

O/069/21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATIONS NOS. 3380012,
3380008 & 3380010
BY RECIPCO HOLDINGS LTD.**

TO REGISTER:

**ECO
ECO PAY
ECO WORLD**

AS TRADE MARKS

AND

**IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NOS. 416636, 416639 & 416640 BY
ECO PROJECT LLC**

BACKGROUND AND PLEADINGS

1. Recipco Holdings Ltd (“the applicant”) applied to register **ECO** as a trade mark in the United Kingdom on 4 March 2019. The application was accepted and published on 15 March 2019 in respect of 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 [sic] 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.

2. On the same day, the applicant applied to register **ECO PAY** as a trade mark in the UK. The application was accepted and published on 15 March 2019 in respect of the goods and services listed above in Classes 9 and 36.

3. Also on 4 March 2019, the applicant applied to register **ECO WORLD** as a trade mark in the UK. The application was accepted and published on 15 March 2019 in respect of the Class 36 services listed in paragraph 1 above.

4. On 17 June 2019, the applications were opposed by Eco Project LLC (“the opponent”). The oppositions are based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concern all the goods and services in the applications. The opponent relies upon the following two marks:

i) EUTM No. 1784769 (subject to opposition proceedings)¹

ECOFUNDATION

Filing date: 3 May 2018

Goods and services applied for:

Class 9

Artificial intelligence software and computer software for analyzing and predicting the financial behavior and determining the financial reputation of individuals;

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SI 2019 No. 269, Schedule 5. Further information is provided in Tribunal Practice Notice 2/2020.

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.

ii) IR No. 1414125

ECOSCORE

Date of designating the EU: 18 April 2018

Date of protection granted in the EU: 20 December 2018

Priority date: 20 October 2017.

Priority claimed from US Trademark No 87654405.

Protection granted for the same goods and services as shown above.

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 "ECO" is the distinctive element of all the marks and that the contested marks would be seen as "an entirely logical extension of the Opponent's brand". Consequently, it claims that there is a clear likelihood of confusion and/or association between the marks.

6. The applicant filed a defence and counterstatement. The applicant submits that the marks are sufficiently similar to the earlier marks for there to be a likelihood of confusion, but that the applications should continue to registration as it claims that its use of the mark ECO predates the application and priority dates of the opponent's marks and so the ECO application is an extension of its earlier marks (US Trademark No 5112064, UKTM 3057516 and IR 1257379) and notes that it has opposed the registration of the opponent's EUTM for **ECOFUNDATION** at the European Intellectual Property Office (EUIPO).

7. Following a stay of proceedings, the applicant filed evidence on 1 September 2020. This shall be summarised to the extent that I consider necessary.

8. The matter came to be heard before me by videolink on 26 January 2021. The opponent was represented by Philip Harris for Lane IP Limited and the applicant by James Fierro.

EVIDENCE

9. The applicant's evidence comes from James Fierro, the Chief Executive of Recipco Holdings Limited. It is dated 28 August 2020. He repeats the information given, and submissions made, in the counterstatement and attaches as Exhibit 1 the Notice of Opposition dated 27 August 2018 to the opponent's **ECOFUNDATION** application. He also states that, with respect to the opponent's **ECOSCORE** mark, the applicant has petitioned for the cancellation of the International Registration.

10. Mr Fierro states that his company has been using the **ECO** trade mark since before May 2014. Exhibit 2 contains articles from Huffington Post and The Express Tribune website discussing the ECO Capacity Exchange and a trading unit called the ECO. The former is dated 29 September 2015 and was written by Mr Fierro. The latter is dated 14 December 2015. For reasons that will become apparent, I shall not summarise their contents here.

DECISION

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

“A trade mark shall not be registered if because –

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

12. 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,

(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.”

13. The application and designation upon which the opponent relies qualify as earlier trade marks under the above provision. As neither mark completed its registration procedure within the five years before the date of application of the contested marks, they are not subject to proof of use and the opponent is therefore entitled to rely on all the goods and services in the specifications, subject to the outcome of any related proceedings.

14. The applicant has admitted that the marks are similar and that there would be a likelihood of confusion. Mr Fierro confirmed at the hearing that this was its position. However, it seeks to defend its applications by claiming that it is the owner of earlier intellectual property 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.”

15. In the case of the opponent’s earlier EU Trade Mark application, this is exactly what it has done and those proceedings will take their course through the EUIPO. No action has been taken against the EU designation of the International Registration.

16. As a consequence of the applicant’s admission that there is a likelihood of confusion, the oppositions succeed under section 5(2)(b).

Final Remarks

17. In his skeleton argument, Mr Harris referred me to the recent decision of Mr Phillip Johnson, sitting as the Appointed Person, in *SKYCLUB*, BL O/044/21. He submitted that, following this decision, it was not open to the Tribunal to treat the filing of a TM8 as a “blanket denial” of a pleaded section 5(2)(b) case. However, as the applicant had admitted that there was a likelihood of confusion and its defence was wrong in law, the oppositions would succeed, regardless of this point.

Outcome

18. All three oppositions are successful and the applications are refused.

Costs

19. The opponent has been successful and is entitled to a contribution towards the costs of these proceedings in line with the scale set out in Tribunal Practice Notice TPN 2/2016. I have taken account of the fact that the three statements were identical and so the award has been calculated as follows:

<i>Preparing a statement and considering the other side's statement:</i>	<i>£200</i>
<i>Preparing for and attending a hearing:</i>	<i>£500</i>
<i>Official fee (x3):</i>	<i>£300</i>
TOTAL:	£1000

20. I therefore order Recipco Holdings Inc to pay Eco Project LLC the sum of £1000. 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 2nd day of February 2021

Clare Boucher
For the Registrar
Comptroller-General