

O/622/20

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF TRADE MARK
APPLICATION UK00003368278
BY CRYPTOPAY LTD**

AND

**IN THE OPPOSITION THERETO
UNDER NO. 416126 BY
BNP PARIBAS PERSONAL FINANCE**

AND

**IN THE MATTER OF THE INTERNATIONAL
REGISTRATION NOS. WO0000001483567, WO0000001462316
AND WO0000001462220 BY
BNP PARIBAS PERSONAL FINANCE**

AND

**IN THE OPPOSITION THERETO UNDER
NOS. 417912, 417913 AND 417914 BY
CRYPTOPAY LTD**

BACKGROUND AND PLEADINGS

1. These are consolidated cross-opposition proceedings between BNP Paribas Personal Finance (“BNP”) and Cryptopay Ltd (“CL”). I will first set out the background regarding the parties’ respective marks before setting out the basis for each party’s opposition.

BNP’s marks

2. In December 2018, BNP applied to register the following international trade mark registrations:



International registration no. 1483567

Colours claimed: Green Pantone No. 7740C

Priority date 13 June 2018

(“the 567 mark”);



International registration no. 1462316

Colours claimed: Pantone No. 7740C

Priority date 11 June 2018

(“the 316 mark”); and



by **cetelem**

International registration no. 1462220

Colours claimed: Pantone No. 7740C

Priority date 11 June 2018

("the 220 mark").

3. The goods and services for which BNP seeks to protect the 567, 316 and 220 marks (collectively, "BNP's marks") for in the UK are shown in **Annex 1** to this decision. I note that the 316 and 220 marks' specifications are identical whereas the 567 mark's specification differs.
4. BNP's international marks were registered on 10 December 2018. With effect from the same date, BNP designated the UK as a territory in which it seeks to protect BNP's marks under the terms of the Protocol to the Madrid Agreement. The 567 mark was published for opposition purposes on 6 September 2019, the 316 mark was published for opposition purposes on 12 July 2019 and the 220 mark was published for opposition purposes on 2 August 2019.

CL's mark

5. On 18 January 2019, CL applied for the following trade mark:

C.PAY

for the following goods and services:

Class 9: Computer software; mobile application software; computer software for use in electronically trading, storing, sending, receiving, accepting, and transmitting digital currency, and managing digital currency payment and exchange transactions;

credit cards; encoded cards; encoded prepaid payment cards; apparatus for processing electronic payments.

Class 36: Financial services; banking services; issuance of credit cards; electronic funds transfer; currency exchange services; digital currency exchange services; facilitating transfers of electronic cash equivalents; digital currency exchange transaction services for transferrable electronic cash equivalent units having a specified cash value; financial consultancy; provision of financial information; investment services; payment processing services; wireless wallets.

("CL's mark")

6. CL's mark was published for opposition purposes on 25 January 2019.

BNP's opposition

7. On 24 April 2019, BNP filed a notice of opposition against CL's mark. The opposition against CL's mark is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and relies upon BNP's marks. BNP relies on some of the goods and services for which its international marks are registered, being those in classes 9 and 36. The goods and services upon which BNP relies are shown in the **Annex 2** to this decision. I note that the 220 mark and the 316 mark share identical specifications, but the 567 mark's specification differs.

8. BNP states that there exists a likelihood of confusion on the part of the public between CL's mark and BNP's earlier marks. CL filed a counterstatement denying the claims made.

9. The relevant date for the purposes of BNP's opposition to CL's mark is 18 January 2019.

CL's opposition

10. On 1 October 2019, CL filed notices of opposition against BNP's marks. CL's oppositions are based on section 5(4)(a) of the Act and are aimed at all goods and services of BNP's marks.
11. In its notices of opposition, CL states that its mark has been used extensively throughout the UK since May 2017 and that it has built up substantial goodwill in relation to the following goods and services:

