

O-100-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**OPPOSITION No. 94857**

**IN THE NAME OF CHARTERED FOREX INC**

**TO TRADE MARK APPLICATION No. 2408890**

**IN THE NAME OF FOREX BANK AB**

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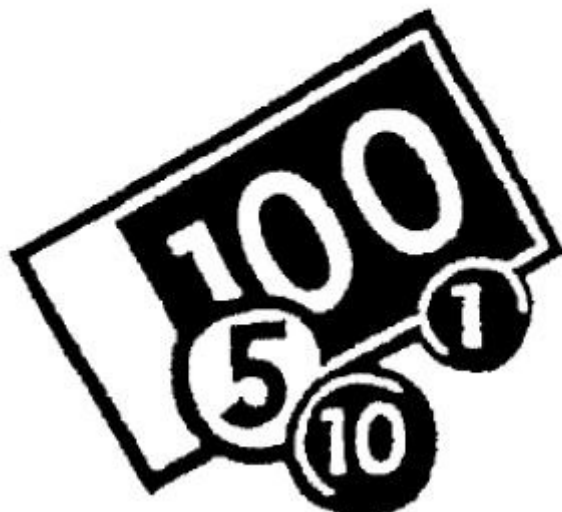
**DECISION**

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Application No. 2408890

1. On 13 December 2005 Forex Bank AB (*‘the Applicant’*) applied to register the following sign as a trade mark for use in relation to a wide range of goods and services in Classes 9, 16, 35, 36, 41 and 42.

**FOREX**



2. Chartered Forex Inc (*‘the Opponent’*) objected to the application for registration, citing the earlier right to which it was entitled as proprietor of the following trade mark registered under number 2364475 with effect from 27 May 2004:



Class 36: Arranging monetary transfers and currency exchange.

Class 39: Packaging, transportation and delivery of articles, goods and valuables.

3. The Opponent contended that the application for registration in Classes 9, 16, 35, 36 and 41 should be refused under section 5(2)(b) of the Trade Marks Act 1994 on the ground that there would be a likelihood of confusion if the Opponent’s mark and the Applicant’s mark were used concurrently in the United Kingdom in relation to goods and services of the kind in issue.

## Procedure

4. The Applicant disputed the objection to registration. No evidence was filed by either party. Both parties were content for the opposition to be determined without recourse to a hearing. Written submissions were filed on behalf of the Applicant. The Opponent elected to file no written submissions.

## Outcome of the registry proceedings

5. The opposition succeeded in relation to some of the goods and services specified by the Applicant and failed as to the remainder for the reasons given in a written decision issued on 3 November 2008 (under reference BL O-301-08) by Mr. M. Reynolds acting on behalf of the Registrar. On the basis that each side had achieved a measure of success against the other, he made no order for costs.

6. The goods and services for which registration was refused were as follows:

Coded and uncoded magnetic cards, in the form of bank and debit cards; registered software for transfer of funds and information about funds. (Class 9)

Printed matter, printed information material, printed publications, printed forms and valuable documents; uncoded debit cards of plastic and/or paper. (Class 16).

Financial analysis; banking, debit card services; financial management, financial information, financial consultancy, financial services; credit card services; electronic funds transfer; issuing of travellers' cheques; exchanging money; money exchanging office. (Class 36)

These were taken to represent areas of trading activity in which the application for registration conflicted with the Class 36 specification of the Opponent's earlier trade mark.

7. The Hearing Officer found that there would be a likelihood of confusion within those areas of trading activity upon the following basis:

30. Quite clearly there is no similarity between the device elements of the marks. However, as I have taken the view that the word Forex has independent distinctive character (more obviously so in relation to some goods and services than others) then the presence of that word in both marks points to a reasonable degree of similarity between the marks when the prominence of the word is taken into account and the fact that in oral usage it is more likely to be the reference point than the devices. That position is only slightly diluted by the different presentational features of the words - the one in what I have described as 'stencil' upper case lettering, the other in title case and in an unremarkable font. I find that visual, aural and conceptual considerations lead to the view that the marks differ in their presentational features and graphical components, but are, in overall terms, similar to a reasonable degree as a result of the presence of the Forex element.

8. The determining factor in his assessment was his decision to regard the word **FOREX** as distinctive in the absence of any evidence confirming his own perception that it was an abbreviation for, and recognised reference to, foreign exchange.

