

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3130080
AND THE REQUEST BY INTUIT INC
TO REGISTER THE TRADE MARK**

MINT

IN CLASS 9

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 406251
BY THE ROYAL BANK OF SCOTLAND GROUP PLC**

Background and pleadings

1. On 5 October 2015, Intuit Inc (“the applicant”) applied to register as a trade mark the word MINT for the following goods in class 9:

Computer software; downloadable computer software applications; 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.

2. The application was published for opposition purposes in the Trade Marks Journal on 18 December 2015. It is opposed by The Royal Bank of Scotland Group plc (“the opponent”) under sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Sections 5(1) and 5(2)(a) are based on the following two earlier marks:

(i) UK 2360715G for the word MINT; filed on 13 April 2004; completed its registration procedure on 19 December 2008:

Class	Goods or services
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,

	<p>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.</p>
16	<p>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</p>
36	<p>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.</p>
41	<p>Books clubs; providing on-line electronic publications of books, magazines and other publications (not downloadable); leasing of books, video cassettes, CDs, DVDs and pre-recorded film; providing on-line publications for entertainment, in</p>

	particular electronic games, books and magazines; all relating to financial, banking, credit, credit card, mortgage, savings, loan and insurance services; consultancy, information and advisory services relating to all the aforesaid services.
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(ii): EUTM 3899333 for the word MINT; filed on 24 June 2004; completed its registration procedure on 3 November 2005:

Class	Goods or services
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 on-line 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.
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.
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3. Section 5(2)(b) of the Act is based on the following earlier mark:

EUTM 5317102 MINT MOBILE; filed on 15 September 2006; completed its registration procedure on 18 June 2010:

Class	Goods or services
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.

4. The opponent also relies upon classes 9, 16, 35 and 36 of 2360715G for its section 5(3) ground. The class 35 services are:

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.

5. The sign relied upon under section 5(4)(a) of the Act is MINT. The opponent claims it has used this sign throughout the UK since January 2004 in relation to financial services, credit card services, computer software; online and digital financial services.

6. The opponent claims that the application should be refused in relation to identical goods (section 5(1)). It claims that there is a likelihood of confusion under sections 5(2)(a) and 5(2)(b) owing to the identical or similar marks and identical or similar goods. Under section 5(3) of the Act, the opponent claims that it has a reputation in the goods and services relied upon, such that there would be unfair advantage taken of this reputation and detriment to the repute of its mark should the application be used on inferior goods and services. The section 5(4)(a) claim is that the opponent has goodwill attached to MINT for the goods and services listed in paragraph 5 above, and that use of the application would be a misrepresentation, causing damage to the opponent's goodwill. Accordingly, the opponent claims that registration of the mark is liable to be prevented under the law of passing off.

7. The applicant denies all the grounds of opposition. Specifically in relation to section 5(3), the applicant claims that it has due cause to use its mark. Each of the opponent's marks had been registered for five years or more when the applicant's mark was published for opposition, which means that they are all subject to the proof of use provisions under section 6A of the Act. The opponent has provided a statement of use of its marks in respect of all its claimed goods and services under sections 5(1), 5(2)(a), 5(2)(b) and 5(3) of the Act. The applicant has put the opponent to proof of use in respect of the opponent's UK MINT mark for all goods and services in classes 9, 16, 36 and 41, with the exception of credit card services in class 36. It has not put the opponent to proof of use of its mark in respect of the class 35 services¹, relied upon for the section 5(3) claim, but it does put the opponent to proof of a reputation sufficient to found its section 5(3) claim². The applicant has also put the opponent to proof of use for all goods and

¹ Box 7 of form TM8.

² Paragraph 3 of the counterstatement.

services covered by the opponent's EU MINT mark, and for all goods in class 9 covered by the opponent's EU MINT MOBILE mark.

8. Both parties are professionally represented. Neither party chose to be heard. I make this decision based on the papers received.

