

O-381-16

IN THE MATTER OF THE TRADE MARKS ACT 1994

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

AND IN THE MATTER OF OPPOSITION
No. 402643 BY
THE ROYAL BANK OF SCOTLAND GROUP PLC

ON APPEAL FROM THE DECISION OF MR GEORGE SALTHOUSE
DATED 4th JANUARY 2016

DECISION

1. This is an appeal from a decision of Mr George Salthouse, the Hearing Officer for the Registrar, in the opposition by Royal Bank of Scotland Group Plc (“RBS”) to the registration of the mark ‘MINT.’ Mr Salthouse decided that the opposition succeeded and the Applicant, Intuit Inc, appeals that decision.

Background

2. On 18 December 2013, the Applicant applied to register the trade mark **MINT** for the following the following goods in Class 9 and services in Classes 35 and 36:

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

Class 35: Business management; business administration; office functions; accounting; bookkeeping; administrative accounting; business management advice and assistance; company and business information; compilation of statistics; price comparison services; compilation of information into computer databases; data search in computer files for others; economic forecasting; computerised file management; providing information, news, opinions and advice in the fields of

accounting, tax preparation and planning, personal budgeting, household budgeting and consumer spending, including via computer or communication networks, the internet, social media and software applications; providing comparisons of the products and services of others, including through computer or communication networks, the internet, social media and software applications; providing economic forecasting and analysis, including through computer or communication networks, the internet, social media and software applications.

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

3. The application was published in January 2014, and on 7 August 2014 RBS filed this opposition, relying upon three earlier marks;
 - a. UK registered trade mark **MINT**, No. 2360715G, ("the 715 Mark") registered in 2008 with effect from April 2004 for goods in Classes 9 and 16 and services in Classes 35 and 36;
 - b. EUTM **MINT**, No. 3899333, registered in November 2005 with effect from June 2004 for goods in Class 9 and services in Class 36; and
 - c. EUTM **MINT MOBILE**, No. 5317102, ("the Mint Mobile Mark") registered in June 2010 with effect from September 2006 for goods in Classes 9 and 16 and services in Class 35.

The full specifications of those marks as registered are set out in Annex A hereto.

4. The opposition was based upon sub-sections 5(1) and 5(2) relying on all three earlier marks, and upon sub-sections 5(3) and 5(4)(a) relying upon reputation and goodwill in the 715 Mark.
5. The Applicant put RBS to proof of use of the 715 Mark and of EUTM 3899333, save in relation to use in respect of credit cards. Evidence was filed on both sides, including two witness statements made by RBS's Head of Intellectual Property, Mr Richard Curtin, seeking to prove use of the Marks, and the reputation and goodwill in the 715

Mark. The Applicant also filed evidence dealing mainly with its pre-existing business in the USA.

6. No hearing was sought. The Applicant alone filed written submissions and the Hearing Officer decided the opposition on the papers. In brief, he decided:

As to proof of use:

- a. The relevant period for proof of use was 9 May 2009 to 8 May 2014. RBS had proved use of the 715 Mark and of EUTM 3899333 for a limited range of goods and services ("the Effective Goods/Services"), namely for credit cards in Class 9 and for the limited range of services in Class 36 shown in Annex B hereto;

As to s 5(2)(b)

- b. None of the goods or services applied for were similar to the Effective Goods/Services of the 715 Mark or to the Effective Goods/Services of EUTM 3899333;
- c. All of the Applicant's goods in Class 9 were similar to RBS's broader range of Class 9 goods in the specification of the Mint Mobile Mark, but none of the Applicant's Class 35 or 36 services were similar to any of the goods/services of the Mint Mobile Mark;
- d. The 715 Mark and EUTM 3899333 were identical to the mark applied for, and the Mint Mobile Mark was similar to it to a medium degree;
- e. The opposition under sub-section 5(2)(b) succeeded in relation to all of the goods in Class 9 but failed in relation to the services in Classes 35 and 36;

As to s 5(3)

- f. The 715 Mark had a reputation in the UK;
- g. A link would be made between the marks in relation to some but not all of the goods and services (those identified in paragraph 60 of the decision, see Annex C hereto). Where such a link would be made, this would lead to unfair advantage/detriment so that the sub-section 5(3) objection succeeded in relation to the same group of goods and services;

- h. The Applicant did not have due cause to use the mark applied for;

As to s 5(4)

- i. RBS had goodwill in the mark MINT in relation to credit card services; and use of the Applicant's mark in relation to the goods or services identified in paragraph 60 of the decision would lead to misrepresentation and damage so that the sub-section 5(4)(a) objection succeeded in relation to them.
- 7. As a result, the application was permitted to proceed to registration only for certain services in Class 35, which are those services identified in paragraph 61 of the Decision and in Annex C below.
 - 8. The Applicant appealed the decision under sub-sections 5(3) and 5(4)(a). RBS sought and was granted an extension of time to file a Respondent's Notice. In addition to providing additional reasons to support the Hearing Officer's decision it argued that the refusal under s 5(2) should have been wider.
 - 9. Neither party wished for a hearing on the appeal. Both made submissions in writing which I have carefully considered along with all of the documents before the Hearing Officer.

