer by telecommunications; money transfer services utilising electronic cards; bank card, credit card, debit card and electronic payment card services; providing multiple payment options by</p>	<p>Financial lending; Financial transactions; Financial forecasting; Financial management; Financial securities; Analysis (Financial -); Research (Financial -); Management (Financial -); Financial assistance; Financial evaluations; Clearing, financial; Financial credit services; Financial fund management; Financial sponsorship services; Collections (Organising financial -); Financial risk management; Financial loan services; Financial economic analysis; Financial intermediary services; Financial evaluations [banking]; Insolvency services [financial]; Financial payment services; Financially-guaranteed financing; Financial trust operations; Financial trust administration; Financial affairs services; Financial transaction services; Personal financial planning; Financial guarantee services; Financial brokerage services; Online financial transactions; Arranging financial transactions; Computerised financial analysis; Financial asset management; Financial loss management; Asset evaluation [financial]; Financial valuation services; Financial information services relating to financial bond markets; Financial information services relating to financial stock markets; Financial lending against security; Personal</p>
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means of customer-operated electronic terminals available on-site in retail stores; providing an online website for the provision of financial, banking and payment services; financial services for the withdrawal of money; information services relating to finance, provided online from a computer database or the internet; electronic payment services; electronic funds transfers; electronic debit transactions; electronic money transfer services; electronic fund-transfer services; payment processing and administration services; providing for digital currency or digital token for use by members of an on-line community via a global computer network; providing for digital currency or digital token, incorporating cryptographic protocols, used to operate and build applications and blockchains on a decentralized computer platform and as a method of payment for goods and services; information, consultancy and advisory services in connection with all of the aforesaid.

financial planning services; Financial credit scoring services; Financial analyses (Preparation of -); Economic research services [financial]; Preparation of financial reports; Financial management of companies; Factoring of financial undertakings; Financial management of pensions; Provision of financial securities; Business liquidation services, financial; Risk management [financial]; Financial trust management; Financial portfolio management; Financial management services; Financial management for businesses; Financial management of funds; Financial investment management services; Financial management of stocks; Risk management consultancy [financial]; Pension fund financial management; Management of financial assets; Financial management advisory services; Financial risk management services; Financial planning and management; Financial management and planning; Financial management relating to banking; Financial management of current accounts; Financial management of holding companies; Financial management of building projects; Financial management of membership schemes; Financial management of cash accounts; Financial management of share

	<p><i>accounts; Financial advisory and management services; Financial management relating to investment; Financial management via the Internet; Financial information management and analysis services; Financial management services relating to hospitals; Financial management of real estate projects; Financial services relating to wealth management; Financial management of building renovation projects; Financial management of employee pension plans; Financial management of collective investment schemes; Financial management of building occupancy expenses; Financial management services relating to medical institutions; Financial management services relating to nursing institutions; Advisory services relating to [financial] risk management; Financial advisory services relating to assets management; Computer information services relating to financial management; Financial management services relating to convalescent institutions; Financial management services relating to local authorities; Financial management services relating to retirement homes; Financial management services relating to dental institutions; Advisory services relating to financial asset management; Financial</i></p>
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	<p> <i>management of reimbursement payments for others; Financial management of shares in other companies; Financial management services relating to banking institutions; Financial management services provided via the Internet; Financial consultancy in the field of risk management; Financial research in the field of risk management; Financial services for the management of credit cards; Financial exchange; Studies (Financial -); Financial underwriting; Sponsorship (Financial -); Financial analysis; Financial analyses; Financial studies; Financial clearing; Financial appraisals; Financial brokerage; Consultancy (Financial -); Financial evaluation; Financial assessments; Financial guardianship; Financial appraisal; Appraisals (Financial -); Consultations [financial]; Financial information; Information (Financial -); Financial planning; Financial sponsorship; Valuations (Financial -); Brokerage (Financial -); Financial consulting; Financial investment; Financial investments; Financial management of risk capital, investment capital and development capital; Provision of financial information for professionals in the field of portfolio management, for portfolio management;</i> </p>
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	<p><i>Portfolio management; Building management; Property management; Investment management; Asset management; Share management; Housing management; Securities management; Fund management; Capital management; Cash management; Estate management; Trust management; Funds management; Wealth management; Financial exchange services; Planning (estate -) [financial]; Financial information processing; Financial clearing houses; Financial appraisal services; Financial consultation services.</i></p>
<p><i>Class 42: Data encryption services; development, updating and maintenance of software and database systems; software development services; design of software; creating and maintaining websites; computer services; hire of computers; provision of security services for computer networks, computer access and computerised transactions; design and development of information systems relating to finance; design of websites; hosting of databases; providing temporary use of online downloadable software; Software as a Service (SaaS); hosting of websites for the provision of financial, banking and payment services.</i></p>	<p><i>Class 42: Computer technology consultancy; Information technology services; Technological engineering analysis; Technological planning services; Technological advisory services; Technological research services; Technological design services; Information technology consulting services; Information technology [IT] consultancy; Information technology support services; Technological research relating to computers; Technological services relating to design; Expert opinion relating to technology; Professional consultancy relating to technology; Information technology [IT] consulting services; Expert advice relating to technology;</i></p>