“Prepaid cards; credit cards; encoded cards; encoded prepaid payment cards; digital wallets, bitcoin wallets, and related computer software and services relating to regulatory compliance and the bitcoin exchange; mobile application software; apparatus for processing electronic payments; issuance of credit cards; electronic funds transfer, currency exchange services; financial consultancy; provision of financial information; investment services; payment processing service.”
12. CL states that the use of BNP's marks would misrepresent the goods and services for which protection is sought in respect of CL's mark and that such use would damage CL's business and goodwill, including diluting the rights of the name 'C.PAY'. BNP filed counterstatement denying the claims made.
13. The relevant date for the purposes of CL's opposition to BNP's marks are 11 June 2018 in respect of the 316 and 220 marks and 13 June 2018 in respect of the 567 mark.
14. By letter dated 4 November 2019, the Tribunal confirmed to the parties that the proceedings were to be consolidated pursuant to Rule 62(1)(g) of the Trade Marks Rules 2008.
15. CL is represented by Haseltine Lake Kempner LLP and BNP is represented by CSY London. Only CL filed evidence in chief in the form of the witness statement

of Dmitrii Guniashov dated 27 January 2020. While BNP did not file any evidence in chief, it did file evidence in reply in the form of the witness statement of Lorna Hobbs dated 25 August 2020. No hearing was requested and both parties filed written submissions in lieu of a hearing. I have taken the evidence and the written submissions into consideration and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

EVIDENCE

16. As above, both parties have filed evidence and I will summarise their most pertinent points below.

CL's evidence

The Witness Statement of Dmitrii Guniashov

17. Mr Guniashov is the director of CL, a position he has held since 14 October 2013, being the date of the company's incorporation. He states that CL is a global digital currency service provider. Mr Guniashov has exhibited print outs from CL's website, being www.cryptopay.me¹. The printouts are undated and will, therefore, not assist CL.

18. Mr Guniashov goes on to discuss CL's relationship with two separate companies, being CPS Transfers Ltd ("CPS Transfers") and CPay Foundation Ltd ("CPay Foundation"). I note that CPS Transfers is referred to as a sister company of CL and that Mr Guniashov and Mr Georgii Basiladaze are the persons with significant control of both companies. I also note that CPay Foundation is a company incorporated in the Cayman Islands and that Mr Guniashov is not a director or shareholder. However, the director and sole shareholder is Mr Basiladaze, being the co-director and shareholder of CL and CPS Transfers. Throughout the evidence, Mr Guniashov explains use of the mark by CPS Transfers. Mr Guniashov sets out towards the end of his statement that since 2016, CPS Transfers has used

¹ Exhibit DG3

CL's mark with its consent and that, in September 2019, all unregistered rights and goodwill in CL's mark were assigned from CPS Transfers to CL. Mr Guniashov states that any goodwill arising from any use of the mark by CPS Transfers now belongs solely to CL. A copy of the trade mark assignment and license agreement dated 17 September 2019 is attached confirming this.²

19. The development of the C.PAY brand is then discussed. Mr Guniashov explains that C.PAY is a shortened version of Cryptopay, which was the name previously used on the company's pre-paid cards. C.PAY is the second generation of the company's pre-paid cards, with the first generation being launched in early 2015. Mr Guniashov states that the first generation Cryptopay card was one of the first cards that linked to digital currency on the market.

20. A basic explanation of how the Cryptopay pre-paid card works is provided. I note that its purpose is to act as a pre-paid card wherein users can use their bitcoins in day-to-day life. Mr Guniashov sets out that bitcoin consists of complex financial and technical infrastructures and that the C.PAY pre-paid card is provided so that it can be accessed in a user-friendly manner.

21. Mr Guniashov proceeds to discuss the reasoning behind the selection of the term C.PAY and the development of the product. I note that Mr Guniashov sets out that by August 2017, CL was one of the longest running digital currency service providers in Europe. During the development of the C.PAY card, CL engaged the services of a card producer and approval of the design of the pre-paid cards was signed on 12 December 2016. I note that on the proof approval forms provided,³ a total of 5,000 cards were ordered for manufacture on 9 January 2017 and a total of 10,000 cards were ordered for manufacture on 25 July 2017.

22. The C.PAY card was launched in the UK and globally in May 2017 by CPS Transfers. A printout from CL's website which shows the C.PAY pre-paid card is included.⁴ I note that this printout was obtained via the internet archive programme,

² Exhibit DG15

³ Exhibit DG5

⁴ Exhibit DG6

'The Wayback Machine', and is dated 30 May 2017 and that it shows promotional material for the C.PAY card. Mr Guniashov states that the C.PAY cards were available for order and were issued to customers during the period of 7 August 2017 to 3 October 2017.

