O/0229/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. WO0000001719030
BY HILLGREEN CAPITAL, LLC
TO REGISTER THE TRADE MARK:

GOOD MONEY

IN CLASS 33

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600002981
BY GOODMONEY CIC

BACKGROUND AND PLEADINGS

1. On 15 February 2023, Hillgreen Capital, LLC ("the holder") registered the International trade mark displayed on the cover of this decision, under trade mark number WO0000001719030 ("the IR"). With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The IR claims a priority date of 30 November 2022 from the U.S.[1] Registration is sought for the following goods:

   Class 33: Alcoholic beverages, except beers.[2]

2. On 28 July 2023, GOODMONEY CIC ("the opponent") filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all the goods of the application. The opponent relies upon its following series of marks to support its claim.

GOODMONEY

Goodmoney

GOODMONEY

UK trade mark number: 3276722
Filing date: 12 December 2017
Registration date: 06 April 2018
Goods and services relied upon:

Class 16:	Printed vouchers;
Class 35:	Advertising

[1] Priority claimed from Trademark No. 97698241
[2] Originally the holder had also registered the mark for "*Advertising, business management*" services in class 35. However, during the course of these proceedings the holder has chosen to amend its specification and remove those services.

Class 36: Issuing of payment gift cards[3]

("the first earlier mark")

3. Given the respective filing and priority dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. As it had been registered for more than five years at the date of the application, it is subject to the proof of use requirements specified within section 6A of the Act. However, the applicant did not request that the opponent prove use, as such, the opponent can rely on all of the goods and services identified.

4. Within its pleadings the opponent claims the holders trade mark would cause confusion given the nature of the goods and services as its gift vouchers can be redeemed with its businesses that sell food and drink, including non-alcoholic beverages.

5. The holder denies that the goods and services are similar, however, accepts that the competing marks are similar on the basis that they are the same save for a space between "GOOD" and "MONEY".[4]

6. The opponent represents itself; the holder is professionally represented by Joffe & Partners LLP.

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1 to 3 of rule 20 of the Trade Mark Rules 2008 but provides that rule 20(4) shall continue to apply. Rule 20(4) stipulates that:

> "the Registrar may, at any time, give leave to either party to file evidence upon such terms as the Registrar thinks fit".

The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. Neither party requested to file any evidence.

[3] Within its notice of opposition, the opponent identifies the services relied upon in class 36 as "Gift Cards", however, this exact term is not found within its class 36 specification. I note that within its counterstatement the holder has interpreted the opponent to be relying on its term "Issuing of payment gift cards" which I find to be a sensible interpretation and will proceed on this basis, particularly given that the opponent has not disputed this understanding within its written submissions.
[4] Holder's counterstatement paragraph 3.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary, but both parties filed written submissions in lieu.[5] This decision is taken following a careful perusal of the papers.

Relevance of EU law

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Preliminary issues

10. The opponent raises within its submissions:

> "Furthermore, the proposed trademark is using the name Good Money not to communicate ethics, but as a synonym for 'lots of money'. I feel this is a crass and ostentatious use of the name Good Money and not something we want our business to have any connection or association with."[6]

However, this is not a consideration for the purpose of section 5(2)(b) grounds, which purely considers whether a likelihood of confusion arises between the marks.

[5] However, I note that the holder's submissions were merely a repeat of its amended defence.
[6] The opponent's written submissions in the form of an email dated 12 September 2024.

DECISION

Legislation

11. Sections 5(2)(b) and 5A of the Act read as follows:

> "5(2) 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".
>
> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Case law

12. I am guided by the following principles which are 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 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:

> (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 the goods and services

13. All relevant factors relating to the goods and services should be taken into account, which include, inter alia:[7]

• the physical nature of the goods and services;

• their intended purpose;

• their method of use / uses;

• who the users of the goods and services are;

• the trade channels through which the goods and services reach the market;

• in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

• whether they are in competition with each other (taking into account how those in trade classify the goods and/or services, for instance whether market research companies put them in the same or different sectors)

or

• whether they are complementary to each other. Complementary signifying that "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 and/or services lies with the

[7] See Canon, Case C-39/97, paragraph 23; and British Sugar PLC v James Robertson & Sons Ltd., [1996] R.P.C. 281 – the "Treat" case.

same undertaking".[8] Noting that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[9]

14. When interpreting the terms in a specification, I bear in mind that it is necessary to focus on the core of what is being described and that trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. Nevertheless, the principle should not be taken too far and where words or phrases in their ordinary and natural meaning are apt to cover the category of goods or services 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.[10]

15. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

> "365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

16. The competing goods and services are found in paragraphs 1 and 2 of this decision, however, for ease I have replicated them within the table below:

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[8] *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82, see also *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL O/255/13
[9] *Kurt Hesse v OHIM*, Case C-50/15 P, se also *Sanco SA v OHIM*, Case T-249/11
[10] *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

Holder's goods	Opponent's goods and services
Class 33: Alcoholic beverages, except beers	Class 16: Printed vouchers Class 35: Advertising Class 36: Issuing of payment gift cards

17. I acknowledge that the opponent pleads:

> "The trademark that we are opposing is also applying for Class 33 Alcoholic Beverages excluding beer. Our gift vouchers can be redeemed with businesses that sell food and drink including non-beer alcoholic beverages. We are concerned that the proposed trademark would cause confusion with the current and future advertising we do on behalf of independent wine merchants, vineyards, gin producers etc. In addition since vouchers are such an integral aspect of advertising in the beverage industry we feel there is a lot of crossover between Classes 16, 35 and 36."[11]

18. Taking the holder's class 33 goods, *Alcoholic beverages, except beers,* against the opponent's class 16 goods, *Printed vouchers,* I acknowledge the holder's response within its defence/counterstatement:

> "It is denied that "Alcoholic beverages, except beers" under Class 33 is similar to any of the goods for which the Earlier Mark is registered in Class 16, namely "Gift cards; Printed vouchers". In particular, it is denied that these goods are similar in nature, originate from the same source and/or are offered through similar trade channels to the same end users for the same use. Indeed, alcoholic beverages do not bare any resemblance to, nor have any association with printed vouchers."[12]

19. Having considered both parties submissions and the caselaw above which I am guided by, I find that the competing goods are dissimilar. This is because the goods differ in nature, method of use and intended purpose. The holder's goods are alcoholic drinks that will include drinks such as wines, spirits and champagne.

