

O/833/22

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3569442
BY JONES AMEGBOR**

TO REGISTER:

WiseApp

WISEAPP

AS A SERIES OF TWO TRADE MARKS IN CLASS 36

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 424673 BY
WISE PAYMENTS LIMITED**

BACKGROUND AND PLEADINGS

1. Jones Amegbor (“the applicant”) applied to register the series of two trade marks shown on the cover of this decision for protection in the United Kingdom on 17 December 2020. The application was accepted and published on 26 February 2021 in respect of the following services:

Class 36

Banking; e-money services; processing of payments; bill payments; other payment services; money remittance; money transfers; payment card issuance; life insurance services; pension services; financial advisory services; brokerage services excluding general insurance; accounting and audit services.

2. On 23 April 2021, the application was opposed by TransferWise Ltd, which on 25 June 2021 changed its name to Wise Payments Limited (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and concerns all the services in the application.

3. Under section 5(2)(b), the opponent is relying on the following marks:

Mark	Services relied upon
UKTM No. 3346396  Application date: 17 October 2018 Registration date: 1 March 2019	<u>Class 36</u> <i>Financial affairs; monetary affairs; monetary affairs including those relating to the transfer of funds and providing methods of payment including providing pre-paid methods of payment and monetary credit for others; banking; financial services including foreign currency trading, exchange, payments, conversions, accounts and transfers; electronic money transfers; electronic foreign currency payment processing; electronic money services; electronic money transfer of foreign currency; financial transactions; financial transactions including effectuating the transfer of funds and banking services and facilitating transactions involving electronically stored</i>

Mark	Services relied upon
	<i>monetary value; financial services including internet accounts and banking; financial services including on-line cash accounts, banking and providing pre-paid methods of payment and monetary credit for others; checking and savings account services for foreign currency accounts; the provision of information, consultancy and advice relating to the aforesaid.</i>
UKTM No. 3346401 TRANSFERWISE Application date: 17 October 2018 Registration date: 5 April 2019	As above.

4. The opponent claims that the marks are highly similar and that the services covered by the marks are identical. Consequently, it claims that there exists a strong likelihood of confusion on the part of the relevant public in the UK.

5. Under section 5(3), the opponent is relying on UKTM No. 3346401. It claims that this mark has a reputation for *Financial services* and that the relevant public would make a link between the applicant's services and those of the opponent. As a result, the applicant would gain an unfair advantage because the reputation of the earlier mark would accrue to its business and unfairly increase the marketability of the services to be offered under the contested mark. Alternatively, use of the contested mark would cause detriment to the distinctive character and/or repute of the earlier mark.

6. The applicant filed a defence and counterstatement denying the claims made. In particular, he argues that the marks are sufficiently different and that this position is consistent with the view taken by the Examiner who reviewed the application under the Right Start process. He also denies that the services are identical or similar but does not deny that UKTM No. 3346401 had a reputation.

Evidence and Submissions

7. The opponent filed evidence in the form of a witness statement from Andrea Gildea dated 6 January 2022. It is accompanied by 24 exhibits. Ms Gildea is Head of Legal and has been employed by the opponent since March 2017. Her witness statement goes to the history of the opponent, its turnover and customer base, and marketing and promotional activity. It also includes legal submissions, which I shall not treat as evidence.

8. The applicant has filed no evidence but made written submissions on 7 March 2022. In response to these submissions, the opponent filed evidence in reply in the form of a witness statement from Charlene Louise Nelson, a Chartered Trade Mark Attorney at the opponent's representatives, Foot Anstey LLP. This is state of the register evidence.