	<p><i>User authentication services using blockchain technology; Development of new technology for others; Technological consulting services for digital transformation; Information services relating to information technology; Computer and information technology consultancy services; user authentication services using blockchain technology; Research in the field of telecommunications technology; Engineering services relating to data processing technology; Services for the provision of technological information; Technical consultancy services relating to information technology; Technological advisory services relating to computer programs; Compilation of information relating to information technology; Engineering services in the field of communications technology.</i></p>
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14. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16, Jacob J. (as he then was) stated:

“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.”

15. In the judgment of the Court of Justice of the European Union 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”.

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

17. It has been established by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme

v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC 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”.

Class 9

19. The contested *Financial management software* is included in the more general category of the earlier mark’s *Computer software*, and is therefore considered to be identical in accordance with the *Meric* principle.

Class 36

20. The majority of contested services are characterised as being financial, and relate to all manner of financial activities including financial valuation, financial risk management, and financial planning. The following contested services are included in the more general category of the earlier mark’s *Financial and monetary services*, and are therefore considered to be identical:

Financial valuations; Financial advice; Financial consultancy; Financial research; Financial leasing; Financial affairs; Financial services; Financial banking; Financial consultation; Financial lending; Financial transactions; Financial forecasting; Financial management; Financial securities; Analysis (Financial -); Research (Financial -); Management (Financial -); Financial assistance; Financial evaluations; Clearing, financial; Financial credit services; Financial fund management; Financial sponsorship services; Collections

(Organising financial -); Financial risk management; Financial loan services; Financial economic analysis; Financial intermediary services; Financial evaluations [banking]; Insolvency services [financial]; Financial payment services; Financially-guaranteed financing; Financial trust operations; Financial trust administration; Financial affairs services; Financial transaction services; Personal financial planning; Financial guarantee services; Financial brokerage services; Online financial transactions; Arranging financial transactions; Computerised financial analysis; Financial asset management; Financial loss management; Asset evaluation [financial]; Financial valuation services; Financial information services relating to financial bond markets; Financial information services relating to financial stock markets; Financial lending against security; Personal financial planning services; Financial credit scoring services; Financial analyses (Preparation of -); Economic research services [financial]; Preparation of financial reports; Financial management of companies; Factoring of financial undertakings; Financial management of pensions; Provision of financial securities; Business liquidation services, financial; Risk management [financial]; Financial trust management; Financial portfolio management; Financial management services; Financial management for businesses; Financial management of funds; Financial investment management services; Financial management of stocks; Risk management consultancy [financial]; Pension fund financial management; Management of financial assets; Financial management advisory services; Financial risk management services; Financial planning and management; Financial management and planning; Financial management relating to banking; Financial management of current accounts; Financial management of holding companies; Financial management of building projects; Financial management of membership schemes; Financial management of cash accounts; Financial management of share accounts; Financial advisory and management services; Financial management relating to investment; Financial management via the Internet; Financial information management and analysis services; Financial management services relating to hospitals; Financial management of real estate projects; Financial services relating to wealth management; Financial management of building renovation projects; Financial management of employee pension plans; Financial management of collective investment