23. Despite Mr Guniashov's comments regarding the time period above (being 7 August to 3 October 2017), he goes on to state that the first batch of cards were issued on 18 July 2017 and a number of scans of these cards are included.⁵ I note that the names and numbers of the cards have been removed. Further, the scan is undated and I note that of the seven cards shown, only one lists British Sterling as its currency. Mr Guniashov then goes on to state that the first card ordered by someone with a UK address was on 15 August 2017.

24. Mr Guniashov states that, during this period, a total of 5,709 cards bearing the word C.PAY were issued. Given that Mr Guniashov has stated that the first batch of cards were issued on 18 July 2017 but also that the first card was ordered on 7 August 2017, it is not clear what period Mr Guniashov is referring to here. Of the 5,709 cards issued, 1,602 were delivered to EU customers and, of those, 543 were delivered to UK customers. A spreadsheet is attached that shows the delivery location and issue date of each of those cards within the UK. However, I note that the spreadsheet shows 544 cards being issued. The recipients of the cards are spread throughout the UK, including London, Bristol, Manchester, Hull, Northern Ireland, Scotland and Wales. Despite Mr Guniashov's comments regarding the timeframes of availability of the cards, two of the cards appear to have been issued in March 2017, with the remaining cards being issued from July 2017 onwards. These cards were available for order in the UK until 3 October 2017 when the programme was closed.

25. Between 2 October 2017 and 1 November 2017, CPay Foundation held an initial coin offering ("ICO") to assist in financing the development of new products and to acquire appropriate licenses in Europe and Asia. The purpose of the ICO was to sell a new type of cryptocurrency (or token) with the designation C.PAY. A 'White

⁵ Exhibit DG7

Paper' dated 25 September 2017 has been provided that sets out information regarding the ICO and the CPAY token.⁶ The evidence sets out that the ICO's aim was to raise funds so that CL could expand its business and develop new products. The process of the ICO was that the customer would purchase tokens from CPay Foundation as a form of investment in CL and that the amount invested is returned to the customer together with further returns that are dependent upon CL's performance. Within the 'White Paper' I note the following:

- a. The CPAY tokens are purchased from and distributed by CPay Foundation, who are defined in the document as the 'Distributor';
- b. "ICO's have quickly grown to account for more start-up funding in blockchain-based companies than all of Venture Capital";
- c. The funds raised from the ICO will allow CL to accelerate the building of its new platform which needs a higher volume of loans than they were able to support at the time the White Paper was issued;
- d. The repayments and the rewards to the customers are distributed by CPay Foundation; and
- e. After the ICO ends, no further CPAY tokens will be issued.

26. No evidence has been provided as to who was sent the 'White Paper' document and what regions it was aimed at, although I do note that citizens of the USA, Canada and the Republic of Singapore were exempt from participating in the ICO. Further, UK citizens were only permitted to partake if they were self-certified sophisticated investors. I have no evidence or submissions as to what this means.

27. As a result of the ICO, the CPay Foundation attracted investments of more than 6 million US dollars. During the ICO phase, a total of 90,414,745 C.PAY tokens were issued by CPay Foundation.

28. CL also operates a digital wallet, which is what is used to access cryptocurrencies. CL's digital wallet is available via its website or via an app that is available for both Apple iOS and Android devices. The digital wallet has been offered to members of

⁶ Exhibit DG9

the general public since the beginning of 2014. The iOS app has been available since 5 June 2017 and the Android app was been available since 9 November 2017. Screenshots of the Google Play store (where the Android app can be downloaded) and the App Store (where the iOS app can be downloaded) are enclosed. I note that in both printouts, the apps are called 'C.PAY'. However, I note that neither of these printouts are dated.

29. Mr Guniashov proceeds to discuss the marketing of CL's mark. He sets out that marketing expenditure in the UK between August and October 2017 totaled approximately \$250,000 and that most of the PR services are provided by a company based in Bulgaria. I note Mr Guniashov has provided three invoices in respect of marketing conducted during the ICO⁷ which total the sum of \$87,600. These invoices appear to relate to online advertising on 69 websites. I note that of the websites listed, only two are UK websites (being '.co.uk' websites) with the remainder being '.com', '.eu', '.net', '.co' or '.org'. Mr Guniashov states that CL's mark has a large UK following and a number of customers based in the UK.

30. A number of online articles are provided⁸ and I note that Mr Guniashov states that they are accessible worldwide, including the UK. While I note the content of the articles provided, no information is provided regarding the number of visitors from the UK that have accessed these articles.

