

O-421-12

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS IN THE MATTER OF TRADE MARK
APPLICATIONS 2561410 & 2576410
BY VISA EUROPE LIMITED, FOR THE FOLLOWING MARKS:**

**WINK
&
wink**

AND

OPPOSITIONS THERETO (NOs 101843 & 102251) BY VOCALINK LIMITED

The background and the pleadings

1) Application 2561410 was filed by Visa Europe Limited (“Visa”) on 14 October 2010 and it was published in the Trade Marks Journal on 4 February 2011. The application is for a trade mark consisting of the word: **WINK**. Visa then filed application 2576410 on 25 March 2011 and it was published on 20 May 2011 for a trade mark consisting of the word: **wink**. Although the applications cover more goods and services, the opposition relates only to the following:

Class 09: Electronic wallets; computer software for electronic wallet services; electronic data storage and transmission software; electronic data storage media; data storage devices; computer software for payment processing; computer software for enabling transfer of funds and purchase of products and services offered by others; computer software for electronic debit and credit transactions; computer software for transaction authentication and verification; computer software for financial fraud detection and protection; computer software for verifying authenticity of credit cards, debit cards, payment cards, prepaid cards and smart cards; computer software for secure payment transactions; computer software for clearing and reconciling financial transactions; computer software for electronic check-out services at point of sale; computer software for electronic funds transfer; computer software relating to credit cards, debit cards, payment cards, prepaid cards and smart cards; credit cards, debit cards, payment cards, prepaid cards and smart cards; none of the aforesaid in relation to services provided via ATM terminals.

Class 36: Electronic wallet services; payment processing services; enabling transfer of funds and purchase of products and services offered by others, all via a global computer network or electronic communication network; electronic debit and credit transactions; transaction authentication and verification services; financial fraud detection and protection services; providing secure payment transaction services via a global computer network or electronic communication network or mobile device; clearing and reconciling financial transactions via a global computer network or electronic communication network; electronic check-out services at point of sale; electronic funds transfer; credit card, debit card, payment card, prepaid card and smart card services; banking and financial services via a global computer network or electronic communication network; dissemination of financial information via a global computer network or electronic communication network; financial services; banking services; financial data services; financial analysis; none of the aforesaid services being provided via ATM terminals.

2) Vocalink Limited (“Vocal”) opposes the registration of Visa’s marks on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In each case, the earlier marks/signs that are relied upon consist of,

or contain, the word: **LINK**. The various earlier marks and sign (for the purposes of section 5(4)(a)) are:

UK registration 2200447 which was filed on 17 June 1999 and which completed its registration procedure on 12 July 2002. The registration is in respect of the word mark: **LINK** for the following services in class 36: Electronic payment card services.

The application was accepted on the basis of acquired distinctiveness; the following clause was included when the mark was published: "Proceeding because of distinctiveness acquired through use and trade evidence".

A statement of use (and reputation) was made in relation to all of the services for which the mark is registered.

UK registration 1274743 which was filed on 1 October 1986 and which completed its registration procedure on 25 July 1997. The registration is in respect of the mark:



for the following services in class 36: Banking services for the dispensing of cash; funds transfer and payment services; financial information services; all included in Class 36.

A statement of use (and reputation) was made in relation to all of the services for which the mark is registered.

Community trade mark ("CTM") registration 198036 which was filed on 1 April 1996 with its registration procedure being completed on 17 December 2002. The registration is in respect of the word mark: **LINK** for the following services in class 36: Banking services for the dispensing of cash; funds transfer and payment services; financial information services.

A statement of use (and reputation) was made in relation to all of the services for which the mark is registered.

CTM registration 198002 which was filed on 1 April 1996 with its registration procedure being completed on 26 February 2003. The registration is in respect of the mark:



for the following services in class 36: Banking services for the dispensing of cash;

funds transfer and payment services; financial information services.

A statement of use (and reputation) was made in relation to all of the services for which the mark is registered.

The sign: LINK which is claimed to have been used in the UK since 1985 in respect of: "electronic payment card services".

3) Given their filing dates, all four of Vocal's trade mark registrations constitute earlier marks as defined by section 6 of the Act. Given the dates on which they completed their respective registration procedures, they are all subject to the proof of use provisions set out in section 6A of the Act.