9. Neither side requested a hearing or filed written submissions in lieu of attendance.

10. As noted above, the opponent is represented by Foot Anstey LLP, while the applicant is a litigant in person.

Preliminary Issues

11. I shall address the applicant's reference to the Right Start trade mark examination process first. This process enables an applicant to check that their application meets the requirements for registration before paying the full fee, which is necessary if the applicant wishes to proceed. The grounds on which trade marks are examined do not include what are called "relative grounds", i.e. potential conflicts with earlier rights. Earlier rights holders may be informed that the marks appear to be similar, but the application will be registered unless there is a successful opposition. The fact that a trade mark examiner found that Mr Amegbor's application met the legal requirements for registration does not mean that the Registry considered that it is not similar to the opponent's mark. That is the question I must decide here.

12. The applicant has searched the Trade Mark Register and Companies House records for the word “WISE” and notes that, at the date of his submissions, there were 675 trade marks covering services in Class 36 co-existing with the opponent’s marks and over 8,000 businesses with this word in their names. These results do not help his case. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, the General Court (“GC”)¹ stated that:

“As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS (Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71).”²

13. The state of the register evidence filed by the opponent is equally of no assistance.

14. A similar argument can be made with respect to the business names. The fact that they are on the Register of Companies does not in itself prove that they are used in the market to identify goods and/or services as coming from a particular undertaking. There is also no information on the goods and/or services that may be supplied by them.

¹ 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 Trade Marks 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, although the UK has left the EU.

² Paragraph 73.

Section 5(2)(b)

15. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because –

...

(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.”

16. The registrations upon which the opponent relies qualify as earlier trade marks under section 6(1)(a) of the Act. The applicant requested that the opponent prove it has used UKTM No. 3346396. However, as both marks were registered within the five years before the date on which the application for the contested mark was made, they are not subject to proof of use provisions³ and the opponent is therefore entitled to rely on all the services for which the marks stand registered.

17. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

³ Section 6A of the Act

- 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater 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; and

k) 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.

Comparison of services

18. It is settled case law that I must make my comparison of the services on the basis of all relevant factors. These may include the nature of the services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Services are complementary when

“... 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 [or services] lies with the same undertaking.”⁴

19. The services to be compared are shown in the table below:

Earlier services	Contested services
<u><i>Class 36</i></u> <i>Financial affairs; monetary affairs; monetary affairs including those relating to the transfer of funds and providing methods of payment including providing pre-paid methods of payment and</i>	<u><i>Class 36</i></u> <i>Banking; e-money services; processing of payments; bill payments; other payment services; money remittance; money transfers; payment card issuance; life insurance services; pension services;</i>

⁴ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

Earlier services	Contested services
<i>monetary credit for others; banking; financial services including foreign currency trading, exchange, payments, conversions, accounts and transfers; electronic money transfers; electronic foreign currency payment processing; electronic money services; electronic money transfer of foreign currency; financial transactions; financial transactions including effectuating the transfer of funds and banking services and facilitating transactions involving electronically stored monetary value; financial services including internet accounts and banking; financial services including on-line cash accounts, banking and providing pre-paid methods of payment and monetary credit for others; checking and savings account services for foreign currency accounts; the provision of information, consultancy and advice related to the aforesaid.</i>	<i>financial advisory services; brokerage services excluding general insurance; accounting and audit services.</i>

20. The correct approach to the interpretation of terms in specifications was set out by Arnold LJ in *Sky Plc & Ors v Skykick UK Ltd & Anor*, [2020] EWHC 990 (Ch):

“...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.”⁵

21. The term *Banking* appears identically in both specifications.

22. I agree with the opponent that the applicant’s *E-money services* are identical to the opponent’s *Electronic money services*, as “E” would be understood as an abbreviation for “Electronic”.

23. The applicant’s *Money transfers* includes the opponent’s *Electronic money transfers*. Services may be considered as identical when they are included within a broader term in the other party’s specification: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29. Consequently, I find that these services are identical.

24. The opponent’s *Financial affairs* would, in my view, be interpreted as referring to services for managing money, carrying out financial transactions (such as payments) and individual financial services such as pensions and insurance. I therefore find that this would include the applicant’s *Processing of payments; bill payments; other payment services; money remittance; payment card issuance; life insurance services; pension services; brokerage services excluding general insurance*. The services are identical per *Meric*.

