

O/235/16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3095599
BY VEROFY LTD
TO REGISTER**



IN CLASSES 36 AND 42

AND:

**OPPOSITION THERETO UNDER NO. 404634
BY VFX FINANCIAL PLC**

BACKGROUND AND PLEADINGS


1. On 22 February 2015, Verofy Ltd (the applicant) applied to register the trade mark shown on the cover page of this decision in classes 36 and 42 of the Nice Classification system.¹

2. For the purpose of this opposition the contested services are as follows:

Class 36

Charge card and credit card services; Charge-card services; Computerised banking services; Computerised financial advisory services; Computerised financial analysis; Computerised financial data services; Computerised financial information services; Computerised financial services; Computerised financial services for retail businesses; Computerised information services relating to banking matters; Computerised information services relating to financial business; Credit and cash card services; Credit and debit card services; Credit card and debit card services; Credit card and payment card services; Credit card management services; Credit card payment processing; Credit card protection and registry services; Credit card services; Credit card transaction processing services; Credit card validation services; Credit card verification; Credit cards services; Merchant bank (services of a-); Merchant banking; Merchant banking services; Monetary exchange; Monetary transaction services; Monetary transactions; Money exchange and transfer; Payment administration services; Payment and receipt of money as agents; Payment processing; Payment transaction card services; Tokens of value (Issue of -).

3. Following publication of the application on 20 March 2015, Pay2Global Limited filed a notice of opposition directed against the services in class 36 of the application. Following an assignment,² the opposition now stands in the name of VFX Financial PLC (the opponent). The opposition is based upon grounds under sections 5(2)(b) of the Trade Marks Act 1994 (“the Act”)³. The opponent relies upon the following mark and services:

Mark details:	Services
<p>TM: 2563837</p> <p>A series of two marks:</p> <p style="text-align: center;">MoBe</p> <p>And:</p> 	<p>Class 36</p> <p>Financial services, financial affairs; monetary affairs including banking; money transfer services; electronic money transfer services; online money transfer services; payment services; electronic payment services; online payment services; payment and receipt of money as agents; enabling the transfer of funds to facilitate the purchase of products and services offered by others, all via electronic communication networks; clearing and reconciling financial transactions via electronic communication networks; mobile telephone top-up and credit services; credit or pre-pay services for use in the purchase of goods and services;</p>

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

² *Dated 5 November 2015.*

³ *The opposition originally included a 5(3) ground which was not pursued.*

<p>Filing date: 10 November 2010</p> <p>Date of registration: 1 April 2011</p>	<p>bureau de change services; foreign exchange services, brokerage of currency, buying and selling of currency; issue of tokens of value; issuing of gift vouchers; issue of vouchers and discounts; banking services, home banking, online banking, virtual banking, telephone banking; clearing services; clearing-house services; credit card, charge card, cash card and debit card services; issuing electronic money; escrow services, online escrow services; auction payment services; online auction payment services; providing financial fraud protection and prevention and dispute resolutions services; charity fundraising services; advice, consultancy and information services relating to any of the aforesaid services.⁴</p>
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4. On 29 September 2015, the applicant filed a counterstatement in which it denies the grounds of opposition.

5. The opponent elected to file written submissions during the period allowed for filing evidence. Neither side requested to be heard, nor did they file submissions in lieu of attendance at a hearing.

6. I make this decision following a review of all of the papers before me.

DECISION

7. Section 5(2)(b) of the Act states:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

8. 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.

⁴ On its opposition form the opponent appears to rely on all of its goods and services in classes 9, 35, 36 and 38. In its attached statement of grounds and submissions it identifies the competing goods as being those in class 36.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. The opponent's series mark is an earlier mark which is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.⁵

Section 5(2)(b) case law

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

The principles

“(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

⁵ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

Preliminary issues

11. The applicant submits in its statement of grounds:

“POINT 13: As stated above the brand Mobicard is not consumer focussed and we will not be selling our products and services to consumers. Also [the opponent] states identical services, we have not made clear what our services are so we are unsure as to how the opponent can claim the Subject Mark is for identical services.”

12. Until a trade mark has been registered for five years (when the proof of use requirements set out in s.6A of the Act kick in), it can be relied upon for all goods and services for which it is registered. Consequently, the opponent’s earlier UK mark must be entitled to rely on the services for which it is registered in class 36 without the opponent needing to prove any use its mark in relation to those services.

13. So far as the applicant’s proposed use of its mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*⁶, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of

⁶ Case C-533/06

registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

14. Similarly, differences between the services currently provided by the parties are irrelevant, as is the intended market, except to the extent that those differences are apparent from the lists of services they have tendered for the purpose of the registration of their marks.

15. Views expressed by the parties relating to marks which are not those shown on the register, marks which they might have decided to register as an alternative or the future use of a mark with material added, are irrelevant factors in these proceedings.

16. In determining whether or not there will be a likelihood of confusion, I must consider the opponent's specification as registered, since it is not subject to proof of use. This must be compared with the applicant's specification as published.

