BL O/1211/23

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED PROCEEDINGS FOR

TRADE MARK APPLICATION NOS. 3656855 AND 3656848

IN THE NAME OF ONEFOR HOLDING GMBH FOR THE TRADE MARKS

OneFor

AND

IN CLASSES 9, 16, 35, 36, 38 AND 42

AND THE OPPOSITIONS THERETO UNDER NOS. 428979 AND 428981

BY TSC VENTURES DESIGNATED ACTIVITY COMPANY

AND

THE OPPOSITIONS THERETO UNDER NUMBERS 428980 AND 428982

BY BLACKHAWK NETWORK, INC.

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF JUDI PIKE (O/194/23) DATED 24 FEBRUARY 2023.

DECISION

Introduction

1. This is an appeal by OneFor Holding GmbH ("**Appellant**") from decision O/194/23 of Ms J. Pike ("**Decision**") concerning the oppositions by TSC Ventures Designated Activity Company ("**First Respondent**") and Blackhawk Network, Inc ("**Second Respondent**") to the Appellant's applications for the marks OneFor ("**Word Application**") and the logo shown below ("**Logo Application**"), made pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU, in respect of the goods and services listed below (together "**the Applications**").

Class 9: *Debit cards and credit cards [encoded or magnetic]; software for processing electronic payments made by and for others; authentication software.*

Class 16: *Cash cards and credit cards [not encoded or not magnetic].*

Class 35: *Business management; business administration, in particular data research in computer files, business investigations, commercial and business information, market research, market analysis; office functions, in particular office functions for payment and receivables management, including as back-up service determination of payment data.*

Class 36: *Finance services; monetary affairs; real estate affairs; insurance; electronic funds transfer services; electronic payment services with electronic processing of payment data; credit card and debit card transaction processing; bill payment services; mobile electronic payment services; finance services, in particular electronic capital transfer; providing electronic mobile payment services for others; electronic foreign exchange payment processing; payment processing services, namely, providing virtual currency transaction processing services for others; clearing and reconciling financial transactions via a global computer network; finance services, in particular the provision of financial information, financial analysis, financial consultancy, financial services for the processing of debt purchases for third parties; monetary affairs, in particular collection of outstanding debts [collection transactions], payment and receivables management, review of the creditworthiness and soundness of commercial enterprises and private individuals, providing information in the area of debt collection and financial receivables in call centers, credit assessment and credit rating and risk assessment on the basis of mathematical-statistical calculations [scoring], including the preparation of score cards.*

Class 38: *Electronic transmission of payment data.*

Class 42: *Scientific and technological services and design relating thereto, in particular design of score cards; providing temporary use of online non-downloadable software for processing digital or electronic payments; providing temporary use of online non-downloadable authentication software for controlling access to and communication with mobile terminals, computers and computer networks.*

2. The Respondents opposed the Applications under sections 5(2)(b), 5(3) and 5(4) of the Trade Marks Act 1994. The First Respondent relied upon the following marks, the specifications of which are set out in the Annex to this decision:

No. 906979264 ("the **264 mark**")	Filing date: 11 June 2008 Registration date: 20 May 2009

 Colours claimed: Grey, orange, blue, purple, light yellow, dark yellow, light pink and dark pink.	
No. 913263108 ("the **108 mark**")  Colours claimed: Grey; orange; blue; purple; light yellow; dark yellow; light pink; dark pink.	Filing date: 17 September 2014 Registration date: 10 February 2015
No. 915749849 ("the **849 mark**")  Colours claimed: Red; White; Yellow; Light Blue; Purple; Pink; Orange; Light Grey; Light Red.	Filing date: 12 August 2016 Registration date: 14 March 2017

3. The Second Respondent relied upon the following marks, the specifications of which are set out in the Annex to this decision:

No. 3483428 ("the **428 mark**") One4All Favourites	Filing date: 22 April 2020 Registration date: 10 August 2020
No. 3483585 ("the **585 mark**")  	Filing date: 23 April 2020 Registration date: 9 October 2020

 Series of two marks.	

