

O/0910/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATIONS NOS.

3380012, 3380008 AND 3380010

BY

RECIPCO HOLDINGS LTD.

TO REGISTER AS TRADE MARKS:

ECO

ECO PAY

ECO WORLD

AND

OPPOSITIONS THERETO

UNDER NOS. 416636, 416639 AND 416640

BY

ECO, INC.

Background and Pleadings

1. On the 4 March 2019, Recipco Holdings Ltd (“the Applicant”) applied to register in the United Kingdom the three trade marks as set out on the front cover of this decision. Each of the marks were accepted and published in the trade marks journal on 15 March 2019.

2. The ECO mark was applied for in relation to the following goods and services:

Class 9: Downloadable software for facilitating commercial transactions through electronic means via wireless networks, global computer networks and mobile telecommunication devices; Downloadable software for enabling the electronic transfer of money between users; Computer software used to process mobile payments; computer software for transmitting, processing, facilitating, verifying, and authenticating transaction and payment information; Computer software for ensuring the security of mobile payments via mobile devices; computer software for the storage, transmission, verification, and authentication of payment and transaction information; Artificial intelligence software and computer software for analyzing and predicting financial behavior and matching vendor and buyer trade data; computer software for consumer loyalty programs and loyalty cards for accessing and using loyalty points; Computer software, electronic transactions, transmission, reception, storage and transmission of digital currencies, virtual currency, tokens, digital tokens of value and digital tokens of exchange each including digital, crypto and other electronic currencies for use by members via a computer network forming part of an exchange; Computer programs for investment purposes, namely, the translation of electronic communications into financial transactions and trading workflows; Computer software platforms that accommodates multiple types of payment and debit transactions and for aggregating and integrating information and data into trading workflows; a computer program that converts instant messages into a platform to execute

financial transactions; Computer software for use in connection with the electronic storage, transmission, presentation, verification, authentication, and redemption of coupons, rebates, discounts, incentives, and special offers.

Class 35: Charitable services, namely, facilitating administrative coordination among charitable social purpose organizations; exchange services, namely, providing a commercial trade exchange of products and services, and customer club services for commercial, and promotional purposes; economic forecasting services; procurement services for others; commercial evaluation and rating of consumer goods for others prior to purchase; customer loyalty services and customer club services for commercial and promotional purposes; promoting the goods and services of others; business information and administration services, namely, providing a searchable online evaluation database for buyers and sellers.

Class 36: Financial services relating to issuance and management of digital currency, virtual currency, tokens, digital tokens of value and digital tokens of exchange each including digital, crypto and other electronic currencies for use by members via a computer network forming part of an exchange; Financial services, namely, providing, processing, verifying, authenticating and administration of mobile payments, loyalty reward card transactions, and bill payment transactions with merchants, and vendors via mobile devices; Financial transaction services, namely, providing secure commercial transactions and payment options; Monetary and financial exchange services, namely, exchange services in the nature of discovery, execution, clearing, reconciling and settlement of trade and financial transactions facilitated by a globally accessible database and computer network, the Internet and other interactive electronic media; Currency issuance and trading, namely, issuance of units of value constituting a trading currency as a constituent element of a

global economic architecture that can be used to trade available capacity and as a means of trade for the advancement of humanitarian aid; Providing financial information relating to financial transactions in the nature of commodity data, market data, market views, financial data, product volume, weight, and pricing, settlement details, order quantities, delivery dates, transaction life-cycle status, contract symbols, and transaction summary reports; Providing any or all of the aforesaid services on-line via a website that is accessible by users via a computer terminal and/or a mobile communication device.

Class 42: Providing an electronic platform that enables multiple participants to execute trading transactions and negotiation and communication.

3. The ECO PAY mark was applied for in respect of the goods and services as listed above in classes 9 and 36, and the ECO WORLD mark was applied for in respect of only the class 36 services as aforesaid.

