

O/368/21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003450525
BY WORLDREMIT LTD
TO REGISTER:**



AS A TRADE MARK IN CLASSES 9, 36 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 420127 BY
TWINT AG**

BACKGROUND AND PLEADINGS

1. On 10 December 2019, Worldremit Ltd (“the applicant”) filed an application to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods and services:

Class 9: Computer software and application software for use in the provision of financial services; computer software and application software for use in financial transactions; computer software and software applications (including for mobile devices) for the purpose of facilitating the transfer of money over the internet, facilitating the provision of foreign exchange services, facilitating remote payment of money, managing and processing of payment transaction data and telecommunications data and facilitating the sale and purchase of telephone credit; computer software and application software relating to the electronic transfers of funds; computer software and application software for use in online money transfer, foreign exchange, remote payment of money, management of and processing of payment transaction data, electronic payments and payment for telephone credit; money dispensing and sorting devices.

Class 36: Financial services; financial transfers and transactions; payment services; money transfer services; funds transfer services; electronic money transfers; monetary affairs including those relating to the transfer of funds and providing methods for payment including pre-paid methods of payment and monetary credit for others; foreign exchange services; remote payment services; international money transfer services; financial services including foreign currency trading, exchange, payments, conversions, accounts and transfers; the managing and processing of payment transaction data; electronic payment services; payment for telephone credit; provision of telephone credit; money transfer services over the Internet, foreign

exchange services, remote payment of money, management of and processing of payment transaction data, electronic payment services and payment for telephone credit, via a website; financial services including on-line cash accounts and banking; services for direct deposit of funds into customer bank accounts; information, consultancy and advisory services relating to these services.

Class 42: Software as a service [SaaS]; software as a service [SaaS] which facilitates online money transfer services, foreign exchange services, remote payment of money, management of and processing of payment transaction data, electronic payment services and payment for telephone credit; providing temporary use of non-downloadable software for use in online money transfer, foreign exchange, remote payment of money, management of and processing of payment transaction data, electronic payments and payment for telephone credit; information, consultancy and advisory services relating to these services.

2. The applicant's mark was published for opposition purposes on 31 January 2020 and on 24 April 2020, it was opposed by Twint AG ("the opponent"). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following marks:



EUTM no. 013497623¹

Filing date 26 November 2014; registration date 15 May 2015

("the opponent's first mark");

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 – please see Tribunal Practice Notice 2/2020 for further information.



EUTM no. 013497541

Filing date 26 November 2014; registration date 15 May 2015

("the opponent's second mark");



International Registration Designating the UK no. 1352989

International registration date 9 March 2017; date protection granted in the UK 15 September 2017

Priority date 29 September 2016

("the opponent's third mark"); and



International Registration Designating the UK no. 1352990

International registration date 9 March 2017; date protection granted in the UK 22 September 2017

Priority date 29 September 2016

("the opponent's fourth mark")

3. The opponent relies on all goods and services for which its marks are registered. The opponent's first and second marks' specifications are identical, as are the opponent's third and fourth marks' specifications. The opponent's goods and services are set out in the **Annex** to this decision.

4. The opponent claims that as a result of the high similarity between the marks and the identity and/or similarity of the parties' goods and services, there exists a very significant likelihood of confusion including a likelihood of association. The applicant filed a counterstatement denying the claims made.
5. Both parties filed evidence in chief. A hearing took place before me on 29 April 2021. The applicant was represented by Mark Holah of Bird & Bird LLP, who have represented the applicant throughout these proceedings. The opponent was represented by Ms Charlotte Blyth of Hogarth Chambers, instructed by HGF Limited, who have represented the opponent throughout these proceedings. Both parties filed skeleton arguments in advance of the hearing.
6. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

7. The opponent filed evidence in chief in the form of the Witness Statement of Tanya Elizabeth Waller dated 20 October 2020. Ms Waller is employed as a Chartered Senior Trade Mark Attorney at the opponent's representatives and her statement is accompanied by two exhibits, being two previous decisions of this Office, namely the decisions numbered O/448/18 and O/155/20.
8. The applicant filed evidence in chief in the form of the Witness Statement of Mark Holah dated 24 December 2020. Mr Holah is a partner at the applicant's representative and his statement is accompanied by one exhibit, being three front pages of results for trade mark searches on the online search facility 'TMView'.
9. I have taken both parties' evidence into consideration in reaching my decision and will refer to them below where necessary.