4) Visa filed counterstatements denying the grounds of opposition. In its counterstatements, Visa asked Vocal to provide proof of use in respect of its four earlier marks. However, by the time of the hearing before me they no longer put Vocal to proof of use, consequently, I will consider the earlier marks on the basis of their specifications as registered.

5) Both sides filed evidence. The matter then came to be heard before me on 21 September 2012 at which Vocal were represented by Ms Denise McFarland, of counsel, instructed by D Young & Co LLP; Visa were represented by Ms Jessie Bowhill, also of counsel, instructed by Taylor Wessing LLP.

Vocal's evidence

Witness statement of Martyn Gould dated 20 September 2011

6) Mr Gould is employed by Vocal as head of its LINK scheme. He provides a detailed account of the use by Vocal of its marks and the services to which such use relates. I do not propose to summarise all of this in detail; all of the evidence has, of course, been fully read and borne in mind. I consider it sufficient to simply highlight some of the key facts that emerge:

- Vocal's use of its marks relate to what is referred to as the LINK network. This facilitates, in particular, the ability of a customer to use the ATM of a bank/building society which is not provided by his or her own bank/building society. This could be to dispense money or for other ATM services.
- To facilitate the above, banks or building societies that wish to be part of the network need to become "network members" and, therefore, services provided to them include fund transfers etc. Of its network members, numerous well known high street banks/building societies are listed.
- The marks are used to signal that a bank/building society is part of the network. The LINK signs (usually the word and device) is depicted on

bank cards and ATMs. Therefore, if a person has a bank card displaying the link sign they know that they can use it at an ATM displaying the LINK sign.

- The network was set up in 1985 and has been in continuous operation since then.
- As of October 2010, around 63,000 ATMs carried the LINK sign with around 100 million LINK enabled cards being in circulation, many of which (but clearly not all) carried the LINK sign.
- The number of LINK transactions has ranged between 1,835 million and 2,999 million between 2002 and 2010. The value of those transactions has ranged between £60.8 billion and £117 billion.

7) Mr Gould refers to the goods and services that Visa have applied for and explains why he considers such services to conflict with those of Vocal. I have borne this in mind, but will only return to his comments to the degree necessary. Mr Gould also gives his view on the similarity between the marks, including what he says is a close aural similarity (particularly for those whose first language is not English and those with regional accents or speech impediments who may pronounce words in a “lazy” manner) and visual similarity (for which he highlights that use of the word WINK in certain fonts may make the letters LI look more like a W) and he gives examples of why a likelihood of confusion may arise; his examples relate to use of the mark WINK on ATMs or bank cards with the consumer confusing the sign with LINK and believing that a WINK card may be used in a LINK ATM or a LINK card being able to be used in a WINK ATM. He states that the problem may be exasperated by the use of Visa’s VISA trade mark which is commonly depicted on ATMs and bank cards alongside the LINK trade mark (pictures of such uses are provided, which show a stylized VISA sign and the LINK word and device mark on an ATM and on a bank card).

8) Mr Gould refers to the unfair advantage that Visa may gain from using its marks. He refers to an agreement between the parties preventing Visa from using LINK composite marks or marks that are “confusingly similar” to LINK. He refers to other applications made by Visa which include the word LINK (VISA READY LINK, for example). He considers this to demonstrate Visa’s wish to trade off the reputation of Vocal’s LINK marks. He states that Visa is, effectively, a direct competitor and that it has engaged in anti-competitive actions before; I will come back to this evidence in more detail, but only if it is necessary to do so.

Witness statement of Paul Smee dated 22 November 2011

9) Mr Smee’s witness statement was filed as evidence in other proceedings (not involving Visa) and is introduced in these proceedings under cover of a witness statement of Ms Gemma Williams (a trade mark associate at D Young & Co –

Vocal's representatives). Mr Smee is CEO of the Payments Council. The role of the council is to undertake a strategic role in the development of payments in the UK. Mr Smee attests to his knowledge of the services provided by Vocal with badged (the word and device mark) ATMs and bank cards. He has also seen reference to the LINK brand more generally. He is aware of the significant use of Vocal's marks and it is his view that they have a significant reputation.