schemes; Financial management of building occupancy expenses; Financial management services relating to medical institutions; Financial management services relating to nursing institutions; Advisory services relating to [financial] risk management; Financial advisory services relating to assets management; Computer information services relating to financial management; Financial management services relating to convalescent institutions; Financial management services relating to local authorities; Financial management services relating to retirement homes; Financial management services relating to dental institutions; Advisory services relating to financial asset management; Financial management of reimbursement payments for others; Financial management of shares in other companies; Financial management services relating to banking institutions; Financial management services provided via the Internet; Financial consultancy in the field of risk management; Financial research in the field of risk management; Financial services for the management of credit cards; Financial exchange; Studies (Financial -); Financial underwriting; Sponsorship (Financial -); Financial analysis; Financial analyses; Financial studies; Financial clearing; Financial appraisals; Financial brokerage; Consultancy (Financial -); Financial evaluation; Financial assessments; Financial guardianship; Financial appraisal; Appraisals (Financial -); Consultations [financial]; Financial information; Information (Financial -); Financial planning; Financial sponsorship; Valuations (Financial -); Brokerage (Financial -); Financial consulting; Financial investment; Financial investments; Financial management of risk capital, investment capital and development capital; Provision of financial information for professionals in the field of portfolio management, for portfolio management; Portfolio management; Financial exchange services; Planning (estate -) [financial]; Financial information processing; Financial clearing houses; Financial appraisal services; Financial consultation services;

21. The contested *Fund management; Capital management; Cash management; Trust management; Funds management; Wealth management; Asset management; Share management;* and *Investment management* are all considered to be types of financial services and are therefore identical in all but name to the earlier mark's *Financial and monetary services*.

22. Whilst the wording of the contested *Building management; Property management; Housing management; Securities management; and Estate management* implies that the management relates to the tangible structures of buildings and properties themselves, the management is actually specific to the financial aspect of the structures by virtue of the contested services having been applied for in Class 36. The contested services are therefore all financial in nature and are subsequently included in the more general category of the earlier mark's *Financial services*. As such, the contested services *Building management; Property management; Housing management; Securities management; Estate management* are found to be identical in accordance with the *Meric* principle.

Class 42

23. The earlier mark is registered for the general category of *Computer services*. The following contested services all relate directly to computers or information technology (IT), and are therefore included in the general category *Computer services* of the earlier mark, making them identical in accordance with the *Meric* principle:

Computer technology consultancy; Information technology services; Information technology consulting services; Information technology [IT] consultancy; Information technology support services; Technological research relating to computers; Information technology [IT] consulting services; Information services relating to information technology; Computer and information technology consultancy services; Services for the provision of technological information; Technical consultancy services relating to information technology; Technological advisory services relating to computer programs; Compilation of information relating to information technology.

24. The contested *Technological design services* and *Technological services relating to design* are general categories that would include the earlier mark's more specific *Design of websites*, and are therefore identical in accordance with the *Meric* principle.

25. The contested services include *Engineering services relating to data processing technology* whilst the earlier mark includes *Data encryption services*. Although both services relate to data, the way in which they do so is quite different, with one being

the encryption of data and the other being the engineering of technology for processing data. The intended purpose, use, end user and trade channels are unlikely to be the same. Further, they do not appear to be in competition. The services would therefore appear to be dissimilar. However, the earlier mark is registered for *Data processors* in Class 9, which clearly utilise data processing technology. The *Engineering services relating to data processing technology* is therefore complementary to *Data processors* insofar as the former is important or essential to the latter.