MY APPROACH

10. At the hearing, the parties' focused their submissions regarding the similarity of the marks on the opponent's first and third marks only. This was on the basis that, as they are registered in black and white, they represent the opponent's best case. I agree with these submissions. As a result, my approach in this decision will be based on the global assessment in respect of the opponent's first and third marks only.

PRELIMINARY ISSUE

11. Within its evidence, the applicant introduced print outs from searches undertaken on 'TMView' for trade marks that are categorised as a letter 'W'. The search results include UK trade marks, EUTMs and international registrations that designate the UK. The purpose of this evidence is to show that due to the prevalence of trade marks in classes 9, 36 and 42 for the letter 'W', the opponent "is not entitled to wide rights to prevent the registration of W marks in any of these classes covered by the Application."²

12. For reasons that I will now explain, the applicant's point regarding the presence of multiple trade marks on the register categorised as the letter 'W' for classes 9, 36 and 42 have no bearing on the outcome of this opposition. I note that in the case of *Zero Industry Srl v OHIM, Case T-400/06*, the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word

² Paragraph 6 of the Witness Statement of Mark Holah dated 24 December 2020

'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71). “

13. The fact that there are many trade marks that are categorised as the letter 'W' is not a relevant factor to the distinctiveness of the opponent's marks. The applicant has filed no evidence to demonstrate that any of these marks are actually in use in the market place. The outcome of this opposition will be determined after making a global assessment whilst taking into account all relevant factors but the state of the register is not relevant to that assessment.

14. I also note that the applicant's evidence set out that the opponent's marks were not returned in the 'TMView' searches that they undertook for marks categorised as the letter 'W'. This was also raised at the hearing where it was submitted that those compiling the database did not see the opponent's mark as a 'W'. Further, the applicant also submitted at the hearing that even the trade mark registries where the opponent's marks are registered do not categorise them as the letter 'W', meaning that they are not seen as such. While these points are noted, the fact that the opponent's marks have not been categorised on databases and/or trade mark registers as a 'W' does not preclude them from being viewed that way by average consumers. This is an assessment I must make when assessing the distinctive character of the opponent's marks and the search results provided by the applicant have no bearing on this.

15. Finally, during the hearing, the applicant noted that the examination report conducted by this Office did not cite the opponent's marks meaning that the examiner did not feel that the marks were similar. For reasons I will now explain, the applicant's point regarding the examination report conducted by this office has no bearing on the outcome of this opposition. The initial search undertaken by a UK Trade Mark Examiner is not an exhaustive search of the register for all potentially similar marks. Further, oppositions against trade marks are not exclusively reserved for those parties identified by this Office as having potentially

similar marks to the applied for mark. The guidance provided by this Office in relation to earlier rights³, at paragraph 9, states:

“Any third party can object to your trade mark, including those not notified. Please note, if you receive a notice of threatened opposition the onus is on you to contact the earlier right holder to try and negotiate or reach an agreement before the end of the opposition period.”

16. The applicant was informed of this by way of written correspondence dated 27 January 2020, which stated:

“The requirements for registration appear to be met so your application is accepted. The details of your application will now be published in our online Trade Marks Journal for opposition purposes. As soon as your trade mark is published, we will send you confirmation of the publication details. After the mark has been published, there is a 2 month opposition period in which anybody may oppose its registration.” (emphasis added)

17. It is within any party’s rights to oppose an application and it is not detrimental to an opponent’s case if the UK Trade Mark Examiner did not identify them within their initial search. Ultimately, the matter before me depends upon a global assessment taking into account all relevant factors and the holder’s submissions regarding the notification process is not relevant to that assessment.