31. Mr Guniashov states that CL has been present on twitter since June 2013 and on facebook since 9 October 2013. Printouts of CL's twitter and facebook pages are attached.⁹ I note that the pages refer to 'Cryptopay' and not CL's mark. Additionally, the printouts are undated save for one that is dated after the relevant date. While I note that some of the posts shown are dated, they are all dated after the relevant date. Therefore, these printouts do not assist CL.

32. CL also has a community forum hosted on 'Bitcoin Forum' that was set up on 3 March 2016. A printout from the forum is attached to the statement that shows a

⁷ Exhibit DG11

⁸ Exhibit DG12

⁹ Exhibit DG13

number of posts from 2016. While I note that these posts are before the relevant date, there is no information explaining whether these users are from the UK. Additionally, the posts refer to 'Cryptopay' and not C.PAY.

33. Mr Guniashov has provided a table showing how many members of the public have accessed the C.PAY website. The table is reproduced below:

Year:	Web users	UK web users
2017	2,845,078	243,462
1 Jan 2018 to 13 June 2018	1,358,301	105,336
14 June 2018 to 31 Dec 2018	469,126	51,398
1 Jan 2019 to 25 June 2019	298,352	49,427
Total:	4,970,857	449,623

34. It is Mr Guniashov's understanding that C.PAY has a 5% share of the relevant market in the UK. Mr Guniashov believes that "5% represents the percentage of bank cards issued in the UK with the option to load proceeds from sale of cryptocurrency, that is issued in the [sic] conjunction with Cryptopay during years 2016-2017." I note that this isn't based on precise calculations but rather a general understanding of the size of the company in relation to its market and competitors.

35. Finally, figures for goods purchased under CL's mark in the UK are also provided. The figures cover the year 2017. I will not reproduce the table in full but I note the following:

- a. 128 payments were made in the UK using the C.PAY cards;
- b. the total value of transactions processed with C.PAY cards in the UK was 17,701 euros; and
- c. of the ICO token sale referred to at paragraph 25 above, the total value of tokens issued in the UK was €5 million.

BNP's evidence

Witness Statement of Lorna Hobbs

36. Ms Hobbs is a Chartered Trade Mark Attorney who represents BNP. Ms Hobbs sets out that she has conducted research regarding the number of card payments issued in the UK. A document published in November 2018 by UK Finance is enclosed¹⁰ that shows the number of payment cards issued in the UK at the end of 2017 was 175,700,000. This is broken down to 98.2m debit cards, 58.6m credit cards, 13.4 ATM cards and 5.5m charge cards. This document is dated after the relevant dates for CL's opposition but before the relevant date for BNP's opposition. In any event, the figures provided in respect of the total number of cards issued in the UK isn't likely to have changed substantially over the relatively short period between the publication date and the relevant dates for CL's opposition. I, therefore, consider this evidence relevant as it indicates the likely size of the market around the relevant dates. Ms Hobbs also encloses information about UK Finance by way of a printout from its website.¹¹ While I note its contents, I also note that the printout is dated 25 August 2020 and is, therefore, dated after the relevant date.

37. Ms Hobbs states that 162.5m payment cards were in use in the UK in 2018. This information was obtained from an online article dated 3 July 2020¹² and published on a website called Statista. A printout from Statista dated 25 August 2020 is enclosed¹³ and I note that it describes itself as a leading provider of market and consumer data. While these printouts are dated after the relevant date, I consider them to be relevant given that the information obtained relates to the market size around the relevant date.

38. Ms Hobbs states that she reviewed the cryptopay.me website on 9 March 2020 and on 25 August 2020.¹⁴ While I note her comments, they relate to CL's business activities after the relevant date. Given that the evidence submitted by CL states

¹⁰ Exhibit LH1

¹¹ Exhibit LH2

¹² Exhibit LH3

¹³ Exhibit LH4

¹⁴ Exhibits LH5 and LH6

that its activities in relation to the C.PAY card ended in October 2017, I do not consider that the evidence provided by Ms Hobbs reflects CL's activities prior to the relevant date. They are not, therefore, relevant to these proceedings.

