

O-328-16

IN THE MATTER OF THE TRADE MARKS ACT 1994

AND IN THE MATTER OF TRADE MARK APPLICATION NO. 3061613
IN CLASS 36 IN THE NAME OF ERIS FX LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO NO.
403491 BY ERIS INNOVATIONS, LLC

AND

ON APPEAL FROM THE DECISIONS OF MR MARK BRYANT
DATED 27 OCTOBER 2015 and 11 NOVEMBER 2015

SUPPLEMENTAL DECISION

1. On 9 May 2016, I handed down a written decision in the appeal from Mr Bryant's two decisions. I decided that the appeal would be rejected, and upheld the opposition to the Applicant's trade mark application as it then stood.
2. However, I also decided to give the Applicant a further opportunity to amend its specification, if it wished to do so, to see whether it was possible to produce a specification which was narrower than that considered on the appeal, and was clearly unobjectionable.
3. The specification which the Hearing Officer had rejected was:
Class 36: Currency exchange services, namely, non-cash spot and forward transactions and onward delivery of funds; but not including trading of or providing information about trading of futures and options, the exchange of financial derivatives and interest rate products, futures exchange services or financial transactions relating to any of these excluded services.
4. The Hearing Officer considered that the services were in part identical and in part similar to the Opponent's Class 36 services:

Class 36: Providing financial services, namely, trading of futures and options on futures contracts based on a commodity index through a global computer network; providing information concerning the trading of futures and options on futures contracts based on a commodity index through a global computer network; financial services, namely, providing for the exchange of financial derivatives and interest rate products, via the internet and intranet systems; futures exchange services.

5. Taking up the opportunity given in my decision, the Applicant provided a proposed amended specification which was:

“**Class 36:** Regulated Money Service Business activities, namely: online bureau de change services and transmission of the converted funds to nominated bank accounts, but excluding trading in, facilitating trading in, or providing access to trading in currencies, commodities or any financial derivatives.”

The proposed specification was submitted along with a number of documents supporting certain statements made in the written submissions. For instance, the Applicant explained that “Money Service Business” is a legally-defined term, and supplied a document showing the meaning of it.

6. The Opponent objects to this specification also. It submits that it is unfair for the Applicant continue to make such amendments, that (contrary to the guidance given by Mr Alexander QC in the *Multisys* decisions which I mentioned in my initial decision) further evidence would be necessary to deal with the amendment, and also that the proposed amendments do not result in a clearly unobjectionable specification.

7. The Opponent’s first complaint was that the approach taken by the Applicant, in providing a series of proposals narrowing down or amending its specification, was the sort of behaviour deprecated by Mr Alexander QC in *Multisys (No. 2)* [2012] RPC 15 at [27]:

“ ...where a broad specification is in issue in opposition proceedings, the proprietor should consider whether a narrower specification would be less susceptible to objection and should put any such alternative forward for consideration at the earliest opportunity in the opposition proceedings so that it can be considered in the first instance by the registrar. It should do so with regard to Tribunal Practice Notice (TPN) 1/2011. Applicants should not think that they will, in general, be able to get away with uncompromising defence of wide specifications until the last minute in

the expectation that they will be allowed to narrow down to something permissible in the end.”

8. There has certainly been some delay in the Applicant’s attempt to narrow down its specification to something which it hopes will not clash with the Opponent’s earlier mark; doubtless that has been exacerbated by the Applicant acting without professional advice. I have firmly in mind the impact of that delay, and of the iterations of the specification, upon the Opponent and upon the costs of this opposition. Moreover, I must keep in mind the proper approach to amending a specification which may be partly unobjectionable, as set out in TPN 1/2012 (which replaced TPN 1/2011 to which Mr Alexander alluded). Rewording a specification is only acceptable where there is “real practical scope to give effect to Article 13.”
9. Nevertheless, it did not seem to me that it would be wrong to permit the Applicant to produce a further proposal, and the Applicant cannot be blamed for having this last try at producing an acceptable specification in the light of my initial decision.
10. The Opponent submitted that in order to give proper consideration to the proposed amendment to the specification it would have been necessary to file additional evidence, for instance as to the meaning of a “Regulated Money Service Business.” As I explained in my decision of 9 May, the Applicant sought to back up its arguments on the appeal with lengthy explanations and evidence of the meanings of terms used in both parties’ specifications. I considered that these amounted to fresh evidence which could not be admitted on the appeal. Rather similarly, the Applicant has now provided a number of documents supporting its explanations of the meaning of the terms used in the proposed amended specification. In my judgment, the very fact that the Applicant felt it necessary to provide such documents with the revised specification shows the difficulty of using such terminology in a trade mark specification. All of this reflects the fact that evidence would have had to be filed, probably by both parties, to establish whether the proposed specification still includes services similar to the Opponent’s.
11. The use of the term a “Regulated Money Service Business,” even though qualified by the rest of the proposed specification, seems to me also to breach the requirement that a trade mark specification must be identified with sufficient clarity and precision to enable the competent authorities and third parties to determine the extent of the protection sought by reference

only to the material on the Register. The need for such clarity arises from the judgment of the CJEU in the *IP Translator* case, Case C-307/10 *Chartered Institute of Patent Attorneys v Registrar of Trade Marks* [2013] RPC 11, especially at [48]-[49]:

“48 ... economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties (Sieckmann, at [51], and Heidelberger Bauchemie, at [30]).

49 Accordingly, Directive 2008/95 requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought.”

12. The Applicant submits that the phrase would be understood by “a sophisticated market participant” but I do not consider that I am in a position to decide whether it would be understood by all potential competitors for the Applicant’s services. For that reason alone, I consider that the current proposal cannot be accepted.
13. I do not accept the Opponent’s suggestion that the express exclusions in the proposed new specification show that there is an overlap of the specifications, but it does seem to me that there is some force in the Opponent’s submission that the proposed specification is not “clearly unobjectionable” as it specifically includes “online bureau de change services.” As the Opponent pointed out, Mr Riddle’s evidence suggested that there was a level of similarity between bureaux de change (both high street and online) and the Opponent’s services, both as to the nature of the services offered and as to the providers of the different services. The Applicant submitted that there is a distinction between the services in its current specification which it says is “not in respect of physical currency,” and bureaux de change. However, I cannot accept that assertion in the absence of evidence challenging Mr Riddle’s evidence of the Opponent.
14. In those circumstances, it seems to me that there is at least a possibility that there is some similarity between the services described in the new proposed specification and the Opponent’s services. If so, then given the similarity between the marks, there may still be a likelihood of confusion, so that the revised specification is not clearly unobjectionable.

15. For these reasons, I reject the Applicant's proposed amended specification, and the appeal fails.
16. In my decision of 9 May, I said that the Applicant should pay the Opponent £1500 towards the costs of the appeal. I consider that it would be fair to increase that sum, to reflect the additional costs incurred by the Opponent in responding to the proposed new specification. The Opponent invited me to award those costs off the scale, but for the reasons set out at paragraph 9 above I do not consider that the Applicant has behaved in a manner justifying off the scale costs. I will order that the appeal be dismissed, and that the Applicant do pay the Opponent £2000 towards the Opponent's costs of the appeal by 5 pm on 26 July 2016, to be paid in addition to the costs awarded by the Hearing Officer.

Amanda Michaels

The Appointed Person

11 July 2016