DECISION

Section 5(2)(b): legislation and case law

18. Section 5(2)(b) of the Act reads as follows:

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

³ <https://www.gov.uk/government/publications/trade-marks-earlier-rights/earlier-rights-fact-sheet--2>

(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 or association with the earlier trade mark.”

19. Section 5A of the Act states as follows:

“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.”

20. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community 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.

21. The opponent’s marks qualify as earlier trade marks under the above provisions. As the opponent’s marks had not completed their registration process more than 5 years before the application date of the mark in issue, they are not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods and services for which its marks are registered.

22. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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 goods and services

23. The applicant's goods and services are set out in paragraph 1 of this decision. The opponent's goods and services are set out in the **Annex** to this decision.

24. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

25. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

26. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“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 fur 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”.

27. At the hearing, the applicant submitted that it considered the goods and services to be either identical or highly similar. In light of the applicant’s concession, I do not

consider it necessary to carry out a detailed goods and services comparison. However, I will make a distinction between those goods and services I consider identical and those I consider highly similar.

28. I consider the following services in the applicant's specification to be similar to a high degree with the services in the opponent's specification.

Class 36: Payment for telephone credit; provision of telephone credit; foreign exchange services; information, consultancy and advisory services relating to these services.

29. As for the remaining goods and services in the applicant's specification, I consider all of these to be identical to the goods and services in the opponent's specifications on the basis that they either have direct counterparts or are identical under the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

30. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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. 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

31. At the hearing, both parties made submissions in respect of the average consumer and nature of the purchasing act. The opponent submitted that the average consumer is a member of the general public that uses financial services or financial software whereas the applicant submitted that the average consumer for most of the goods and services at issue is both members of the general public and business users. In respect of the level of attention paid, the opponent submitted that it should be considered to be only slightly higher than average at most. Alternatively, the applicant submitted that, in respect of the financial and money transfer services, as well as goods and services connected with the provision of those services, the degree of attention paid by the average consumer is far above average, if not high. However, the parties agree that for software as a service, the level of attention paid will be normal in the areas outside of the financial field.

32. I agree with the applicant that the average consumer for the goods and services will be a member of the general public or a business user. This is on the basis that members of the general public will use goods such as software for financial services (such as mobile banking apps) whereas business users will use goods such as money dispensing devices. As for the level of attention paid, I find that there will be various factors the average consumer takes into consideration during the selection process of the goods and services such as security, nature of the provider and ease of use. I find that for some goods and services, such as software for the provision of financial services, provision of telephone credit and software as a service, the level of attention will, generally, be medium. However, for some goods and services, such as financial services that involve large sums of money, the average consumer will have additional considerations such as heightened security requirements and information regarding any potential rate of return on their financial holdings. For these services, I consider that the average consumer will pay a reasonably high degree of attention. Overall, I am of the view that the level of attention will range from a medium degree to a reasonably high degree depending on the goods and services selected.

33. The goods and services are likely to be obtained by visiting the provider's physical premises or by visiting their website. At physical premises, the average consumer is likely to select the goods or services after seeing them on signs and/or on

brochures/pamphlets. A similar process will apply in relation to websites where the consumer will select them after viewing a list of goods and/or services. Visual considerations are, therefore, likely to dominate the purchasing process. I note that, at the hearing, the opponent submitted that both visual and aural considerations will play a role in the selection of the goods and services on the basis that the average consumer may receive word of mouth recommendations or use telephone banking services. While telephone banking services are offered by most banks, this is, in my view, an ancillary service to main banking services. While the service will be provided aurally, it will not be selected that way as, to access those services, the consumer must already have an account with the bank, which is a service that will be selected visually via the methods described above. While I cannot discount an aural component to the selection of the goods and services in that some consumers may receive word of mouth recommendations or even advice from salespersons, I still consider that the selection process will be, primarily, a visual one.

Distinctive character of the opponent's marks

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 C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, 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 promoting 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 various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not pleaded that its marks have obtained enhanced levels of distinctiveness nor has it filed any evidence to that effect. Therefore, I have only the inherent position to consider.