4. On 17 June 2019, the applications were opposed, originally brought under the name Eco Project LLC but now stand in the name of Eco, Inc (“the Opponent”).¹ The oppositions are based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) against all the goods and services of the applications. The Opponent relies upon the following mark²:

EUTM No. 17894769

ECOFUNDATION

Filed on 3 May 2018 and registered on 13 November 2021 (claiming a priority from 3 November 2017 in the USA) for the following goods and services:

Class 9: Artificial intelligence software and computer software for analyzing and predicting the financial behavior and determining the financial reputation of

¹ Following an assignment to Beam Network, Inc on 19 August 2019 and a subsequent change of name to the current Opponent on 14 January 2021.

² In the original proceedings the Opponent also relied upon International Registration no. 1414125, but by the time the matter came before me this registration was no longer active having been cancelled by the office of origin. The EU Designation of the International Registration was therefore withdrawn and no longer relied upon in this opposition.

individuals; Computer software for use in electronically trading, transmitting, receiving, storing, and sending digital currency, virtual currency, digital tokens, and digital assets, and managing payments and exchange transactions involving digital currency, virtual currency, digital tokens, and digital assets; Computer software for use in connection with the electronic storage, transmission, presentation, verification, authentication, and redemption of coupons, rebates, discounts, incentives, and special offers; computer software for use in connection with consumer loyalty programs and loyalty cards used to access and use loyalty points.

Class 36: Financial services, namely, providing electronic transfer of a virtual currency for use by members of an on-line community via a global computer network; Financial services in the nature of providing management of financial assets and digital assets, namely, transmission of digital currency via electronic communication network; providing financial transactions, namely, clearing and reconciling transactions, via global computer network; digital asset transactions, namely, digital currency exchange transaction services for transferrable electronic cash equivalent units having a specified cash value; providing financial information; providing financial information via a web site; providing an online computer web site that provides commercial financial transaction data, account management, financial reporting, accounting features and related reference information; financial affairs and monetary affairs, namely, financial information, management and analysis services; financial analysis, namely, compiling and analyzing statistics, data and other sources for information for financial purposes; financial information in the nature of rates of exchange; financial information processing; Providing financial risk management services for electronic funds transfer; credit and debit card and electronic check transactions via a global computer network; credit and cash card payment processing services; Financial services, namely, providing credit scoring services.

Class 42: Platform as a services (PAAS) featuring computer software for analyzing and predicting the financial behavior and determining the financial reputation of individuals; Providing temporary use of online non-downloadable cloud-based software for use in electronically trading, transmitting, receiving,

storing, and sending digital currency, virtual currency, digital tokens, and digital assets, and managing payments and exchange transactions involving digital currency, virtual currency, digital tokens, and digital assets.

5. The Opponent claims that the marks are highly similar and that the Applicant's goods and services are identical, or at least highly similar to its own goods and services. In particular, it submits that the element/word ECO is the distinctive element of all the marks and consequently consumers would understand the contested marks to be logical extensions of the Opponent's brand leading to a likelihood of confusion and/or association on behalf of the relevant consumer.

6. The Applicant filed defences and counterstatements submitting that the applied for marks are sufficiently similar to the earlier mark for there to be a likelihood of confusion but that the applications should continue to registration because the Applicant's use of the mark ECO predates the filing date and priority dates of the earlier mark and so the ECO applications are an extension of its earlier marks (US Trade mark no. 5112064, UKTM 3057516 and IR 1257379). The Applicant confirms that it has opposed the Opponent's ECOFOUNDATION mark at the EUIPO. I shall deal with this in greater detail below.³

7. The Applicant filed evidence pertinent to these oppositions on 1 September 2020 which will be summarised to the extent that is considered necessary to the decision in suit. The Opponent chose not to file evidence. The Opponent has been represented throughout by Abion UK Ltd (previously Lane IP) and the Applicant is currently represented by Calathea IP Ltd.⁴

8. There has been a protracted history relating to these proceedings having first come before the tribunal for hearing on 26 January 2021 before a different Hearing Officer. A decision was issued initially on 2 February 2021 under number BL O/069/21. That decision was appealed. The basis of the appeal was that the Hearing Officer had failed to consider the Applicant's request for a stay to enable it to seek professional representation and inter alia to await the outcome of the opposition proceedings

³ The opposition proceedings before the EUIPO were unsuccessful as a result of the dismissal of the opposition on 13 August 2021. The earlier ECOFOUNDATION mark therefore remains a registered right for all the goods and services of its registration. The Opponent may therefore still rely on this mark to the full extent of its registration as an earlier right.