Evidence

9. The opponent's evidence comes from Suzanne Wright, who had been the opponent's Intellectual Property Manager for three years at the date of her witness statement (7 September 2016).

10. Ms Wright states that the opponent "has offered a credit card under the MINT trade mark, in association with other financial benefits, such as travel accident insurance, emergency assistance and loans, continuously since 2004". She states that MINT cards offer convenience cheques and cash withdrawal, and free online account management. Between 2004 and 2009, RBS offered loans under the MINT brand. MINT cards are accepted wherever Mastercard is accepted.

11. Ms Wright gives a number of yearly statistics from 2004 to 2014 relating to MINT credit card services. In 2014, the year before the opposed application was filed, there were 343,000 UK customers with a MINT credit card account. This figure had gradually decreased since 2004 (when there were 1,306,000 customers). Ms Wright states that the card is still available and is still used by a substantial number of customers. In 2014, there were 96,000 purchases³ made within EU countries by MINT customers (decreasing from 846,000 in 2004). MINT customers transferred 21,000 balances to MINT from other credit cards in 2014⁴ (down from 958,000 in 2004).

12. Ms Wright states that there are approximately 50 million credit card accounts in the UK, of which the opponent has about an 8.5% share. MINT makes up about 6.5% of the opponent's credit card custom.

³ To a value of £9.3million.

⁴ To a value of £53 million.

13. Exhibits SW2, SW3 and SW4 comprise copies of press articles from national and regional UK newspapers which refer to the MINT credit card. Respectively, these are from 2006-7, 2008 and 2009. The relevant dates in these proceedings are the date of application, 5 October 2015 (for the purposes of sections 5(1), 5(2), (5(3) and 5(4)(a)) and, for proof of use, from 19 December 2010 to 18 December 2015. These articles are dated prior to the relevant proof of genuine use dates.

14. Exhibit SW5 comprises prints of screenshots of television advertisements from YouTube, which ran prior to 2009. Ms Wright states that they were known for being humorous, a fact picked up in one of the newspaper articles contained in Exhibit SW2 (Daily Mail, 8 October 2006), referring to the “popular Mint credit card...famous for its unique curved design and bizarre adverts”.

15. Ms Wright states that the MINT credit card has been offered exclusively to the opponent’s customers since 2009 and that the opponent has not, therefore, advertised MINT cards in a traditional sense to new customers since 2009. However, monthly advertising campaigns are sent to existing customers advertising special offers, such as balance transfer promotional rates. Some examples from July 2011 to May 2014 are included in Exhibit SW6. A total of 771,715 of these special offer letters were issued during 2013. In 2014, the opponent contacted 180,000 customers, on average 5 times during the year, at a cost of £217,000 to the opponent.

16. Exhibit SW7 comprises an example of a MINT paper statement. Ms Wright states that both paper and online statements are offered. There are also SMS and email alerts available to MINT customers to remind them to pay their MINT credit card bill. Exhibit SW10 comprises example Notices of Variation sent to MINT customers dating from November 2011 and June 2014.

17. Exhibit SW12 comprises a report which lists visitor numbers to the MINT website (mint.co.uk) during October 2013. There were 130,512 successful logins during that month. There were 58,486 views of the page where customers can view their personal statement and 33,757 views of the page where payments are made. There were 1,530,898 unique visitors to the website in 2012; 1,535,698 unique visitors in 2013; 1,349,389 unique visitors in 2014, and 1,099,935 unique visitors in 2015.

18. Ms Wright states that it is “common knowledge” that banking and credit card services are offered digitally as well as through more traditional sources. She states that most credit card services provide mobile phone software in the form of ‘apps’ which enable users to view account balances, pay bills and make payments using mobile technology devices. There are no exhibits to support this statement.

19. The remainder of Ms Wright’s witness statement consists of submissions which I bear in mind, but will not include in this summary of the statement of facts.