36. The opponent's marks comprise of a hexagon that is displayed in black in the opponent's first mark and in white on a black background in the opponent's third mark. Within the hexagon sits an element that is presented in white in the opponent's first mark and in a grey gradient in the opponent's third mark. This element is the main point of contention between the parties in that the applicant submits it will be seen as a stylised shape whereas the opponent submits it will be seen as the letter 'W'. Having taken all of the parties' submissions and evidence into account, I find that while some average consumers may, as the opponent submits, seek to find a meaning within the opponent's marks, this will not be a significant proportion. Instead, I agree with the applicant's submissions in that the majority of average consumers will see it as an unusual shape due to its significant stylisation. Further, I am of the view that the majority of average consumers are used to seeing trade marks consisting solely of figurative shape elements and will not necessarily seek to find a meaning in the opponent's marks.

37. I find that the shape element dominates the distinctive character of the opponent's marks with the hexagon contributing only slightly. While the additional elements of the grey gradient and the additional background in the opponent's third mark will also contribute slightly to that mark, I do not consider that they will do so to the

extent that it results in an increased level of inherent distinctive character when compared to the opponent's first mark. Overall, I find that, as the opponent's marks have no obvious meaning with no allusive or descriptive qualities, they both enjoy a high degree of inherent distinctive character.

38. Alternatively, if my primary finding is wrong and the opponent's marks are seen as containing a letter 'W' by a significant proportion of average consumers, I find that the distinctive character of the mark will be lessened, but not considerably so. This is because the letter 'W' is not particularly high in distinctiveness given that there is a propensity for many undertakings to adopt single letters as indicators of trade origin. Instead, it is my view that it is the stylisation of the 'W' that contributes more to the distinctiveness of the mark. Overall, in the event that a significant proportion of average consumers recognise the letter 'W' within the opponent's marks, I find that they will enjoy a reasonably high degree of inherent distinctive character

Comparison of marks

39. It is clear from *Sabel 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.

40. 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.”

41. 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.

42. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
<div style="text-align: center;">  <p>("the opponent's first mark")</p>  <p>("the opponent's third mark")</p> </div>	<div style="text-align: center;">  </div>

43. At the hearing, both parties made detailed submissions in respect of the comparison of the marks. While I do not intend to reproduce the submissions in full here, I will, where necessary, refer to them below.

Overall Impression

The applicant's mark

44. The applicant's mark consists of the letter 'W' presented in a white standard typeface that sits within a purple octagonal shape. Despite the fact that the 'W' has elements of purple shading to give it a translucent appearance, I do not consider that this will interfere with the perception of a white 'W'. The letter 'W' plays the

greater role in the overall impression of the mark with the colours used and the octagon playing lesser roles.

The opponent's first mark

45. I am of the view that the shape element will dominate the overall impression of the mark. The hexagon element will be seen as a background element only and while I do not consider it will be overlooked due to its contrast with the shape element, it will play a lesser role in the overall impression of the mark. Even if the shape element is recognised as a 'W', it will not affect that element's role in the overall impression of the opponent's first mark

The opponent's third mark

46. As with the opponent's first mark, the shape element will dominate the overall impression of the mark with the hexagon playing a lesser role. As for the additional elements, being the use of the grey gradient shading and the black background, I find that these will play lesser roles in the overall impression of the mark. In line with my finding at paragraph 45 above, I consider that this will apply regardless of whether or not it is seen as a shape or a 'W'.

Visual Comparison

47. The applicant has submitted that the use of colour is a point of visual difference between the marks on the basis that the registration of marks in black and white does not cover use of the marks in any colours. I disagree with this. While registering a mark in black and white does not cover the use of complex colour arrangements, it should nominally be considered that it can be used in any colour.⁴

The applicant's mark and the opponent's first mark

48. The only point of visual similarity between the marks is the presence of an ordinary polygon shape. Even taking this similarity into account, I note that the polygon

⁴ see paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

shapes are different in that the applicant's is an octagon whereas the opponent's is a hexagon. I do not consider that this difference will be overlooked. Further, each of these polygons play lesser roles in their respective marks. The remaining elements of the marks are different. Taking all of the above into account, I do not consider that the use of a different polygon shape as a background in each mark is sufficient to warrant a finding that the marks are visually similar.