⁴ The Applicant has periodically been self-represented by its Chief Executive Officer Mr James Fierro and was previously professionally represented by Reed Smith LLP.

brought before the EUIPO. Further, it raised an issue regarding the Opponent's standing and whether the original Opponent was the correct entity to have brought the opposition. The matter came before the Appointed Person Ms Emma Himsworth, on 21 April 2021 and a decision was issued on 4 June 2021.⁵

9. After consideration of the issues, on appeal Ms Himsworth held that "*there [was] no way of knowing whether the Hearing Officer forgot or ignored the application for a stay and/or simply failed to give reasons for the refusal.*" Consequently, the decision was set aside, and the proceedings were remitted back to the Registrar for reconsideration as to the stay request and the future conduct of the opposition proceedings. It was noted that one of the reasons for the stay request being the need for additional time to appoint legal representation had fallen away, since by the time of the appeal hearing the Applicant was represented.

10. In so far as the 'standing' issue of the Opponent, Ms Himsworth noted that at the time the opposition was filed the requirements of Article 2 of The Trade Marks (Relative Grounds) Order 2007 were satisfied given that the entity bringing the action at the date of issue (being Eco Project LLC) was the proprietor of the earlier rights relied upon at that time. Given the assignment to Eco, Inc (formerly Beam Network, Inc) Ms Himsworth noted that in so far as the issue of standing was concerned "*It was accepted on behalf of the Applicant that if there was a valid substitution of Eco, Inc. ...for [Eco Project LLC] then the issue of 'standing' would fall away.*" Further she noted in her decision that the Applicant would consent to the Opponent's application for substitution to Eco, Inc if the matter were remitted back to the Registrar. Consequently, both the application for a stay and the substitution issue were remitted back to the Registry for determination and for further directions as to how the oppositions should proceed.

11. Due to an administrative error the proceedings did not resume before the Registry until 7 March 2023 and came before me initially for a further final hearing on 7 May 2025. Due to difficulties in contacting the Applicant and its then representative (Reed Smith LLP) the hearing was converted to a Case Management Conference ("CMC"). By the time of this CMC, it was clear that the basis of the original remittal i.e. to stay the proceedings, had fallen away and was no longer a live issue. The issue regarding the Opponent's standing had been resolved before the Appointed Person leaving only

⁵ BL O/425/21

the formality of recording the substitution of the Opponent as Eco, Inc to be determined and the Registry's records to be updated accordingly. That has now been done. At the CMC, Mr Fierro made a fresh application for a stay of the proceedings to seek further professional representation (as he was no longer represented by Reed Smith LLP) and to await the outcome of invalidation proceedings against the earlier right at the EUIPO. I refused the application for a stay pending the outcome of the invalidation proceedings, which as yet had not been instigated, but granted a short period of time for the Applicant to instruct new representation. I set out the reasons for my decision in a letter issued shortly after the CMC and adopt those reasons here. Further I made directions regarding the future conduct of the proceedings.

12. Following the CMC, Calathea IP Ltd contacted the Registry to formally record themselves as the Applicant's representatives. The proceedings resumed and the parties were contacted regarding the management of the proceedings in the normal way in so far as requesting a final hearing and the filing of further submissions is concerned. No further applications were made by those representing the Applicant and neither party requested a hearing or sought to file further submissions in lieu of a hearing.