26. The following contested services all relate to technology, either as a general category or in a more specific form:

Technological engineering analysis; Technological planning services; Technological advisory services; Technological research services; Expert opinion relating to technology; Professional consultancy relating to technology; Expert advice relating to technology; Development of new technology for others; Technological consulting services for digital transformation; Research in the field of telecommunications technology; Engineering services in the field of communications technology

Although the earlier mark is not registered for technological services per se, it is registered for the general category of *Computer services*. However, I do not consider the general category of *Computer services* to be similar to the above contested technological services. The main purpose of the type of computer services that are proper to Class 42 is to secure personal and financial data, and to detect attempts at data theft.¹ In my opinion, the intended purpose and (to a lesser extent) end user of such services will likely be different from the applicant's above services which offer technological research, or technical engineering analysis, or professional consultancy relating to technology. Further, I do not consider the respective services to be complementary or in competition, and therefore the above identified contested services are dissimilar. The same finding applies when comparing the identified

¹https://www.wipo.int/classifications/nice/nclpub/en/fr/?basic_numbers=show&class_number=42&explanatory_notes=show&gors=&lang=en&menulang=en&mode=flat¬ion=&pagination=no&version=20190101

contested services with the earlier mark's fundamentally financial goods and services in Classes 9 and 36.

27. Although the contested *User authentication services using blockchain technology* is also a technological service, it is particularised as relating specifically to user authentication. To my mind, user authentication is identical to the aspect of the earlier mark's *Computer services* which keeps secure personal data and detects unauthorized access. The contested *User authentication services using blockchain technology* is therefore identical.

28. Further to a full comparison of the goods and services at issue, all of the contested goods and services have been found to be either identical or complementary to those of the earlier mark, except for the following Class 42 services:

Engineering services relating to data processing technology; Technological engineering analysis; Technological planning services; Technological advisory services; Technological research services; Expert opinion relating to technology; Professional consultancy relating to technology; Expert advice relating to technology; Development of new technology for others; Technological consulting services for digital transformation; Research in the field of telecommunications technology; Engineering services in the field of communications technology.

29. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

30. In relation to the above identified Class 42 services found to be dissimilar there can be no likelihood of confusion. Consequently, I will continue with the assessment of a likelihood of confusion without considering such services.

Comparison of marks

31. 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 the marks, 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.”

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

33. The respective trade marks are shown below:

Earlier mark(s)	Contested mark
METaverse BANK THE METaverse BANK	MetaBank

34. The earlier mark is a series of two marks, consisting of the words “METaverse BANK” and “THE METaverse BANK”. The addition of the article THE has minimal

impact to my mind, and therefore I shall refer to the series of two earlier marks as one and the same, i.e., METAVERSE BANK. Both terms METAVERSE and BANK are presented in a plain, non-stylised font. Neither party has made direct submissions as to the meaning of METAVERSE, save for the Applicant implying it is the same as “Web 3” and not of the “real world”. According to the Collins English Dictionary, the METAVERSE is a proposed version of the internet that incorporates three-dimensional virtual environments, or is an already existing three-dimensional virtual world.² The meaning of the English-language word BANK is undoubtedly more well-known as referring to a financial institution, both as a brick-and-mortar building and as a concept where money is kept. The combination METAVERSE BANK hangs together to create the impression of a financial institution that exists either in a virtual environment, or for the purposes of a virtual environment. As such, neither element is more dominant.