Approach to the appeal

- 10. The appropriate approach for me to adopt on these appeals was restated by Mr Daniel Alexander QC sitting as the Appointed Person in *Indian trade mark* BL O/439/14 and I gratefully adopt his summary of the position, the relevant parts of which read as follows:

"5. This appeal is a review of the hearing officer's Decision. Robert Walker LJ (as he then was) said of such appeals:

"...an appellate court should in my view 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" (*Reef Trade Mark* [2003] RPC 5 at [28]; see also *BUD Trade Mark* [2003] RPC 25).

6. Mr Justice Arnold recently summarised the principles in the light of the more recent authorities from the Court of Appeal and the Supreme Court as follows in *Shanks v Unilever Plc & Ors* [2014] EWHC 1647 at [27]-[28]:

"The role of the appeal court

27. The role of the appeal court was recently reviewed by Lewison LJ in *Fine & Country Ltd v Okotoks Ltd* [2013] EWCA Civ 672, [2014] FSR 11, where he said:

"50. The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant's complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind. There are many examples of statements to this effect. I take as representative Lord Hoffmann's statement in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] 1 WLR 2416, 2423:

'Secondly, because the decision involves the application of a not altogether precise legal standard to a combination of features of varying importance, I think that this falls within the class of case in which an appellate court should not reverse a judge's decision unless he has erred in principle.'

51. Where the appeal is (or involves) an appeal against a finding of fact, the role of an appeal court is as stated by Lord Mance in *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23 [2007] 1 WLR 1325 at [46] ...

28. I would add that the Comptroller-General of Patents is a specialist tribunal, and therefore the warning given by Baroness Hale of Richmond in

AH (Sudan) v Secretary of State for the Home Department [2007] UKHL 49, [2008] 1 AC 678 at [30], ... is apposite in this context:

" ... This is an expert tribunal charged with administering a complex area of law in challenging circumstances. To paraphrase a view I have expressed about such expert tribunals in another context, the ordinary courts should approach appeals from them with an appropriate degree of caution; it is probable that in understanding and applying the law in their specialised field the tribunal will have got it right: see *Cooke v Secretary of State for Social Security* [2002] 3 All ER 279, para 16. They and they alone are the judges of the facts. It is not enough that their decision on those facts may seem harsh to people who have not heard and read the evidence and arguments which they have heard and read. 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 or expressed themselves differently. ... "

7. These general principles are just as much applicable to appeals from the Comptroller as to other appeals and I have therefore borne them in mind in addressing the grounds of appeal, particularly those where an overall factual evaluation by the hearing officer has been made."

Merits of the appeal

11. It may be helpful first to note the points which are not challenged on the appeal. First, there is no appeal against the Hearing Officer's conclusions in relation to proof of use. Secondly, there is no appeal against the Hearing Officer's decision pursuant to sub-section 5(2)(b) to uphold the opposition in relation to the application for all of the Applicant's goods in Class 9.

Reputation

12. The first substantive point taken by the Applicant is that the Hearing Officer was wrong to conclude in paragraph 50 of the decision below that the 715 Mark had a significant reputation in the UK and EU, and to conclude in paragraph 57 that RBS

had "easily satisfied the *General Motors* reputation requirement in relation to credit card services" under the 715 Mark.

13. The Applicant referred me to the comments of Mr Geoffrey Hobbs QC sitting as the Appointed Person in *CA Sheimer (M) Sdn Bhd's Trade Mark Application* [2000] E.T.M.R. 1170 (Note); [2000] R.P.C. 484 in which Mr Hobbs (uncontroversially) stated that it is necessary for a party claiming a reputation to adduce evidence of facts and matters from which it could properly be concluded that it does have such a reputation. On the other hand, in *Enterprise Holdings Inc v Europcar Group UK Ltd* [2015] EWHC 17 (Ch); [2015] F.S.R. 22, Arnold J (in the context of an infringement action) repeated his view that proving a reputation is not a "particularly onerous requirement."
14. The Applicant submits that the evidence in this case did not support those conclusions, despite (as I have said) not having appealed the Hearing Officer's conclusions on proof of use. There was no challenge to the veracity or credibility of Mr Curtin's evidence, but the Applicant submits that the evidence contained a number of assertions which were unsupported by the exhibits provided, so that the Hearing Officer had jumped to conclusions about reputation which were not substantiated by the evidence, and had reached a conclusion which no reasonable tribunal could have reached. It argued that the Hearing Officer's mistakes as to reputation permeated all of his findings under sub-ss. 5(3) and 5(4)(a). The Grounds of Appeal were quite detailed but the Applicant challenged in particular the Hearing Officer's findings:
 - a) that in December 2013 RBS was advertising the Mint card to "other RBS customers" that is to say, to RBS customers who did not already hold a Mint card; and
 - b) that advertising which took place between 2007 and 2009 would have continued to "resonate" with customers in December 2013.
15. In its written submissions on the appeal, the Applicant commented that RBS's Respondent's Notice did not dispute the detailed points which the Applicant had

made about the evidence in the Grounds of Appeal. If that is to suggest that RBS should have adduced evidence on the appeal to counter the Applicant’s submissions, it does not seem to me a good point, especially given the constraints on adducing fresh evidence on appeal. RBS rightly referred to the evidence before the Hearing Officer and my role is to consider whether the Hearing Officer erred on the basis of that evidence.