25. I find that the applicant’s *Financial advisory services* are identical to the opponent’s *Provision of information, consultancy and advice relating to [Financial affairs]*.

26. That leaves the applicant’s *Accounting and audit services*. These services are usually included in Class 35 of the Nice Classification but the High Court confirmed in *Multi-Access Limited v Guangzhou Wong Lo Kat Great Health Business Development Co Limited* [2019] EWHC 3357 (Ch) that the Registrar’s decision as to the classification of goods and services is final. Consequently, a registered trade mark should not be treated as not covering clearly described goods or services simply

⁵ Paragraph 56.

because the trade mark may have been registered in a class in which those goods or services are not, or are no longer, usually classified. *Accounting and audit services* are clearly described services that include assistance with day-to-day financial tasks such as bookkeeping, the preparation of business accounts, the checking of an entity's financial records. The purpose is therefore similar to the opponent's *The provision of information, consultancy and advice relating to [Financial affairs]*, as both concern looking after and dealing with capital. The users are likely to be the same and there are likely to be some shared trade channels as the same firms may provide accounting and audit services as well as advice on how to manage the financial affairs of clients. There may be some competition, but it will not in my view be significant. Overall, I find that the services are similar to a medium degree.

Average consumer and the purchasing process

27. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”⁶

28. The opponent submits that the average consumer of the services is a member of the general public or a business. I agree. The frequency of purchase is likely to vary. *Pension services*, for example, would be purchased infrequently as the consumer would be making a long-term investment, while *Money transfers* may be effected more often. However, I consider that, as the services are related to financial matters where trust is an important factor, the average consumer will pay a higher than average degree of attention when deciding which supplier to use. They are likely to see the

⁶ Paragraph 60.

marks used on websites and promotional literature, but may also receive word-of-mouth recommendations, including from brokers and other advisors. It is my view that both the visual and aural aspects of the mark will play a significant role in the purchasing process.

Comparison of marks

29. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”⁷

30. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

31. The respective marks are shown below:

⁷ Paragraph 34.

Earlier marks	Contested series of marks
UKTM No. 3346396:  UKTM No. 3346401: TRANSFERWISE	WiseApp WISEAPP

Comparison between the contested marks and UKTM No. 3346396

⁸ The word “APP” alludes to the way in which consumers would expect to access the services. The overall impression of the marks lies in the juxtaposition of the two words.

33. The earlier mark consists of the word “WISE” in title case, in white upon a dark blue background. To the left of the word is a small flag device in light blue. In *Migros-Genossenschafts-Bund v European Union Intellectual Property Office (EUIPO) (CReMESPRESSO)*, Case T-68/17, the GC said:

⁸ Paragraph 51.

“... it should first of all be noted that, according to well-established case-law, in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements (see, to that effect, judgment of 6 December 2013, *Premiere Polish v OHIM – Donau Kanol (ECOFORCE)*, T-361/12, not published, EU:T:2013:630, paragraph 32 and the case-law cited).”⁹

34. I consider that the word “WISE” makes the greatest contribution to the overall impression of the mark, with the flag playing a minor role. Furthermore, “WISE” has an independent distinctive role in the mark. The dark blue background also plays a minor role in the overall impression of the mark, given the relatively small size of the verbal and figurative elements within the mark as a whole.

35. As the contested marks are word marks, they cover the words in any colour, so may be used in white on a dark blue background, and in the same font as the earlier mark: see *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39. As I have noted, though, the proportions of the earlier mark play a role in its overall impression. The verbal element of the earlier mark is wholly included at the beginning of the contested marks. Taking the marks as wholes, I find that they are visually similar to a low to medium degree.