20. The applicant’s evidence comes from Oscar Webb, who is a solicitor working for the applicant’s professional representatives, Nabarro LLP. He explains that the exhibits adduced are documents which are referred to in the applicant’s written submissions. The exhibits are as follows:

- Exhibit OW1: a print from techcrunch.com containing background details about the founding of Mint.com.
- Exhibit OW2: a print from mint.com containing details about the funding of the Mint.com platform.
- Exhibit OW3: prints from intuit.com containing details about the applicant’s purchase of Mint.com and the number of users, as at 2010 (3 million in the US). Mint.com is described as a provider of online personal finance services, and the applicant as a provider of consumer software-as-a-service.
- Exhibit OW4: a print from the US Patent and Trademark Office website showing details of the US trade mark registration for MINT (and leaf device).
- Exhibit OW5: prints from investopedia.com, modestmoney.com, stevieawards.com and techland.time.com, containing details of industry awards, ranking and feedback about the applicant’s MINT product. The investopedia.com article describes Mint.com as allowing users to check savings, investments, credit cards and bank accounts online, and to track

spending habits. The techland.time.com article refers to the “50 Best Android Apps for 2013”, listing Mint.com Personal Finance.

- Exhibit OW6: a print from a Google search for the term ‘mint’ which shows the opponent’s website as the top result.
- Exhibit OW7: a print from the opponent’s website (mint.co.uk). This was printed on 18 January 2017. It says “We’re sorry, MINT are not currently accepting new Card applications. If you already have a Credit Card with MINT, we are here to help and you can contact us by phone or post...you can also ask a question on this website.” Similar statements are also shown in respect of not accepting new loan applications or new insurance applications.

21. With the exception of exhibits OW6 and OW7, all the exhibits emanate from the US.

Decision

22. I note that in earlier proceedings before the IPO between the parties⁵, in which the same three earlier rights were relied upon to attack an application by the present applicant for MINT in classes 9, 35 and 36, earlier mark EUTM 5317102 MINT MOBILE was not subject to proof of use. The opponent was successful under section 5(2)(b) against all of the applicant’s class 9 goods on the basis of its class 9 goods covered by EUTM 5317102. EUTM 5317102 is now subject to proof of use, along with the other earlier marks. I also note that the earlier decision of the IPO was appealed to the Appointed Person. However, the outcome in relation to class 9 of the application under section 5(2)(b) and the findings in relation to the opponent’s proof of use were not appealed⁶.

⁵ BL O/001/16.

⁶ BL O/381/16.

Proof of use

23. Section 6A of the Act states

“(1) This section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if—

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes—

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

24. The enquiry under section 6A of the Act is identical to that set out under section 46, the part of the Act which deals with the issue of revocation on the grounds of non-use, because both sections 6A and 46 cover genuine use of a mark. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis*

Beheer BV [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the

purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

25. Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

26. The overwhelming picture presented by the individual exhibits, the exhibits collectively, and from the witness statement is that MINT is a credit card. It has been used in relation to credit card services, which is what has been accepted by the applicant. There is no use in relation to class 9 goods i.e. to create or preserve a market share in the class 9 goods, other than potentially credit cards, which are provided as part of the credit card service, rather than as a manufacturer or cards for other businesses. However, I do not need to decide this point because credit card services puts the opponent in a stronger position in relation to the applicant's goods than is the case in relation to credit cards.

27. This means that EUTM5317102 cannot be relied upon as an earlier mark. The opponent relies upon the class 9, 16, 36 and 41 goods and services of UKTM 2360715G. There is no use in relation to the class 9 and 16 goods. Providing printed matter about one's own products or services is not creating or preserving a market for printed matter⁷. There is no evidence of use in relation to the class 41 services.

28. Credit card services, for which there is genuine use, fall in class 36. *In Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

⁷ See *Alpex Pharma v EUIPO*, Case T-355/15 (GC).

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

29. The class 36 specification of earlier mark 2360715G is:

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.