39. The remainder of Ms Hobb's statement discusses research she has undertaken in respect of the nature of cryptocurrencies and their associations to major banks and building societies. Ms Hobbs has also included printouts from major bank's websites¹⁵, an extract from the Bank of England's website that discusses cryptocurrency,¹⁶ a consultation document published by HM Treasury,¹⁷ extracts from the Financial Conduct Authority's website,¹⁸ and various online articles.¹⁹ While I note Ms Hobbs's comments, I do not consider them important to the outcome of these proceedings.

DECISION

40. If CL's opposition under section 5(4)(a) of the Act is successful, BNP's marks will not proceed to registration in the UK. Consequently, BNP's opposition under section 5(2)(b) of the Act will fall away because BNP's marks will no longer be capable of being relied upon. I will, therefore, proceed with assessing CL's opposition first. If successful, I will proceed no further. However, if unsuccessful, I will proceed to assess BNP's opposition.

Section 5(4)(a)

41. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

¹⁵ Exhibits LH7 – LH8

¹⁶ Exhibit LH9

¹⁷ Exhibit LH10

¹⁸ Exhibits LH11 – LH14

¹⁹ Exhibit LH15

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

42. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

43. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per

Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”

44. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant Date

45. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

46. The relevant date for assessment of CL's claim under section 5(4)(a) of the Act is the priority dates of BNP's marks, namely, 11 June 2018 for the 316 and 220 marks and 13 June 2018 for the 567 mark.

Goodwill

47. The first hurdle for CL is that it needs to show that it had the necessary goodwill in the sign 'C.PAY' at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

48. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

49. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

50. Goodwill arises as a result of trading activities. From the evidence provided, CL appears to have operated as a business which traded in pre-paid C.PAY branded payment cards and a C.PAY digital wallet. It also claims to have traded in ‘CPay tokens’. I will now consider the extent to which CL has acquired goodwill (if any) in its business activities as a whole.

51. The evidence sets out that the digital wallet can be accessed via CL's website and a ‘C.PAY app’ that is available on both the iOS and Android app stores. Firstly, I note that there are no figures regarding the users of the C.PAY apps and the printouts provided are undated. Further, while there are figures regarding users from the UK visiting CL's website, there is no evidence that these users visited the website to conduct any business.

52. When assessing goodwill, I am reminded of the fact that absent an agreement to the contrary, the goodwill of a business is owned by the undertaking that the customers perceive as being responsible for the trade.²⁰ In respect of the ICO, I note the following:

- a. The introduction section of the 'White Paper' document confirms that it was issued by CPAY Foundation;
- b. CPAY Foundation is defined within the document as 'the Distributor';
- c. There is one formal reference to CL throughout the document and that is within the legal disclaimer section of the document wherein it states:

"Prospective acquirers of CPAY tokens should carefully consider and evaluate all risks and uncertainties associated with the cryptocurrencies, Cryptopay Ltd and their respective businesses and operations, the CPAY tokens and the CPAY Initial Coin Offering.";
- d. The word 'Cryptopay' is used throughout the document but is not a defined term. While general business activities of 'Cryptopay' are referred to, it is also used in reference to various types of products or services such as a pre-paid card, the Cryptopay wallet, the Cryptopay UI, Merchant Processing, Brokerage Services and Cryptopay online accounts;
- e. The 'CPAY Initial Token Sale' section expressly states that the 'Distributor', being CPay Foundation, is the company that offers the tokens for sale. Mr Guniashov, in his statement, confirms that it is CPay Foundation that will pay the aggregate revenue to the holders. Further, the 'White Paper' states that CPay Foundation will retain 10% of CPAY tokens, to be used for various purposes; and
- f. In the 'Conclusion' section of the document, it states that:

"With the ICO to be conducted by the Distributor, a wide range of individuals will have the opportunity to participate in our long-term growth and success story to fundamentally change the world of payments, brokerage and banking."

²⁰ *MedGen v Passion For Life* [2001] FSR 30

53. Based on the evidence provided, I do not consider that upon purchasing CPay tokens, a customer would see CL as one of the entities behind the ICO itself. Instead, I find that the customer would identify CPay Foundation as the entity responsible for the ICO with CL being seen as the company upon which the customer's investment relies. While the customer would be dependent upon CL's performance, goodwill arises out of trading activities and there is no customer/trader relationship between the customer and CL. The customer/trader relationship is between the customer and CPay Foundation. Further, there is no contemporaneous agreement through which any goodwill generated by CPay Foundation enured to CL. While there is evidence that CL acquired the goodwill owned by CPS Transfers prior to filing the opposition, there is no evidence that CPS Transfers owned the goodwill generated by CPay Foundation or that CPay Foundation assigned its goodwill directly to CL. Therefore, any goodwill in respect of this business activity accrues to CPay Foundation. This business does not, therefore, assist CL in establishing goodwill in its mark under the section 5(4)(a) grounds of its opposition.

