

O/462/21

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003185346

IN THE NAME OF GLINT PAY LTD

FOR THE FOLLOWING TRADE MARKS AS A SERIES:

**glint**

**GLINT**

IN CLASSES 9, 36 AND 42

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 502871

BY GLINT INC.

## BACKGROUND AND PLEADINGS

1. Glint Pay Ltd (“the proprietor”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK on 13 September 2016. It was registered on 30 December 2016 for goods and services in classes 9, 36 and 42.<sup>1</sup>

2. On 28 October 2019, Glint Inc. (“the applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon sections 5(1) and 5(2)(a) of the Act and concerns all the goods and services the contested mark is registered for. The applicant had originally based its application on sections 5(3) and 5(4)(a) also, but these grounds were struck out by the Registry for a failure to file evidence to support them.

3. Under sections 5(1) and 5(2)(a), the applicant relies on the following European Union trade mark (“EUTM”) number 013300637, the pertinent details of which are as follows:<sup>2</sup>

**Representation:** GLINT

**Filing date:** 26 September 2014

**Registration date:** 16 February 2015

**Priority date:** 16 April 2014

4. The applicant relies upon all the goods and services in its registration in classes 9, 35 and 42.<sup>3</sup>

5. Under section 5(1), the applicant claims that the parties’ marks and their respective goods and services are identical. Further, or in the alternative, under section 5(2)(a),

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<sup>1</sup> These will be listed in the goods and services comparison later in this decision.

<sup>2</sup> Although the UK has left the EU and the EUTM relied upon by the applicant now enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application for invalidation was filed before the end of the transition period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the application on the basis of the right as it existed at the date on which invalidation proceedings were launched.

<sup>3</sup> These will be listed in the goods and services comparison later in this decision.

the applicant claims that the parties' marks are identical and their respective goods and services are similar, resulting in a likelihood of confusion.

6. The proprietor filed a defence and counterstatement denying the grounds of invalidation. It admits that the marks at issue are the same word but denies they are identical due to conceptual differences.<sup>4</sup> The proprietor denies any similarity or identity between the parties' goods and services and, therefore, denies a likelihood of confusion.

7. Both parties filed evidence in chief and the applicant filed evidence in reply. A hearing took place before me on 31 March 2021, by video conference. The applicant was represented by Philip Harris of Lane IP; the proprietor was represented by Jamie Muir Wood of Hogarth Chambers.

8. The applicant is represented by Lane IP; the proprietor by James Ware Stephenson.

## **EVIDENCE AND WRITTEN SUBMISSIONS**

9. Both parties filed evidence. The applicant's evidence in chief consists of written submissions and evidence, in the form of the witness statement of Jandan Aliss, a Trade Mark Attorney at Lane IP. It contains evidence adduced to show the definition of the word GLINT and the claimed similarity/identity between the parties' goods and services and is accompanied by 3 exhibits. The proprietor's evidence in chief is in the form of the witness statement of Silvia Theresia Baumgart, Solicitor of James Ware Stephenson. The accompanying 14 exhibits go to the comparison of the parties' goods and services and customers. The applicant's evidence in reply is in the form of a second witness statement of Jandan Aliss, accompanied by 6 exhibits, which also relate to the comparison of goods and services.

10. I shall not summarise the evidence and submissions here, but I have reviewed them in their entirety and will refer to them where appropriate during my decision.

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<sup>4</sup> At the hearing, Mr Muir Wood briefly mentioned the concept of the word GLINT in relation to gold, but confirmed that the proprietor's position is that it accepts that the marks are identical.

## **PRELIMINARY ISSUE**

11. Filed by the proprietor are exhibits relating to the parties' customers/target market<sup>5</sup> and the goods and services "actually"<sup>6</sup> provided by the parties.<sup>7</sup> Differences between the goods and services currently provided by the parties are irrelevant, except to the extent that those differences are apparent from the list of goods and services they have tendered for the purpose of registration of their marks. It is the goods and services for which each mark is registered that I will be comparing, later in my decision. The assessment I must make between the goods and services is a notional and objective assessment, rather than a subjective one. For example, the targeting of specific demographics is temporal and may change over time. As such, it is not appropriate to take that factor into account. However, I will make an assessment, later in my decision, as to who the average consumer is for the goods and services at issue.