30. Some of these terms are very wide and cover activities for which there is no use. For instance, 'banking' covers mortgages, current accounts and savings, the latter being the exact opposite of the opponent's activities (credit card services). For other terms such as mortgage services, there is no use. Applying the case-law, the opponent may not rely upon *Banking services; mortgage services, automated banking services; insurance services; financial consultation services; financial information services; financial advisory services; mortgage services*. Nor may it rely upon *credit brokerage*: this term describes the services of an intermediary that facilitates transactions between third parties offering credit and those seeking credit. The opponent offers credit itself via its MINT credit card service. It has shown no use of brokerage services, which I consider to be a separate category of services, distinct from credit card services.

31. This leaves *payment and credit services; advice and enquiries regarding credit; services for the provision of credit; consultancy, information and advisory services relating to all the aforesaid services*.

32. This seems to me to be a fair reflection of the use shown by the opponent as far as earlier mark 2360715G is concerned. Removing any of these services would be pernicky.

33. The class 36 specification for EUTM 3899333 is:

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.

34. In line with my findings above, the opponent may not rely upon terms which are too wide and capable of further division into coherent sub-categories:

Financial services; banking services; automated banking services; mortgage services; insurance services; financial consultation services; financial information services; financial advisory services; computerised financial services; information services relating to mortgages, banking and finance.

35. Nor may the opponent rely upon terms which form categories of services for which there is no use:

Debit card, charge card, cash card and bank card services; monetary transfer; credit brokerage; financial analysis and providing reports; 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.

I do not think the average consumer would describe credit card balance transfers as loan services. If one wished to finance a car purchase or a new kitchen, a loan in the traditional sense would be sought rather than a credit card balance transfer. Credit card balance transfers do not constitute genuine use of *monetary transfer* services, the natural meaning of which would be the moving of money around accounts, or to third parties, such as telegraphic transfer. Providing credit card balance transfers as part of its credit card services does not entitle to the opponent to claim that it has created a market share in services for monetary transfer.

36. *Account debiting services; cheque encashment services; automatic cash dispensing services, automatic teller machine services; acceptance of deposits* are all part and parcel of providing users with credit card services. In *Galileo International Technology, LLC v European Union* [2011] EWHC 35 (Ch), Mr Justice Floyd considered the issue of a fair specification for travel reservation computer systems, which also offered calendar and document management functions. He observed:

“The average consumer does not see the sale of a car as a sale of climate control systems or computers or satellite navigations systems, although cars are now often sold with such built-in functionality”.

I would therefore hesitate to include the terms listed above in a fair specification. There is also the question of whether the use shown is sufficient, bearing in mind that this is an EU trade mark registration⁸. I find that I do not need to decide these points because a fair specification for the EUTM will leave the opponent in no better a position compared to the UK registration in relation to all three grounds of opposition.

Proof of use outcome

37. The opponent may rely upon MINT in relation to the following services:

Payment and credit services; credit card services; advice and enquiries regarding credit; services for the provision of credit; consultancy, information and advisory services relating to all the aforesaid services.

Sections 5(1), 5(2)(a) and 5(2)(b) of the Act

38. Sections 5(1), 5(2)(a) and 5(2)(b) provide:

“5.—(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

⁸ See *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 (CJEU) and *TVR Automotive Ltd v OHIM*, Case T-398/13 (GC).

(2) A trade mark shall not be registered if because –

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

(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.”

39. The services which the opponent may rely upon are self-evidently not identical to the opponent’s goods. The section 5(1) ground of opposition therefore fails.

40. The section 5(2)(b) ground was founded only upon EUTM 5317102, MINT MOBILE. As there was no proof of use for the goods and services for which this mark is registered, it cannot be relied upon. This ground fails.

41. As regards the section 5(2)(a) ground, the marks are identical. In view of this, there is no need to set out the case-law relating to the comparison of marks. In terms of the other factors relevant to likelihood of confusion, I note the well-established principles from the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(d) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(e) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant but whose attention varies according to the category of goods or services in question; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97.

(f) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(g) 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(h) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Comparison of goods and services

42. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*. where 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.”

43. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. ‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

“82 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...”