54. Even if the goodwill generated from the ICO was to reside in CL, I do not consider that the evidence provided is reliable enough in order to demonstrate goodwill in the UK. My reasons follow.

55. Of the evidence relating to the 'CPay tokens', I note the following:

- a. CL stated that it obtained \$6 million worth of investments during its initial offering. The evidence does not set out what countries the ICO was available in, but I note that the 'White Paper' provided by CL sets out that the ICO was not available to citizens, residents or green card holders of the USA, Canada or Republic of Singapore;
- b. The ICO's availability was restricted in the UK to self-certified sophisticated investors only. I have no evidence or submissions to explain what this means; and
- c. Of the \$6 million worth of investments, there is no evidence as to whether these consumers were in the UK. However, I note further in CL's evidence,

it states that a total of €5 million worth of CPay tokens were issued in the UK in 2017.

56. Firstly, the figures provided in relation to the investments during the ICO appear inconsistent in that \$6 million appears to be the entirety of investments achieved via the ICO but that €5 million worth of tokens were purchased by UK customers during the ICO. Given the approximate exchange rate between US dollars and euros, this would suggest that the UK market makes up the entirety of the customer base of the CPay tokens. I am skeptical that this is the case, particularly given that the evidence relating to advertising expenditure shows only 2 of the 69 websites being directed at the UK. In addition, I have set out at paragraph 25 above that one of the purposes of the ICO was to use the funds to acquire appropriate licenses in Europe and Asia. This would indicate that CL intended to trade in both continents. Given the inconsistencies within the evidence, I do not accept that the entirety of the investments obtained during the ICO was solely within the UK.

57. In further consideration of CL's UK customers, I note that the evidence states that CL has a 'number of customers in the UK'. No breakdown of customers is given in respect of the investment obtained via the ICO. This evidence is seemingly vague, particularly in contrast to specificity of CL's evidence regarding the UK customers of the C.PAY pre-paid payment card. From the evidence provided, I am unable to determine how many actual UK customers there were for the ICO. As a result, I conclude that the evidence regarding the number of customers of the ICO in the UK to be unreliable.

58. Within its evidence, CL stated that the C.PAY prepaid cards had a 5% share of the relevant market, being bank cards with the option to load proceeds from the sale of cryptocurrency. However, the goods upon which CL claims to have goodwill in are the broader categories of "credit cards", "encoded cards" and "encoded prepaid payment cards". As a result, the relevant market will be for all of these goods and not just cards with the option to load proceeds from the sale of cryptocurrency. I note that Ms Hobbs has provided evidence that states that at the end of 2017, there were 175.7 million payment cards issued in the UK and by the end of 2018, this

figure stood at 162.5 million. I consider this evidence to be relevant to the market at issue and, therefore, I am of the view that the market for these goods is significant and the market share put forward by CL does not relate to that much larger market.

59. CL issued 543 or 544 cards in the UK between March and October 2017, with the majority of those being issued between July and September of that year. Given the size of the market in question, I consider these figures to be low. CL has also provided evidence regarding users accessing its website from the UK. While I note that the figures provided between 2017 and the relevant date are significant, there is no evidence of any actual trading via the website. CL's evidence also sets out that its UK marketing expenditure between August and October 2017 was \$250,000. While the figure is noted, there are issues with the evidence provided. Firstly, the evidence states that this was in relation to the marketing of the 'C.PAY mark' and does not explain whether it was specifically aimed at advertising the C.PAY prepaid card or what else was being marketed by CL. Secondly, I have set out above that \$87,600 of the total expenditure was for advertising during the ICO, which the evidence shows was traded in by a different company, namely CPay Foundation. This would indicate that the advertising was aimed specifically at the ICO and I have no evidence as to whether or not this was the case. Further, of this evidence, only two websites from the 69 shown were aimed at the UK market. While I note that Mr Guniashov set out that the figures provided relate to UK advertising and I also note in its submissions that CL states that it 'spent a vast sum of money in advertising the C.PAY card', it is clear from the evidence provided (being the invoices) that the advertising was not aimed at the UK market. In the absence of any further evidence or explanation as to the specificity of the expenditure, I cannot accept that it relates to the C.PAY prepaid cards or that it was aimed at the UK market. As a result, the marketing expenditure does not assist CL.

