

BLO/0415/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003650110
BY EASYGO SOLUTIONS PTY LTD AND BIJAN TEHRANI
FOR THE FOLLOWING TRADE MARK:**

STAKE

Stake



(SERIES OF 3)

IN CLASSES 9, 35, 36, 38 AND 41

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 505754
BY STAKESHOP PTY LTD**

BACKGROUND AND PLEADINGS

1. Medium Rare Limited (“the old proprietor”) applied to register the series of three trade marks shown on the cover page of this decision (“the Contested Marks”) in the UK on 2 June 2021. It was registered on 22 October 2021 for the following goods and services:

Class 9 Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; Recorded and downloadable media, computer software, blank digital or analogue recording and storage media; Computers and computer peripheral devices; Software and applications for mobile devices; Downloadable software in the nature of a mobile application; Application software; Application software for smart phones; Computer application software; Computer software applications, downloadable; Computer game software for use on mobile and cellular phones; mobile apps and software for gambling and gaming; Gaming software; Entertainment software; Interactive entertainment software; Computer game software; Computer software for entertainment; Sports betting applications; Betting software; Gambling software; Computer game software for use with on-line interactive games; Software for processing images, graphics and text; Software for processing digital images; Online payment software; Software for arranging online transactions; Payment software; E-payment software; parts and fittings for all the aforesaid goods.

Class 35 Advertising; Business management; Business administration; Office functions; Promotion of goods and services through sponsorship; Promotion of goods and services through sponsorship of sports events; Promotion of goods and services through sponsorship of international sports events; Advertising, including promotion of products and services of third parties through sponsoring arrangements and licence agreements relating to international sports' events; Promotion services relating to esports events; Advertising services relating to esports

events; information, advisory and consultancy services relating to the aforesaid services.

Class 36 Insurance; Financial affairs; Monetary affairs; Real estate affairs; Financial sponsorship of sports events; Financial sponsorship of sporting activities; Online financial transactions; Services for debiting and crediting financial accounts; Payment card services; Payment processing services; Electronic payment services; Payment transaction card services; Processing of payments for banks; Collection of payments for goods and services; Electronic processing of payments via a global computer network; Bank card, credit card, debit card and electronic payment card services; Processing payments for the purchase of goods and services via an electronic communications network; information, advisory and consultancy services relating to the aforesaid services.

Class 38 Telecommunications; Broadcasting of esports events; Streaming of esports events; Access to content, websites and portals; providing multiple-user access to a global computer information network; provision of access to gaming and gambling websites via the internet; chatroom services; on-line communication services; data communication services by electronic means; data communication services accessible by password; data transmission for others; automatic transfer of digital data using telecommunications channels; electronic transmission and retransmission of sounds, images, documents, messages and data; secured data, sound and image transmission services; communication services, namely, electronic transmission of data and documents among users of computers; information, advisory and consultancy services relating to the aforesaid services.

Class 41 Education; Providing of training; Entertainment; Sporting and cultural activities; Online gaming services; Online casino services; Online sports betting services; Online gambling services; Betting services; Sports betting services; Lottery services; Online interactive entertainment; Online entertainment services; Providing online video games; Online

computer game services; Provision of online computer games; Online game services through mobile devices; Information relating to computer gaming entertainment provided online from a computer database or a global communication network; Providing esports facilities; Entertainment services relating to esports; Provision of information relating to esports; Sports information services; Sports entertainment services; Entertainment in the nature of football games; Entertainment in the nature of soccer games; Conducting of live sports events; Organising of football events; Sporting services; Providing sports news; Sporting results services; Education, entertainment and sports; Education, entertainment and sport services; Providing information about sporting activities; Provision of information relating to sports; Provision of information relating to sporting events; Provision of information relating to entertainment online from a computer database of the Internet; organisation and conducting competitions; information, advisory and consultancy services relating to the aforesaid services.