35. The contested mark consists of the conjoined terms Meta and Bank. Both terms Meta and Bank are presented in a plain, non-stylised font. The Opponent did not make any submission as to the meaning of the contested mark. In its counterstatement, the Applicant indicated that it used Metadata in the provision of its services “thus the name MetaBank”. However, the contested mark is not ‘Metadata Bank’. According to the Collins English Dictionary the term Meta by itself means self-referential, concerned with cultural conventions, indicating change, or concerned with concepts of a particular discipline when used as a prefix.³ Whilst a certain number of consumers may be familiar with this meaning, I do not believe that Meta is a term that would be universally well-known by the majority of average consumers, and neither party provided submissions that it would be. I believe that a number of consumers may have heard of the word Meta but would be unsure of its precise meaning. The meaning of the second term Bank is the same as identified in reference to the earlier mark. By virtue of being conjoined, the two terms Meta and Bank hang together. For the consumer who is aware of the meaning of Meta, the concept created by the conjoined terms will either be that of a bank that is self-referential, or a bank that is concerned with being a bank, or (as indicated by the Applicant) a bank of/for metadata. For the consumer who is either unsure of the precise meaning of Meta, or who has never heard of the

² <https://www.collinsdictionary.com/dictionary/english/metaverse>

³ <https://www.collinsdictionary.com/dictionary/english/meta>

word, the concept of the conjoined terms will be understood as referring to a type of bank, although the specific type of bank will be unknown.

Visual similarity

36. The marks are visually similar insofar as they each contain the two combinations of four letters that create the words META/Meta and BANK/Bank. The letters/words in common represent the entirety of the contested mark. The marks are visually different due to the inclusion of the five letters VERSE in the earlier marks, which have no counterpart in the contested mark. I have explained that for convenience I will refer to both earlier marks in the series as METAVERSE BANK, based on my opinion that the word THE will have minimal impact. However, I do not discount the fact that the Opponent is entitled to use both forms of mark in the series, and in instances where it uses the form with the word THE, this will represent a visual difference from the contested mark.

37. Overall, the marks are considered to be visually similar to between a medium and high degree.

Aural similarity

38. The marks are aurally similar insofar as they each contain the two-syllable word META/Meta and one-syllable word BANK/Bank. The marks differ aurally due to the inclusion of the one-syllable term VERSE in the earlier mark, and also (when used) the word THE in the earlier mark.

39. Overall, the marks are aurally similar to between a medium and high degree.

Conceptual similarity

40. The earlier mark consists of the concept of a financial institution that exists in the virtual environment of the metaverse. The concept of the contested mark varies between a bank that deals with metadata, a bank that is self-referential, a bank that is only concerned with being a bank, or an unknown type of bank. The marks coincide in the concept of being/offering financial institutions (i.e., BANK/Bank). This is the extent of the conceptual similarity.

41. Overall, the marks are conceptually similar to a low degree.

Average consumer and the purchasing act

42. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

43. 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.”

44. The goods and services at issue include those which are financial by nature, and cover a broad range of financial aspects from every day average consumer consumables, such as *Credit cards* and *Financial loan services*, to more specific and specialist consumables, such as *Credit card encoding machines* and *Business liquidation services*. The goods and services at issue also relate to computing (Information Technology), design, data and authentication, all of which include both the everyday and more specialist versions of the consumable. The relevant consumer of the goods and services at issue with therefore include both the average and specialist consumer. Considering that to my mind the services will cover the entire spectrum of finance, the level of attention will encompass both low and high degrees attention, therefore being medium overall.

45. Based on the nature of the goods and services at issue, I consider the purchasing process to most likely be visually dominated. Whether the consumer is purchasing

Financial management software or *Property management services*, the consumer will invariably be examining the visual aspect of the related marks, and would therefore most likely be making a purchase decision based on the visual appearance of the marks. I do not dismiss the possibility that the marks may be spoken, for instance over the telephone or in conversation, and I accept that there may also be an aural element to the purchasing process.

Distinctive character of the earlier trade mark

46. The Opponent has not made a direct claim that its earlier mark has acquired an enhanced degree of distinctive character, nor has it filed any evidence of use that may indicate such a position. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

47. 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).”