Visa's evidence

Witness statement of Gareth Rowlands dated 21 March 2012

10) Mr Rowlands is an in-house solicitor of Visa and has been employed by it since December 2007. He explains that his role involves dealing with trade mark matters and that he has been closely involved in the project relating to the WINK mark.

11) Mr Rowlands explains that Visa is an entirely separate company from Visa International Service Association ("Visa International"). He explains that since October 2007 Visa has operated the UK and European markets with Visa International operating in the rest of the world. He states that there is no corporate connection between the two. The only connection is that Visa International owns the VISA trade marks which they then licence to Visa.

12) In relation to the choice of the WINK mark, and confirming once more that he was closely involved in the project from its outset, he categorically states that there was no ulterior motive in the choice of the name. The LINK mark was never discussed or, so far as he is aware, never entered the minds of anyone involved. The thinking behind the mark was to allude to speed and ease (presumably of use), like someone winking or "in the blink of an eye".

13) Mr Rowlands gives his own views on the similarity between the marks – he highlights the different meanings and that in all respects they are very different. In response to Mr Gould's font point, he considers the examples Mr Gould provided were very obscure and confirms, in any event, that Visa do not plan to use the mark WINK in such a way. He does not consider Mr Gould's point about the aural similarity (to the extent based on lazy pronunciation) to be credible or relevant. In any event, he states that the visual and conceptual aspects of the mark are more important in this case. He states that LINK does have a meaning in relation to the services in question – he notes that the word LINK was only accepted as a trade mark on evidence of acquired distinctiveness because it was "very descriptive" (copies of the relevant examination reports are provided). Mr Gould also refers to other UK and CTM registrations that contain the letters –INK for the services at issue. He says many of them proceeded with a specification limited away from services provided at ATMs due, he assumes, to the threat of opposition from Vocal. He also refers to other marks that include the word LINK. Mr Rowlands notes a CTM registration for the word BLINK which similarly includes an ATM

exclusion. Visa asked Vocal for disclosure of relevant correspondence relating to this – he says that Vocal provided nothing in response. It should be noted that Visa did not ask the tribunal to direct any form of disclosure.

14) In relation to the agreement between the parties, he states that Visa was not a party to this and, in any event, the marks are not confusingly similar.

Vocal's reply evidence

Witness statement of Graham Mott dated 14 June 2012

15) Mr Mott works for Vocal as Head of Development and External Relations. He explains that Mr Gould has now retired but he knew him and he is very familiar with the matters covered by his witness statement. Mr Mott provides, essentially, a critique of Mr Rowlands' evidence. He begins by commenting on Mr Rowlands himself, highlighting that he has only been employed by Visa since 2007, which means he may not have been employed by it at the unspecified date when Visa were thinking about the WINK mark. He notes that Mr Rowlands provides no use of the WINK mark or of its genuine desire to use it. He highlights that Mr Rowlands appears to try to speak on behalf of others which, of course, he cannot do. He believes the foregoing to undermine the value of Mr Rowlands' evidence.

16) Mr Mott refers to the relationship between Visa and the other VISA companies. He highlights (and exhibits) a consolidated financial statement for Visa, Inc from 2011 which refers to other VISA companies as being subsidiaries. Mr Mott notes, though, that Visa is not a subsidiary but it nevertheless has various commercial arrangements with Visa, Inc including "put and call options" for the acquisition of Visa's shares. He notes that Visa International still owns various trade marks in the EU even though it is a subsidiary of Visa, Inc. Mr Mott provides documentation about an application made by Visa International for the mark WINK in Australia in 2008.

17) Mr Mott takes from all this that there is a continuing link between all the VISA companies. He also believes that the WINK mark in Australia must be connected in some way to the present application and that it has driven the application in the UK by Visa. Mr Mott makes various comments regarding the agreement Mr Gould initially referred to – I do not consider it necessary to say any more about this.

18) In relation to the choice of the WINK name, Mr Mott, again, questions Mr Rowlands' role in this and whether he was privy to all discussions. He highlights, again, the Australian WINK mark. Mr Mott states that when the mark was coined it was likely that a clearance search was conducted, which would almost certainly have revealed the LINK marks. He provides evidence of a search that D Young and Co instructed a third party search provider (Thomson Compumark) to complete in respect of the mark WINK in Class 36 – Vocal's LINK marks were

identified in the search. Mr Mott states that if a search was not conducted then he finds it incredible that Visa did not think of the LINK marks given the previous history described above.