60. While I note that even a small business which has more than trivial goodwill can protect signs which are distinctive of the business under the law of passing off,²¹ I

²¹ Stacey v 2020 Communications [1991] FSR 49

consider the evidence to be far from extensive. Even if CL had obtained UK goodwill in October 2017, it would have been minimal. I note that the evidence states that only 128 transactions took place using the C.PAY card, all of which took place in 2017. On this point, CL even states that most of the cards were inactive shortly after delivery because the card programme was closed. In the absence of evidence of any further trading activity between October 2017 and June 2018, I am of the view that any goodwill that resided in CL's business would have dissipated by the relevant date to the point where it was trivial. As noted in the case law cited above, the burden is on CL to prove goodwill. I am not satisfied, based on the evidence field, that it has done so.

61. CL's opposition based on section 5(4)(a) of the Act fails. I will now proceed to consider BNP's opposition of CL's application under the grounds set out in section 5(2)(b) of the Act.

Section 5(2)(b)

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

“(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,

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

63. 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.”

64. 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.

65. BNP’s marks qualify as earlier trade marks under the above provisions. BNP can rely upon all of the goods/services for which its marks will be protected in the UK in the light of the failure of CL’s opposition.

66. 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

67. CL's goods and services are set out in **paragraph 5** above and BNP's goods and services are set out in **Annex 2** to this decision.

68. 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".

69. 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.

70. The General Court 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 für 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”.

71. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

72. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between

goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

73. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

74. I have written submissions from both parties in respect of the comparison of goods and services. While I will not reproduce those submissions in full, I have taken them into consideration when undertaking the following goods and services comparison.

Class 9 goods

75. “Credit cards”, “encoded cards” and “encoded prepaid payment cards” in CL’s specification fall within the wider category of “magnetic coded cards for commercial and financial use” in BNP’s marks specifications. These goods are therefore identical under the principle outlined in *Meric*.

76. “Apparatus for processing electronic payments” in CL’s specification falls within the category of “fixed and portable computer and electronic apparatus and instruments for payment and collection” in BNP’s marks specifications. These goods are therefore identical under the principle outlined in *Meric*.

77. Insofar as “computer software” and “mobile application software” in CL’s specification covers software intended for the promotion and/or marketing of

financial, credit and insurance products, loyalty and customer retention programs or the aggregation of bank accounts, they will be identical under the principle outlined in *Meric* to the terms “downloadable electronic publications intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs”, “downloadable computer software applications intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs”, “downloadable computer software applications intended exclusively for the aggregation of bank accounts”, “downloadable software applications for mobile communication devices intended exclusively for the aggregation of bank accounts” in BNP’s marks’ specifications. However, where CL’s terms do not cover these specific areas they will not be identical. They will, however, overlap in nature and method of use. There will also be an overlap in user in that the user bases of computer and mobile application software are very wide. Additionally, there may be an overlap in trade channels as computer and mobile software is often found on various platform’s ‘app stores’ such as the Apple iOS store, the Android store and the Windows store. Overall, I find these goods to be identical or, at least, similar to a medium degree.

78. “Computer software for use in electronically trading, storing, sending, receiving, accepting, and transmitting digital currency, and managing digital currency payment and exchange transactions” in CL’s specification describes software wherein a user logs into in order access his/her digital currency and, from there, can undertake a number of different actions, such as sending or trading it. While I acknowledge that digital currency is not the same as physical currency, it will still have a monetary value in the mind of the user. Therefore, I consider that these goods will be similar to “digital wallets”, “downloadable computer software applications intended exclusively for the aggregation of bank accounts” and “downloadable software applications for mobile communication devices intended exclusively for the aggregation of bank accounts” in BNP’s marks’ specifications. All of these goods will be types of software that a user can use to access their money or digital currency. There will, therefore, be overlap in nature, purpose and method of use. While I agree with CL’s submissions that the goods will “arguably have different intended customers”, there will still be an overlap between the user

base because the user of a digital currency will also have a traditional bank account that he/she will likely access via computer software or mobile applications. Overall, I consider these goods to have at least a medium degree of similarity.