48. The earlier mark consists exclusively of plain words without any additional stylisation or figurative elements, and as such any inherent distinctive character rests exclusively in the meaning of the words (THE) METAVERSE BANK. It seems to me that the earlier mark hangs together to create the concept of a bank that exists in the virtual environment, or a bank for use in relation to the virtual environment. Such a concept is currently unusual and futuristic, as the three-dimensional virtual world is in its infancy and is neither accessible nor used by the vast majority of ordinary consumers. However, the average consumer would be given a clear impression based on the meaning of the combination of words, being that of a financial institution that exists in the metaverse or exists for the finances of the metaverse.

49. Considering that the goods and services at issue are either financial or computer-based, the concept of the mark is not without descriptive meaning. I therefore do not consider the earlier mark to have a particularly high degree of distinctive character.

Likelihood of confusion

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

51. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle, whereby 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 (see *Canon*, C-39/97, para 17). Further factors to keep in mind include the distinctive character of the Opponent’s trade mark, the nature of the purchasing process, and the average consumer for the goods and services. As regards the average consumer, I must also be alive to the fact that the consumer rarely

has the opportunity to make direct comparisons between trade marks, and must instead rely upon the imperfect picture of them that he has retained in his mind.

52. Whilst conducting a global assessment of the likelihood of confusion I must be cogent to the fact that not all aspects of the respective signs will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods or services are marketed, and in which type of store they are made available.⁴ Having conducted a comparison of the marks at issue, I have determined that it is the visual consideration which is of primary importance in the assessment of a likelihood of confusion, due to the purchasing process of the respective goods and services being visually dominated.⁵ With this in mind, it is important to reaffirm that I have found the marks to be visually similar to between a medium and high degree. It is also important to reaffirm that I did not rule out the possibility that the marks may be spoken in certain purchasing environments, in which case it is also worth recognising that I found the marks to be aurally similar to between a medium and high degree.

53. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of

⁴ *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03

⁵ *Quelle AG v OHIM*, Case T-88/05

the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

54. Considering that it is the visual perspective which is the most important in the purchasing process of the goods and services at issue, the fact that the beginning of the contested mark and first mark in the series of the earlier mark are identical is significant. As for the second mark in the series, whilst it begins with the word THE, I consider this element to be non-distinctive, playing a lesser role than the subsequent METAVERSE BANK in the overall impression of the mark. In my view, the consumer would attribute less importance to the element THE element, and still perceive the marks at issue as sharing similar if not identical beginnings.

55. It is also significant that all eight letters of the contested mark are wholly contained within the earlier mark. Whilst the last four letters BANK/Bank of each mark will likely be perceived as being descriptive or non-distinctive in relation to the goods and services at issue, this does not detract from the fact that the shared letters nevertheless represent visually identical elements. The sharing of the first-four and last-four letters in each mark also creates an aural similarity between the marks, as the letter combinations consist of syllables that will be enunciated identically in each mark.

56. From a conceptual comparison stand-point, I have found the marks to be conceptually similar to only a low degree. This is because although the marks share the concept of 'Bank' (which is a descriptive or at least non-distinctive element in relation to many of the goods and services), the concepts of the terms METAVERSE and Meta are quite different. However, it is worth revisiting my opinion that I consider it possible for a certain number of consumers to be unsure as to the meaning of the

word 'Meta'. I find it entirely possible that a certain number of consumers may mistake the later mark MetaBank for the earlier mark METAVERSE BANK on the basis that they incorrectly assume the terms Meta and METAVERSE to be one and the same, or in the alternative that the former is a short-form version of the latter. Whilst I accept that the number of consumers who perceive this may not necessarily be in the majority, I nevertheless consider them to constitute a significant number, as I do not believe that 'Meta' is a particularly well-known term. With this in mind, I refer to the finding of Lord Justice Kitchen in *Interflora Inc v Marks & Spencer Plc* [2015] Bus LR 492, in which he confirmed a finding of confusion can be made if only a significant number (not necessarily the majority) of consumers are confused.