16. In order to give proper consideration to the points which I have summarised in paragraph 14 above, it seems to me to be necessary to bear in mind some of the main points of Mr Curtin's evidence. The Hearing Officer described the evidence as follows:

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

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

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

17. Mr Curtin had explained that the MINT card was launched in January 2004. At paragraph 18 of his first witness statement, he said that prior to 2009 the card was advertised "externally throughout the UK by virtue of multiple advertising channels including newspaper adverts, television adverts, billboards, radio adverts and banners on the side of buses. The television advertisements were known for being memorable and humorous and have been posted by fans, for viewing on YouTube.” Paragraph 7 of the Decision reflects paragraphs 19 and of the witness statement:

"19. The MINT credit card has been offered exclusively to existing RBS customers since 2009. As a consequence RBS has not advertised MINT cards in a traditional sense to new customers since this date, but the MINT brand continues to be advertised publicly and outwardly by virtue of monthly advertising campaigns that are sent to existing customers advertising special offers such as balance transfer promotional rates.

20. One way in which RBS markets the MINT brand is by sending mail shots with special offers and promotions to customers. Attached as Exhibit RC6 are examples of customer promotional letters ... that were sent out to MINT customers between July 2011 and May 2014 ... During 2013, 771,715 of this type of letter were sent to customers. In 2014, RBS contacted 180,000 customers and on average these customers were contacted five times throughout the year A similar number of promotional letters were sent to customers every year back to

2010. Prior to that RBS is offering MINT cards to new customers so the figure is likely to have been substantially higher."

Mr Curtin exhibited a number of documents, some of which I discuss below.

18. When dealing with the claim to reputation for the purpose of the opposition based upon sub-section 5(3), the Hearing Officer said:

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

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

57) This would appear to be contradictory. In its later submissions the applicant suggests that the opponent has been "phasing out its MINT business". The applicant points out that recent mailshots have been sent to approximately 180,000 existing card holders, although this figure is after the relevant date, 18 December 2013. It is quite true that the number of card holders is declining, but in 2013 the opponent had 381,000 card holders in the UK. It was still advertising the card to other RBS customers, which given that RBS is one of the UK's largest banks would be a considerable number. However, even if one simply looks at the number of MINT credit card holders in the years prior to the relevant date it shows that they decline from 1.2 million in 2007 to 381,000 in 2013. The average during this period was approximately 697,000 per annum. This is a substantial number of people who have a MINT credit card account. This type of reputation and goodwill does not cease immediately unless a company very publically goes out of business. This is clearly not the case here as the card is still available and is still being used by a substantial number of customers. The significant amount

of advertising which took place in 2007-2009 will also resonate with customers today as will the very distinctive shape of the card, which was highly publicised. To my mind, the opponent has easily satisfied the General Motors reputation requirement in relation to credit card services under its trade mark MINT.”

19. It is paragraph 57 with which the Applicant takes issue on the appeal, and in paragraph 7 of the Grounds of Appeal, it identified a number of ways in which the Hearing Officer had erred in that paragraph.¹

20. The first point under paragraph 16 above (identified in paragraphs 4 to 6 of the Grounds of Appeal) is whether the Hearing Officer was right to find that RBS had continued to advertise MINT credit cards to *all* of RBS’s customers up to the relevant date in December 2013. The Applicant contrasted what Mr Curtin said at the beginning of paragraph 19 about offering the credit card to "existing RBS customers" with the fact that his exhibits consisted of letters/documents sent to existing MINT card customers rather than to the wider audience of all RBS customers. This, according to the Applicant, meant that the advertising was directed only to a "small (and diminishing) group of existing customers of the credit card itself." The Appellant submitted that Mr Curtin “clearly meant” that from 2009 onwards there was no advertising to anyone other than existing MINT account holders, so that the Hearing Officer made a mistake in saying that RBS was still advertising the card to other RBS customers.