4. I shall refer to all the above as the "**Earlier Marks**".

5. In the Decision, J. Pike for the Registrar held that the oppositions were partially successful, with the Applications refused for all goods and services except for *real estate affairs*, for which they may proceed to registration.

6. On 24 March 2023 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decision

7. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):

   a. The average consumer is a member of the general public or a business consumer, exercising a degree of attention ranging from medium to high;

   b. The purchase will be made primarily on a visual basis, but there may also be an aural dimension;

   c. The Hearing Officer considered s.5(2)(b) primarily on the basis of the 849 Mark as it was not subject to proof of use, it had a wider specification than the other Earlier Marks and it was not significantly different to the other Earlier Marks;

   d. The 849 Mark has a low to medium degree of distinctiveness, which has been enhanced through use to a high level only in respect of gift cards;

   e. For the Word Application, there is a low to medium degree of visual similarity, a medium to high degree of aural similarity and a medium degree of conceptual similarity;

   f. For the Logo Application, there is a low degree of visual similarity, a medium to high degree of aural similarity and a medium degree of conceptual similarity;

   g. The Appellant's *real estate affairs* are dissimilar to the goods/services covered by the 849 Mark. However, all the other goods/services in the Applications are identical or in the alternative highly similar to the goods/services covered by the 849 Mark;

   h. Overall, there is a likelihood of both direct and indirect confusion with the 849 Mark in respect of all similar/identical goods, but not in respect of *real estate affairs*.

Grounds of Appeal

8. In the skeleton argument, the Appellant made the following criticisms of the Decision:

a. **Ground 1:** the Hearing Officer erred in her conceptual comparison of the Applications with the 849 Mark. Specifically, she correctly held that the 849 Mark will be perceived as the phrase "one for all" and that that phrase conveys a concept of "something which has universal application or can be used universally". However, the concept conveyed by the Contested Marks is an incomplete idea which leaves space for the consumer to complete the phrase or to seek further explanation. It is therefore a cryptic concept that tells the consumer only that something has a purpose but leaves the consumer to complete what that purpose is. Those two concepts are completely different and the Hearing Officer ought to have found not only that there was no conceptual similarity between the marks, but in fact that there was conceptual dissonance between the marks.

b. **Ground 2:** the Hearing Officer's error in Ground 1 vitiated the overall assessment of the likelihood of confusion, such that that global assessment must be undertaken afresh.

c. **Ground 3:** the Hearing Officer's conclusions regarding the likelihood of direct and indirect confusion are wrong in light of her findings earlier in the Decision.

9. The Appellant's Counsel, Ms Blythe, expanded upon the above at the hearing, and I set out below further details as are necessary to understand my overall conclusions. I am grateful to Ms Blythe for her clear and detailed written and oral submissions, which I found very helpful. The Respondent attended the hearing as an observer, but did not file any submissions or participate in the hearing.

Standard of review

10. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was recently summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

> **"Appellate Function**
>
> 24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS* O/039/21), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:
>
> i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
>
> ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);
>
> iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court

was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

25. In the context of appeals relating to the likelihood of confusion, an evaluative issue described by Mr Iain Purvis QC sitting as an Appointed Person in *ROCHESTER Trade Mark* BL O/049/17 at [31] as "indeterminate and open to debate", Mr Purvis QC went on to say this at [33]:

"…the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:

'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."'

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts."

11. I shall bear all the above in mind when reviewing the Decision.

A preliminary issue – the Grounds of Appeal

12. The Grounds of Appeal raise a number of criticisms of the Decision. My impression of the Grounds of Appeal is that they are diffuse and arguably do not disclose any error of principle or point to any part of the decision that is “wrong” in the sense set out 10(iii) above. The Respondent chose not to respond to the appeal, no doubt in part because it considered that the appeal, as set forth in the Grounds of Appeal, was weak.

13. After the appeal had been filed, the Appellant switched representatives (to Walker Morris), and instructed a very experienced trade mark Counsel, Ms Blythe. The skeleton argument was filed, as is customary, two days before the appeal hearing. On reading the skeleton argument, two

matters immediately stood out. First, it was clearly a very well-drafted document, disclosing powerful challenges to the Decision. Secondly, those challenges were arguably not foreshadowed in the Grounds of Appeal. I wrote to the parties prior to the hearing, proposing that the issue of whether the arguments in the skeleton argument were sufficiently pleaded in the Grounds of Appeal be considered at the outset of the hearing.