19) Mr Mott goes on to to make further comments including some about the similarity of marks, the other LINK/-INK registrations, the agreement, the respective goods/services and the reputation of LINK. All this will be borne in mind but I do not consider it necessary to detail it all here.

Further evidence

20) On 31 August 2012 Visa sought leave to file a second witness statement of Mr Rowlands dealing, primarily, with some of the criticisms Mr Mott had made, some of which Mr Mott had argued undermined the value of Mr Rowlands' evidence. I discussed this at the hearing with the parties. Vocal objected to the evidence coming in as it was very late in the day and well after the end of the evidence periods. Visa considered it important that the evidence came in, particularly as it dealt with the concerns that Mr Mott had expressed and his comments on the value of Mr Rowlands' evidence.

21) Mr Mott, whilst not specifically asking for Mr Rowlands' evidence to be disbelieved, was nevertheless calling into question the credibility of Mr Rowlands' evidence. In such circumstances, I considered it appropriate to admit the further evidence. I discussed the implications of this at the hearing. I asked whether Vocal wished to cross-examine Mr Rowlands (who was present at the hearing anyway). Vocal did not seek to cross-examine him. I went on to hear the substantive matters but indicated that Vocal could make a request to file further evidence of fact strictly in relation to the factual points it wished to counter in Mr Rowlands' evidence. I sent a letter after the hearing giving directions to this effect. Counter evidence from Mr Richard Brown was submitted. Whilst I agree with Visa that the content of Mr Brown's witness statement is not fully in line with what I directed, I consider it permissible for it to also be admitted. As things stand then, and summarised briefly, the further evidence consists of:

Second witness statement of Mr Rowlands dated 31 August 2012

22) Mr Rowlands states that Visa's WINK project commenced in January 2010. He states that he was personally involved with the project throughout. He states that he has reconfirmed with the leading personnel in Visa (those also involved in the project) the points covered by his witness statement (including, presumably whether LINK was in their mind). He does not alter his views of the matter. In terms of clearance searches, he confirms that such searches were undertaken after the name was selected – Visa did not at any point receive any legal advice in relation to Vocal's LINK marks.

23) Mr Rowlands comments on the relationship between the various VISA companies. He states, again, that the 2007 changes led to the two organisations becoming completely independent. Mr Rowlands refers to the Australian WINK mark. He understands why Mr Mott would speculate in the way that he did, but Mr Rowlands states that the selection of the mark was simply co-incidental. Visa only become aware of the Australian WINK mark as a result of its clearance search.

Witness statement of Richard Brown

24) Mr Brown is a solicitor and partner in the firm of Thomas Eggar LLP, Vocal's solicitors. Mr Brown provides evidence that Visa's external legal advisors (who it is assumed were responsible for the clearance search referred to by Mr Rowlands) have been Taylor Wessing LLP with the partner reference JWR, who he assumes to be Mr Jason Rawkins. Mr Brown states that Mr Rawkins represented Visa International when the agreement referred to in the evidence was negotiated (in 1997).

25) In terms of Mr Rowlands' reconfirming his earlier evidence with various personnel, Mr Brown highlights (and provides evidence from Visa's own website) that the individuals named by Mr Rowlands joined in 2007 and 2008 respectively and that a number of other key personnel (who Mr Brown names) predate and overlap the corporate restructuring and would have been, presumably, in a better position to reconfirm the evidence.

Visa's response to the above and its evidence relating to disclosure requests

26) Visa submitted a letter in response to the above in which it asked if it was necessary to confirm certain parts of Mr Rowlands' second witness statement in relation to the clearance search undertaken and that the legal advice received was about the LINK name. Although what they are seeking to clarify is not altogether clear to me, I am loath to direct any further evidence be filed. I consider the evidence currently admitted to be sufficient and anything further serves no effective purpose. This also applies to the request by Visa to file evidence of the correspondence between the parties relating to its disclosure request (mentioned in paragraph 13 above); this matter is peripheral. No further evidence is permitted or necessary.