21. It seems to me that there is some ambiguity in Mr Curtin's evidence on this point. His initial comments are to some extent supported by an article dated 6 October 2009 from The Independent, which referred to RBS restricting new applications for Mint credit cards to existing RBS and NatWest current account holders. This suggests that

¹ A further point was raised in the written submissions provided to me on the appeal, challenging the finding that the MINT card was still available in 2013. That point was not raised in the Grounds of Appeal, so that it would not be right to allow the Applicant to rely upon it. In any event, it seems to me to be a hopeless point in the light of the evidence of the continuing correspondence sent to customers by RBS, and the figures in the witness statement.

the card would have continued to be advertised to all RBS customers. However, in the light of other letters and documents which he exhibited, it seems to me that the Applicant was probably right to say that RBS did not continue to market MINT cards to all of its customers. Nevertheless, I do not think it at all clear that the Hearing Officer's conclusions were incorrect.

22. Next, the Applicant challenged the finding that there had been a "significant amount of advertising between 2007 and 2009." Mr Curtin had referred to advertising prior to 2009 on "multiple advertising channels" such as newspapers, radio and television adverts, but the Applicant argued that this statement was really no more than a bare assertion, since it was not supported by proper supporting evidence of sums spent on advertising and details of advertising campaigns etc. Mr Curtin had only provided screen-shots from YouTube showing that some television advertisements for the MINT card had been uploaded on to YouTube in June 2010. The screen-shots showed that the clips had since been viewed 26,000 times (presumably up to March 2015 when the screen-shots were taken). The Applicant said that this was not good enough to substantiate what Mr Curtin had said.
23. However, Mr Curtin had also exhibited a selection of newspaper articles dating from 2006-9 which mentioned MINT cards. One of these was an article from The Daily Mail dated 8 October 2006 which referred to RBS's "popular Mint credit card ... famous for its unique 'curved' design and bizarre adverts ..." This suggests not only that there had been advertising, but that it had had an impact at least upon the journalist who wrote the article.
24. I conclude that there was some evidence to support Mr Curtin's statement as to advertising carried out prior to 2009, although plainly the evidence could have been far stronger had proper figures and details been provided. I am not sure why the Hearing Officer referred to advertising between 2007 and 2009, but I consider that the Hearing Officer was justified in finding that there had been some advertising of the MINT card prior to 2009; it is possible that he erred in finding that the evidence

proved substantial advertising or advertising more specifically between 2007 and 2009.

25. The Applicant also challenged the Hearing Officer's finding that the advertising from 2007-9 would "resonate with customers today" saying that there was no evidence at all to support this. I take it as read that the Hearing Officer meant to state that the advertising would have resonated with customers at the relevant date. I also note that he referred to the advertising having a continuing impact on customers, rather than on the public as a whole, and I assume that he meant to refer to customers holding a MINT card. Even so, I am not sure on what basis the Hearing Officer made this finding. Mr Curtin's evidence dealt at paragraph 20 with steps taken to advertise the MINT card and associated services to RBS or MINT customers from 2009 to 2014. I cannot see how this shows that earlier advertisements would have continued to "resonate" with the customers in that period, as there is no suggestion that the later advertisements referred to them. I consider that this was an error.
26. Next the Applicant challenged the Hearing Officer's finding that the distinctive shape of the MINT card would also have resonated with customers, as it was highly advertised. Similarly, the Applicant submits that there was inadequate evidence to support this, no more than a poor photograph of one of the cards. I do not accept this criticism of the Hearing Officer's analysis of the evidence. In addition to the photograph of the card, Mr Curtin produced several other documents, such as the screen-shots of the television adverts, which showed that the card had a distinctive shape. The fact that the shape was well-known was supported by The Daily Mail article dated 8 October 2006, which described it as famous. The evidence may not have been very strong, but I consider that it was open to the Hearing Officer to conclude that the shape of the MINT card was very distinctive, had been publicised and would be known to customers at the relevant date.
27. The Applicant also submitted that the evidence about letters and documents sent to MINT card holders was inadequate or post-dated the relevant date, but it seems to

me that Mr Curtin's witness statement was clear in explaining that the type and scale of use had been stable from 2010 to 2014, and had previously been higher.

28. The Applicant submitted that as a result of these errors, the Hearing Officer had been wrong to conclude that the 715 Mark had a reputation. In so far as there were errors, I am not persuaded that any of them would have had a material effect upon the Hearing Officer's conclusions. Even without them, he would have come to the same conclusion. It is clear, in my judgement, reading the decision as a whole and paragraphs 56 and 57 in particular, that the Hearing Officer took the view that the scale of use of and customer base for the MINT cards was sufficient for the mark to have retained a substantial reputation and goodwill at the relevant date.
29. In its written submissions, the Applicant submitted that the Hearing Officer was also wrong because his reasoning was that the Mark remained known to a substantial number of customers. It is not clear to me that this point was pleaded in the Grounds of Appeal, it was not pleaded in those terms, but may have been implicit. The Applicant's submission was that the Hearing Officer erred because he should have considered whether the Mark was known to a "significant part of the public concerned." At paragraph 13 of his witness statement, Mr Curtin said that there 'are' around 50 million credit card accounts in the UK, of which RBS holds about 8.5%, with MINT cards making up about 6.5% of RBS's accounts. It may be that he was setting out the position in 2015 rather than at the relevant date. MINT's overall market share was probably small, in the light of those figures, but may (one cannot tell from that paragraph) have been greater at some earlier stage.
30. Mr Curtin's evidence was unchallenged as to the number of people using MINT credit cards and extent of use of them. The credit cards were available from 2004 onwards, and the table above shows the numbers of cardholders and transactions. The numbers did fall, but it does not seem to me that it is fair to describe the number of customers as "small" at any stage.

