

**O-544-16**

**TRADE MARKS ACT 1994**

IN THE MATTER OF REGISTRATION NO 3070828  
STANDING IN THE NAME OF MOMENTUM FINANCIAL TECHNOLOGY LIMITED  
AND  
AN APPLICATION FOR CANCELLATION UNDER NO 501082  
BY TRANSFER TO MOBILE FINANCIAL SERVICES LIMITED

## Background

1. The trade mark **MONEY HUB** is registered under No 3070828 and stands in the name of Momentum Financial Technology Limited (“the registered proprietor”). It has a filing date of 2 September 2014 (“the relevant date”), was entered in the register on 5 December 2014 and stands registered for the following goods:

Computer software; software based aggregation tool for accounts and accounting; financial software to allow for management of finances; software to allow for financial planning and financial investor profiles; financial management software.

2. By way of an application filed on 16<sup>th</sup> December 2015, Transfer to Mobile Financial Services Limited (“the applicant”) applied to cancel the registration by declaring it invalid. It did so under the provisions of section 47 of the Trade Marks Act 1994 (“the Act”) relying on grounds under sections 3(1)(b), (c) and (d) of the Act. It claims:

- The mark offends against section 3(1)(b) as “The words MONEY and HUB when used in relation to the goods covered are ordinary words to which ordinary meaning is attached and directly describe the services offered”;
- The mark offends against section 3(1)(c) as “the words MONEY HUB immediately inform consumers that the product provided is a hub, or centralized exchange (effected by computer software), relating to money” and is descriptive of the goods covered;
- The mark offends against section 3(1)(d) as “the words MONEY and HUB are both used frequently and consistently (and often in combination) in the trade by various companies to describe technological products and services relating to money and centralized exchanges [and that a]s such, they are inherently, or have become, customary in the English language”.

3. The registered proprietor filed a counterstatement denying the claims made. In the alternative, it claims the trade mark has acquired a distinctive character as a result of the use made of it.

4. Both parties filed evidence with the registered proprietor also filing written submissions. Both parties also filed written submissions in lieu of a hearing.

5. At this point, I pause to address an issue in relation to the applicant's written submissions filed in lieu of a hearing. The registered proprietor requests that they not be taken into account. It does so on the basis that they are "late" as the applicant did not file submissions during the evidence rounds (whether in chief or in reply) and is being unreasonable by filing submissions in lieu which raise new arguments. It claims that this has led to the registered proprietor being prejudiced because it has had only limited time to consider them and, had they been filed at an earlier stage, it would have been able to take them into account in deciding whether it wished to opt to be heard or have a decision from the papers.

6. Whilst the registered proprietor criticises the applicant's submissions in lieu as being "late" they were filed within the period allowed. In terms of what it considers to be "new arguments" the registered proprietor refers me to paragraph 45 of the applicant's submissions which state:

"...even if it is considered that the Registration does not directly describe software as such, the Registration still lacks distinctiveness...the fact that the Registration is composed of non-distinctive words and could be understood as a meaningful phrase that identifies a relevant characteristic within this field of goods is enough to render the Registration non-distinctive, even if the Registration may not be directly descriptive for certain specific goods in the specification."

7. For its part, the applicant submits it is entitled to make legal submissions either orally at a hearing or in written form in lieu of a hearing. It submits that it has chosen to file them in written form and submits that it did so in a clear and concise form in good time.

8. I have set out above at paragraph 2 the claims made by the applicant when seeking cancellation of the registration. In relation to the claims made under section

3(1)(b) and (c) of the Act, both are made on the basis of the alleged descriptive nature of the mark. Though not entirely clear, the wording of the submissions, which I have set out above at paragraph 6, could be said to seek to introduce a separate claim under section 3(1)(b) on the basis that the mark has no distinctive character.

9. The basis of a party's case should be set out at the earliest opportunity so that the other party knows the case against it. In cancellation proceedings, this is by the completion of the statements of case included within or attached to either the application to declare a mark invalid (Form TM26(i)) or the notice of defence and counterstatement (Form TM8). It is possible to request leave to amend those forms at a later date though any such request should also be made at the earliest opportunity. Any request to amend the basis of an attack or a defence must be explicitly made giving full details of the desired amendment. It is not good practice to wait until the proceedings are about to be determined before seeking amendment(s) nor is it acceptable to add a new ground implicitly through submissions.