## **DECISION**

12. Sections 5(1) and 5(2)(a) have application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

"47(1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

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<sup>5</sup> Exhibits STB4 and STB5.

<sup>6</sup> Paragraphs 16 and 17 of the witness statement of Silvia Theresia Baumgart.

<sup>7</sup> Exhibits STB12 and STB13.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) [...]

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

13. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

### **Sections 5(1) and 5(2)(a)**

14. Section 5(1) of the Act states that:

“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 mark is protected.”

15. Section 5(2)(a) states that:

“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, [...]

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

16. The mark relied upon by the applicant qualifies as an earlier mark and, given its registration date, is not subject to the proof of use provisions contained in section 47(2A) of the Act.

### **Identity of the marks**

17. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

18. The marks to be compared are as follows:

<b>Earlier mark</b>	<b>Contested mark</b>
GLINT	glint GLINT

19. It is self-evident that the marks are identical.

### **Section 5(2)(a) – Relevant law**

20. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98,

*Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.*

### The principles

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

21. The competing goods and services are shown in the table below:

<b>Earlier mark</b>	<b>Contested mark</b>
Class 9: Computer software in the field of human resources; computer software in the field of employment; computer software in the field of organizational development.  Class 35: Providing organizational development consulting services; consulting services in the field of human resources development; human	Class 9: Computer software and applications for mobile devices for the purpose of financial services; computer software and applications for mobile devices for the purpose of currency exchange and trading services; computer software and applications for mobile devices for the purpose of banking services; computer software and applications for mobile devices for the purpose of financial investment

<p>resource analysis and consulting services.</p> <p>Class 42: Software as a service (SAAS) services in the field of human resources; software as a service (SAAS) in the field of employment; software as a service (SAAS) services in the field of organizational development.</p>	<p>services; computer software and applications for mobile devices for the purpose of electronic payments services; computer software and applications for mobile devices for the purpose of stocks, securities and bond trading services; <del>computer software and applications for mobile devices for the purpose of electronic payment services;</del><sup>8</sup> computer software and applications for mobile devices for the purpose of gold trading services; computer software and applications for mobile devices for the purpose of commodities trading services.</p> <p>Class 36: Financial services; banking services; provision of a digital currency and payment card backed by gold bullion; credit card and debit card services; provision of currency trading services; provision of a payment, trading, investment and exchange platform; currency exchange and transfer services; financial investment services; gold trading services; commodity trading services; securities trading services; stocks trading services; bond trading services; <del>financial investment services;</del><sup>9</sup> electronic payments services.</p>
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<sup>8</sup> I note this term has been entered twice in the proprietor's specification, so I will disregard the duplicate.

<sup>9</sup> As above.

	<p>Class 42: Software design and development in the field of financial services; Software design and development in the field of financial investment services; Software design and development in the field of banking services; Software design and development in the field of currency exchange and trading services; Software maintenance services in the field of financial services; Software maintenance services in the field of financial investment services; Software maintenance services in the field of banking services; Software maintenance services in the field of currency exchange and trading services; Software consultancy services in the field of financial services; Software consultancy services in the field of financial investment services; Software consultancy services in the field of banking services; Software consultancy services in the field of currency exchange and trading services.</p>
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22. In *Gérard Meric v Office for Harmonisation in the Internal Market* (“OHIM”), Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

23. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

(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.

24. In the judgment of the CJEU in *Canon*, the court stated at paragraph 23 of its judgment that:

“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.”

25. 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/services. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is 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”.

26. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... 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."

27. 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.”

28. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

*“...the applicable principles of interpretation are as follows:*

*(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*

*(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

*(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

*(4) A term which cannot be interpreted is to be disregarded.”*

29. Before looking at the goods and services in each class, I will deal with the respective parties' use of “for the purpose of” and “in the field of”. At the hearing, Mr Harris made the following submission:

“We cannot ignore the words “for the purposes of” or “in the field of”. They clearly have an effect on the breadth of the specifications in suit. As a matter of ordinary language, I submit that this extends them beyond the strict narrow interpretations of financial services and human resources that my learned friend is going to urge you to find. It extends to anything that would be reasonably interpreted as being for the purpose of rendering those financial services, which would include anything in support of financial services, and so on.”