2. On 23 January 2023, Stakeshop Pty Ltd (“the applicant”) applied to have the Contested Marks declared partially invalid under section 47 of the Trade Marks Act 1994 (“the Act”) based sections 5(2)(b) and 5(3) of the Act. However, the applicant withdrew its section 5(3) ground in writing on 10 May 2024, and the applicant also withdrew its invalidation against classes 9, 35, 38 and 41 in writing on 23 May 2024.

3. On 4 June 2024, an amended Form TM26(i) was filed by the applicant. This confirmed that the invalidation was to proceed against the old proprietor’s following services:

Class 36 Insurance; Financial affairs; Monetary affairs; Real estate affairs; Online financial transactions; Services for debiting and crediting financial accounts; Payment card services; Payment processing services; Electronic payment services; Payment transaction card services; Processing of payments for banks; Collection of payments for goods and services; Electronic processing of payments via a global computer network; Bank card, credit card, debit card and electronic payment card

services; Processing payments for the purchase of goods and services via an electronic communications network; information, advisory and consultancy services relating to the aforesaid services.

4. However, on 6 January 2025, the applicant also withdrew its invalidation against the term “real estate affairs” in class 36,¹ and on 23 January 2025, the proprietor filed a Form TM23, whereby they partially surrendered the following services:

Class 36 Insurance; Financial affairs; Monetary affairs; Online financial transactions; Services for debiting and crediting financial accounts; Payment card services; Payment processing services; Electronic payment services; Payment transaction card services; Processing of payments for banks; Collection of payments for goods and services; Electronic processing of payments via a global computer network; Bank card, credit card, debit card and electronic payment card services; Processing payments for the purchase of goods and services via an electronic communications network; information, advisory and consultancy services relating to the aforesaid services.

5. I note that the above class 36 services are the only services remaining which are subject to the invalidation. However, as confirmed by the applicant’s email dated 29 January 2025, and at the hearing, the applicant wanted to pursue the invalidation against the class 36 services, notwithstanding the surrender of the registration. This was on the basis that the proprietor would still have protection of these services from its registration date, 22 October 2021, up until the surrender date of the registration, being 23 January 2025. However, if the invalidation proceedings are successful, then under section 47(6) of the Act, the registration is deemed never to have been made.² Therefore, the applicant highlights that the surrender of the services does not automatically dispose of the invalidation proceedings.

¹ This resulted in the following class 36 services not being subject to invalidation: *Real estate affairs; Financial sponsorship of sports events; Financial sponsorship of sporting activities.*

² This finding is supported by the reasoning of Mr Geoffrey Hobbs QC sitting as the AP in BL O/170/07, paragraph 29. This case was quoted in the decision BL O/146/20, which submitted before the Registry, by the applicant, maintaining their pursuit of the invalidation.

6. Under section 5(2)(b), the applicant relies upon the following trade mark:



UK registration no. UK00003693779

Filing date 13 September 2021.

Registration date 31 December 2021.

Priority date 15 March 2021.

Relying upon all of its services for which the earlier mark is registered, namely:

Class 36 Financial services; provision of information relating to financial services; securities trading services; securities trading services; commodities, gold, mercantile, monetary and security exchanges; financial exchange services; quotation of stock exchange prices; securities exchange services; stock exchange services; commodity trading (financial services); options trading; trading in bonds; trading in contracts on stocks; trading in currencies; trading in equities; trading in futures; trading in options; trading in securities; trading in stocks; trading of emission reduction credits; trading of shares; financial brokerage; financial fund management; financial investment; financial securities; financial securities; financial services; financial transaction services; agencies for the exchange of financial operations; brokerage services relating to financial instruments; computerised financial services; conducting of financial transactions; brokerage of securities; brokerage services for securities; brokerage services relating to the securities markets; recording the transfer of securities; securities brokerage; securities broking; exchange brokerage; share exchange schemes; stock exchange quotations; Superannuation services; Management of financial affairs; Management of investments; Management services relating to investments; Advisory services relating to financial

investment; Advisory services relating to financial matters; Advisory services relating to financial planning; Advisory services relating to money management; Financial advice; Financial planning; Financial portfolio management; Investment account services; Investment advice; Investment analysis; Investment business services; Management of financial assets; Management of funds; Monitoring of financial portfolios; Monitoring of pension funds; Pension advisory services; Pension and retirement and superannuation plans and funds; Pension fund financial management; Personal financial planning advisory services; Provision of financial information; Taxation financial planning services.