31. The real issue, however, is whether those numbers reflect knowledge of the MINT mark by a significant part of the public concerned. It seems to me that they would and that this was what the Hearing Officer meant in paragraph 57. The question is not what proportion of the 50 million credit card accounts were MINT accounts, but what proportion of members of the relevant public were aware of those accounts. I consider that I can take judicial notice of the fact that many people, who hold a credit card will have more than one credit card account. As a result, the fact that there are 50 million credit card accounts does not mean that there are 50 million members of the relevant public. In addition, there may have been turnover of card holders in earlier years, and anyone who had held a MINT credit card at any time from 2004 right up to 2013 would plainly know of the Mark. Any such reputation and goodwill would not have ceased because an individual credit card account was closed (see by analogy e.g. *Maslyukov v Diageo Distilling Ltd & Anor* [2010] EWHC 443 (Ch); [2010] RPC 21 at [74]-80). In addition, many of the newspaper articles exhibited by Mr Curtin made references to MINT cards alongside other well-known credit card accounts dates between 2007 and 2009. For example, an article from The Sunday Herald in July 2007 listed MINT cards in its top 6 “Pick of the Plastic.”
32. In my judgment, the Hearing Officer was fully entitled to come to the view expressed in paragraph 57 that the goodwill attached to the MINT name would not have been lost prior to the relevant date and there were no errors in the decision which would have had a material effect upon that finding. I dismiss this first point in the appeal.

Link

33. The Applicant submitted that even if the 715 Mark had a reputation, no link would have been made between the marks, when used for goods/services which were not similar to the credit cards for which the Mark had a reputation.
34. The basis for finding a link necessary to apply s 5(3) was set out by the CJEU in Case C-252/07, *Intel Corporation Inc. v CPM United Kingdom Ltd* [2008] E.C.R. I-8823; [2009] R.P.C. 15. It held

“40 By point (i) of Question 1 and Question 2, the national court asks, essentially, what the relevant criteria are for the purposes of establishing whether there is a link, within the meaning of the judgment in *Adidas Salomon and Adidas Benelux* (‘a link’), between the earlier mark with a reputation and the later mark in respect of which a declaration of invalidity is sought.

41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.

43 In that respect, the following points must be made.

44 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.

45 However, the fact that the conflicting marks are identical, and even more so if they are merely similar, is not sufficient for it to be concluded that there is a link between those marks.

46 It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.

47 The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which that mark was registered. That may be either the public at large or a more specialised public (see *General Motors*, paragraph 24).

48 It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

49 Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

50 Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.”

35. The Hearing Officer took into account the following points in finding that a link would be established between the marks:
- the marks are identical (paragraph 58);
 - the Applicant's services included services involving financial advice and planning as well as business advice, some of which (he said) are the sort of services which institutions offering credit card services are "well-known as being eager to sell to its customers" (paragraph 59);
 - those goods/services were identified in paragraph 60, by contrast those about which it would not be reasonable to make that assumption were identified in paragraph 61;
 - there would be confusion as to the origin of the goods/services identified in paragraph 60.
36. The Applicant challenged his findings on a number of bases. First, it submitted that the Hearing Officer had essentially found a link because he had found that there would be a likelihood of confusion for the goods/services identified in paragraph 60

but that this conflicted with his findings as to likelihood of confusion in paragraph 53 of the decision.

37. Paragraph 53 so far is relevant reads as follows:

“53) With regard to the opponent’s mark CTM5317102 in view of the above and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the class 9 goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore succeeds in relation to the class 9 goods. However, *there is no likelihood of consumers being confused into believing that the class 35 and 36 services provided by the applicant are those of the opponent or provided by some undertaking linked to them.* The opposition under Section 5(2)(b) therefore fails in relation to the class 35 & 36 services ...” [I have removed the Hearing Officer's emphasis and added my own italics to highlight the relevant part of this paragraph.]