The marks at issue – are they similar?

27) To engage the provisions of both sections 5(2)(b) and 5(3) of the Act, Visa's mark must be similar to those of Vocal. If they are not similar then the heads of damage relevant to those claims cannot arise. As this issue is common to both these grounds of opposition, and as it will also be relevant to the ground under section 5(4)(a), I will begin by making a comparison of the marks. When doing so, I will bear in mind that the average consumer normally perceives a mark as a

whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components.

28) Vocal's best case lies with its word mark LINK. If Visa's mark is not similar to this mark then Vocal's case is not improved with its word and device mark. Neither do I see a material difference between the two opposed applications – they stand and fall together. In view of this, the marks to be compared are:

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29) The dominant and distinctive elements of the marks are the words WINK and LINK respectively. Neither mark breaks down further than this. In terms of concepts, the marks are like chalk and cheese. Both have clear, understandable, and completely dissonant meanings. The marks are conceptually dissonant. Ms McFarland made a submission relating to the fact that neither mark has a known meaning in the financial field. This, though, has no effect on the conceptual understanding that the average consumer will take away from the marks.

30) In terms of the visual comparison, both marks are of the same length, both being made up of four letters, the last three of which are shared. However, the initial letters W/L differ and there is no meaningful similarity between a W and an L (unlike letters such as U and V). I have borne in mind the point regarding fonts, but I agree with Ms Bowhill that such fonts (as provided in Mr Gould's evidence) are either quite obscure (and so would not constitute a notional and fair use) or do not create any additional material similarity. The marks are short, and whilst just a rule of thumb¹, I consider that this means that the difference in the initial letters will stand out more. Another rule of thumb is that the beginnings of marks tend to attract more attention – whilst I do not wish to overplay this factor (particularly as I consider this rule of thumb to have less of a role to play when short marks are involved) it is another point to bear in mind. Overall, I consider the marks to possess only a low degree of visual similarity.

31) Similar considerations run through the aural comparison. It could be argued that the beginning sounds are not as distinct from each other as I have found in respect of the visual impact of the differing initial letter. However, like Ms Bowhill, I do not go so far as to agree with the lazy pronunciation point. I still consider the difference in the beginning sounds to be reasonably noticeable. The marks, of course, rhyme. I consider there to be a moderate degree of aural similarity.

In her skeleton argument Ms Bowhill stated:

“That [the common letters INK] alone is not sufficient for a finding of similarity. On the contrary, the initial letters “W” and “L” are crucial to the

¹ See, for example, the decision of the Appointed Person in *Boo Boo*, BL 0/387/11.

way in which the marks are to be perceived, and produce a very different overall effect visually, aurally and conceptually.”

32) As has been stated many times by the courts, conceptual differences may have a counteractive effect on the other aspects of similarity (see, for example, Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-643). Whilst conceptual differences do not always succeed in achieving this (see the General Court’s (“GC”) judgment in *Nokia Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-460/07*), in the case before me, I consider, **overall, that the strong conceptual dissonance extinguishes the low/moderate degrees of visual and aural similarity. My primary finding is that the marks are not similar.**

33) As stated earlier, to engage the provisions of sections 5(2)(b) and 5(3) it is a prerequisite that the marks are similar. In view of the above finding, the oppositions under sections 5(2)(b) and 5(3) are dismissed. In terms of section 5(4)(a), whilst there is no statutory provision requiring similarity of signs, it is difficult to see how an opponent can succeed without the sign it relies upon being similar to the applied for mark. If the marks are not similar then there can be no misrepresentation. In her submissions, Ms McFarland did not outline a case that was stronger under section 5(4)(a) than under section 5(2)(b). Vocal is in no better position and, therefore, the oppositions are dismissed under section 5(4)(a) also.

34) In view of the above, the grounds of opposition have failed. However, for the sake of completeness, I will go on to give more detailed views in case I am found to be wrong on my assessment of the similarity (or lack of) between the marks. I will do so on the basis that if the marks are to be considered similar on account of the sharing of the last three letters (which I have accepted creates a low and moderate degree of visual and aural similarity respectively) and that the conceptual dissonance I have described (which must still be held to be in play) does not extinguish such similarities, then the degree of similarity between the marks is considered to be low. I will initially make my more detailed assessments against the applied for services in class 36 as this is where the specifications of the parties overlap most and where Vocal’s mark is claimed to have a reputation – if a likelihood of confusion/misrepresentation/link is not established in such circumstances then Vocal has little prospect of successfully opposing anything else.