[11] Opponent's amended TM7F, Q16
[12] The applicant's defence, paragraph 4

These are consumable liquids that will be drank for taste and enjoyment. Whereas the opponent's goods are printed vouchers that are used by consumers to redeem against goods and services. Although I accept that vouchers may be redeemable for goods such as wines or spirits, this does not result in a finding of complementarity as whilst users can use vouchers to purchase wines or spirits it is not strictly necessary, as users can purchase these goods by alternative payment methods. Furthermore, the vouchers can be used to pay for a wide range of other goods not merely wines and spirits. The trade channels are also unlikely to overlap as whilst retail stores that offer wines may also offer gift vouchers for their own wines, they do not typically offer vouchers that are redeemable against a number of other goods. Equally, businesses offering gift vouchers for a variety of other companies' goods, do not tend to sell those goods themselves. The goods are not in competition as you cannot drink gift vouchers instead of wine and vice versa wine cannot be provided in substitute of gift vouchers. Whilst users may overlap this will be to such a general degree that it fails to engage similarity. Consequently, as discussed above, these goods are not similar.

20. As for the opponent's services against the applied for goods in class 33, I note the holder's submissions:

> "It is further denied that the services relied upon for the opposition on for which the Earlier Mark is registered under Classes 35 and 36 and the goods under Class 33 for which the Trade Mark is to be registered are complementary, in the sense of one being essential or important for the use of the other. Advertising and/or issuing gift cards are not essential nor required [for] alcoholic beverages and vice versa."[13]

21. Turning to the class 36 services *Issuing of payment gift cards,* I understand these services to include issuing of gift cards that the recipient can then use to purchase or take money off a wide range of gifts and services covered under the terms of the gift card, and as such I acknowledge that the opponent's submissions in relation to gift vouchers applies equally to its class 36 services. However, I do not

[13] Ibid, paragraph 6

accept that just because the class 36 services can be used to redeem goods such as the holder's goods in class 33 there is similarity between these goods and services. If this was the case, it would mean that any goods and services potentially redeemable under the class 36 services would be similar, given the range of goods and services that this could potentially cover, to reach this conclusion would offer too wide a scope of protection. With regards to complementarity, the same principle as discussed above (at paragraph 20) in relation to the class 16 goods applies equally to these services, that is, even though the services can be used to buy goods in class 33, the services are not essential to the purchase of alcoholic beverages such as wine and as such there is no complementarity. Further, companies offering the class 36 services do not typically also provide the goods for which the vouchers are redeemable, resulting in different trade channels. Neither are the goods and services competitive as you cannot use alcoholic beverages to replace the issuing of payment gift card services and vice versa. Moreover, goods and services clearly differ in nature, method of use and intended purpose. Whilst some users may overlap as members of the general public may choose to purchase the services and the goods, this will be to such a broad extent that it will not engage similarity. Consequently, the goods and services in class 36 are not similar.

22. Finally, in relation to similarity with the class 35 services, *advertising* services are taken in the context of advertising services that are offered to third parties, rather than the advertising that would be done as part of one's own business. As a result, it follows that there is no similarity between the opponents *advertising* services and the holder's *alcoholic beverages, except beers* in class 33. They differ in nature, method of use and intended purpose as one is an alcoholic drink which is drank for the purpose of enjoyment, whilst the other is clearly advertising services which are typically used by businesses for the purpose of publicising and promoting goods and/or services. The trade channels will differ as they will typically be offered by different companies. They are not complementary as whilst advertising can be for the purpose of advertising alcoholic beverages, the goods and services are not essential to one another. Further, consumers will not reasonably believe that the goods and services derive from the same undertaking. Users are also unlikely to overlap as users for alcoholic beverages

are more likely to be the general public, whereas users of advertising services are more likely to be businesses.

23. As some level of similarity is required between the competing goods and services in order for there to be a likelihood of confusion,[14] the opposition fails under section 5(2)(b) of the Act.

CONCLUSION

24. The opposition under section 5(2)(b) of the Act has failed in its entirety. Subject to any successful appeal, the application will proceed to registration.

COSTS

25. As the holder has been successful, it is entitled to a contribution towards its costs. The relevant scale is that published in Tribunal Practice Notice 1 of 2023 at paragraph 13.[15] In the circumstances, I award the holder the sum of **£250** for considering a notice of opposition and filing a counterstatement. [16]

26. Accordingly, I hereby order GOODMONEY CIC to pay Hillgreen Capital, LLC. the sum of **£250**. This sum is to be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of March 2025

Sarah Wallace
For the Registrar

[14] *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA
[15] As the opposition was brought after 1 February 2023.
[16] No award has been made for filing written submissions as it is observed that a copy of the amended defence was filed in place of written submissions in lieu. Further, the original defence filed on 7 May 2024 and the amended defence file on 24 July 2024 are not drastically different as to warrant costs.