The average consumer and the nature of the purchasing act

17. In accordance with the above cited case law, I must determine who the average consumer is for the services at issue and also identify the manner in which those services will be selected in the course of trade.

18. 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.”

19. The average consumer for the services at issue may be a member of the general public or a professional/business. A member of the general public may take advantage of credit card services or make an online auction payment but the commissioning and purchase of some of the services, such as credit card transaction processing services, clearing-house services or online escrow services are more likely to be made by a business or professional.

20. The services in the respective parties' specifications are wide ranging and disparate. Consequently, the manner in which they will be selected, and the degree of care that will be taken by the average consumer during their selection, is also likely to vary accordingly. A member of the general public buying currency for a holiday is likely to choose those services visually and is likely to pay no more than average degree of attention when doing so. A business user commissioning an undertaking to provide merchant banking services or provide computerised financial services for its retail business, on the other hand, is likely to pay considerable attention to what is likely to be an expensive purchase. The process is likely to include an initial review of potential candidates (e.g. by using specialist publications and websites) and may include a range of meetings with various undertakings to discuss various options and their costs.

Consequently, a mixture of both visual and aural considerations is likely to come into play and a high degree of attention is likely to be paid to the selection of such services. Due to the wide ranging nature of the respective parties' services I will return to the issue of the average consumer when I consider the likelihood of confusion later in this decision.

Comparison of services

21. The services to be compared are as follows:

Opponent's services	Applicant's services
<p>Class 36 Financial services, financial affairs; monetary affairs including banking; money transfer services; electronic money transfer services; online money transfer services; payment services; electronic payment services; online payment services; payment and receipt of money as agents; enabling the transfer of funds to facilitate the purchase of products and services offered by others, all via electronic communication networks; clearing and reconciling financial transactions via electronic communication networks; mobile telephone top-up and credit services; credit or pre-pay services for use in the purchase of goods and services; bureau de change services; foreign exchange services, brokerage of currency, buying and selling of currency; issue of tokens of value; issuing of gift vouchers; issue of vouchers and discounts; banking services, home banking, online banking, virtual banking, telephone banking; clearing services; clearing-house services; credit card, charge card, cash card and debit card services; issuing electronic money; escrow services, online escrow services; auction payment services; online auction payment services; providing financial fraud protection and prevention and dispute resolutions services; charity fundraising services; advice, consultancy and information services relating to any of the aforesaid services.</p>	<p>Class 36 Charge card and credit card services; Charge-card services; Computerised banking services; Computerised financial advisory services; Computerised financial analysis; Computerised financial data services; Computerised financial information services; Computerised financial services; Computerised financial services for retail businesses; Computerised information services relating to banking matters; Computerised information services relating to financial business; Credit and cash card services; Credit and debit card services; Credit card and debit card services; Credit card and payment card services; Credit card management services; Credit card payment processing; Credit card protection and registry services; Credit card services; Credit card transaction processing services; Credit card validation services; Credit card verification; Credit cards services; Merchant bank (services of a-); Merchant banking; Merchant banking services; Monetary exchange; Monetary transaction services; Monetary transactions; Money exchange and transfer; Payment administration services; Payment and receipt of money as agents; Payment processing; Payment transaction card services; Tokens of value (Issue of -).</p>

22. In comparing the services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM)*, Case T-133/05, which, while referring to goods, is equally applicable in principle when considering the parties' respective services:



“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

23. All of the services in the applicant's specification fall within the following broad terms contained in class 36 of the opponent's specification: credit card, charge card, cash card and debit card services; financial affairs, monetary affairs including banking, home banking, online banking and virtual banking; information services; payment services.

24. In conclusion, all of the applicant's services in class 36 of its specification are identical to services listed in the opponent's class 36 specification. In its statement of grounds the opponent sought to rely on all of its goods and services in classes 9, 35, 36 and 38, whilst in its submissions it only compares its class 36 services to those of the applicant. Having made the finding I have in respect of class 36, the opponent is in no better position if I were to compare its remaining classes against the services listed in the application, and I decline to do so.

Comparison of trade marks

25. The competing trade marks are as follows:

The opponent's trade mark	The applicant's trade mark
	

26. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁷, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

27. The first of the opponent's earlier trade marks (in a series of two) consists of the letters 'MoBe', presented in black. The capitalisation of the M and B serve to create a natural break between the first two letters and the second two. In the second mark of the series the presentation of the letters is the same with the additional feature that the second two letters, 'Be' are presented in pink, further emphasising the natural break between, 'Mo and 'Be'. In the second mark the word is presented over a grey shaded background which fades from white at the top to a darker grey at the bottom. A slight shadow of the letters, 'MoBe' is visible, reflected in the grey background. The overall impression of the first mark rests entirely in the letters, MoBe. In the second

⁷ *Sabel v Puma AG, para.23*

mark the overall impression is dominated by the letters 'MoBe', the background being given no origin significance and the slight shadow of the lettering likely to go largely unnoticed.