13. The matter now proceeds with a decision from the papers based on the material as originally filed.

Evidence

14. The Applicant's evidence consists of the witness statement of James Fierro, the Chief Executive of the Applicant, dated 28 August 2020. Mr Fierro's evidence serves to repeat the information and submissions contained in the Applicant's counterstatement related to these proceedings and the statement of grounds which accompanied his application against the earlier mark at the EUIPO.⁶ Mr Fierro reiterates that the Applicant has been using the ECO trade mark since before May 2014. He produces extracts of articles, as published in the Huffington Post (dated 29 September 2015) and The Express Tribune (dated 14 December 2015). It is noted that the Huffington Post article was written by Mr Fierro himself. Both articles discuss the ECO Capacity Exchange and a trading unit called the ECO.

⁶ Exhibit 1

15. I note that Mr Fierro also filed a further witness statement dated 15 April 2021 for the purposes of the appeal which were described by Ms Himsworth as “*an update as to the current status with regards the Applicant’s challenges to the earlier rights relied upon by the Opponent*”.⁷ There is nothing of any significance in this witness statement pertinent to the issues to be determined which are relevant to section 5(2)(b) of the Act. Therefore, whilst I have taken it into account, I do not propose to summarise it.

Decision

16. Section 5(2)(b) of the Act 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.”

17. Section 5A of the Act reads as follows:

“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.”

18. An “earlier trade mark” is defined in section 6(1) of the Act as:

“(a) a registered trade mark, international trade mark (UK), a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

⁷ Paragraph 12(2)(b) of decision O/425/21

(b) a European Union trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired,

(ba) a registered trade mark or international trade mark (UK) which –

(i) has been converted from a European Union trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

19. Given the filing dates of the respective marks, the earlier mark upon which the Opponent relies (which is an EUTM) qualifies as an earlier trade mark under the above provision. As the earlier mark had not completed its registration procedure within the five years before the date of application of the contested marks, it is not subject to proof of use and the Opponent is therefore entitled to rely on all the goods and services of its specification as aforesaid.

Case Law

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

(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 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 to mind the earlier mark, 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.

21. The Applicant has not attempted to distance itself from the earlier admissions made in the TM8 forms. There is an unequivocal admission that the marks are similar and that there would be a likelihood of confusion. Mr Fierro, the Applicant's CEO has had the benefit of legal advice from two professional representatives. He repeated that admission at the first hearing and no application has been made at any time during the currency of these proceedings to retract or resile from those admissions either on appeal or in the remitted resumed proceedings before me. Consequently, those admissions still stand. The basis of the Applicant's defence remains that it is the owner of earlier rights. Section 4.5 of the Trade Marks Manual states that:

“The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton & Anor*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

Parties are reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.”

22. I note that whilst the Applicant sought to challenge the validity of the earlier mark, the opposition proceedings brought by it before the EUIPO were unsuccessful and were dismissed. Further at the date of writing this decision no invalidation proceedings have commenced. The basis of the Applicant's defence, therefore, is unsustainable before me.

23. Consequently, given the Applicant's admission that there is a likelihood of confusion the oppositions under section 5(2)(b) succeed in their entirety, and the applications shall be refused registration.

Costs

24. Ms Himsworth set aside the original cost award and reserved the costs of the appeal to the Registrar to consider the matter afresh. I shall award the same costs in respect of the original proceedings as awarded by the original Hearing Officer in decision O/069/21. I also note that the Applicant whilst successful on appeal in getting the matter remitted back to the Registry for further determination was not ultimately successful. This redetermination of the matter, however, has not (other than in attendance at the CMC) given rise to the Opponent incurring any additional costs. Consequently, I award costs on the following basis:

Original costs

Preparing a statement and considering the other side's statement:	£200
Preparing for and attending a hearing:	£500
Official fee (x3):	£300

Costs for the Appeal

Preparation and hearing:	No Further Award
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Costs of the resumed proceedings

Preparation and attendance at the CMC:	£500
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25. I order Recipco Holdings Inc to pay Eco, Inc the sum of £1,500. The above sum should 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 29th day of September 2025

Leisa Davies

For the Registrar

Comptroller-General