36. The word “WISE” is the only element of the earlier mark that can be articulated and it will be pronounced as the standard English word. The contested mark will be pronounced as “WISE-AP”, with two syllables, the first of which is identical to the earlier mark. I find that the marks are aurally similar to at least a medium degree.

37. A person who is wise is someone who is prudent, well-informed and sensible. Both parties’ marks will bring this characteristic to the mind of the average consumer. Each party’s marks contain some additional conceptual content (a flag or an app) that is not

⁹ Paragraph 52.

shared by the other. I find the marks to be conceptually similar to at least a medium degree.

Comparison between the contested marks and UKTM No. 3346401

38. UKTM No. 3346401 is a word mark and, in my view, despite being conjoined, the average consumer would identify the two words “TRANSFER” and “WISE”. I note that “TRANSFER” is descriptive of at least some of the services covered by the mark, such as *Electronic money transfers*. The overall impression of the mark lies in the juxtaposition of these two words.

39. Both parties’ marks share the word “WISE”, albeit in different positions within the marks. The contested marks are seven letters long, while the earlier mark is twelve letters long. I find that they are visually similar to a low degree.

40. The earlier mark has three syllables, the last of which is the same as the first of the contested marks. I find that they are aurally similar to a low degree.

41. The juxtaposition of the two words in the earlier mark will bring to the mind of the average consumer a wise transfer of funds or other assets. This is a more specific concept than the general characteristic of wisdom that was conveyed by the other earlier mark. I find that the marks are conceptually similar to between a low and a medium degree.

42. I found that there is a greater degree of visual and aural similarity between the contested marks and UKTM No. 3346396. As both earlier marks have identical specifications, I shall continue my assessment of the section 5(2)(b) ground on the basis of UKTM No. 3346396 and return to UKTM No. 3346401 if required.

Distinctive character of the earlier mark

43. 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 *Windsurfing Chiemsee v Huber and Alternberger* [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).”

44. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

45. The opponent does not claim to have used UKTM No. 3346396 before the relevant date. At that point, it supplied its services under the other earlier mark, changing its name to WISE after the relevant date. Therefore, I have only the inherent position to consider. The word “WISE” is a commonly used word in the English language. It is mildly allusive of a quality possessed by users of the services and so would have a relatively low degree of inherent distinctiveness. However, the addition of the figurative element and the small size of the verbal and figurative elements relative to the mark as a whole raise that level to medium.

Conclusions on likelihood of confusion

46. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services or vice versa. I keep in mind 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 they have in their mind.

47. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Iain Purvis QC, sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.’

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark

at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

48. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."¹⁰

49. He also said:

"As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."¹¹

¹⁰ Paragraph 12.

¹¹ Paragraph 13.

50. Earlier in my decision, I found that all the contested services were identical to the opponent's services, apart from *Accounting and audit services*, which I found to be similar to a medium degree to *The provision of information, consultancy and advice relating to [Financial affairs]*. I found that the marks were visually similar to a low to medium degree and aurally and conceptually similar to at least a medium degree. I also found that the average consumer would pay a higher than average degree of attention. For this reason, I consider it unlikely that they would mistake one mark for another, given the differences that exist between them, notwithstanding the shared element "WISE". I find there to be no likelihood of direct confusion.

51. I turn now to indirect confusion. In my view, the average consumer would interpret the "APP" part of the contested marks as the means by which the services are accessed. They are likely not to recall that the earlier mark contains a flag device or the relative proportions of the elements of the mark, and I have already found that the verbal element of the mark will be more memorable. Even if they do recall the flag, the verbal element plays an independent distinctive role in the mark. While I found that "WISE" had a relatively low degree of inherent distinctive character for the services at issue, this does not automatically mean that there cannot be a likelihood of confusion: see *L'Oréal v OHIM*, Case C-235/05 P, paragraph 45. I consider that the average consumer will assume that the contested marks are used for the opponent's services in the form of an app. There is a likelihood of indirect confusion and the opposition is successful under section 5(2)(b) in respect of all of the applicant's services.

