

O-340-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2529903  
BY STATE STREET (JERSEY) LIMITED  
TO REGISTER THE TRADE MARK**

**Cash<sup>2</sup>**  
IN CLASS 36

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER Nos. 100267 BY  
CHEQUEPOINT FRANCHISE CORPORATION**

## BACKGROUND

1) On 22 October 2009 State Street (Jersey) Limited, formerly Mourant & Co Limited, (hereinafter the applicant), applied to register the following trade mark:

# Cash<sup>2</sup>

2) In relation to “Financial services; banking; financial services provided via the Internet; provision of Financial Information” in Class 36.

3) The application was examined and accepted, and subsequently published for opposition purposes on 11 December 2009 in Trade Marks Journal No.6815.

4) On 11 March 2010 Chequepoint Franchise Corporation (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Filing date/ registration date	Class	Specification
Cash22 CASH22 cash22  A series of three marks	2510862	11.03.09 / 26.06.09	14	Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.
			16	Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters packaging materials; printers' type; printing blocks; disposable nappies of paper for babies; printed publications; paint boxes for children; cheque book holders.
			36	Insurance; financial services; real estate agency services; building society services; banking; stockbroking; financial services provided via the Internet; issuing of tokens of value in relation to bonus and loyalty schemes; provision of financial information.

b) The opponent states that its mark is well known in the UK with regard to the services for which it is registered and that the mark in suit and the services applied for are similar to the earlier mark and its specification. As a result it contends that the mark in suit offends against Sections 5(2)(b), 5(3) and 5(4)(a) of the Act. The grounds of opposition under Section 5(3) and 5(4)(a) were withdrawn by the opponent on 25 March 2011.

5) On 16 July 2010 the applicant filed a counterstatement which denied the opponent's claims. They also pointed out that they provide an investment service for corporate and high net worth

individuals, investing at least £250,000 whereas the opponent provides a high street money transfer and currency exchange service. They also point out that they have been using their mark since at least 29 September 2006, earlier than the date of first use claimed by the opponent which was given as “mid 2008”.

6) Both parties filed evidence, and both seek an award of costs in their favour. The matter came to be heard on 5 September 2011. At the hearing, the applicant was represented by Ms Szell of Messrs Venner Shipley; the opponent was represented by Ms Nursaw of Messrs Reddie & Grosse.

### **OPPONENT’S EVIDENCE**

7) The opponent filed a witness statement, dated 25 October 2010, by Catherine Nursaw the opponent’s Trade Mark Attorney. This merely provides copies of correspondence between the parties when seeking an amicable resolution to the opposition.

### **APPLICANT’S EVIDENCE**

8) The applicant filed two witness statements. The first, dated 25 January 2011, is by Justin Chapman who is Head of the applicant’s Treasury Department. He states that the first deposit under the mark in suit was made on 29 September 2006. He states that the applicant provides an investment service with initially a £1million minimum investment, later reduced to a minimum of £250,000. At exhibit JC1 he provides a copy of an advertisement in which the applicant’s mark is referred to as “cash squared” and the investment service offered is explained.

9) The second witness statement, dated 25 January 2011, is by Matt McManus an employee of the applicant company. He provides a Google search of the opponent which seems to show that they are involved in money transfers, pay day loans and pawn broking.

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

### **DECISION**

11) The only ground that remains is under Section 5(2)(b) which reads:

“5.-(2) A trade mark shall not be registered if because -

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

13) In these proceedings the opponent is relying upon its earlier mark which has an application date of 11 March 2009. It is clearly an earlier trade mark and as it had not been registered for five years at the point at which the application was published it is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

14) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

15) In essence the test under section 5(2)(b) is whether there are similarities in marks and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the services, the category of services in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the services in their specifications.

16) In the instant case the opponent has not provided any evidence regarding use of its mark. It cannot therefore benefit from an enhanced reputation. To my mind, the opponent's mark enjoys only a very modest level of inherent distinctiveness given that the services being relied upon relate to financial matters and the initial part of the mark is the word "cash".

17) I now turn to consider the services of the two parties. In its' skeleton argument the applicant accepted that the services of the two parties must be regarded as identical.

18) I must determine who the average consumer would be for the services of both parties. Broadly speaking the relevant services are banking and financial services. The applicant referred me to BL O-148-10 where Professor Annand acting as the Appointed Person quoted from the decision of the Hearing Officer:

“The average consumer for financial services can be either the general public or commercial undertakings. There is no evidence regarding the nature of the purchasing act but, it is my experience that, this is normally reasonably well considered with potential customers taking note of charges, interest rates, price comparisons, accessibility of services etc before entering into the purchasing act. I do not believe that this would be appreciatively different for personal or commercial banking or other financial activities.”

And:

“As both sets of services require a well considered purchasing act, it follows that the relevant consumers will have a greater ability to discern between trade marks and the undertakings providing the respective services when compared with, for example, the purchasing act involved in the trade of a common consumer item.”

19) I am content to adopt this reasoning. I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant’s mark	Opponent’s mark (series of three)
Cash <sup>2</sup>	Cash22 / CASH22 / cash22

20) The opponent’s mark is a series of three but they are virtually identical and so I shall simply use the initial mark in the series and refer to it in the singular. The applicant referred me to the following OHIM cases. In case 349/2010 the First Board of Appeal said:

“19. Phonetically, the public may pronounce the contested trade mark ‘Run2’ as ‘run squared’, as the applicant suggests, or as ‘run’ plus the equivalent word for ‘squared’ in another language. The meaning ‘squared’ is commonly expressed by the notation of a superscript ‘2’ in connection with numbers or variables. The way the number 2 is represented is unusual and will be highlighted in the respective trade mark when referring to it verbally, either by the word ‘squared’ or the description ‘superscript 2’ or in a similar way in other languages.”