49. Even if my primary finding is wrong and the shape element in the opponent's first mark is seen as a 'W' by a significant proportion of average consumers, I do not consider that this will alter my above finding. While both marks will be seen as containing a 'W', they are stylistically very different and I note that just because two marks may share representations of the same thing, it does not automatically result in a finding of visual similarity between them.⁵ Therefore, I see no justification for adjusting my above finding on the sole basis that both marks contain a significantly different representation of a 'W'.

The applicant's mark and the opponent's third mark

50. While the additional elements of the black background and the use of a grey gradient in the shape element in the opponent's third mark will not be overlooked entirely, I do not consider that they will result in a different outcome of visual similarity than the one that I have found at paragraph 49 above. Therefore, I consider that these marks are visually dissimilar.

Aural Comparison

51. As my primary finding is that the opponent's marks will not be seen as including the letter 'W', they will not be capable of aural pronunciation. Therefore, the marks are aurally dissimilar. However, if my primary finding is wrong and a significant proportion of average consumers do see a letter 'W' in the opponent's marks, then the marks will be aurally identical.

⁵ *The Royal Academy Of Arts V Errea Sport S.P.A.* BL O-016-16

Conceptual Comparison

52. The opponent's marks, being made up solely of shapes, do not carry any conceptual meaning. Further, while the applicant's mark contains the recognisable element of a letter 'W', it carries no obvious meaning. As a result, none of the marks carry any obvious concept that is capable of being grasped by the average consumer. Therefore, I consider the marks to be conceptually neutral. The same finding will also apply in the event that a significant proportion of average consumers see the letter 'W' in the opponent's marks due to the fact that they will still carry no obvious meaning for the average consumer.

Likelihood of confusion

53. 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 goods and 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. The first is 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 goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods 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.

54. I have found the goods and services to be either identical or similar to a high degree. I have found the average consumer to be both members of the public and business users. I have found that the average consumer will select the goods and/or services through primarily visual means (although I do not discount an aural component). I have concluded that the average consumer will pay between a

medium and a reasonably high degree of attention during the purchasing/selection process depending on the goods and services being selected.

55. My primary finding is that the opponent's marks have a high level of distinctive character and that they are visually and aurally dissimilar and conceptually neutral with the applicant's mark. However, in the event that my primary finding is incorrect and a significant proportion of average consumers do see a 'W' in the opponent's marks, it will enjoy a reasonably high level of distinctive character. In these circumstances, I have found the marks to be visually dissimilar, aurally identical and conceptually neutral. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

56. This assessment of likelihood of confusion is made after taking all of the above factors and the principle of imperfect recollection into account. Given that my primary finding is that the opponent's marks will not be seen as containing a 'W', I see no plausible basis to make a finding of either direct or indirect confusion between the marks, even on goods and services that are identical or highly similar or where the average consumer pays a reasonably high degree of attention. However, even if I am wrong in my primary finding and a significant proportion of average consumers would see a 'W' within the opponent's marks, I make the same finding that there is no direct or indirect confusion between the marks. My reasons follow.

57. In these circumstances, the fact that the marks are aurally identical and the goods and services are either identical or highly similar are factors that weigh in the opponent's favour. However, my finding of visual dissimilarity between the marks weighs against the opponent. I note that visual, aural and conceptual similarities do not always carry the same weight, for example, where goods/services are purchased/selected by primarily visual means, greater weight will be attributed to the visual similarities/differences.⁶ This is the case here, meaning that more weight will be attributed to the visual differences between the marks. Further, while I have found that the opponent's marks enjoy a reasonably high degree of inherent distinctive character, I have attributed this to the stylisation elements of the marks

⁶ *New Look v OHIM* T-117/03 to T-119/03 and T-171/03

rather than the letter within them. The applicant's mark does not share such stylisation. Taking all of this into account, I do not consider there to be a likelihood of direct confusion between the marks, even on those goods and services that I have found to be identical or where the average consumer pays a reasonably high degree of attention.