Section 5(3)

52. As the opposition has been wholly successful under section 5(2)(b), the section 5(3) ground puts the opponent in no better a position. However, for completeness, I will consider whether the opposition would succeed under this ground.

53. Section 5(3) of the Act is as follows:

"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 European Union trade mark or international trade mark (EU) in the European Union) 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.”

54. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L’Oréal SA & Ors v Bellure & Ors* (Case C-487/07) and *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09). 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 Salomon*, 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 and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that

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 and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the 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'Oréal*, 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

Reputation

55. The applicant did not deny that UKTM No. 3346401 had a reputation. Indeed, in his submissions he says that *“The scope of protection afforded to the Opponent’s mark should, therefore, be effectively limited to its reputation for TRANSFERWISE”*.¹² However, as the opponent has made no claims as to the strength of the reputation and this is a relevant factor when I come to consider whether there is a link between the marks in the mind of the public, I shall examine the evidence.

56. In *General Motors*, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the

¹² Response to Point 3.

absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

57. The opponent claims that UKTM No. 3346401, **TRANSFERWISE**, has a reputation for *Financial services*. The relevant date on which reputation must be shown is the date of application for the contested series of marks: 17 December 2020.

58. The opponent was founded in 2011 and traded under UKTM No. 3346401 until shortly after the relevant date, when it changed its name to WISE. In its first few years, its business was focused on an innovative way of conducting currency exchange and international money transfers that reduced the costs incurred by customers. Further services were launched in 2017 (a Borderless account that could hold multiple currencies and support direct debits and international payments) and 2018 (a debit card allowing customers to spend money in their Borderless account in any currency).

59. The following table shows the growth in the worldwide volume of transactions per month:¹³

Year ending 31 March	Worldwide (per month)
2020	£4 billion
2019	£4 billion
2018	£2 billion
2017	£1 billion
2016	£800 million
2015	£500 million

60. Global turnover is shown in the table below:¹⁴

¹³ Witness statement of Andrea Gildea, paragraph 32.

¹⁴ Witness statement, paragraph 25.

Year ending 31 March	Worldwide (£millions)
2021	421
2020	302.6
2019	177.9
2018	117
2017	66
2016	27
2015	9

61. UK turnover figures are also given for the last three financial years: £51.0 million (2019), £72.7 million (2020) and £95.8 million (2021).¹⁵ These represent 28%, 24% and 22% respectively of global turnover.

62. Ms Gildea states that the opponent has a 36.6% market share for international money transfers in the UK and refers me to two articles on this subject in Exhibit AG8A, one dated 2018 and the other 2020. Both appear to refer to the same study conducted by mobile data platform Ogury in 2017 into users' engagement with mobile banking and financial applications. The second article explains:

"Ogury's study revealed that 8.8% of the 1,265,000 mobile users analysed downloaded at least one retail bank or FinTech app during the third quarter of 2017, ended September.

Within this, the key names remain dominant, with TransferWise maintaining a 36.6% share in the international money transfer market in the UK, whilst PayPal retains its place as the top owned FinTech-based app in the UK, appearing on 31.2% of devices."¹⁶

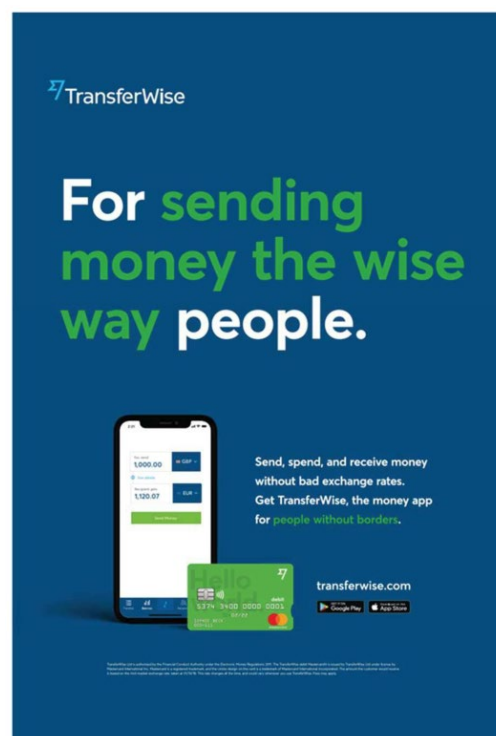
63. I take from this that 36.6% of the UK mobile users analysed in the survey who had downloaded an app for international money transfers had downloaded the opponent's