30. In response, Mr Muir Wood submitted:

“My learned friend quotes *Skykick* in his skeleton argument. I remind you that it is important to interpret terms narrowly. He then goes on in his submissions

to interpret terms as broadly as possible. In my respectful submission, he is doing precisely the opposite of what *Skykick* encourages you, in fact requires you to do, and his submissions are at odds with that decision.”

31. Mr Harris then referred to *YouView* and submitted:

“Whilst it might be right to put some narrowing on that specification, there is no need to go any narrower than absolutely necessary as required by the words. The words “for the purposes of” are clearly broader than mere financial services per se.”

32. Having considered the arguments put forward by both parties, and considering the case law referred to by them, as well as the decision in *Avnet*, I am minded to agree with Mr Muir Wood. Use of the terms “for the purpose of” and “in the field of” does not allow the words that follow to be given a broader interpretation than the core meaning of them. In fact, I consider the opposite to be true. Those terms specifically limit the goods or services to, in this case, the sector which follows. Simply limiting a term within a specification to a certain sector does not constitute straining the language so as to produce a strict, narrow meaning. In fact, applying anything other than the ordinary meaning of those sectors would give rise to terms with no limits. I consider the parties’ use of “for the purpose of” and “in the field of” to specifically limit its respective goods and services to whatever follows those phrases.

#### The proprietor’s class 9 goods

33. Since both parties, in their submissions and at the hearing, focused on “financial services”, I will deal first with the proprietor’s “computer software and applications for mobile devices for the purpose of financial services”, given that I consider it to be the broadest term in the specification. As Mr Harris did at the hearing, I will compare it to the applicant’s “computer software in the field of human resources”. I consider it to be clear that, given the goods are both computer software, the comparison to be made is between the limitations of the software i.e. financial services and human resources. In this regard, Mr Harris submitted:

“[The proprietor] concede[s] that at paragraph 8 of the statement of grounds and counterstatement, the very first line of which says, “It is agreed that the applicant’s protection extends to computer software in the field of human resources in the financial sector.” They clearly accept that in principle the software we provide, or the software for which we have protection extends into the financial sector. In my submission, that brings it within the *Meric* principle, the inclusive identity principle, because if it is software in the field of human resources and the financial sector it is for the purpose of financial services, the term “for the purpose of” being an extremely wide term.

Without straining to interpret that language it is absolutely clear that it is not intended to limit the proprietor’s specification purely to financial services, but any software for the purposes of financial software, and that would include human resources in the field of the financial sector.”

34. As Mr Muir Wood submitted at the hearing, the fact that computer software in the field of human resources could be used in the financial sector does not mean said software is for financial services.

35. In order to make an accurate comparison, I must, in accordance with *Avnet*, understand the core meaning of financial services and that of human resources. Both parties filed evidence in this regard. The applicant filed a definition of human resources taken from <https://en.wikipedia.org>.<sup>10</sup> The article lists the various functions of a human resources manager, one of which being to “manage employee payroll, benefits and compensation”. The proprietor filed a definition of the function of human resources taken from [www.cipd.co.uk](http://www.cipd.co.uk) (the website of the Chartered Institute of Personnel and Development).<sup>11</sup> The definition refers to recruiting and developing people and managing their performance, with no mention of payroll or a financial aspect to the role. The applicant filed evidence in reply to dispute the proprietor’s evidence.<sup>12</sup> The exhibit contains articles from three different websites discussing the role of a human resources department or manager. Collectively, they refer to the overseeing of

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<sup>10</sup> Annex 3 to the witness statement of Jandan Aliss dated 30 July 2020.

<sup>11</sup> Exhibit STB2 to the witness statement of Silvia Theresia Baumgart.

<sup>12</sup> Annex 1 to the witness statement of Jandan Aliss dated 30 November 2020.

compensation and benefits and the processing of payroll. Also within the exhibit is a job advert for a human resources officer, which lists one of the responsibilities as administering payroll. At the hearing, Mr Muir Wood referred to the proprietor's evidence<sup>13</sup> and submitted that financial services are defined as "the process of acquiring a financial good involving some sort of transaction". The applicant has not filed in evidence a definition of financial services, but many of its exhibits aim to highlight the financial nature of human resources.