9. He identified the issue confronting him in the following terms:

20. The issue is whether Forex would be understood as an abbreviation for, or recognised reference to, foreign exchange. If or to the extent that that is the case, then that component would serve to

tell the relevant public what such goods/services are or what they relate to and not that those goods or services are from a common trade source.

21. My initial reaction to the word was that it did indeed carry such a message. The difficulty I have is that I have no yardstick against which to test my own reaction. If my view of the matter is the correct one I would have expected evidence to have been filed to demonstrate the fact. In the absence of any such evidence I need to consider whether I can proceed on the basis of taking judicial notice of the fact.

10. In that respect he drew upon the reasoning in two decided cases:

22. In *Chorkee Trade Mark*, O-048-08, Anna Carboni, sitting as the Appointed Person stated:

‘36...While the Applicant contended in its Counterstatement that the earlier marks would be recognised to refer to the Cherokee tribe and that the tribe was well known to the general public, no evidence was submitted to support this. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.’

23. The following passage from *Citigroup, Inc., v. OHIM*, Case T-325/04 shows that a similar approach is taken in OHIM:

‘51. According to the case-law, the restriction brought about by Article 74(2) of Regulation No. 40/94, according to which, in proceedings relating to relative grounds for refusal of registration, OHIM’s examination is restricted to the facts, evidence and arguments provided by the parties and the relief sought, does not preclude it from taking into consideration, in addition to the facts expressly put forward by the parties to the

opposition proceedings, facts which are well known, that is, which are likely to be known by anyone or which may be learnt from generally accessible sources (Case T-185/02 *Ruiz-Picasso and Others v. OHIM – DaimlerChrysler (PICARO)* [2004] ECR II-1739, paragraph 29).’

These observations appear to have left him with the impression that meaning should be attributed to a word in inter partes proceedings as if it was a fact which needed to be established on the basis of: (1) evidence; or (2) judicial notice in lieu of evidence.

11. He did not feel able to say on the strength only of his own personal perception that the word **FOREX** was well known as an abbreviation for ‘foreign exchange’. With no evidence to guide him one way or the other, his default position was to proceed upon the footing that the word **FOREX** was likely to be perceived as an independent distinctive element in each of the marks in issue:

24. In *South Beck Trade Mark*, O-160-08, Richard Arnold QC, sitting as the Appointed Person, held that the hearing officer was entitled to rely on his own knowledge of the English language in reaching his conclusion as to how the word would be understood by the average consumer. In that case the word in question, ‘beck’, was acknowledged to have a clear dictionary meaning (though the hearing officer had had evidence to that effect before him). In this case I have no evidence on the point and am uncertain whether my own approach to the word can be taken as being properly representative of all or any of the relevant groups of consumers.

25. I note that in applying the above guidance in the *Chorkee* case the Appointed Person said:

“I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a

native American tribe. This is a matter than can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this.”

The question of whether judicial notice can be taken is, therefore, linked not to awareness at large but rather must be considered in the context of the state of knowledge of the average consumer for the goods or services in issue. That may have important implications where one is dealing with a word that may be widely known and used amongst consumers in a particular area of trade albeit that it is less well known amongst the wider public.

26. If that is right then it may well be possible to conclude that foreign exchange dealers, say, would immediately understand any descriptive significance inherent in the word Forex. But I am unable to reach even that limited conclusion without evidence as to the state of knowledge and understanding of that segment of the relevant consumer groups. More generally, as I have indicated above, professionals in the financial services field and more sophisticated business users of such services merely represent one of the potential consumer groups. I have no evidence (or any degree of certainty) as to the reaction of the average man in the street faced with the word even in the context of currency exchange services. It is possible that some will discern a barely disguised reference to the nature of the goods or services. But I would not put it higher than that. The average consumer is not credited with pausing to analyse marks. So, whilst I would not be at all surprised to find that, in the context of currency exchange services, some members of the general public would see in the word a descriptive indication, in the absence of evidence to the contrary it would in my view be a step too far to take judicial notice of widespread public understanding or recognition of the word Forex. For a significant part of the general public at least the word is more likely to be regarded as having independent distinctive character within the marks at issue.

## The Appeal

12. The Applicant appealed to an Appointed Person under section 76 of the 1994 Act contending, in substance, that any doubt as to the normality of the Hearing Officer's own understanding of the word **FOREX** could, should and would have been dispelled by looking at the Registry's guidelines on examination and appropriate works of reference. For completeness I should record that this was not an approach that the Hearing Officer had been asked to adopt in the written observations filed on behalf of the Applicant at first instance.