¹⁵ Witness statement, paragraph 26. Nearly 9 months of the financial year ending 31 March 2021 fall before the relevant date.

¹⁶ Exhibit AG8A, pages 94-95.

app. It does not say that the opponent had 36.6% of the whole UK market for international money transfers, as downloading an app is not the same as using it.

64. Before the opponent changed its name, the TRANSFERWISE mark was used on its app and its website alongside the flag device that appeared in the other earlier mark the opponent relied on under section 5(2)(b).¹⁷ The mark would also have been seen on advertising and other promotional materials. Ms Gildea states that the opponent spent £12.3 million on advertising for the financial year ending 2016 and £9.37 million for 2015. She adds that more recent figures are confidential.¹⁸ A TV advertisement was aired in 2015, but no information is given on how widely this might have been viewed. Social media channels were also used to advertise the opponent's services, but, while Ms Gildea has provided me with details of the numbers of followers for 2018, 2019 and 2020, she does not state how many of these were based in the UK, and so it is difficult to draw any conclusions from those particular campaigns. More helpful to the opponent are the advertisements that were placed on London Underground and London buses between 2015 and 2018. An example is shown below:¹⁹



¹⁷ Exhibit AG14, page 125.

¹⁸ Paragraph 42.

¹⁹ Exhibit AG17, page 162.

65. In addition, the opponent has undertaken a number of what Ms Gildea describes as “publicity stunts” in London between 2014 and 2020. These included the 2014 “Nothing to Hide” campaign, where more than 100 people stripped to their underwear and which was reported by UK media such as *The Mirror* and *The Evening Standard*, and a “Stop Hidden Fees” campaign outside the Houses of Parliament in 2016.²⁰

66. Exhibit AG20 contains a sample of ten articles from third-party publications and websites, including *Financial Times*, *The Telegraph*, *The Guardian* and BBC News. The earliest is dated 8 April 2017 and the latest 18 August 2020. The opponent has also received third-party recognition in the shape of awards, which are listed in paragraph 44 of Ms Gildea’s witness statement. These include UK-based awards, such as the UK Tech Awards (in which the opponent was named Company of the Year in 2019), and US, Australian, Estonian and global awards. Ms Gildea explains that the international nature of the fintech sector means that “*awards granted in non-UK countries will often have resonance in the marketplace here in the UK*”.²¹

67. The opponent claims that UKTM No. 3346401 has a reputation for *Financial services* and, as I have already noted, the applicant does not deny this. However, the evidence indicates that the focus of the opponent’s activities is international money transfers and the promotional activity that I have been shown is directed towards this service. I note that a large proportion of the promotional activity appears to be directed towards London. I believe that it is reasonable to take judicial notice of the fact that London has a large number of inhabitants and/or workers with international connections. I infer from this fact that a significant proportion of the public interested in international money transfers, would have had the opportunity to become aware of the opponent’s mark and so I find that it has a moderate reputation for *Electronic money transfers*. I find that the reputation of the mark for financial services as a whole is weaker.

²⁰ Paragraph 43.

²¹ Paragraph 44.

Link

68. In paragraph 42 of *Intel*, the CJEU set out the factors that are relevant to an assessment of whether the public would make a mental link between the marks. I consider each of them in turn.