10. The applicant has not sought leave to amend its claims at any time. I therefore proceed on the basis of the claims as set out in the original application and give this decision after careful consideration of the written material before me. The evidence and written submissions will not be summarised but will be referred to as necessary later in this decision.

## **Decision**

11. Section 47 of the Act states:

**“47. - (1)** The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use

which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) ...

(3) ...

(4) ...

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(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.”

12. The relevant parts of section 3 of the Act state:

“3(1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

### **The objection under section 3(1)(d) of the Act**

13. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of this section of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

14. In support of its objection under this ground, the applicant refers me to the witness statement of Caroline Julia Campbell Bass. She states she is a solicitor at Fieldfisher LLP, the applicant’s representatives in these proceedings. Ms Bass’ witness statement serves only to act as a vehicle to introduce a number of exhibits which are either extracts from dictionaries or other publications most, if not all, of which appear to have been downloaded from the internet. In respect of the objection under this ground, Ms Bass refers to the following exhibits:

- CJC21: A single page comprising an article taken from Mashable.com entitled “How Qualcomm empowers women across the world to achieve their business goals”. It refers to the company’s “Wireless Reach” initiative which aims to “accelerate their business through mobile technology”. It goes on to say:

“A large amount of Filipino communities don’t have access to traditional banking systems, which means they’re forced to rely on less conventional methods for managing their finances and paying bills. Small “money hubs” are the most popular of the non-traditional solutions, effectively taking the place of a bank without the strings attached. These hubs can crop up

anywhere, but sari-sari stores (sic) have increasingly offered the financial service as part of their business repertoire.”

The article explains that a sari-sari store is “The Philippine equivalent of an American convenience store...a rural, one-stop-shop where community members can buy a wide array of goods and food products.” There are also references in the article to “equipping sari-sari owners to mobile money hub capabilities”, “turning their sari-sari stores into mobile money hubs that can help better serve the needs of communities, and provide a much needed avenue for business growth” and refers to one lady “describing how the money hub business helped resurrect her sari-sari store after the devastation of the typhoon...”. The article is dated 29 September 2015;

- CJC22: An article dated 15 April 2015 from *The Examiner (Washington, DC)* entitled “GOP dirt diggers dog Clinton” which refers to a US political opposition group having staff in “...the big money hubs such as Boston, New York and San Francisco...”
- CJC23: An essay published in *The Guardian* on 10 November 2014. It begins “We need a bolder charity sector which claims the right to have an opinion...”. At the conclusion of the essay is the following: “For more news, opinions and ideas about the voluntary sector, join our community it’s free. The charity money hub is funded by CAF.”;
- CJC24: An article taken from *Economist Intelligence Unit (EIU) Country Reports* dated 13 May 2014. It is entitled “Global tax pact targets financial havens”. Under the heading “Singapore and Switzerland” there is a reference to “The two countries [ranking] among the top 15 money hubs, alongside much larger economies like the US, UK and Japan.”;
- CJC25: An article from *CITY A.M.* dated 12 March 2013 entitled “London aims to be Islamic money hub” which refers to the government launching a campaign to promote London as a centre for Islamic finance.

15. The applicant submits that this evidence “show[s] generic use of the term “MONEY HUB”” and that the phrase has:

“become customary in the English language. The fact that it has been used in relation to small stores, cities with large financial sectors and even charities, illustrates a wide range of customary use in the current language. Used in relation to software products, the mark will clearly be understood as indicating a software product that fulfils a comparable role.”

16. As the registered proprietor points out in its submissions, the goods at issue in these proceedings is computer software. These five articles, most of which are from American publications or date from after the relevant date, do not refer to computer software. References to charities or to cities or countries as being “money hubs” because they are or have aims to become known for their financial trade or to wireless technology being used to enable a few stores in the Philippines to become a type of mobile bank, go nowhere near to showing that MONEY HUB has become customary in the current language or in the bona fide and established practices in any trade and certainly not in the trade in computer software and particularly not in the UK at the relevant date or indeed any other date. The objection under section 3(1)(d) fails.

#### **The objections under sections 3(1)(b) and (c) of the Act**

17. The applicant’s objections under sections 3(1)(b) and (c) are both based upon claims that the mark is descriptive of a characteristic of the goods. As there is no other argument put forward as to why the mark falls foul of section 3(1)(b), it follows that both grounds will stand or fall together (see the comments of Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*). Accordingly, there is no need to consider the section 3(1)(b) ground independently of the section 3(1)(c) ground.