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken against transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

44. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

45. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

46. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

47. The goods and services to be compared are:

Opponent's services	Applicant's goods
<p><i>Payment and credit services; credit card services; advice and enquiries regarding credit; services for the provision of credit; consultancy, information and advisory services relating to all the aforesaid services.</i></p>	<p><i>Computer software; downloadable computer software applications; 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.</i></p>

48. The applicant's term *computer software* is unrestricted in scope. In *Galileo International Technology, LLC v European Union*, Floyd J stated:

"39. The unrestricted specification is of enormously wide scope. The Hearing Officer wisely reminded himself of what Laddie J had said about wide specifications for computer software in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850. Laddie J considered that:

"... there is a strong argument that a registration of a mark simply for "computer software " will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls the computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act."

40. That was a case decided under the Trade Marks Act 1938, but, like Laddie J, I see no reason why the views there stated should not apply under the [1994] Act."

49. *Computer software for creating reports and graphs; computer software for forecasting and analysis of data; computer software for data aggregation; 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 providing alerts; computer software for enabling users to retrieve account balance and transaction information using mobile phones, smart phones, and mobile telecommunication networks.*

50. The nature of goods and services is different. Ms Wright states that it is common practice that banking and credit card services are offered digitally as well as through more traditional sources. She states that most credit card services provide mobile

phone software in the form of 'apps' which enable users to view account balances, pay bills and make payments using mobile technology devices. Although the opponent has provided no evidence of this, I note that the applicant has: the investopedia.com article describes Mint.com as allowing users to check savings, investments, credit cards and bank accounts online, and to track spending habits. The techland.time.com article refers to the "50 Best Android Apps for 2013", listing Mint.com Personal Finance. This was two years prior to the application date; apps have increased in popularity since 2013, not diminished. The applicant submits:

"...the EU General court case of *GRAZIA* (Case T490/12) sets out the relevant approach. The case involved two identical marks (*GRAZIA*) with the earlier mark being registered for *inter alia* "software" in Class 9 and the later applicant covered *inter alia* "financial services" in class 36. The General Court held that "*the goods and services covered by the marks are different in every respect*" (para 74) stating that "*in view of the very widespread use of computers by companies, the fact that they are used by the applicant and the intervener to market their goods and services is insufficient in itself to establish that those goods and services are similar or complementary*" (para 28). The Court went on to conclude that there was no possibility that consumers would form a link between the goods and services of the respective marks for the purposes of Article 8(5) of regulation No 207/2009 "*even though the signs at issue are identical and the sections of the public to which the goods and services covered by those signs are directed overlap in part, there is no likelihood of a connection being made between them, as those goods and services are different in all respects*" (para 78).

The General Court's findings that there was no similarity whatsoever between the goods and services or that consumers would make any link between them was specifically upheld on appeal by the CJEU in case no C-548/14P (17 September 2015.)

51. In actual fact, the class 36 services which were opposed were not 'financial services'. They were 'Financing services; brokerage of business investments with private equity; arranging contracts for the procurement of financial capital; financing

consultancy, in particular financial consultancy with regard to company take-overs; financial business valuations; mergers and acquisitions, namely financial consultancy with regard to the purchase or sale of companies and company shares; capital investments; venture capital fund administration’.

52. These services are different to credit card and payment services which are retail services provided by, e.g. a bank. Further, the relevant date in *GRAZIA* was 8 April 2008. The use of apps has developed considerably since then. I do not find the *GRAZIA* case to be of assistance.

53. There is an obvious convergence between the users of such apps and users of credit card services, who may wish to stay on top of their spending, pay bills and view their bill payments and remaining credit allowances, to see reports of when and where they spent money, and to receive alerts relating to payment dates, use of the card and so on. Such data would be aggregated could be presented in graph form. The average consumer of a credit card will be the average consumer of such an app. An app which enables one to pay bills shares a common purpose with payment services. The channels of trade coincide, a bank offering credit card services also offering such an app. There would be no point in such an app without the accompanying credit card services. There is, therefore, complementarity (although I note that the applicant’s software is provided independently, I must consider notional and fair use). I find that the services listed in the previous paragraph are similar to a reasonable degree to the opponent’s credit card services and payment services.