57. As for the consumer who does understand the different meanings of the terms Meta and METAVERSE, and for whom the marks are conceptually similar to only a low degree, they too could still nevertheless mistake the marks for one another. In *Nokia Oyj v OHIM*, Case T 460/07, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

58. I also refer to *Diramode S.A. v Richard Turnham and Linda Turnham* (BL O/566/19), in which Mr Geoffrey Hobbs QC, sitting as the Appointed Person, overturned a decision that the conceptual differences between PIMKIE and PINKIE were sufficient to outweigh the visual and aural similarities between them. Mr Geoffrey Hobbs QC found that:

‘Even though one of the marks in issue refers to a clear and immediately apparent concept and the other does not have a clear meaning which can be immediately perceived by the relevant public, the degree of visual and aural similarity between them may still be sufficient to give rise to the existence of a likelihood of confusion’.

59. Whilst the consumer may perceive certain conceptual differences between the marks METAVERSE BANK and MetaBank, it is nevertheless worth acknowledging that such differences would not neutralise the relatively strong visual and aural similarities between the marks.

60. It is worth briefly revisiting my finding that the distinctive character of the earlier mark is not particularly high due to its potentially descriptive or non-distinctive perception in relation to the goods and services at issue. However, I am aware that in *Formula One Licensing BV v OHIM*, Case C-196/11P, the CJEU found that a registered trade mark must be assumed to have at least some distinctive character. I am also aware that in *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found⁶ that a weakly distinctive earlier trade mark does not preclude the possibility of a likelihood of confusion. As such, the visual and aural similarities remain capable of causing confusion.

61. I am cognate of the fact that I have found a certain number of goods and services to be purchased by the specialist consumer, who invariably pays a higher degree of attention. However, as the GC found in *Vetpharma*,⁶ even a consumer with a higher degree of attention will rely on imperfect recollection and as such they are as equally susceptible as the average consumer to mistaking the later mark MetaBank for the earlier mark METAVERSE BANK, especially in relation to goods and services that have been found to be either identical or complementary.

62. Taking into account the factors that the goods and services at issue are either identical or complementary, that the marks are visually and aurally similar to between a medium and high degree, and that each type of consumer is subject to the impacts of imperfect recollection, I find it entirely possible that upon seeing/hearing the contested mark both types of consumer would mistake it for the earlier mark they had seen/heard previously.

63. In light of the above, I consider there to be a likelihood of direct confusion in relation to those contested goods services found to be either similar or complementary.

⁶ *Vetpharma Animal Health v EUIPO*, Case T-146/21

Conclusion

64. The opposition under Section 5(2)(b) is partially successful. Subject to an appeal, the application will be refused for the following contested goods and services:

Class 9 *Financial management software.*

Class 36 *Financial valuations; Financial advice; Financial consultancy; Financial research; Financial leasing; Financial affairs; Financial services; Financial banking; Financial consultation; Financial lending; Financial transactions; Financial forecasting; Financial management; Financial securities; Analysis (Financial -); Research (Financial -); Management (Financial -); Financial assistance; Financial evaluations; Clearing, financial; Financial credit services; Financial fund management; Financial sponsorship services; Collections (Organising financial -); Financial risk management; Financial loan services; Financial economic analysis; Financial intermediary services; Financial evaluations [banking]; Insolvency services [financial]; Financial payment services; Financially-guaranteed financing; Financial trust operations; Financial trust administration; Financial affairs services; Financial transaction services; Personal financial planning; Financial guarantee services; Financial brokerage services; Online financial transactions; Arranging financial transactions; Computerised financial analysis; Financial asset management; Financial loss management; Asset evaluation [financial]; Financial valuation services; Financial information services relating to financial bond markets; Financial information services relating to financial stock markets; Financial lending against security; Personal financial planning services; Financial credit scoring services; Financial analyses (Preparation of -); Economic research services [financial]; Preparation of financial reports; Financial management of companies; Factoring of financial undertakings; Financial management of pensions; Provision of financial securities; Business liquidation services, financial; Risk management [financial]; Financial trust management; Financial portfolio management; Financial management services; Financial management for businesses; Financial management of funds; Financial*