38. The peculiarity of the sentence which I have emphasised above in paragraph 53 is that the Hearing Officer was considering the likelihood of confusion in relation to the Mint Mobile Mark alone, and had found that none of the Applicant’s Class 35 or 36 services were similar to the goods or services in that specification, so that he did not need to consider a likelihood of confusion for those services. Sub-section 5(2)(b) did not apply to those services at all. In my view, there are three possible explanations for this sentence. First, when the Hearing Officer said that there was no likelihood of confusion for those Class 35 and 36 services, he meant to say that s 5(2)(b) did not apply, but failed to express himself with clarity. Secondly, he was reflecting without further explanation a rather similar line of argument made on that point in the Applicant's written submissions dated 30 September 2015. Or, thirdly, he was momentarily confused and really did consider whether there was a likelihood of confusion in relation to those services. As the Hearing Officer had analysed the similarity of the goods/services in some detail earlier in his decision, I tend to think that the first explanation is the correct one. However, if, as the Applicant submits, the third explanation is the right one, then the Hearing Officer was carrying out a

wholly inappropriate assessment of a likelihood of confusion. Indeed, had he thought that there was similarity of those services, it seems to me that he would have found a likelihood of confusion, as he did in respect of the Class 9 goods.

39. On balance, in the circumstances, I do not think it appropriate to rely upon that single sentence from paragraph 53 to show that the Hearing Officer must have erred in his assessment of whether a link would be made between the marks.

40. The Applicant's next point was that the Hearing Officer erred in his assessment of the relevant goods and services. It challenged the reasons he gave for saying that a link would be made to the goods and services identified in paragraph 60, on the grounds that there was no evidence to support his views about the perception of a likely expansion of credit card services. I consider that this was a matter of which the Hearing Officer was entitled to take judicial notice, giving due weight to the fact that persons aware of the MINT credit card would have known that it was provided by a bank. I do not, therefore, accept that the Hearing Officer erred in principle in considering to what extent the relevant public might perceive the Applicant's services as having some connection with the 715 Mark, and so make the link necessary for a s 5(3) objection.

41. However, the Applicant also challenged the distinctions which the Hearing Officer drew between the various goods/services. The services for which the Hearing Officer found a link (those listed in his paragraph 60) were:

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

Class 36: Small business financial management services; personalised analysis of online banking transactions; transaction management; financial analysis; bill tracking; expense tracking; taxable item tracking; forecasting and analysis of financial data; financial data aggregation; providing information, news, opinions

and advice in the field of banking including via computer or communication networks, the internet, social media and software applications

The services for which the Hearing Officer found no link (those listed in his paragraph 61) were:

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

42. The Applicant sought to rely upon some decisions from the EUIPO in support of the submission that Class 35 services, such as business management services, are dissimilar to credit card services. I do not think that it was suggested that the cases helped the Applicant in relation to its Class 36 services. EUIPO decisions do not bind the UKIPO although they may have some persuasive value. However, it seems to me that they are irrelevant to this appeal, because the Hearing Officer had already found that those goods/services were not similar. His view was that consumers might see a link – but one which in his view fell short of similarity - on the basis that the known credit card supplier had expanded into the fields of financial advice and planning and business advice. In general terms, it does not seem to me that the Hearing Officer can be said to have fallen into material error in this approach.

43. However, the Applicant questioned the distinctions which the Hearing Officer had drawn between some of the services, and this is a point which seems to me to have more force. For instance, the Applicant questioned why a link would be made to ‘business management services’, if none would be made to ‘business administration services.’ It seems to me that, there is scope to examine whether the Hearing Officer followed his own reasoning in paragraph 59 in the distinctions he drew between the two sets of services. On careful consideration, it seems to me wrong to describe the following services as “involving financial advice and planning as well as business advice”: “Business management; accounting; book-keeping; administrative accounting.” No link would, following his logic, be made in relation to those services. However, it seems to me that there is no material error evident in the Hearing

Officer's categorisation of the rest of the Class 35 services for the purposes of establishing a link for s 5(3).

44. The Applicant also submitted that the Hearing Officer had failed to make a proper global assessment of the existence of a link. I have rejected most of the points upon which it relied upon in this respect earlier in this judgment, as many of them relate to the question of the extent of the Mark's reputation. I do not consider that there is any material error in this respect.

'Damage' under sub-section 5(3)

45. In the circumstances, it is necessary to consider the Applicant's next argument, namely that the Hearing Officer erred in his assessment of unfair advantage and detriment. Its arguments in relation to unfair advantage again seem to me to concentrate heavily upon the arguments about the nature and extent of the Mark's reputation and the decline in the number of customers for the MINT credit card. In the light of the Hearing Officer's findings as to reputation, which I have upheld, it does not seem to me that the Applicant has put forward any real challenge to the finding of unfair advantage. I dismiss that element of the appeal.
46. The Hearing Officer also held that there would be a detriment to the distinctive character of the 715 Mark. The Applicant challenged this finding on the basis that RBS had not pleaded detriment. However, it seems to me that RBS did plead detriment in the continuation sheet annexed to its TM7. However, as in any event I uphold the Hearing Officer's findings based upon unfair advantage to the extent set out above, the point cannot help the Applicant further.
47. The appeal in relation to the opposition pursuant to sub-section 5(3) therefore succeeds only in relation to the following services in Class 35: Business management; accounting; book-keeping; administrative accounting.