7. The applicant claims that there is a likelihood of confusion because the marks are highly similar and the services are similar.

8. The old proprietor filed a counterstatement denying the claims made.

9. A hearing took place before me on 5 February 2025. The applicant was represented by Ms Becky Knott of Hogarth Chambers instructed by CMS Cameron McKenna Nabarro Olswang LLP. Albeit not present at the hearing, the old proprietor was represented by Stobbs, who filed submissions in lieu of its attendance.³ I make this decision having taken full account of all the papers, referring to them below as necessary.

10. 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.

³ A significant proportion of the old proprietors submissions filed in lieu of attendance of the hearing focuses on the background of the proceedings, which I have summarised above, including the surrender of the class 36 services which are subject to invalidation. The submissions note that whilst the applicant is entitled to pursue the invalidation, "that there is no good reason for doing so given the practical effect" is the same. However, as noted above, the surrender does not dispose of these proceedings.

PRELIMINARY ISSUE

11. As noted above, I have made multiple references to the “old proprietor”, that being Medium Rare Limited. This is on the basis that on 10 February 2025, the Registry received a Form TM16 assigning the contested series of marks from Medium Rare Limited to Easygo Solutions Pty Ltd and Bijan Tehrani (“the proprietors”). This was confirmed in an official letter dated 18 February 2025.

12. On 2 March 2025, an official letter from the Registry asked the proprietors to confirm that they had sight of the forms filed, that they stand by the statements made in the counterstatement, and that they confirm where the name of the original proprietor appears, this should be read as though it was in their names. It also asked them to confirm that they accepted the liability for costs in the proceedings. On 17 March 2025, Stobbs confirmed via email that the new proprietors agreed to all of the above.

DECISION

13. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

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

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

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

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

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

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

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

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

(c) the use conditions are met.

(2B) The use conditions are met if –

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

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

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

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

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist 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.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(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.”

Section 5(2)(b)

14. Section 5(2)(b) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(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.”

15. Due to its earlier priority date, the trade mark upon which the applicant relies qualifies as an earlier trade mark pursuant to section 6 of the Act. The earlier mark has not completed its registration process more than five years before the relevant date (the filing date of the proprietors’ trade mark). Accordingly, the use provisions at section 47(2A) of the Act do not apply. The applicant may rely upon all of the services it has identified without demonstrating that it has used the mark.

Section 5(2)(b) - case law

16. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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 services

17. The competing services are as follows:

Applicant's services	Proprietors' services
<p><u>Class 36</u> Financial services; provision of information relating to financial services; securities trading services; securities trading services; commodities, gold, mercantile, monetary and security exchanges; financial exchange services; quotation of stock exchange prices; securities exchange services; stock exchange services; commodity trading (financial services); options trading; trading in bonds; trading in contracts on stocks; trading in currencies; trading in equities; trading in futures; trading in options; trading in securities; trading in stocks; trading of emission reduction credits; trading of shares; financial brokerage; financial fund management; financial investment; financial securities; financial securities; financial services; financial transaction services; agencies for the exchange of financial operations; brokerage services relating to financial instruments; computerised financial services; conducting of financial transactions; brokerage of securities; brokerage services for securities; brokerage services relating to the</p>	<p><u>Class 36</u> Insurance; Financial affairs; Monetary affairs; Online financial transactions; Services for debiting and crediting financial accounts; Payment card services; Payment processing services; Electronic payment services; Payment transaction card services; Processing of payments for banks; Collection of payments for goods and services; Electronic processing of payments via a global computer network; Bank card, credit card, debit card and electronic payment card services; Processing payments for the purchase of goods and services via an electronic communications network; information, advisory and consultancy services relating to the aforesaid services.</p>