investment management services; Financial management of stocks; Risk management consultancy [financial]; Pension fund financial management; Management of financial assets; Financial management advisory services; Financial risk management services; Financial planning and management; Financial management and planning; Financial management relating to banking; Financial management of current accounts; Financial management of holding companies; Financial management of building projects; Financial management of membership schemes; Financial management of cash accounts; Financial management of share accounts; Financial advisory and management services; Financial management relating to investment; Financial management via the Internet; Financial information management and analysis services; Financial management services relating to hospitals; Financial management of real estate projects; Financial services relating to wealth management; Financial management of building renovation projects; Financial management of employee pension plans; Financial management of collective investment schemes; Financial management of building occupancy expenses; Financial management services relating to medical institutions; Financial management services relating to nursing institutions; Advisory services relating to [financial] risk management; Financial advisory services relating to assets management; Computer information services relating to financial management; Financial management services relating to convalescent institutions; Financial management services relating to local authorities; Financial management services relating to retirement homes; Financial management services relating to dental institutions; Advisory services relating to financial asset management; Financial management of reimbursement payments for others; Financial management of shares in other companies; Financial management services relating to banking institutions; Financial management services provided via the Internet; Financial consultancy in the field of risk management; Financial research in the field of risk management; Financial services for the management of credit cards; Financial exchange; Studies (Financial -); Financial underwriting; Sponsorship

(Financial -); Financial analysis; Financial analyses; Financial studies; Financial clearing; Financial appraisals; Financial brokerage; Consultancy (Financial -); Financial evaluation; Financial assessments; Financial guardianship; Financial appraisal; Appraisals (Financial -); Consultations [financial]; Financial information; Information (Financial -); Financial planning; Financial sponsorship; Valuations (Financial -); Brokerage (Financial -); Financial consulting; Financial investment; Financial investments; Financial management of risk capital, investment capital and development capital; Provision of financial information for professionals in the field of portfolio management, for portfolio management; Portfolio management; Building management; Property management; Investment management; Asset management; Share management; Housing management; Securities management; Fund management; Capital management; Cash management; Estate management; Trust management; Funds management; Wealth management; Financial exchange services; Planning (estate -) [financial]; Financial information processing; Financial clearing houses; Financial appraisal services; Financial consultation services.

Class 42 *Computer technology consultancy; Information technology services; Technological design services; Information technology consulting services; Information technology [IT] consultancy; Information technology support services; Technological research relating to computers; Technological services relating to design; Information technology [IT] consulting services; User authentication services using blockchain technology; Information services relating to information technology; Computer and information technology consultancy services; user authentication services using blockchain technology; Engineering services relating to data processing technology; Services for the provision of technological information; Technical consultancy services relating to information technology; Technological advisory services relating to computer programs; Compilation of information relating to information technology.*

65. Also subject to an appeal, the application will proceed to registration for the contested services found to be dissimilar, namely:

Class 42 *Engineering services relating to data processing technology; Technological engineering analysis; Technological planning services; Technological advisory services; Technological research services; Expert opinion relating to technology; Professional consultancy relating to technology; Expert advice relating to technology; Development of new technology for others; Technological consulting services for digital transformation; Research in the field of telecommunications technology; Engineering services in the field of communications technology.*

COSTS

66. Although the Opponent has not been wholly successful, it has nevertheless successfully opposed a substantial number of the applied for goods and services. I therefore consider it appropriate to award the Opponent a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the Opponent the sum of £300.

Filing a notice of opposition and considering the counterstatement	£300
Total	£300

67. I therefore order Kevin Ho to pay Simon Adrian Alexander Squibb the sum of £300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 25th day of July 2023

Dafydd Collins
For the Registrar
The Comptroller-General