14. At the start of the hearing, Counsel for the Appellant conceded that Ground 3 in the skeleton was not foreshadowed in the Grounds of Appeal, and accepted that permission would be required for the Appellant to advance that particular argument. However, the Appellant submitted that Grounds 1 and 2 were adequately pleaded in the Grounds of Appeal, and that the Appellant was accordingly entitled to advance those arguments in the hearing. Had it been conceded that Grounds 1 and 2 were not sufficiently pleaded in the Grounds of Appeal, I would have been prepared to consider an application to adjourn the hearing to permit the Grounds of Appeal to be amended and the Respondent to respond to those as it saw fit, but in light of the Appellant's stance that was not necessary.

15. Rule 71(1A) of the Trade Marks Rules 2008 states:

> "Where the appeal arises in proceedings between two or more parties, notice of appeal to the person appointed under section 76 shall be filed on Form TM55P, which shall include the appellant's grounds of appeal and his case in support of the appeal".

16. In practice, the 'grounds of appeal' and 'statement of case in support' are almost always coalesced into a single document. No further guidance is given in the Trade Marks Rules as to the level of detail required in the Grounds of Appeal. That issue was addressed by Simon Thorley QC, sitting as the Appointed Person, in *COFFEEMIX Trade Mark* [1998] R.P.C. 717. Mr Thorley QC, after citing the relevant parts of the Trade Mark Rules 1994 (which were then in force) said:

> "It will thus be seen that the Statement of Grounds of Appeal and Statement of Case form an important part in the appeal procedure. The provisions of the Act providing for a right of appeal to the Appointed Person are significant in that they provide for a quick and cheap method of testing any decision of the registrar. The fact that no appeal lies from the decision of the Appointed Person enables finality at an early date. In the case of a trade mark application, this is important not only to the applicant but also in the wider public interest, so that the interested public may know at an early date the extent to which a monopoly by way of trade mark rights are to be granted to rival traders.
>
> Rule 58 provides both the registrar and the Appointed Person with the opportunity, having considered the Statement of Grounds of Appeal and Statement of Case, to conclude, pursuant to section 76(3) of the Act, that a point of general legal importance may be involved which justifies any additional delay and expense which would be occasioned by a reference to the High Court followed, possibly, by an appeal to the Court of Appeal and beyond.
>
> It is plain from section 76(3) and from rules 57 and 58 that, if a matter is one which either the registrar or the Appointed Person believes might properly be transferred to the Court, observations by the other parties should be made at an early date so that no unnecessary delays occur.
>
> The above considerations highlight the importance of a full Statement of Grounds of Appeal and Statement of Case being served pursuant to rule 57. When I say full, I do not

mean that the document should be prolix or, indeed, drafted with any degree of formality, such as might be the case as with a Notice of Appeal to the Court of Appeal. It must be full in the sense that it must outline each of the grounds of appeal relied upon and state the case relied upon in support of those grounds. It should be as succinct as possible but it must be complete".

17. I respectfully agree with all that Mr Thorley QC said, which remains applicable despite the 1994 Rules having been superseded, and would add as follows. The Grounds of Appeal are arguably a more important document in appeals to the Appointed Person than in appeals to the High Court or Court of Appeal. Unlike the latter, the Grounds of Appeal in appeals to the Appointed Person are not accompanied by a skeleton argument, and there are no sequential skeleton arguments – rather, each party files its skeleton argument shortly before the hearing. Consequently, a very important purpose of the Grounds of Appeal in appeals to the Appointed Person is to properly delineate the arguments on appeal so that the Respondent is given good advance notice of the points they have to address in their skeleton argument and at the hearing.