securities markets; recording the transfer of securities; securities brokerage; securities broking; exchange brokerage; share exchange schemes; stock exchange quotations; Superannuation services; Management of financial affairs; Management of investments; Management services relating to investments; Advisory services relating to financial investment; Advisory services relating to financial matters; Advisory services relating to financial planning; Advisory services relating to money management; Financial advice; Financial planning; Financial portfolio management; Investment account services; Investment advice; Investment analysis; Investment business services; Management of financial assets; Management of funds; Monitoring of financial portfolios; Monitoring of pension funds; Pension advisory services; Pension and retirement and superannuation plans and funds; Pension fund financial management; Personal financial planning advisory services; Provision of financial information; Taxation financial planning services.	
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18. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

19. I bear in mind that for the purposes of considering the issue of similarity of services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.⁴ I also find that the applicant’s “financial services” is a very broad term which covers a range of services that pertain to money, including (and not limited to) finance, banking, investing, payments, lending, and the management of money. On this basis, I find the following:

Financial affairs; Monetary affairs; Online financial transactions; Services for debiting and crediting financial accounts; Payment card services; Payment processing services; Electronic payment services; Payment transaction card services; Processing of payments for banks; Collection of payments for goods and services; Electronic processing of payments via a global computer network; Bank card, credit card, debit card and electronic payment card services; Processing payments for the purchase of goods and services via an electronic communications network.

20. All of the proprietors’ above services fall within the broader category of “financial services” in the applicant’s specification. They are identical on the principle outlined in *Meric*.

Information, advisory and consultancy services relating to the aforesaid services.

21. The proprietor’s above services fall within the broader categories of the “provision of information relating to financial services”, “advisory services relating to financial matters”, “financial advice” and “provision of financial information” in the applicant’s specification. The services are identical on the principle outlined in *Meric*.

⁴ see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38

Insurance

22. At the hearing, Ms Knott submitted that the proprietors' "insurance" is *Meric* identical to the applicant's "financial services". This is supported by the finding in *Fil Investment Services Limited v Fidelis Underwriting Limited* – [2018] EWHC 1097 (Pat) (11 May 2018), paragraphs 89 to 90 (and reinforced in paragraph 96) where it was found that financial services cover insurance services.⁵ For the sake of completeness, I note that insurance is a means of protection from financial loss, and thus is financial in nature. I also find that the parties services will overlap in trade channels (being provided by the same financial undertakings), method of use, purpose and user. I therefore find that the parties services' are identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

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

24. The average consumer for the services will be members of the general public or businesses. The cost of the services in question is likely to vary, and the majority of the services will be purchased relatively infrequently by members of the general public,

⁵ <https://www.bailii.org/ew/cases/EWHC/Patents/2018/1097.html>

but relatively frequently by businesses. The average consumer will also take various factors into consideration such as the cost and commission rate, customer service standards, reliability, type of services offered and the suitability of those financial services to the consumer's needs. I also consider that as the services provided are financial in nature, all of which could involve significant sums of money, that between a medium and high degree of attention will be paid during the purchasing process.

25. The services are likely to be purchased from financial undertakings, or their online equivalents. Alternatively, the services may be purchased following perusal of signage on physical premises, advertisements or inspection of a business directory. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase which, as highlighted by the applicant, might involve discussions with brokers and financial advisors.

Comparison of the trade marks



26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which 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.”

27. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

28. The respective trade marks are shown below:

Applicant's mark	Proprietors' marks
	 <p data-bbox="986 1308 1209 1346">(SERIES OF 3)</p>

29. The applicant's mark consists of the capitalised word "STAKE" presented in a stylised typeface, which compresses the letters, with the widest letters at the beginning of the mark, and the thinnest letters at the end of the mark. I find that the word "STAKE" plays a greater role in the overall impression, with the stylisation playing a lesser role.

30. The proprietors' series of 3 marks consists of the word "STAKE". The first mark is a word mark presented in upper-case, the second mark is presented in a black slightly stylised title-case typeface, and the third mark is presented in the same stylised typeface as the second mark in the series, but presented in white on a black square background. In the applicant's skeleton argument, they state that the marks within the series must "differ only as to matters of a non-distinctive character not substantially

affecting the identity of the trade mark”.⁶ I therefore find that the element which appears in all of the marks, that being the word “STAKE”, plays a greater role in the overall impression, with the stylisation and background playing a lesser role in the marks.

31. Visually, all of the parties’ marks consist of the word “STAKE”. This acts as a visual point of similarity. However, the applicant’s mark and the second and third marks of the proprietors’ series are presented in different stylised typefaces, which acts as visual points of difference. Nevertheless, as a whole, I find that the parties’ marks are visually similar to a high degree.

32. Aurally, the stylisation of the parties marks does not affect their pronunciation, and, therefore, as they all consist of the word “STAKE”, they are aurally identical.

33. Conceptually, at the hearing, the applicant submitted that the marks convey the conceptual meaning of a “stake”, meaning a share or financial involvement in something such as a business. I agree. I also find that the stylisation and background of the parties’ marks does not contribute to the meaning of the marks and therefore, they are all conceptually identical.

Distinctive character of the earlier trade mark

34. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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

⁶ They also refer to section 41(2) of the Act and the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corpn* [2016] Bus. L.R. 849 at [7], [58], and [66].

C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

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

36. As the applicant has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

37. As noted above, the conceptual meaning conveyed by the applicant’s “STAKE” mark is a share or financial involvement in something such as a business. I find that this is highly allusive of the applicant’s financial services. Whilst I bear in mind that the mark is presented in a stylised typeface, I do not find that this significantly contributes to the distinctive character of the mark. I therefore find that the earlier mark is inherently distinctive to between a low and medium degree.

Likelihood of confusion

38. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the

average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. This includes the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

39. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found all of the marks to be visually similar to a high degree.
- I have found all of the marks to be aurally identical.
- I have found all of the marks to be conceptually identical.
- I have found the applicant's mark to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer as members of the general public or businesses who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that between a medium to high degree of attention will be paid during the purchasing process for all of the services which are financial in nature.
- I have found the parties' services to be identical.

40. I also bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion. Therefore, taking all of the above into account, considering the principle of imperfect recollection, and bearing in mind that

all of the marks consist of, or include the word STAKE (which plays a greater role in the overall impression in all of the marks), I consider that there is a likelihood of direct confusion. I find that the stylised typefaces (and the black background of the third mark in the proprietors' series) would be easily overlooked by the average consumer paying between a medium and high degree of attention, especially as they play a lesser role in the overall impression of the marks. Furthermore, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times, to my mind, the high degree of visual similarity between the marks will lead the average consumer to mistake one mark for the other, especially as it is being used on identical services. Even where aural considerations apply, the identical pronunciation of the marks will have the same result. I also note that the marks are conceptually identical, meaning there is no conceptual hook to differentiate them. I find that there is a likelihood of direct confusion.

41. I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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 recognized 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.”

42. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he

said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

43. I consider that the shared common use of the word STAKE in all of the parties’ marks will lead the average consumer to conclude that they originate from the same or economically linked undertakings. The only difference between the marks is that they are presented in different stylised typefaces and the third mark in the proprietors’ series of marks has a black background. Therefore, the consumer will likely perceive the proprietors’ marks as updated versions of the applicant’s mark, and vice versa.⁷ I consider that it is not uncommon for undertakings to re-brand themselves from time to time to accommodate changes in marketing considerations. Therefore, taking the above into account, I find there to be a likelihood of indirect confusion.