Section 5(2)(b)

35) Section 5(2)(b) of the Act 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.”

36) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) 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 of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks 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."

Comparison of the marks

37) I have already made my comparison. My primary finding was that the marks are not similar. But for the purposes of this part of the decision I will consider that that the similarities assessed lead to a low degree of similarity.

The average consumer

38) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

39) The services in question are financial in nature. The average consumer consists of both members of the general public and businesses who require financial services for either their personal or business needs. By their very nature, at least a reasonable degree of care and consideration will be adopted by the average consumer when selecting an appropriate service provider. Sometimes that degree of care and consideration will be higher than the norm. For example, if the average consumer wishes to obtain a mortgage or make financial investments, this is likely to represent an important choice that will be well thought out and considered.

40) Vocal's services include those which facilitate the dispensing of money, funds transfer and payment services etc. Obviously, where to have ones money dispensed is largely dependent on where the average consumer has deposited it and the relationship (including inter-bank networks) that the depositing bank has with other banks and dispensing services. When seeking a service of this type the average consumer will still, in my view, adopt a reasonable degree of care as he or she will need to ensure that the service provider has the appropriate linkage with the bank who holds the money. This is particularly the case if the service provider is not the bank with whom the money is deposited. However, particularly at ATMs, this may be a simple process with the average consumer reading the information (which often contains various trade marks) displayed on the ATM and no more than that. Ms McFarland highlighted this process and submitted that a casual approach was therefore in play with consumers often using ATMs in a hurry. Whilst noted, the average consumer will nevertheless not wish the ATM to swallow his or her card or to have the transaction declined so I consider the process, overall, to equate to a reasonable (but no higher or lower than the norm) degree of care and consideration. Similar considerations would apply to money dispensing through means other than ATMs. In terms of fund transfer and payment services, I again consider that a reasonable degree of care and attention will be displayed. The importance of the service is not on a par with, for example, the taking out of a mortgage, but the choice of an appropriate service provider will not be a casual one. In terms of services directed at businesses or, indeed, other financial institutions, then the degree of care is likely to be higher on account of the likely importance of the selection that is being made.

Comparison of services

41) As stated earlier, I will focus upon the class 36 services initially. When making the comparison, all relevant factors relating to the services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

42) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

43) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

44) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”² and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning³.

² See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

³ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

45) Taken together, the earlier marks cover:

“Electronic payment card services” and “Banking services for the dispensing of cash; funds transfer and payment services; financial information services.”

46) The application includes what I must hold to be identical services as they are, in essence, the same thing. If they are not identical then the differences must be wafer thin and, thus, highly similar. Some of these terms are wide terms relating to banking/finance which are considered identical as they include within their ambit identical services to those of the earlier mark. The terms in question are:

payment processing services;

enabling transfer of funds and purchase of products and services offered by others, all via a global computer network or electronic communication network;

providing secure payment transaction services via a global computer network or electronic communication network or mobile device;

electronic check-out services at point of sale;

electronic funds transfer;

banking and financial services via a global computer network or electronic communication network;

dissemination of financial information via a global computer network or electronic communication network;

financial services;

banking services;

47) I have, of course, borne in mind that the applied for specification includes the exclusion:

“none of the aforesaid services being provided via ATM terminals”

48) Whilst this is noted, this does not effect my assessment on identical services because Vocal’s services are not limited to those provided at an ATM and would, therefore, include variants of the service provided other than at an ATM. In any event, whether the services are provided at an ATM or otherwise, they are still highly similar on account of their primary purpose etc.

49) I will come back to the other services applied for in class 36 and the other class of goods if it becomes necessary to do so.