18. The issue of what constitutes "complete" was further addressed by Geoffrey Hobbs QC (as he then was) in *DEMON ALE Trade Mark* [2000] RPC 345 at 357:

> "Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focused statement of the grounds upon which they intend to maintain that the tribunal should or should not do what it has been asked to do. The statement should not be prolix. It should, however, be full in the sense indicated by Mr Simon Thorley Q.C. in *COFFEEMIX Trade Mark* [1998] R.P.c. 717 at 722:
>
> "It must be full in the sense that it must outline each of the grounds ... relied upon and state the case relied upon in support of those grounds. It should be as succinct as possible, but it must be complete".
>
> If a party fails to provide sufficient information in his pleadings as to the nature or extent of the grounds upon which he relies, the registrar "may direct that such ... information as he may reasonably require should be filed within such period as he may specify" under rule 51 of the Trade Marks Rules 1994. The Appointed Person has the same power by virtue of rule 59(2) of the 1994 Rules. A direction may be given under rule 51 by the registrar (or the Appointed Person) of his own motion or upon the application of a party to the proceedings before him".

19. In other words, Mr Hobbs QC suggested that the Appellant should specifically identify the alleged errors in the Decision under appeal by itemising:

- what the Hearing Officer did, but should not have decided, and
- what the Hearing Officer did not, but should have decided.

20. Again, I respectfully agree with Mr Hobbs QC that by adopting that approach, an Appellant will ensure that the required level of detail will be achieved.

21. Turning to the present case, the skeleton argument effectively disavows most of the Grounds of Appeal, stating at §6 "The Appellant filed lengthy grounds of appeal. However, since filing that document, the Appellant has changed representatives and has decided to significantly

narrow its grounds of appeal. The Appellant now effectively relies only upon the errors encapsulated by §17 of the Grounds of Appeal".

22. §17 of the Grounds of Appeal reads:

> "The Opponent's Mark under UK Trade Mark Registration No. 915749849 consists of a red misshapen rectangle, with differing shades of red and therein is ONE4ALL in white font with a number 4 being in various multicolours. The Opponent's Mark also draws reference to The Three Musketeers well known phrase "all for one and one for all!", and this will be recalled by the relevant consumer when they see and hear the Opponent's Mark. The relevant consumer will also notice that the Opponent's Mark contains a number 4 whereas the Appellant's mark contains no numbers. Whilst the marks share the prefix ONE-, the suffixes differ with the -4ALL of the Opponent's marks and the -FOR of the Appellant's marks. The Opponent's Mark is also heavily stylised and as such, protection is in the stylisation of the mark as a whole, which limits the scope of protection of the Opponent's Mark. The relevant public will notice the multicolour in the Opponent's Mark whereas the Appellant's Marks are in black and white. The stylisation of the Appellant's logo mark is also dissimilar to the stylisation of the Opponent's Mark. In view of the above, the Hearing Officer has respectfully erred in finding that the Appellant's marks are confusingly similar to that of the Opponents".

23. During the hearing, the Appellant also contended that §14 of the Grounds of Appeal was relevant to the issue of whether the Grounds of Appeal were sufficiently pleaded. §14 reads:

> "It is also noted that with respect the Hearing Officer made an error when comparing the Appellant's Marks with those of the Opponents on the basis that the Hearing Officer only compared the Appellant's Marks against one of the Opponent's Marks only. This is not a fair and accurate comparison of the marks and as such the Appellant requests that the Appointed Person acknowledge this and rectify this error of judgement. Even where the Hearing Officer compared one of the Opponent's Marks with that of the Appellants, we submit that an error was made in comparing the marks and as such, we request that the Appointed Person review the comparison of the marks in its totality".

24. Standing back, I cannot see that the argument in Ground 1 of the skeleton argument is pleaded at anything approaching a sufficient level in the Grounds of Appeal. Whereas §17 of the Grounds does state "the Hearing Officer has respectfully erred in finding that the Appellant's marks are confusingly similar to that of the Opponents", that is preceded by the wording "In view of the above", and none of the errors alleged in the earlier part of §17 relate to the conceptual similarity of the marks. §14 contends that "an error was made in comparing the marks", but without any further details. At the very least, I would have expected to see a statement of whether the error concerned aural, visual or conceptual similarity, and the nature of the error. For example, was it an error of law, a failure to appreciate the correct facts, a failure to take into account an undisputed fact, or something else? The Grounds of Appeal simply do not say.