## Decision

13. The marks in issue are similar by reason of the fact that they both contain graphic representations of the word **FOREX**. In order to determine the Opponent's objection to registration under section 5(2)(b) of the Act it was necessary for the Hearing Officer to decide whether that would or would not give rise to the existence of a likelihood of confusion, within the meaning of that expression as interpreted by the European Court of Justice<sup>1</sup>, if the marks in issue were used concurrently in the United Kingdom in relation to goods and services of the kind in issue.

14. That could only be done by assessing the significance of the word **FOREX** in the context of the marks in issue from the perspective of a reasonably well-informed and reasonably observant and circumspect consumer of the goods and services concerned. Although the Applicant and the Opponent adduced no

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<sup>1</sup> See Case C-102/07 Adidas AG v. Marca Mode CV [2008] ECR I-00000, [2008] FSR 38 at paragraphs 27 to 29.



evidence in relation to that point, their failure to do so did not relieve the Hearing Officer of his obligation to determine the objection under section 5(2)(b) as best he could. It did, however, require him to concentrate on doing so fairly and impartially without attempting to build a case for or against either party. If at the end of the exercise he was not persuaded that there would be a likelihood of confusion, the objection to registration would be rejected.

15. In relation to the issue identified in paragraphs 20 and 21 of his decision<sup>2</sup>, it was open to the Hearing Officer to look at appropriate works of reference for the purpose of supplementing his understanding of the meaning(s) that the word **FOREX** could properly be taken to possess in accordance with ordinary English language usage in this country. In The Coca-Cola Co. of Canada Ltd v. Pepsi-Cola Co. of Canada Ltd<sup>3</sup> Lord Russell of Killowen stated:

While questions may sometimes arise as to the extent to which a court may inform itself by reference to dictionaries, there can, their Lordships think, be no doubt that dictionaries may properly be referred to in order to ascertain not only the meaning of a word, but also the use to which the thing (if it be a thing) denoted by the word is commonly put.

There are numerous instances of dictionaries and other works of reference being considered in decisions issued by the Community Trade Marks Office and the supervising courts in Luxembourg in inter partes proceedings under the Community Trade Mark Regulation<sup>4</sup>.

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<sup>2</sup> quoted in paragraph 9 above.

<sup>3</sup> (1942) 59 RPC 127 (PC) at 133.

<sup>4</sup> merely by way of example, see Beiersdorf AG's Trade Mark [2001] ETMR 19, p.187 at paras 11, 12 (OHIM First Cancellation Division); Case T-237/01 Alcon Inc. v. OHIM [2003] ECR-411 at

16. If the Hearing Officer had checked the normality of his own understanding of the word **FOREX** by comparing it with the meaning(s) indicated in appropriate works of reference, he would have been using generally accessible information to help him identify the ordinary meaning(s) of the word in the English language as written and spoken in this country. This is not normally regarded as evidence gathering. In Baldwin & Francis Ltd v. Patents Appeal Tribunal<sup>5</sup> Lord Reid said<sup>6</sup>:

A judge is supposed to know the law, the English language and such facts as are common knowledge. If he refers to authorities or dictionaries or other works dealing with these matters he can safely do so because his general knowledge enables him to check and appreciate them.

and Lord Denning said<sup>7</sup>:

And no one ever calls the author of a dictionary to give evidence. All that happens is that the court is equipping itself for its task by taking judicial notice of all such things as it ought to know in order to do its work properly.

It thus appears to me that the failure of the parties to adduce evidence in the present proceedings could neither prevent the Hearing Officer from checking his understanding in the way I have indicated nor compel him to assume without deciding that the word **FOREX** was likely to be perceived as an independent distinctive element in the marks in issue.

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paras. 43 to 46; Case T-291/03 Consorzio per la tutela del formaggio Grana Padano v. OHIM [2008] ETMR 57 at paras. 67, 71 and 85.

<sup>5</sup> [1959] AC 663 (HL).

<sup>6</sup> at p.684.

<sup>7</sup> at p.691.

17. The need for the Hearing Officer to check the normality of his understanding of the word **FOREX** was underlined by the following caveat in the Addendum to Chapter 3 of the Trade Marks Registry Work Manual:

- **FOREX**

This is unregistrable for foreign exchange or financial related services, object under Section 3(1)(d), unless, of course, the mark is combined with other matter to make an acceptable whole.