21) Also opposition number B1205459 where the following was stated at page 5:

“Visually, the earlier mark coincides with the contested mark in the letters “e”, “n”, “e”, “r” and “g” albeit in different stylised lettering. They differ in the letters “ie” and “ia” of the earlier mark as opposed to the letter “y” of the contested mark, in the words SOLAR TERMODINÂMICA” and the device of a wavy line of the earlier mark and the numeral “2” of the contested mark. Bearing in mind the foregoing the Office considers that there is a medium degree of visual similarity.

Aurally, “energie” of the earlier mark and “energy” of the contested mark are pronounced identically. The earlier mark contains the additional syllables en//er//gi//a sol//ar term//o//din//am//ic//a and the contested mark also contains the syllable “squared” or its equivalent depending on the language.

Bearing in mind the foregoing, the Office considers that the signs have a medium degree of aural similarity.

Conceptually, in English the word "energy" means a source of power as does the word "energie" of the earlier mark in German and the similar words "énergie" in French "energía" in Spanish and "energia" in Portuguese. In Portuguese the phrase "ENERGIA SOLAR TERMODINÂMICA" means thermodynamic solar energy.

The small numeral "2" of the contested mark is a mathematical symbol indicating to multiply a number by itself, as seen in the Cambridge dictionary on-line.

Therefore, the signs are conceptually similar insofar as they contain the word "energie" and "energy", at least for the English, German, Spanish, French and Portuguese speaking consumers.

It follows from the above that the signs are similar to a certain degree."

22) However, I also note the following from OHIM Case 235/05:

- 42 It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.
- 43 It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.
- 44 In the second place, as was pointed out at paragraphs 35 and 36 of this judgment, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.
- 45 The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that

consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

23) The applicant contended that the number in the instant mark would be viewed by the average consumer as a superscript number and be referred to as “squared”. I agree that this is one way that the mark can be viewed but I do not accept that all consumers will view it in the same manner. In my opinion superscript numbers are most commonly used after a number to indicate that the number is squared, cubed etc. I do not believe that superscript numbers are commonly used as an alternative to the word “squared” or that they are usually used following a word. I do not accept the contention that the distinctiveness of each mark lies in their numbers and that I should ignore the word element “cash” as this is descriptive when used with the services in the instant case. I do not believe that the average consumer would upon viewing the two marks ignore the initial word element and instead focus solely upon the number “22” and the superscript “2”. I believe that they will be regarded as wholes and whilst the word element is inherently weak, the combination of a word and number makes for marks which whilst weak, each have a small degree of inherent distinctiveness.

24) Visually the two parties’ marks have a degree of similarity in that they both contain the word “cash”. However, this is not particularly distinctive when applied to financial and banking services as in the instant case. The applicant’s mark has a superscript numeral “2” whereas the opponent’s mark has the number “22”. To my mind there is a considerable degree of visual similarity.

25) Aurally the applicant contends that its mark would be pronounced as “cash squared” whereas the opponent’s mark would be pronounced as “cash twenty- two”. The opponent does not accept that the average consumer would view the applicant’s mark as being the equivalent of “cash squared” but instead would view it as “cash two”. To my mind, consumers would be split as to pronunciation, with some using “cash–squared” and others using “cash-two”. It is common to read of employers decrying the lack of basic mathematical ability in prospective employees, this strengthens my view that the majority of the population will be unaware of what a superscript number denotes. The opponent also contended that its mark could be spoken as “cash-two-two”. Whilst I think that it is more likely that the opponent’s mark will be oralised as “cash-twenty-two” I cannot rule out the possibility that some consumers may use “cash-two-two”. Aurally there is therefore a degree of similarity, which just outweighs the differences. “Cash-two-two” obviously being closer than “cash twenty-two”.

26) Conceptually, I believe that consumers will be split on whether they view the applicant’s mark as “cash-squared” or “cash<sup>2</sup>” but in either case I believe that it does not conjure up a picture or image, and so the applicant’s mark is conceptually neutral. It was contended that the opponent’s mark would be seen as a play upon the phrase “catch-22”, which refers to the concept of a paradoxical set of circumstances which preclude any attempt to escape them. The phrase comes from the book by Joseph Heller which was also made into a film in 1970. It was contended that the phrase was well known. No evidence as to the popularity of the book film or phrase was provided. I do not accept that the majority of consumers will be familiar or even conversant with the phrase or its meaning. I believe that they will view the mark as simply the

word “cash” and the number “22”. Consequently, I do not believe that there is any conceptual difference between the two marks.

27) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. In this case the services will not be entered into without some consideration and the earlier mark has a low degree of distinctive character. However, the services are identical and the similarities between the marks outweigh any differences. I therefore conclude that there is a likelihood of confusion with the earlier trade mark. The ground of opposition under Section 5(2)(b) therefore succeeds.

#### COSTS

28) The opponent has been successful in the single ground which it maintained. As such it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£200
Preparing evidence and considering and commenting on the other side’s evidence	£500
Preparing for and attending a hearing	£400
Expenses	£200
<b>TOTAL</b>	<b>£1,300</b>

29) I order the applicant to pay the opponent the sum of £1,300. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 04 day of October 2011**

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