The distinctiveness of the earlier mark

50) The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

51) In terms of the inherent characteristics of the mark (focusing, again, on Vocal's word only mark), LINK is a commonly known and understood English word. Although Mr Mott provided an extract from a financial dictionary showing that LINK has no defined financial meaning, this does not detract from the normal understandable meaning of the word. The word itself is weak in distinctiveness, indeed, weak enough for the UK registration to be allowed to proceed only on the basis of acquired distinctiveness. The reason for such weakness is because the services may provide links between banks making, for example, the dispensing of money easier. However, the mark has been used significantly. Whilst the majority of the actual use relates to the word and device mark, I agree with Ms McFarland that the word mark will, nevertheless, have acquired an enhanced distinctive character through the use of the word and device mark; this is akin to the way in which a mark may acquire a distinctive character through its use as part of another mark (see *Societe des produits Nestle SA v Mars UK Ltd*, (C-353/03)). I consider all the earlier marks to have a highly distinctive character through such use.

Likelihood of confusion

52) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

53) In my view, having regard to the various factors I have outlined, and bearing in mind the concept of imperfect recollection and the degree of care and attention likely to be used by the average consumer, I do not consider that the average consumer will mistake WINK for LINK. Irrespective of the low degree of similarity between the marks, the differences identified earlier are sufficient to enable the average consumer to differentiate between them. In terms of imperfect recollection, I see no likelihood of WINK being mis-remembered or mis-recalled as LINK, or vice versa. This is so even bearing in mind the reputation of the LINK mark. There is no likelihood of direct confusion. With regard to indirect confusion,

I see no reason why the average consumer will put the identified degree of similarity between the marks down to the same or related undertakings being responsible for the service, even if the services are identical. The average consumer will, in my view, regard the marks as different trade marks from different undertakings.

Section 5(4)(a)

54) In line with my earlier comments, I do not consider Vocal to be in any better position to succeed under section 5(4)(a). If the marks are not similar enough for a likelihood of confusion to arise, then, in these circumstances, a misrepresentation will likewise not arise.

Section 5(3)

55) Although this ground has been fully borne in mind and considered, I can explain my views briefly. There is no dispute, indeed it is settled law, that it is necessary for the relevant public to make a linkⁱ between the marks. Even accepting that Vocal has a reputation in respect of its marks and even though the services are identical or highly similar, I do not consider that the degree of similarity (if, contrary to my primary finding, there is any) between the marks is sufficient for the earlier mark(s) to be brought to mind. Without a link being established the ground of opposition must fail.

The evidential points

56) Before concluding, I make the observation that the findings I have made above contain little reference to the evidence filed by the parties as to the relationship between Visa and other VISA companies, the previous disputes (and the agreement) between Vocal and VISA companies, and the choice by Visa of the WINK name. If it had been proven that the name WINK had been selected to either confuse the public or at least bring LINK to mind, then, whilst such evidence would have been borne in mind and given full cognisance – I still do not consider that it would have altered my view on the similarities (or lack of) between the marks and whether a likelihood of confusion/misrepresentation/link would have been established. In any event, I am far from satisfied that the mark WINK was chosen for any ulterior motive. Vocal have tried to undermine the evidence of Mr Rowlands but, its attempts to do so seem to me to be nothing more than speculation. Whilst I understand, as did Mr Rowlands, why the Australian WINK mark gave rise to certain concerns, I would nevertheless, on the basis of all the evidence before me, have accepted that WINK was selected by Visa without LINK being in its mind. The other evidence relating to the relationship with various VISA companies and the previous issues that Vocal have had with them are not telling. Neither does the agreement matter. The agreement related to marks confusingly similar to LINK. I have not found the

marks in question to fall into such a category so this agreement takes matters no further forward regardless of who the agreement was between.

Conclusion

57) The oppositions fail in their entirety.

Costs

58) Visa has been successful and is entitled to a contribution towards its costs. I hereby order Vocalink Limited to pay Visa Europe Ltd the sum of £2000. This sum is calculated as follows:

Preparing a statement(s) and considering the other side's statement(s)

£500

Considering and filing evidence

£800

Attending the hearing

£700

59) In coming to the above I have borne in mind the late evidence filed by Visa and the need for Vocal to deal with this – a small reduction from what I may otherwise have awarded has been made. The above sum should 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 26th day of October 2012

**Oliver Morris
For the Registrar,
The Comptroller-General**

ⁱ In *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) ("Intel"), the CJEU provided guidance on the factors to consider when assessing whether a link has been established. It stated:

41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

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