25. In my view, not only was the scope of Ground 1 entirely undisclosed in the Grounds of Appeal, the specifics which were included in the Grounds of Appeal were positively misleading in light of the Appellant's subsequent change of case, as they concerned entirely different alleged errors which have all now been abandoned. The Respondent, had it chosen to respond, would have had no idea what it needed to address in its skeleton argument in relation to Ground 1 as eventually pleaded in the Appellant's skeleton argument.

26. Whereas Ground 2 is pleaded in the Grounds of Appeal, it is stated to be contingent on the error alleged in Ground 1 being made out. Absent such an error being established, Ground 2 adds nothing over Ground 3, which invites the Appointed Person to find that the Hearing Officer's analysis of the likelihood of confusion was wrong.

27. Given, then, that the grounds as set out in the skeleton argument were not pleaded in the Grounds of Appeal, what is to be done? The Appellant did not seek permission to amend the Grounds of Appeal to accommodate grounds 1 and 2 of the skeleton argument, on the basis that the Grounds of Appeal were adequately pleaded. In my view, it would not be fair on the Respondent to permit the Appellant to rely on inadequately pleaded grounds. Although the Respondent chose not to participate in the appeal, that decision was made on the basis of the Grounds of Appeal, which as I explained above arguably does not disclose any error of principle or point to anything that is wrong in the Decision. The Respondent may well have acted differently had it been confronted, at the outset of the appeal, with the grounds set forth in the skeleton argument. Accordingly, I consider that I have no option other than to dismiss the appeal based on grounds 1 and 2, on the basis of non-compliance with the rules which I outline in paragraphs 15-20 above.

28. As for ground 3, I informed the Appellant during the hearing that I was refusing permission to amend the Grounds of Appeal to include the argument that the Hearing Officer's analysis of likelihood of confusion was simply wrong. That was for two reasons. First, as with grounds 1 and 2, I consider it would be unfair on the Respondent to allow the Appellant to advance a case at the hearing that the Respondent had been unable to consider and respond to. Secondly, and as conceded by the Appellant, ground 3 is very much weaker than grounds 1 and 2. For all the reasons set out in paragraph 10, a contention that a multifactorial analysis is wrong is difficult to sustain in the absence of a distinct error of principle. For my part, unless an error of principle can be established in relation to one or more of the factors taken into account by the Hearing Officer, her finding of a likelihood of confusion in this particular instance is unlikely to be "outside the bounds within which reasonable disagreement is possible".

29. Although the above suffices to dismiss this appeal, I shall briefly address grounds 1 and 2 of the skeleton argument, as they were fully argued at the appeal hearing.

Discussion

30. Looking at each of the grounds in turn, my analysis is as follows.

(1) The Hearing Officer erred in her conceptual comparison of the Applications with the 849 Mark

31. The Hearing Officer found that the 849 Mark will be perceived as the phrase "one for all" and that that phrase conveys a concept of "something which has universal application or can be used universally" (§43 of the Decision). That finding is not challenged by the Appellant.

32. As for the Applications, the Hearing Officer states at §43 that they consist of "an unfinished phrase 'One For', leaving the notion of what the something is for as unanswered". Whereas the Appellant agrees with that analysis, it submits that the concept conveyed by the Applications is "an incomplete idea which leaves space for the consumer to complete the phrase or to seek further explanation. It is therefore a cryptic concept that tells the consumer only that something has a purpose but leaves the consumer to complete what that purpose is".

33. The Appellant further submits that those two concepts are completely different and the Hearing Officer ought to have found not only that there was no conceptual similarity between the marks,

but in fact that there was conceptual dissonance between the marks in that both marks conveyed a completely different message.

34. I consider that the above is a good argument, but in my view the Appellant's further criticism of the Decision is even more compelling. The Appellant points out that whereas the Hearing Officer recognised in §43 that the 'universal' meaning of the 849 Mark "is not present in the later marks", she nonetheless went on to conclude in that same paragraph that the marks still have a medium degree of conceptual similarity. I consider that it was a clear error of principle for the Hearing Officer to make a finding of a medium degree of conceptual similarity which is not only unsupported, but is in fact undermined by, her earlier analysis of the meaning of the Applications.