18. The case law under section 3(1)(c) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1) (c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C191/01P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1) (c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1) (c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1) (c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to

believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

19. The matter must be assessed from the perspective of the relevant consumer of the goods at issue. As set out above, the specification of goods covers computer software at large as well as more specific financial and accounting software. Whilst all of this may be used by both the general public and businesses, for the more specific software the relevant consumer is much more likely to be a business primarily those in the accounting and financial management fields.

20. The applicant asserts that the “words MONEY HUB immediately inform consumers that the product provided is a hub, or centralized exchange (effected by computer software) relating to money”. Ms Bass has filed extracts from various dictionaries to show the meanings of the words MONEY and HUB. There can be no doubt that the very well-known word MONEY will be meaningful in relation to financial and accounting software. Definitions exhibited by Ms Bass for the word HUB show it as being meaningful in relation to computers: *a device for connecting computers in a network (Collins English Dictionary)* and *a device that allows multiple computers to communicate with each other over a network (techterms.com)*, however, this clearly refers to a piece of hardware whilst the goods at issue here is software.

21. Extracts from various dictionaries exhibited by Ms Bass show that HUB is also defined as meaning *the central or main part of something where there is most activity (Cambridge Dictionary online)* or *the focal point (of activity) (Collins English*

*Dictionary (Penguin English Dictionary)*. The registered proprietor criticises this evidence as being:

“selected (cherry-picked) from a range of definitions without any indication of this being the case (such as ellipses)” which “provides an unbalanced reflection of the meaning attributed to [both words]”

and goes on to submit that:

“it is clear that the word [HUB] does not mean “software”, [and] none list “software” as meaning hub”.

22. Ms Bass also exhibits examples of what she refers to as “instances where the word “HUB” has been used, alone or in combination with other words, in relation to software”. This consists of:

- CJC26: an extract from the Scottish Development International website published on 24 September 2015 entitled “Scotland suits software projects”. The article begins: “From the Edinburgh technology hub to the nationwide superfast broadband roll-out, Scotland is the perfect place for successful software and digital technology companies” and continues: “The emergence of the technology hub in Edinburgh has coincided with a boom in new innovative start up businesses ...Scottish software and digital technology companies number well over a thousand...”;
- CJC27: an extract from *The Scotsman* published on 21 August 2015 entitled “Software consultancy Scott Logic launches online hub”. The extract has been poorly printed as the text is incomplete but it describes how the firm has “launched a new online portal [in which] Knowledge: Unleashed is a dedicated hub within the firm’s main site...and provides insight into the latest industry musings of senior staff and other thought leaders”;

- CJCB28: said to be an extract from the LSE online blog dated 24 March 2016. It is entitled “Why we need a hub for software in science” and goes on to refer to “...building a hub for research software”, “a new research hub” called Depsy and how “if you’re a department head and a visit to our hub confirms that one of your researchers is in fact a leading expert for novel sequence alignment software...” and concludes “the existence of a hub for software in science is held back by the same issues that plague research software itself...”;
- CJCB29: an article from *walesonline* dated 17 November 2014 entitled “DVLA puts faith in Swansea Tech Hub, home to some of the most talented software developers in the world” and describes how the organisation “hopes to tap into their “cutting edge skills” by partnering with TechHub Swansea –a networking community of technology and software firms...”;
- CJCB30: An article downloaded on 24 March 2016 from the [laceproject.eu](http://laceproject.eu) website entitled “Degreed software-as-a-service (SaaS) learning solution. I can see no reference to a “hub” within the article though the words LACE Evidence Hub appear at the top of the page and have, underneath them, the words Learning Analytics Community Exchange”. The remaining pages within this exhibit refer to the “LACE Evidence Hub [bringing] together evidences about the effect of learning analytics from across the world...” and it being “a place for recording, organising and searching evidence relating to the theory, research and practice of learning analytics” and how it “seeks to bring together evidence from across the globe to support or contest the effectiveness of learning analytics”;
- CJCB31: pages downloaded on 24 March 2016 from the [itv.com](http://itv.com) website which refers to the ITV Hub (formerly ITV Player) which is described as being “just like telly, but a bit better” and allowing a viewer to access “shows from any of our family of channels”;

- CJCB32: printouts from the Genneworld.com website dated 4 February 2016. It advertises the company's new "interactive education software" which it calls Learn Hub;
- CJCB33: printouts from the Microsoft.com website downloaded on 29 March 2016 which describe the "Microsoft Surface Hub" as a "team collaboration device" which allows you to "walk up and join a Skype for Business meeting with a single tap".