CONCLUSION

44. The partial application for invalidation is successful and the proprietors’ mark is hereby declared invalid in respect of the following services for which it was registered:

Class 36 Insurance; Financial affairs; Monetary affairs; Online financial transactions; Services for debiting and crediting financial accounts; Payment card services; Payment processing services; Electronic payment services; Payment transaction card services; Processing of payments for banks; Collection of payments for goods and services; Electronic processing of payments via a global computer network; Bank card, credit card, debit card and electronic payment card services; Processing payments for the purchase of goods and services via an

⁷ See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, regarding “wrong way round confusion”, referring to *Comic Enterprises*. In that case Kitchin LJ explained that “right way round” or “wrong way round” confusion may be a consequence of nothing more meaningful than the order in which the consumer happened to come across the mark and the sign. He explain further that in both instances the consumer thinks that the goods or services in issue come from the same undertaking or economically linked undertakings, and they may be equally damaging to the distinctiveness and functions of the mark.

electronic communications network; information, advisory and consultancy services relating to the aforesaid services.

45. Under section 47(6) of the Act, the registration is deemed never to have been made for the above services.

COSTS

46. The applicant has been successful and is entitled to a contribution towards its costs. As the proceedings were commenced on 23 January 2023, its costs award will be based upon the scale published in Tribunal Practice Notice 2/2016.

47. In the proprietors' written submissions in lieu, dated 3 February 2025, they state that an award of costs should be made in their favour "particularly given that the applicant has significantly reduced the scope of their claims" and "decided to unnecessarily pursue" the invalidation proceedings notwithstanding the proprietors' surrender of the challenged services".

48. At the hearing, Ms Knott made the following submissions on costs:

- a) The applicant pursued the invalidation proceedings because if successful this deems a registration to have never been made. If they did not pursue invalidation, the proprietors' would have still have protection of the contested services from 22 October 2021 to 23 January 2025.
- b) The proprietors put the applicant to the cost of a hearing as they were the ones who requested the hearing in the first place.
- c) The proprietors surrendered the challenged services less than a week before the hearing when the time and expense of preparing for a hearing had already been incurred.
- d) It was 2 days before the hearing, in its written submissions, when the proprietors demanded that the hearing be vacated.

48. Taking the above into account, Ms Knott asked me to dismiss the proprietors' claims on costs, and to award costs in favour of the applicant on the scale.

49. As noted in paragraph 5 of my decision, it was available for the applicant to pursue the invalidation action, especially as it has a different effect to surrendering the marks. Moreover, as correctly highlighted by Ms Knott, on 12 August 2024, the proprietors requested the hearing, and on 31 January 2025 (5 days before the hearing), they stated that they were no longer attending, but would provide submissions instead, which they did on 3 February 2025.

50. On 23 January 2025, the proprietors' filed a Form TM23 surrendering the contested services, which was confirmed and accepted in an official letter from the Registry dated 29 January 2025. This was exactly one week before the hearing, whereby the parties would have started preparing for the hearing, especially as the Registry requests that skeleton arguments are submitted 2 days before the hearing date.

51. Therefore, taking all of the above into account, I dismiss the proprietors' claims for costs. I shall not be making an award of any kind to the proprietor, nor will I reduce the amount the applicant is entitled to. In the circumstances, I award the applicant the sum of **£900**, which is calculated as follows:

Preparing the application for invalidity and considering the Counterstatement	£200
Preparation for and attendance at hearing	£500
Official fee	£200
Total	£900

52. I therefore order Easygo Solutions Pty Ltd and Bijan Tehrani to pay Stakeshop Pty Ltd the sum of £600. This sum is to be paid within 21 days of the expiry of the appeal

period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 8th day of May 2025

L FAYTER

For the Registrar