54. This leaves *computer software* and *downloadable computer software applications*. These are wide terms covering software performing every type of function. Accordingly, on the logic of the previous paragraph, these goods are also similar to a reasonable degree to the opponent’s credit card services.

Average consumer and the purchasing process

55. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary

according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

56. The average consumer for the opponent's services will be the general public. That is also the case for the applicant's goods, although the subject matter of the limited software means that they are also likely to be used for business purposes as well as for personal finance. A reasonably observant and circumspect average consumer will take care in choosing credit card services, paying attention to such matters as the APR percentage, the credit limit, locations where it can be used, balance transfers and penalties for late or underpayment. The applicant's limited software is also likely to be the subject of a reasonably careful purchase (software at large covers all types of software, such as games which may not be so carefully selected). The marks are identical, whether perceived visually or aurally during the purchasing process.

Distinctiveness of MINT

57. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

58. MINT is a dictionary word meaning a herb/flavour, a type of sweet, and a place where coins are struck. It is a colloquial way of describing a large amount of money and also describing something as new or perfect. None of these meanings describe or plainly allude to any characteristics of the opponent’s services. The mark has an inherent average degree of inherent distinctive character.

59. Whilst I do not think that the advertising and press articles, which are pre-2009, are likely to have a sufficient continuing impact such that the opponent’s mark enjoys enhanced distinctive character on this basis alone, in terms of customer numbers and usage of the credit card services, whilst these have gradually diminished over time, the figures for 2014 show that there were 343,000 customers, and 96,000 purchases. In 2015, the year of application, there were 21,000 balance transfers to MINT from other credit cards (which doesn’t necessarily mean that the MINT cards were used for any other purpose than to shift the credit card debt). The Appointed Person, Ms Amanda Michaels, in the previous proceedings (mentioned earlier in this decision) observed at paragraph 30 of the appeal decision that although the number of customers had shrunk by the relevant date in those proceedings (2013), it was not fair to describe them as small. The figures for 2013 were about 40,000 more than for 2014, which is not enough to make any difference to my assessment. As in these proceedings, the evidence in the previous proceedings also referred to the fact that there ‘are’ 50 million credit accounts in the UK. At paragraph 31 of the appeal decision, Ms Michaels said:

“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.””

60. The evidence in these proceedings goes up until 2014, the year prior to the opposed application. There is no appreciable difference in a later relevant date in these proceedings compared to the earlier proceedings. I find that the opponent’s mark enjoyed an enhanced level of distinctive character at the relevant date in relation to credit card services.

Likelihood of confusion

61. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa.

62. I have found a reasonable degree of similarity in relation to all of the goods of the application. The marks are identical, which is important because it means that the degree of similarity between the parties’ goods and services means that the interdependency principle operates in the opponent’s favour. The opponent’s mark has an enhanced level of distinctive character. I find that there is a likelihood of confusion because there will be an assumption on the part of the average consumer that the ability to manage its credit card account and spending via software/an app

which has the same distinctive name as the credit card is a result of the same or an economically linked undertaking providing both the credit card services and the software/ the app. This assumption is not likely to be deflected by careful consideration in the purchasing process; certainly not enough to militate against the other factors in the global comparison.

Section 5(2)(a) outcome

63. The opposition succeeds under section 5(2)(a) of the Act.

Other grounds of opposition

64. As the opposition has succeeded in full under section 5(2)(a), I will deal briefly with the section 5(3) and 5(4)(a) grounds.

65. My earlier findings in relation to enhanced distinctiveness mean that the opponent's mark had sufficient goodwill and reputation in credit card services on which to base its opposition under these grounds. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

66. The requirements to succeed in a passing off action are well established and are summarised in *Halsbury's Laws of England* 4th Ed. as being that:

i) the claimant's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant's goods or services are those of the claimant;

and iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant's misrepresentation.