58. Further, I see no plausible basis for an average consumer, having recognised the differences in the marks, to believe that the applicant's mark is another brand of the owner of the opponent's marks.⁷ There is no obvious rationale for the differences between the marks in that they do not appear to be indicators of a brand extension or sub-brand of the same or economically linked undertaking. Further, I do not consider that the significant differences in the stylisation of the 'W' element would lead the average consumer to consider that one mark was consistent with a logical re-branding of the other. For example, an average consumer would not consider it logical for an undertaking with a mark that consists of a clear representation of a 'W' to re-brand their mark so as to significantly redesign the presentation of that letter, arguably to the point that it is no longer a clear representation. Consequently, I do not consider there to be a likelihood of indirect confusion between the marks, even of those goods and services that I have found to be identical or where the average consumer pays a reasonably high degree of attention.

CONCLUSION

59. The opposition fails in its entirety and the applicant's mark can proceed to registration.

COSTS

60. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,500** as a contribution towards its costs. The sum is calculated as follows:

⁷ Paragraphs 16 & 17 of *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

Considering the opponent's statement / preparing counterstatement:	£200
Preparing and considering evidence:	£500
Preparing for and attending a hearing:	£800
Total	£1,500

61.I therefore order Twint AG to pay Worldremit Ltd the sum of £1,500. This 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 17th day of May 2021

A COOPER
For the Registrar

ANNEX

The opponent's first and second marks

Class 9

Computer software; Programs for electronic data processing installations and equipment; Data processing programs for communications systems; Application software in the field of mobile operating systems (mobile apps); Computer software and data processing software for e-business portals; Computer software and data processing software for e-business portals, for analysing payment transaction data; Computer software and data processing software for e-business portals, for digitising letters and correspondence in the context of sending and distribution; Computer software and data processing software for e-business portals, for managing alternative delivery addresses and for shipment tracking for letters and parcels; Computer software and data processing software for enabling sending of signed and/or encrypted e-mails; Computer software and data processing software for enabling electronic transmission of data and information; Computer software and data processing software for enabling electronic reception of data and information, in particular letters; Computer software and data processing software for enabling management of alternative delivery addresses and shipment tracking for letters and parcels; Computer software and data processing software for enabling electronic signatures; Magnetic and optical data media; Currency-operated automated teller machines (ATM) and ticket dispensers; Automatic machines for carrying out monetary transactions of all kinds; Automatic machines for information purposes, namely for information regarding monetary affairs and information purposes relating thereto.

Class 35

Drawing up of statements of accounts, payroll preparation, accounting; Publicity and sales promotion services, Rental of advertising space, In particular on a website; Rental of fair huts for sales purposes; Rental of vending machines; Advertising by mail order; Direct mail advertising; Marketing, market research; Business management and organisation consultancy, business consultancy; Business consulting services; Personnel consultancy; Business management in the field of electronic marketplaces; Assistance with regard to handling commercial transactions,

for others, Including information relating thereto; Management of customer address files; Import agencies for vehicles; Document reproduction; Collating and systematic ordering of data in databases; Computerised file management; Administration of loyalty programmes involving discounts or incentives; Consultancy relating to all of the aforesaid services; Including all of the aforesaid services via electronic channels; Consultancy relating to data processing; Retailing via electronic channels, including the internet, in relation to cosmetics, pharmaceutical preparations, computer software and hardware, digital recording media, vehicles, common metals and precious metals, jewellery, clocks and watches, printed matter and publications, gift articles, namely ornaments, stationery products, furniture, textile goods and clothing, games, foodstuffs, beverages and tobacco products.

Class 36

Financial clearing, Electronic funds transfer, Installment loans; Financial affairs; Monetary affairs; Debt collecting services; Real estate affairs, In particular rental of facilities for sales purposes; Insurance; Monitoring, analysis and evaluation of payment transaction data; Electronic processing of business procedures, financial operations and payment transaction data; Financial consultancy for companies, and consultancy relating to all of the aforesaid services; Including all of the aforesaid services via electronic channels.