35. Accordingly, had ground 1 been sufficiently foreshadowed in the Grounds of Appeal, I would have held that there is a conceptual dissonance between the 849 Mark and the Applications.

(2) The Hearing Officer's error in Ground 1 vitiated the overall assessment of the likelihood of confusion, such that that global assessment must be undertaken afresh

36. Given the above, it would have been necessary for me to revisit the global assessment of likelihood of confusion. The Hearing Officer held that the degree of visual similarity was low to medium in respect of the Word Application and low in respect of the Logo Application (§41).

37. Aurally, the Hearing Officer found the degree of similarity to be medium to high (§42). However, having found that the average consumer is likely to make their purchase "on primarily a visual basis, having seen websites and/or physical premises" (§35), the aural similarities are of less importance than the visual similarities.

38. The Appellant submits, and I accept, that a low degree of visually similarity can be neutralised by a strong conceptual difference between the marks. I consider that the conceptual difference between the marks would be likely to obviate any likelihood of direct confusion. As for indirect confusion, I am doubtful that the average consumer would assume "that the parties' marks are brand variants, brand updates or indicate expansions to what goods and services are offered", given that a distinctive feature of the Earlier Marks – the substitution of the numeral "4" for the word "FOR" – is not replicated in the Applications.

39. Overall, whereas it is not entirely clear cut, I would have been minded to allow the appeal on Ground 2.

Conclusion

40. Although grounds 1 and 2 in the skeleton argument reveal a distinct and material error of principle in the Decision, those grounds were not adequately pleaded in the Grounds of Appeal. Accordingly, although with some reluctance, I must dismiss this appeal. The Applications are refused for all goods and services except for *real estate affairs*, for which they may proceed to registration.

Costs

41. Clearly, the Respondent has been the successful party in this appeal. However, the Respondent played no part in the appeal, and has accordingly incurred no costs. I therefore make no order as to costs in this appeal. However, the Hearing Officer's order that the Appellant shall pay £1,890 to the Respondent still stands.

Dr. Brian Whitehead

22 December 2023

Representation

Ms Charlotte Blythe of Counsel for the Applicant / Appellant, instructed by Walker Morris LLP

Barker Brettell LLP for the Opponent / Respondent, who did not participate in the appeal

Annex – the earlier marks other than

906979264

Class 9: Electronic publications, smart cards, electronic multi retail vouchers, electronic credit cards, electronic debit cards, encoded cards, cards bearing stored information; telecommunications apparatus and equipment; recording, testing and regulating equipment; computer software and programs; data and databases recorded on data carriers.

Class 16: Printed cards, printed matter, printed multi retail vouchers, printed publications, purchase cards and gift vouchers, magazines, stationery, diaries, pre-printed forms, identity cards, instructional and teaching material, greetings cards.

Class 35: Organisation, operation and supervision of sales and promotional incentive schemes; provision of information relating to accounts; provisions of statements of account; data processing services; computerised record keeping, accounting and database management services; call centre services; registration services for electronic payment cards, financial cards, purchase cards and gift vouchers; user incentive schemes relating to gift vouchers; provision of promotional services; business planning, assistance and management services; business administration services; procurement services; business investigations and surveys; book-keeping and accounting services; tax assessment preparation; provision of information related to tax, tax consultancy and planning services; business consultancy and advisory services; provision of statements of account, registration and administration services for companies; document reproduction services; computerised record-keeping, accounting and database management services; registration services for credit cards, charge cards, cash cards, cheque guarantee cards, debit cards, payment cards, financial cards and purchase cards; user incentive schemes relating to use of gift voucher cards; consultancy, information and advisory services relating to all the foregoing.