The degree of similarity between the conflicting marks

69. Earlier in my decision, I found that the marks were visually and aurally similar to a low degree and conceptually similar to a medium to high degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

70. All the contested services are financial or monetary services or relate to the management of capital. *Money remittance* and *money transfers* are self-evidently identical to the services for which the opponent has a reputation, while *Banking*, *e-money services*, *processing of payments*, *bill payments*, *other payment services* could all include the opponent's services. Therefore, they are identical on the principle set out by the GC in *Meric*. *Life insurance services* and *pension services* are also included in the broader term *Financial services* and are therefore identical per *Meric*. *Financial advisory services* and *brokerage services excluding general insurance* may share the same trade channels and users as *Financial services*, and I consider that there is a degree of complementarity between them. I find that they are similar to a medium degree.

71 The remaining services are *accounting and auditing services*. These differ in purpose from the services for which the earlier mark has a reputation, although there are likely to be some shared trade channels and users. If there is any similarity, it is at a very low degree. I recall that it is not necessary under this ground for the services to be similar, but that it is still a relevant factor to keep in mind.

The strength of the earlier mark's reputation

72. I found that the earlier mark had a moderate reputation for *Electronic money transfers*. On the basis of the evidence, the reputation is one of transparency (“no hidden charges”) and speediness. The reputation for *Financial services* more generally is weaker.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

73. The earlier mark consists of a word that in the context of the services for which it has a moderate reputation is descriptive (“Transfer”) and one that is mildly allusive (“Wise”). The combination of these two results, in my mind, in a degree of inherent distinctiveness that is low to medium. When I turn to consider whether this distinctiveness has been enhanced through use, the relevant factors are those that I have discussed above in my assessment of reputation. On the basis of my findings there, I take the view that the distinctiveness of the mark has been enhanced to just above a medium degree.

Whether there is a likelihood of confusion

74. It will be recalled that I found a likelihood of confusion under section 5(2)(b). However, that was on the basis of a different mark. I do not consider that the average consumer would be directly confused between the marks, given the visual and aural differences between them. Neither do I find that there would be a likelihood of indirect confusion. The average consumer will notice the different position of the shared element “Wise” in the mark, and it is not such a distinctive term that the average consumer would assume that, in spite of the differences, the marks belong to the same or connected undertakings.

Would there be a link in the mind of the relevant public?

75. It is not fatal to the opponent's case that I have not found a likelihood of confusion. It is just one of several factors that I must take into account when considering whether

there will be a link. I also remind myself that the level of similarity of the marks required to make a link may be less than the level of similarity required to create a likelihood of confusion: see *Intra-Press SAS v OHIM*, Joined cases C-581/13 P and C-582/13 P, paragraph 72. However, it is my view that the differences between the marks are such that the applicant's mark will not bring the earlier mark to mind in any more than a manner that would be too weak to cause any damage to the earlier mark's reputation and distinctive character or give an unfair advantage to the later mark.

76. The section 5(3) ground fails.

Outcome

77. The opposition has been wholly successful under section 5(2)(b) and the application to register UKTM No. 3569442 is refused.

COSTS

78. The opponent has been wholly successful in these proceedings. It is therefore entitled to a contribution towards its costs, based on the scale published in the Tribunal Practice Notice 2/2016. I have taken into account the success under section 5(2)(b) and failure under section 5(3). The award does not include a contribution towards the costs of preparing the evidence. This is because the evidence all went to the section 5(3) ground, as no proof of use was necessary. I have also included the official fees that would have been due for the section 5(2)(b) ground alone. The award is as follows:

<i>Preparing a statement and considering the applicant's statement:</i>	<i>£250</i>
<i>Official fees :</i>	<i>£100</i>
<i>TOTAL</i>	<i>£350</i>

79. I therefore order Jones Amegbor to pay Wise Payments Limited the sum of £350. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of September 2022

**Clare Boucher,
For the Registrar,
Comptroller-General**