According to that entry (which dates back to the mid-1990's) the word **FOREX** should be regarded as a sign or indication which is customary in the current language or in the bona fide and established practices of the trade in relation to financial related services. The correctness of that proposition might need to be checked and re-assessed from time to time. It does not follow that the proposition should be disregarded unless and until it is proven to be correct in any particular case.

18. In the Collins English Dictionary Fourth Edition (1998) the word **FOREX** was stated to be:

short for **foreign exchange**

and in the Shorter Oxford English Dictionary Fifth Edition (2002) it was recorded as:

[Abbreviation]  
*COMMERCE*. The foreign exchange market; foreign exchange.

These entries clearly pointed to the conclusion that the word **FOREX** would, in ordinary English language usage, be understood as an abbreviation for, or recognised reference to, foreign exchange.

19. As Lord Hoffmann emphasised in Kirin-Amgen Inc. v. Hoechst Marion Rousell Ltd<sup>8</sup>.

The meaning of words is a matter of convention, governed by rules, which can be found in dictionaries and grammars. What the author would have been understood to mean by using those words is not simply a matter of rules. It is highly sensitive to the context of, and background to, the particular utterance. It depends not only upon the words the author has chosen but also upon the identity of the audience he is taken to have been addressing and the knowledge and assumptions which one attributes to that audience. I have discussed these questions at some length in *Mannai Investment Co. Ltd. v. Eagle Star Life Assurance Co. Ltd* [1997] A.C. 749 and *Investors Compensation Scheme Ltd v. West Bromwich Building Society* [1998] 1 W.L.R. 896.

These considerations apply to opposition and invalidity proceedings within the commercial setting envisaged by the list of goods and services in issue. They apply in that setting upon the relatively broad basis identified by the European Court of Justice in Case C-533/06 O2 Holdings Ltd. v. Hutchison 3G Ltd<sup>9</sup>.

Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application or registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered.

20. I can see no reason for thinking that the word **FOREX** would not be understood in the sense indicated by the dictionary entries I have mentioned above when it was seen or heard by a reasonably well-informed and reasonably

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<sup>8</sup> [2004] UKHL 46; [2005] RPC 9 at para. 32.

observant and circumspect consumer in the market for goods and services of the kind in respect of which the objection to registration succeeded<sup>10</sup>. It follows, in my view, that the objection to registration under section 5(2)(b) ought to have been assessed upon the footing that the marks in issue were similar by reason only of the fact that they both contained graphic representations of a word which was likely to be understood in the relevant sectors of commerce as denoting **FOREIGN EXCHANGE**. From that perspective the marks would naturally be seen as figurative marks based on a verbal component referring to foreign exchange and the foreign exchange market.

21. The verbal component is prominent in both marks, but it is not distinctive relative to financial goods and services of the kind specified. Taken as a whole, the marks are visually, aurally and conceptually similar without being in any of those respects distinctively similar. They are visually and conceptually dissimilar to a degree which leads me to conclude that each of them taken as a whole is distinctively different from the other. On weighing the differences and similarities between them, I am satisfied that the marks could co-exist in the market place for goods and services of the kind in issue without giving rise to the existence of a likelihood of confusion and would have done so at the relevant date (13 December 2005).

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<sup>9</sup> [2008] ECR I-00000; [2008] RPC 33 at para. 66.

<sup>10</sup> see paragraph 6 above.

## Conclusion

22. The appeal is allowed. The Hearing Officer's decision is set aside. The opposition is dismissed. The application for registration is remitted to the Registrar for further processing in accordance with the Act and the Rules.

23. I am willing to make an order for costs in favour of the Applicant as the successful party, but in doing so I intend to take account of the fact that it provided the Hearing Officer with no assistance by way of evidence or argument directed to the particular point upon which it has succeeded on appeal. Looking at matters in the round, I think it is appropriate to order the Opponent to pay £750 to the Applicant as a contribution towards its costs of the proceedings in the Registry and on appeal, to be paid within 21 days of the date of this decision.

**Geoffrey Hobbs QC**

16 April 2009

Jane Nelson of Urquhart-Dykes & Lord LLP appeared on behalf of the Applicant.

The Opponent was not represented at the hearing of the appeal.

The Registrar was not represented at the hearing of the appeal.