Class 37

Maintenance of computer hardware.

Class 38

Telecommunications, in particular voice and data transmission; Transmission of data and information between customers and companies by means of telecommunications, computers, and via electronic channels; Information regarding electronic transmission of data and information by means of telecommunications and via electronic channels; Routing of messages, in particular SMS (short message service); Telephone services within the framework of a call centre; Transmission of data from databases, In particular via e-mail; Electronic mail; Telephone, telecopier and videotext services, mobile radio services; Providing of access to global computer networks and computer databases; Providing of user access to internet portals,

databases and application software in the field of mobile operating systems (mobile apps); Providing of user access to internet portals, databases and application software in the field of mobile operating systems (mobile apps) for analysing payment transaction data; Providing of user access to internet portals, databases and application software in the field of mobile operating systems (mobile apps) for receiving digitised letters and correspondence; Arranging of access time to a database, with and without payment, for viewing or downloading data, information and graphics or images via electronic media (the internet); Consultancy in the field of the electronic transmission of documents, images, data and information; Consultancy in the field of the transmission of information between customers and businesses by means of telecommunications, by computer or via electronic channels; Consultancy relating to all of the aforesaid services.

Class 42

Design, development and updating of computer hardware and software; Maintenance of software; Maintenance of database software; Maintenance of software for internet access; Development of data processing programs; Development of data processing programs for communications systems; Development of application software in the field of mobile operating systems (mobile apps); Development of computer software and data processing software for e-business portals; Development of computer software and data processing software for e-business portals, for analysing payment transaction data; Development of computer software and data processing software for e-business portals in the field of packaging, sending and distribution of letters, correspondence, and other movable property, including documents, valuables, goods and other commodities; Development of computer software and data processing software for e-business portals for digitising letters, correspondence, and documents; Development of computer software and data processing software for e-business portals for managing alternative delivery addresses and for shipment tracking for letters and parcels; Development of computer software and data processing software for enabling sending of signed and/or encrypted e-mails; Development of computer software and data processing software for enabling electronic transmission of data and information; Development of computer software and data processing software for enabling electronic reception of letters; Development of computer software and data processing software for enabling management of alternative delivery addresses and

shipment tracking for letters and parcels; Development of computer software and data processing software for enabling electronic signatures; Digitising of letters, correspondence, and documents; Scientific and technological services, in particular for communications systems, in the field of mobile operating systems (mobile apps), for e-business portals, for enabling sending of signed and/or encrypted e-mails, for enabling electronic transmission of data and information and for enabling electronic signatures; Rental of operating time on computer hardware (service and access providers); Rental of computers and software; Providing of temporary use of downloadable software applications for using internet portals and access thereto; Providing of temporary use of downloadable data import and management software; Website design services; Rental and maintenance of memory space for websites, for others (hosting); Programming and maintenance, including optimisation, of websites, for others; Rental of access time to a database (information technology); Providing of information relating to all the aforesaid services.

The opponent's third and fourth marks

Class 9

Software; programs for electronic equipment and installations for data processing; data processing software for communication systems; application software for use in the field of mobile operating systems (mobile app); data processing software and programs for e-commerce portals; data processing software and programs for e-commerce portals for analyzing data in the field of payment transactions; data processing programs and software for e-commerce portals for digitizing mail and letters in dispatch and distribution; data processing software and programs for e-commerce portals for address management for alternative distribution and for tracking the dispatching of letters and parcels; data processing software and programs for producing and sending signed and/or encrypted electronic mail; data processing software and programs for producing and electronically transmitting data and information; data processing software and programs for producing and electronically receiving data and information, in particular mail; data processing software and programs for managing alternative distribution addresses and tracking and dispatching letters and parcels; data processing software and programs for producing electronic signatures; magnetic or optical data media; automated teller machines

(ATM) for pre-payment and cash dispensing machines; automated teller machines for carrying out monetary operations of all kinds and for information purposes and automatic payment tags (computer hardware).