67. There is one possible difference between the position under trade mark law and the position under passing off law. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "a substantial number" of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

68. In line with my findings under section 5(2)(a), I find that the goodwill enjoyed in relation to the sign MINT at the date of application (the applicant having filed no prior UK use of its own) was sufficient for it to have been able to prevent use of the application under the law of passing off because the similarities between the goods and services and the identity of the signs would lead to misrepresentation. A substantial number of the opponent's customers would be deceived, leading to damage.

69. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

70. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and*

Spencer v Interflora, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

71. Since I found a reputation and a likelihood of confusion, it follows that I find that the requisite link is established. A likelihood of confusion means that there is an automatic unfair advantage because the applicant's goods will be bought on the premise that they emanate from the opponent or a linked undertaking, thereby increasing the applicant's sales.

72. The applicant has pleaded due cause as a defence. In *Leidseplein Beheer BV v Red Bull*, Case C-65/12, the CJEU held (with my emphasis):

“43. In a system for the protection of marks such as that adopted, on the basis of Directive 89/104, by the Benelux Convention, however, the interests of a third party in using, in the course of trade, a sign similar to a mark with a reputation must be considered, in the context of Article 5(2) of that directive, in the light of the possibility for the user of that sign to claim 'due cause'.

44. Where the proprietor of the mark with a reputation has demonstrated the existence of one of the forms of injury referred to in Article 5(2) of Directive 89/104 and, in particular, has shown that unfair advantage has been taken of the distinctive character or the repute of that mark, the onus is on the third party using a sign similar to the mark with a reputation to establish that he has due cause for using such a sign (see, by analogy, Case C-252/07 *Intel Corporation* [2008] ECR I-8823, paragraph 39).

45. It follows that the concept of 'due cause' may not only include objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical or similar to the mark with a reputation.

46. Thus, the concept of 'due cause' is intended, not to resolve a conflict between a mark with a reputation and a similar sign which was being used before that trade mark was filed or to restrict the rights which the proprietor of that mark is recognised as having, but to strike a balance between the interests in question by taking account, in the specific context of Article 5(2) of Directive 89/104 and

in the light of the enhanced protection enjoyed by that mark, of the interests of the third party using that sign. In so doing, the claim by a third party that there is due cause for using a sign which is similar to a mark with a reputation cannot lead to the recognition, for the benefit of that third party, of the rights connected with a registered mark, but rather obliges the proprietor of the mark with a reputation to tolerate the use of the similar sign.

...

60. Consequently, it follows from all of the foregoing considerations that the answer to the question referred is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the proprietor of a trade mark with a reputation may be obliged, pursuant to the concept of 'due cause' within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith. In order to determine whether that is so, the national court must take account, in particular, of:

- how that sign has been accepted by, and what its reputation is with, the relevant public;
- the degree of proximity between the goods and services for which that sign was originally used and the product for which the mark with a reputation was registered; and
- the economic and commercial significance of the use for that product of the sign which is similar to that mark.”

73. The relevant public is the UK public because they will be moved to buy the applicant's goods, thereby leading to unfair advantage. The applicant's mark has no reputation with the UK public because the applicant has not used its mark in the UK. That it may be successful in the US does not give it due cause to apply for and register its mark in the UK. Trade mark registrations are territorial. Success in one country

does not give the applicant due cause to register in another where there has been no use and there is no reputation amongst relevant consumers in that country. The defence of due cause fails.

Overall outcome

74. The opposition is successful. The application is refused.

Costs

75. The opponent has been successful and is entitled to costs, which I assess on the basis of the scale published in Tribunal Practice Notice 2/2016.

Fee for filing notice of opposition	£200
Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering the other side's evidence	£800
Total	£1300

76. I order Intuit Inc to pay The Royal Bank of Scotland Group plc the sum of £1300 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 21st day of September 2017

Judi Pike
For the Registrar,
the Comptroller-General