Class 36: Banking, financial and monetary services; provision of financial services to support gift vouchers, foreign currency services; value added tax refund services; insurance services; valuation and financial appraisal services; administration of financial affairs; financial settlement services; trustee services; cash management services; cash dispensing services; financial card services; credit card, charge card, cash card, cheque guarantee card, purchase card, payment card and debit card services; rental, hire and lease equipment for processing foreign cards and data relating thereto; investment and savings services; financial advice relating to taxation; financial planning and investment advisory services; financial research; collateral agency services, namely those concerning additional and separate security for repayment of money borrowed; safe custody services; issuing of printed and electronic gift and multi retail vouchers; consultancy, information and advisory services relating to the foregoing.

913263108

Class 38: Telecommunications, communications, telephone, fax, telex, message collection and transmission, and electronic mail services; transmission and reception of data and of information; electronic message delivery services; data interchange services; transfer of data by telecommunication; broadcasting or transmission of radio or television programmes; video text services; television screen based text transmission services and view data services; video conferencing services; telecommunication of information including web pages; providing user access to the Internet; providing telecommunications connections to the Internet or databases; computer-aided

transmission of messages and images; advice, information and consultancy services related to the aforementioned.

Class 39: Travel agency services, booking agency services, arranging, booking and reserving holidays, travel and tours by land, sea and air; delivery services; information, advice and consultancy services relating to the aforementioned.

Class 42: Application service provider; technological services; research services; design services; provision of on-line information, advice and consultancy relating to all the services in this class.

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Class 9: Electronic publications, smart cards, electronic multi retail vouchers, electronic credit cards, electronic debit cards, encoded cards, cards bearing stored information; telecommunications apparatus and equipment; recording, testing and regulating equipment; computer software and programs; data and databases recorded on data carriers; mobile apps.

Class 16: Printed cards, printed matter, printed multi retail vouchers, printed publications, purchase cards and gift vouchers, magazines, stationery, diaries, pre-printed forms, identity cards, non encoded and non magnetic, instructional and teaching material, greetings cards.

Class 35: Organisation, operation and supervision of sales and promotional incentive schemes; provision of information relating to accounts; preparation of statements of account; data processing services; computerised record keeping, accounting and database management services; management of telephone call centres for others; registration services for electronic payment cards, financial cards, purchase cards and gift vouchers; user incentive schemes relating to gift vouchers; provision of promotional services; business planning, assistance and management services; business administration services; procurement services; business investigations and surveys; book-keeping and accounting services; tax assessment preparation; provision of information related to tax, tax consultancy and planning services; business consultancy and advisory services; provision of statements of account, credit card registration services for companies, business administration services; document reproduction services; computerised record-keeping, accounting and database management services; registration services for credit cards, charge cards, cash cards, cheque guarantee cards, debit cards, payment cards, financial cards and purchase cards; user incentive schemes relating to use of gift voucher cards; consultancy, information and advisory services relating to all the foregoing.

Class 36: Banking, financial and monetary services; provision of financial services to support gift vouchers, foreign currency services; value added tax refund services; insurance services; valuation and financial appraisal services; administration of financial affairs; financial settlement services; trustee services; cash management services; cash dispensing services; financial card services; credit card, charge card, cash card, cheque guarantee card, purchase card, payment card and debit card services; rental, hire and lease equipment for processing foreign cards and data relating thereto; investment and savings services; financial advice relating to taxation; financial planning and investment advisory services; financial research; collateral agency services, namely those concerning additional and separate security for repayment of money borrowed; investment custody services; issuing of printed and electronic gift and multi retail vouchers; consultancy, information and advisory services relating to the foregoing.

Class 38: Telecommunications, communications, telephone, fax, telex, message collection and transmission, and electronic mail services; transmission and reception of data and of information; electronic message delivery services; data interchange services; transfer of data by telecommunication; broadcasting or transmission of radio or television programmes; video text services; television screen based text transmission services and view data services; video conferencing services; telecommunication of information including web pages; providing user access to the Internet; providing telecommunications connections to the Internet or databases; computer-aided transmission of messages and images; advice, information and consultancy services related to the aforementioned.

Class 42: Application service provider; technological services; research services; design services; provision of on-line information, advice and consultancy relating to application service provider services, technological services, research services, design services.

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Class 36: Issuing stored value cards.