Class 35

Preparation of statements of accounts, preparation of salary statements, accounting; advertising and sales promotion, rental of advertising space, particularly on a website; rental of stands for sales purposes; rental of vending machines; advertising mailing; distribution of advertising media; marketing, market studies; business management consultancy, business management and organization consultancy; professional business consultancy; human resources consulting; business management in the area of electronic marketplaces; retail sale by electronic means (also via global computer networks); assistance for carrying out commercial business for others, including information relating thereto; management of customer address files; operation of a vehicle import agency; document reproduction; compilation and systemization of information into computer databases, in particular electronic processing of business management, financial operations and transaction data in the field of payments; management of files in computer files; administration of loyalty programs involving discounts or incentives; advice relating to all the aforesaid services; all the aforesaid services also by electronic means; consulting in the field of data processing.

Class 36

Clearing transactions, transferring of funds (electronic), installment loans; financial affairs; monetary affairs; collection operations; real estate affairs, in particular rental of premises for sales purposes; insurance services; monitoring, analysis and evaluation of transaction data in the field of payments; financial consultancy for businesses and advice relating to all the aforesaid services; all the aforesaid services also by electronic means.

Class 38

Telecommunications, particularly transmission of speech and data; information and data transmission between customers and companies via telecommunication media, computers or electronic media; information on the electronic transmission of data and information by means of telecommunications or electronic channels; transmission of

messages, particularly short message services (SMS); telephone services in the framework of a call center; transmission of data from a data bank, particularly by electronic mail; provision of electronic mail services; telephone services, facsimile transmission and communication by computer terminals, mobile telephone communication services; provision of access to networks and global computer data banks; provision of user access to portals on the Internet, data banks and software application used in the field of mobile operating systems (mobile app); provision of user access to portals on the Internet, data banks and software application used in the field of mobile operating systems (mobile app) to analyze transaction data in the field of payments; provision of user access to portals on the Internet, data banks and software application used in the field of mobile operating systems (mobile app) for receiving digital letters and mail; rental of access time to databases (information technology services); fee-based or free provision of access time to a data bank (information technology services), for consulting or downloading data, information and graphics or images via electronic means (the Internet); advice relating to the electronic transmission of documents, images, data and information; advice in the field of transmission of information between customers and companies by means of telecommunication, computers or by electronic media; rental of operating time on computers and computer hardware (service and access provider); advice and information services relating to all the aforesaid services.

Class 42

Design, development, maintenance and updating of computer hardware and software; maintenance of database software; updating of computer software for providing access to the Internet; development of data processing programs; development of data processing programs for communication systems; development of application software used in the field of mobile operating systems (mobile app); development of data processing programs and software for e-commerce portals; development of data processing software and programs for e-commerce portals for analyzing data in the field of payment transactions; development of data processing programs and software for e-commerce portals in the field of packaging, dispatching and distribution of letters, mail and other movable objects such as documents, securities, merchandise and other goods; developments of data processing programs and software for e-commerce portals for digitizing letters, mail and documents; development of data processing

software and programs for e-commerce portals for address management for alternative distribution and for tracking the dispatching of letters and parcels; development of data processing software and programs for producing and sending signed and/or encrypted electronic mail; development of data processing software and programs for producing and electronically transmitting data and information; development of data processing software and programs for producing and electronically receiving data and information; development of data processing software and programs for managing alternative distribution addresses and for tracking and dispatching letters and parcels; development of data processing software and programs for producing electronic signatures; digitization of letters, mail and documents; scientific and technological services, in particular for communication systems, in the field of mobile operation systems (mobile app), for e-commerce portals, for dispatching signed and/or encrypted electronic mail, for electronically transmitting data and information and for producing electronic signatures; software rental; providing temporary use of on-line downloadable computer application software for the use of an e-business portal and access thereto; provision of temporary use of online downloadable software for importing and managing data; website design; rental and maintenance of memory space for use as web sites for others (hosting); computer programming and maintenance, including optimization of web sites for others; advice and information services relating to all the aforesaid services.