The objection under s 5(4)(a)

48. Lastly, the Applicant challenged the Hearing Officer's findings under sub-section 5(4)(a), raising points as to goodwill like those about reputation, and as to misrepresentation like those about a link. I have dealt with these points above, and consider that the result under sub-section 5(4)(a) would match that under sub-section 5(3).

The Respondent's Notice

49. RBS made a number of arguments supporting the Hearing Officer's findings under sub-sections 5(3) and (4)(a). In light of my conclusions above, the only point would be whether there were grounds to maintain the Hearing Officer's findings in relation to the Class 35 services which I have set out at paragraph 53 above. I do not think that anything that RBS says in its Respondent's Notice is relevant to this point.
50. In addition, RBS submitted that the Hearing Officer ought to have upheld the opposition on the basis of sub-section 5(2)(b) against the services listed in paragraph 60 of the decision. It is submitted in particular that the reasons why the Hearing Officer held that a link was likely to be made to the 715 Mark amounted, on proper analysis, to a finding of similarity in respect of the paragraph 60 goods and services. I have some sympathy for this point, but it seems to me that at most similarity might have been found in relation to the goods and services identified under paragraph 60, excluding the Class 35 services which I have set out at paragraph 53 above, as to which it does not seem to me that there are any serious arguments as to similarity with the specification of the Mint Mobile Mark. As a result, applying sub-section 5(2)(b) more widely would not put RBS into a more advantageous position than following the limited success of the Applicant's appeal.
51. Both parties have enjoyed a measure of success on the appeal, but it appears to me that RBS has been considerably more successful than the Applicant. It seems to me appropriate therefore for the Applicant to pay RBS a contribution of £750 in relation

to its costs of the appeal, to be paid by 5 PM on Tuesday, 16 August 2016 in addition to the costs awarded by the Hearing Officer.

Amanda Michaels
The Appointed Person
8 August 2016

ANNEX A

RBS'S EARLIER MARKS

UK registered trade mark MINT, No. 2360715G:

Class 9: Publications, newsletters, magazines, periodical pamphlets and leaflets; all in electronic form supplied on-line from databases or from facilities provided on the Internet (including websites); publications, newsletters, magazines, periodicals, pamphlets and leaflets; all in digital or electronic format supplied on-line; DVDs, CD-ROMs and diskettes; all relating to financial, banking, credit, credit card, mortgage, savings, loan, insurance and travel agency services and promotional services including incentive schemes, loyalty cards, purchase group clubs and discount offers made in connection with financial, banking, credit, credit card, mortgage, savings, loan and insurance services; charge cards, cash cards, bank cards, cheque cards, credit cards, debit cards; magnetically encoded cards for carrying data; multi-function cards for financial services; ATM (Automated Teller Machine) cards, access cards, identification cards, integrated chip cards and pre-paid cards and supporting systems related thereto; ATM machines, point of sale cards and readers; computer software; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web pages and websites); computer software and telecommunications apparatus (including modems) to enable connection to databases; parts and fittings for all the aforesaid goods; hand-held devices for payment and value exchange services and other personal information services; remote control devices; data carriers; computer software for the provision of credit card services, mortgage services, banking services and financial services; computer software providing information relating to credit, credit card services, mortgages, banking and finance; computer software to enable the searching of data relating to the foregoing.

Class 16: Printed matter; books, magazines, leaflets, periodical publications, newsletters, brochures, information materials and information packs; all relating to financial, banking, credit, credit card, mortgage, savings, loan, insurance and travel agency services and promotional services including incentive schemes, loyalty cards, purchase group clubs and discount offers made in connection with financial, banking, credit, credit card, mortgage, savings, loan and insurance services; gift vouchers, payment vouchers, discount vouchers, vouchers for travel by land, sea and air.

Class 35: Organisation, administration, operation and supervision of loyalty schemes and sales information on incentive schemes, buying group offers; organisation, operation, administration and supervision of discounts for goods and services; the bringing together for the benefit of others of a variety of alcoholic beverages, books, video cassettes, CDs and DVDs to enable customers to conveniently view and purchase those goods from a mail order catalogue, by telecommunication, from the Internet or by providing of auctions; information, advisory and consultancy services relating to all the aforesaid services.

Class 36: Banking services; mortgage services, automated banking services; payment and credit services; credit brokerage; insurance services; financial consultation services; financial information services; financial advisory services; advice and enquiries regarding credit; services for the provision of credit; mortgage services; consultancy, information and advisory services relating to all the aforesaid services.