36. Taking all of the evidence into account, I am satisfied that whilst some organisations have separate human resources and finance departments, there is often a crossover between the two in that organisations' payroll departments often sit within their human resources departments. Although payroll is a business service in class 35 and not a financial service in class 36, it has a financial aspect to it and the software used for payroll may be the same or similar to software used for financial services. I also consider it possible that a human resources department could share a software package with a finance department. Therefore, I consider "computer software in the field of human resources" and "computer software and applications for mobile devices for the purpose of financial services" to share a purpose and likely share users and trade channels. I find these goods similar to a medium degree.

37. In my view, the same reasoning applies to the following goods in the proprietor's specification:

Computer software and applications for mobile devices for the purpose of banking services; computer software and applications for mobile devices for the purpose of electronic payments services.

38. I turn now to the remaining class 9 goods:

Computer software and applications for mobile devices for the purpose of currency exchange and trading services; computer software and applications for mobile devices for the purpose of financial investment services; computer

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<sup>13</sup> Exhibit STB1 to the witness statement of Silvia Theresia Baumgart.

software and applications for mobile devices for the purpose of stocks, securities and bond trading services; computer software and applications for mobile devices for the purpose of gold trading services; computer software and applications for mobile devices for the purpose of commodities trading services.

39. Applying the above case law and confining the terms to the core of the possible meanings, I find the remaining computer software goods in the proprietor's specification to be limited to very specific financial services, none of which are similar to the services for which the applicant's computer software goods are limited to. These goods have a different purpose, different users and different trade channels. I do not consider them to be in competition or complementary. I find no similarity between the remaining goods in the proprietor's specification and any of the goods or services in the applicant's specification.

#### The proprietor's class 36 services

40. I will deal first with the proprietor's "financial services" as I consider it to be the broadest term in the specification. Mr Harris, at the hearing, made the following submissions:

"It is quite clear, in my submissions, that financial services can be included within organisational development services. You only have to think about what financial services include. It is not simply a matter of banking. It is not simply a matter of money in/money out. Financial services cover a whole range of products offered to customers that improve financial performances or which are for financial purposes. That in terms of organisational development could include, for example, consultancy or advice relating to restructuring. It would include consultancy or advice relating to the workforce and how the workforce might best be employed in order to maximise financial gain. It could be for the purpose of loan agreements, investments, providing advice and so on."

41. Mr Harris then referred me to the applicant's evidence to demonstrate that large companies such as KPMG and PwC offer both organisational development services and financial services.<sup>14</sup>

42. Mr Muir Wood referred to the same evidence and submitted:

"It refers to it provides financial services in the sense that it provides tax services, it provides services to customers in relation to tax. It provides services to banks in respect of organisational development, so it helps banks develop and evolve their internal structures. That is, as my learned friend said just now, a sector in its own right, the organisational development provided by KPMG. It is a sector in its own right and it is entirely separate from the provision of banking services, credit card services, commodity trading services, gold trading services, et cetera. It is a service provided to the financial sector in the same way that human resources services are provided to the financial sector, but that is not the same as it amounting to a financial service."

43. I agree that large companies providing various services does not automatically deem those services similar, nor am I satisfied that the average consumer would think it is the norm for those services to be offered by the same undertaking. However, I am also minded to agree that it is entirely possible for an aspect of organisational development consulting services to be financial in nature. Whilst organisational development services are unlikely to provide advice on specific financial products or investments, which would be provided by financial institutions, such services could include certain financial aspects, such as tax advice or reports on the business's assets/financial health. Given my findings in relation to the financial aspect of human resources, the same applies to the applicant's "consulting services in the field of human resources development" in that those consulting services could include advice in relation to the remuneration of employees or workers. I do not consider these services to be in competition or complementary, but there may be a shared purpose, the users may overlap, as might the trade channels. I find a low degree of similarity between the proprietor's financial services and the applicant's class 36 services.

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<sup>14</sup> Annex 2 to the witness statement of Jandan Aliss dated 30 July 2020.

44. I consider none of the remaining class 36 services in the proprietor's specification to be as broad as financial services. They consist of specific financial services, the meanings of which are far narrower than financial services at large. I cannot see any obvious similarity between the applicant's goods and services and the remainder of the proprietor's services.