28. The applicant's mark comprises the word 'mobicard' presented in lower case in white. The background to the word is a blue rectangle with rounded corners which is turned to the left by about 20 degrees, resulting in a diagonal presentation with its lowest point situated bottom left. The word is shown horizontally across the centre of the rectangle shape. The rectangle has a thin white outline, made visible by a faint grey drop shadow, which is stronger at the bottom of the mark. To the left of the word is a small blue circle with a white outline which sits just below the letter 'm' of 'mobicard' and about half way up the left side of the rectangle shape.

29. I note that the opponent submits that the dominant and distinctive element of the applicant's mark is the first four letters of the word, namely, 'mobi'. Whilst I except that for some of the services in class 36, the 'card' element is not particularly distinctive, the word in the mark applied for is 'mobicard' and that is how it will be seen by the average consumer. Artificially dissecting the mark and making the comparison on the basis of the first four letters would not be a correct application of the law I have outlined above.

30. The background is not simply a plain blue rectangle. A number of elements, inter alia, the angle of its presentation and the white outline, give it a 'designed' feel. Consequently, it would not go unnoticed by the average consumer and it plays a part in the overall impression of the mark. However, the word 'mobicard' plays the greater role and dominates the overall impression.

Visual similarities

31. Visual similarity between the marks rests in the first three letters of each which are M-O-B. In the application they are part of the longer word 'mobicard' all presented in lower case. In the opponent's mark they are part of 'MoBe', the M and B being presented in upper case, either side of a lower case 'o'. Visually this is a noticeable difference, as is the blue tilted rectangle behind the word 'mobicard' in the application. A further difference is provided by the second of the opponent's mark, where the 'Be' element is presented in pink. Taking all of these factors into account, visual similarity between these marks is low.

Aural similarities

32. The opponent states that the applicant's mark will be pronounced, MOB-EE-CARD. I think that is the most likely pronunciation which will be adopted by the average consumer. It also submits that its own mark will be pronounced the same as the first two syllables in the application, namely, MOB-EE. Given the natural break in the opponent's mark, created by the capitalisation of the first and third letters, it is more likely that the opponent's earlier marks will be pronounced, MOE-BEE. In either case, these marks are aurally similar to at best a medium degree.

Conceptual similarities

33. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁸ The assessment must be made from the point of view of the average consumer.

34. The opponent's series of marks have no meaning in English and will be considered to be invented words by the average consumer. They are therefore, conceptually neutral.

Distinctive character of the opponent's earlier trade marks

35. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

36. I have no evidence of use of the earlier MoBe series mark, so I need only consider its inherent distinctive character. MoBe is an invented word which is not allusive of the services for which it is registered. As a consequence the mark enjoys a high level of inherent distinctive character.

Likelihood of confusion

37. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁹ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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 vice versa.

38. I have made the following findings:

- The parties' marks are visually similar to a low degree.
- The parties' marks are aurally similar to at best a medium degree.
- They are conceptually dissimilar.
- The respective services in class 36 are identical.
- The average consumer may be a member of the general public, a professional or a business. The purchasing process and attention paid varies according to the particular services at issue.
- The earlier series of marks has a high degree of inherent distinctive character.

39. In making a finding in respect of the services in class 36, I bear in mind the decision in *Aldi GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks*

⁸ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

⁹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

and Designs) (OHIM)¹⁰, which related to goods but is equally applicable to services, in which the GC stated:

“91 In addition, the Opposition Division considered that the goods at issue were identical, as was recalled in the contested decision, without the Board of Appeal’s taking a final decision in that regard (see paragraph 40 et seq. above). That implies, in accordance with the case-law cited at paragraph 23 of the present judgment, that, if there is to be no likelihood of confusion, the degree of difference between the marks at issue must be high (see, to that effect, judgment of 29 January 2013 in Case T-283/11 *Fon Wireless v OHIM – nfon (nfon)*, not published in the ECR, paragraph 69).”

40. I have found there to be some similarities between the marks but also some differences which, in my view, are not trivial. The average consumer, through whose eyes this matter must be assessed, may be a professional (paying a high level of attention to technical and expensive financial services) or a member of the general public (using a bank or applying for a credit card). In dealing with financial matters the level of attention paid by the average consumer will be at least average. The nature of the purchase is primarily visual, though I do not rule out an aural element, particularly where a financial advisor may be consulted. Taking into account all relevant factors I find that the differences between the marks far outweigh the similarities even where identical services are involved.

Conclusion

41. The opposition under section 5(2)(b) of the Act fails.

Costs

42. The opposition having failed, the applicant is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place and that the applicant did not file evidence or submissions. I make the award on the following basis:

Preparing a statement and considering the applicant’s statement:	£300
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Total:	£300
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43. I order VFX Financial PLC to pay Verofy Ltd the sum of **£300**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of May 2016

**Ms AI Skilton
For the Registrar,
The Comptroller General**

¹⁰ Case T-505/11