EUTM MINT, No. 3899333

Class 9: Charge cards, cash cards, bank cards, cheque cards, credit cards, debit cards; magnetically encoded cards for carrying data; multifunction cards for financial services; ATM (Automated Teller Machine) cards, access cards, identification cards, integrated chip cards and pre-paid cards and supporting systems related thereto; ATM machines, point of sale card readers; computer software; computer software and publications in electronic form supplied online from databases or from facilities provided on the Internet (including web pages and web sites); computer software and telecommunications apparatus (including modems) to enable connection to databases; parts and fittings for all of the aforesaid goods; data carriers; computer software for the provision of credit card services, mortgage services, banking services and financial services; computer software to enable the searching of data relating to the foregoing; publications, newsletters, magazines, periodicals, pamphlets and leaflets, all in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); publications, newsletters, magazines, periodicals, pamphlets and leaflets, all in digital or electronic format or provided by CD-ROM or diskette

Class 36: Financial services; credit card, debit card, charge card, cash card and bank card services; banking services; mortgage services; monetary transfer; payment services; automated banking services; bill payment services; payment and credit services; account debiting services; cheque encashment services; credit brokerage; automatic cash dispensing services, automatic teller machine services; insurance services; financial consultation services; financial analysis and providing reports; financial information services; financial advisory services; computerised financial services; advice and enquiries regarding credit; services for the provision of credit; acceptance of deposits; discounts of bills (notes); domestic remittance; travellers cheque services; providing loans and savings accounts

services; providing savings bonds; managing saving and investments for others; providing savings accounts and services on-line; information services relating to credit, credit card services, mortgages, banking and finance; advisory, consultancy and information services relating to all of the aforesaid services.

EUTM MINT MOBILE, No. 5317102

Class 9: Telecommunications, telephonic and communications apparatus and instruments; data communication apparatus and instruments; apparatus and instruments for the processing, transmission, reproduction, storage, display, logging, protection, reception and retrieval of data, information, sounds, images, text, audio, graphic images or video or combination thereof; encoded cards; smart cards; magnetic data carriers; cards bearing magnetic data media; media for storing information, data, images and sound; machine readable media; personal digital assistants; satellite receiving and transmission apparatus and instruments; adapters for use with telecommunications apparatus; telephones; mobile telephones; electronic personal organisers; pocket and laptop computers; downloadable ringtones and graphics for mobile phones; customised display screens downloaded to telecommunications apparatus; electronic publications (downloadable) provided on-line from a computer database, the Internet or other electronic network; charge cards, cash cards, bank cards, cheque cards, credit cards, debit cards; magnetically encoded cards for carrying data; smart cards, encoded cards and multifunction cards for financial transactions and financial services; ATM (Automated Teller Machine) cards, access cards, identification cards, integrated chip cards and pre-paid cards, and supporting systems related thereto; ATM machines, cash dispensers, apparatus for payment with encoded cards; automatic paying-in and deposit machines; point of sale card readers; computer software; computer programs; computer operating programs and computer operating systems; computer hardware; computers; computer software and hardware for managing voice mail; computer software and hardware for text messages, SMS (short message system) messages, MMS (multimedia messaging service) messages, MIM (mobile instant messaging services); EMS (enhanced messaging services) or mobile email; application software for mobile telephones; interactive and multi-media software, materials and equipment; calculating machines; data processing apparatus and equipment; software, data, text or images supplied by electrical or electronic means; computer software and publications in electronic or machine readable form; computer software and software upgrades supplied on-line from computer databases, computer networks, global computer networks or the Internet; electronic publications, newsletters, magazines, periodicals, pamphlets, leaflets, instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites); publications, newsletters, magazines, periodicals, pamphlets and leaflets, all in digital or electronic format or provided by CD-ROM or diskette; computer software for facilitating or enabling access to business services, financial services, information services and e-mail services; computer software for use in network communications; computer software for facilitating electronic communications; computer software and telecommunications apparatus (including modems) to enable connection to databases, computer networks, global computer networks and the Internet; computer software to enable searching of data; interactive computer software and interactive computer discs; software for interrogating a bank account by means of text message; compact discs; diskettes, CD-ROMs, DVDs;

computer software to enable the searching of data; parts, fittings and software for all of the aforementioned goods.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters, office requisites (except furniture); instructional and teaching materials (except apparatus); wrapping and packaging materials; plastic materials for packaging; printers' type; printing blocks; printed publications; advertising materials; brochures, vouchers, cheques, cheque books, paying-in books; bank cards, cash cards, cheque cards, debit cards, credit cards, charge cards; cheque book holders.

Class 35: Advertising; advisory, consultancy, information and helpline services relating to all of the aforementioned services; the aforementioned services also provided by a customer care network.

ANNEX B

Goods and services for which use was proved, identified in paragraph 30 of the decision ("the Effective Goods/Services")

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

ANNEX C

Applicant's goods and services for which a link would/would not be found

Goods and services which the Hearing Officer identified in paragraph 60 of the decision:

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

Class 35: Business management; accounting; book-keeping; administrative accounting; business management advice and assistance; economic forecasting; providing information,

news, opinions and advice in the fields of accounting, tax preparation and planning, personal budgeting, household budgeting and consumer spending, including via computer or communication networks, the internet, social media and software applications; providing economic forecasting and analysis, including through computer or communication networks, the internet, social media and software applications.

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

Goods and services which the Hearing Officer identified in paragraph 61 of the decision:

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

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