23. The registered proprietor submits that through its evidence the applicant has "failed to assess descriptiveness" of the word HUB and that it has not been able "to identify any characteristic of software which corresponds with a definition" of the word. It submits that the:

"very specific and technical meaning in relation to networks and communications (which, whilst separate, have a degree of overlap)...would only be known to those who are specialists in the communications sector and it would be erroneous to attribute the knowledge of these definitions to either the general public at large or professionals in the financial sector".

It further submits that:

"i: it is not clear what a "hub" or "centralised exchange" means in reality (for example, we would submit it would not be possible to obtain a registration for a "hub" in Class 09 or a "centralised exchange" in Class 09 as these terms are too vague and unspecific for classification purposes;

ii: in any event, the Registration has not been protected for a "hub" or "centralised exchange", it has been protected for "software";

iii: the Registration has not been protected for software which enables financial exchanges or transactions, it has been protected for software at large and software for financial planning and management; and

iv: the need to put “effected by computer software” in brackets shows that [the applicant] is trying to stretch its argument to try and arrive at the alleged descriptive meaning.

It concludes that “the name “hub” is not used in everyday parlance interchangeably with “software”.

24. I note that all of the material exhibited by Ms Bass set out above post-dates the relevant date in these proceedings. That said, whilst some of the articles refer to companies or other organisations creating or using a hub, this is mainly in the context of it being an internet portal for users (some of which are software creators or users) to come together in the virtual world to store or access material. Other material refer to companies in the technology field being co-located. I do not consider that any of this material shows that the word HUB is descriptive of software. The material at CJC32, however, does show use of the word HUB in relation to software itself. It is used in the format “Learn Hub” which is said to be software which “provides a selection of adaptive multiuser activities including Word Search, Quiz, Matching Activities, Multiplication, Subtraction, Addition, and Number Grids”. The exhibit shows that a range of tools allowing for “Education through Gamification” is available to customers through the company’s software. In my view the use of the term “Learn Hub” in this exhibit is use in a trade mark sense. I consider the mark used is an unusual combination of words and is allusive but is not descriptive of the goods.

25. In my view, that is also the case here. The mark MONEY HUB is allusive, and perhaps highly so, but is not descriptive in relation to the goods at issue which is software, even where the software is for e.g. financial management. That being so, the objections brought on grounds under section 3(1)(b) and (c) of the Act fail.

26. Earlier in this decision, I referred to the applicant’s submissions filed in lieu of attendance at a hearing and indicated that they could be interpreted as introducing a separate claim under section 3(1)(b) on the basis that the mark has no distinctive

character. In case I am found to be wrong in rejecting this argument for the reasons I have given above, I intend to consider them, briefly, here.

27. The principles to be applied under Article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation and is identical to Article 3(1)(b) of the Trade Marks Directive and section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case

C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

28. The factors I have identified above as contributing to the unusualness of the applicant's trade mark are also sufficient, just, to enable the average consumer to identify the origin of the goods at issue here and to distinguish them from those of other undertakings. As a consequence, any application for invalidation of the registration based upon a claim that the mark lacks the necessary distinctiveness under 3(1)(b) would also fail.

29. Whilst my finding means it is not necessary for me to consider the registered proprietor's alternative claim that the mark has acquired distinctiveness through its use, had I done so, it would have failed. This is because there is no evidence of any use of the mark by the registered proprietor or with its consent. The only evidence filed is an extract dated 12 February 2014 taken from the "Finovate" blog which mentions an award being given to "YourWealth for its MoneyHub technology".

## **Summary**

30. The application for cancellation has failed on each of the grounds on which it was brought.

## **Costs**

31. Whilst the registered proprietor seeks costs off the scale because of what it describes as the applicant's unreasonable behaviour in filing submissions late, I have not found its behaviour to have been unreasonable and can see no reason to depart from the normal scale of costs. I make the award on the following basis:

For preparing a statement and considering the other party's statement:	£300
For preparing evidence and considering that of the other party:	£500
For preparing written submissions:	£300
<b>Total:</b>	<b>£1100</b>

32. I order Transfer to Mobile Financial Services Limited to pay Momentum Financial Technology Limited the sum of £1100 as a contribution to its costs. This sum is to be paid within fourteen days of the expiry of appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 22nd day of November 2016**

**Ann Corbett (Mrs)**  
**For the registrar**  
**The Comptroller-General**