#### The proprietor's class 42 services

45. I will deal first with the proprietor's "software design and development in the field of financial services", "software maintenance services in the field of financial services" and "software consultancy services in the field of financial services". I will compare these to the applicant's class 42 services, which include software as a service ("SAAS"). SAAS is essentially the same as software with the only difference being that users purchase software in class 9 as a one-off and download it to their device, using it for as long as needed. On the other hand, SAAS is paid for via a subscription, for example, and rather than being stored on the user's device, it is stored centrally and accessed by the user via a different method (i.e. a web browser). SAAS is updated and upgraded by the service provider on the central server. For this reason, the applicant's SAAS differs to the proprietor's services, which are the design, development and maintenance of software and not the end product of the software itself. Therefore, the services differ in method of use and nature. There is an overlap in purpose of the services, which is limited only in that the services generally relate to software services and that there is an overlap in the financial and human resources sectors discussed at paragraphs 35 and 36 above. However, the users overlap as do the trade channels. Further, there is likely to be a complementary relationship in that consumers would think the design, development and maintenance is important to running the SAAS and that the undertaking responsible for one is responsible for the other. The complementary relationship does not extend to the proprietor's consultancy services as I do not consider consultancy to be important to the running of SAAS. Taking everything into account, I find the proprietor's "software design and development in the field of financial services" and "software maintenance services in the field of financial services" similar to a medium degree, and the proprietor's "software

consultancy services in the field of financial services” similar to a low degree to the applicant’s class 42 services.

46. Moving on to the remaining services, financial investment services, banking services and currency exchange and trading services are narrower than financial services at large and are terms that I find dissimilar to human resources, employment, and organizational development. I therefore find no similarity between the remaining services in the proprietor’s class 42 specification and the applicant’s goods and services.

### **The average consumer and the nature of the purchasing act**

47. It is necessary for me to determine who the average consumer is for the goods and services in question; I must then determine the manner in which the goods and services are likely to be selected by the average consumer in the course of trade.

48. 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.

49. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

50. Mr Muir Wood, in his skeleton arguments and at the hearing, submitted that the average consumer is likely to be a professional in the case of the applicant's goods and services and a professional or member of the public in the case of the proprietor's goods and services, all of whom will pay a high degree of attention to the selection. Mr Harris, at the hearing, agreed that the average consumer is likely to be a consumer within a business. He submitted that there is a wide range of potential consumers, who could pay anything from a low to a significant level of attention, but that the most important group is the one paying a low attention.

51. I consider it unlikely, given the nature of the goods and services, that a consumer will pay only a low degree of attention to the purchase. Whether the consumer is a member of the public or a professional, they are likely to pay at least a medium degree of attention to their selection.

#### **Distinctive character of the earlier mark**

52. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* 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 *WindsurfingChiemsee 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).”

53. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

54. With no evidence of use of the earlier mark from which to make an assessment as to an enhanced distinctive character, I only have the inherent position to consider. GLINT is an ordinary dictionary word which is neither descriptive of nor allusive for the goods and services for which it is registered. I consider the mark to have a medium degree of inherent distinctive character.

### **Likelihood of confusion**

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between

trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

56. I have found the marks to be identical. I have found the earlier mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be either a member of the general public or a professional who will pay at least a medium degree of attention during the purchasing process. I have found the goods and services at issue to be either dissimilar or similar to between a low and medium degree.

57. In consideration of all the above factors, I find that there is a likelihood of direct confusion. Given that the competing marks are identical, and the earlier mark has a medium level of distinctive character, I am satisfied that the average consumer will mistake one mark for the other when used on similar goods and services, even those that are similar to a low degree. I consider this to be the case even where at least a medium degree of attention is paid to the purchase.

## **CONCLUSION**

58. The application for invalidation fails under section 5(1) since I have found none of the goods and services to be identical. The application for invalidation partially succeeds under section 5(2)(a) and the contested mark is hereby declared invalid in respect of the following goods and services:

Class 9: Computer software and applications for mobile devices for the purpose of financial services; computer software and applications for mobile devices for the purpose of banking services; computer software and applications for mobile devices for the purpose of electronic payments services.

Class 36: Financial services.

Class 42: Software design and development in the field of financial services; Software maintenance services in the field of financial services; Software consultancy services in the field of financial services.

## **COSTS**

59. As both parties have been partially successful, I do not consider it appropriate to make an award of costs in this matter.

**Dated this 18th day of June 2021**

**E VENABLES**

**For the Registrar**