Class 36 services

79. “Financial services”, “banking services”, “issuance of credit cards” and “electronic funds transfer” in CL’s specification have direct counterparts in BNP’s marks’ specifications. These services are identical.

80. “Financial consultancy” and “provision of financial information” in CL’s specification both describe a type of financial service and will, therefore, fall within the broader category of “financial services” in BNP’s marks’ specifications. These services will be identical under the principle outlined in *Meric*.

81. “Investment services” in CL’s specification describes a type of financial service. These services will, therefore, fall within the broader category of “financial services” in BNP’s marks’ specifications. These services will be identical under the principle outlined in *Meric*.

82. “Payment processing services” in CL’s specification covers a wide range of services. On a general level, payment processing services will fall within the category of “banking services” and “financial services”, which are both contained in BNP’s marks’ specifications. Further, a payment process is also the facilitating of a financial transaction, meaning that these services will also fall within “financial transactions” in BNP’s marks’ specification. These services will, therefore, be identical under the principle outlined in *Meric*.

83. In my view, and without any submissions to the contrary, something that is an ‘electronic cash equivalent’ will still be something that has financial value. Therefore, the service of “facilitating transfers of electronic cash equivalents” in CL’s specification will fall within the broader categories of “financial transactions” and “electronic funds transfer” in BNP’s marks’ specifications. These services will, therefore, be identical under the principle outlined in *Meric*.

84. I have no submissions in respect of the term “wireless wallets” in CL’s specification.

As a good, I consider a wireless wallet to be software or an application wherein the user can access their funds either from a computer or a mobile device. However, the service of a wireless wallet will be the actual hosting of that wallet on a remote server. Additionally, the service will include the storage of the actual funds in the electronic wallet itself, be that physical funds or digital funds. I note that within class 9 of BNP’s marks’ specifications, the term “electronic wallets”. While these goods and services are in different classes, they are not to be regarded as dissimilar just because they appear in different classes.²² While these goods and services will not be identical, I am of the view that they will overlap in purpose in that they will both allow the user to access their funds electronically. As one is a good and the other a service, they will differ in nature. The user will be identical in that the user of an electronic wallet will inevitably need to have access to the service provided by that wallet. The trade channels will also overlap that the undertaking providing the application/software is also likely to be the same undertaking that provides the service itself. Further, the goods and services are clearly indispensable to each other and when accessing the electronic wallet, the average consumer will believe that both the good and the service are from the same undertaking. Therefore, there will be a complementary relationship between these goods and services. Overall, these goods and services will be highly similar.

85. “Financial services” in BNP’s marks’ specification is a very wide term that, generally speaking, covers currency exchange service. Therefore, I find that “currency exchange services”, “digital currency exchange services” and “digital currency exchange transaction services for transferrable electronic cash equivalent units having a specified cash value” in CL’s specification will fall within BNP’s term of “financial services”. These services will, therefore, be identical under the principle outlined in *Meric*. Even if I am wrong in this finding, the services will overlap in nature in that they both cover finance, purpose, user and trade channels and will, therefore, be highly similar.

²² Section 60A of the Act

The average consumer and the nature of the purchasing act

86. 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.”

87. The average consumer for the goods and services will be a member of the general public or a business user. 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. For some services, particularly where they relate to investment services, the average consumer will have additional considerations such as any potential rate of return and the provider's previous records in respect of returns on investments. In my view, the level of attention paid during the selection process of the goods/services will be medium but, for some services, such as investment services, a higher degree of attention will be paid.

88. The goods/services are likely to be obtained by visiting the service provider's physical premises or by visiting their website. Visual considerations are, therefore, likely to dominate the purchasing process. However, given that word-of-mouth recommendations and advice from salespersons may also play a part, I do not

discount that there will also be an aural component to the selection of the goods and services.

Distinctive character of the earlier marks

89. 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).”

90. 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 distinctiveness of a mark can be enhanced by virtue of the use made of it.

91. I note that BNP's submissions state that its marks have a "high level of inherent distinctiveness", however, no further evidence or submissions have been provided to satisfy this claim. I have no submissions from CL regarding the distinctiveness of BNP's marks. Therefore, I have only the inherent position to consider.
92. BNP's marks all consist of the letter 'C' presented in a large, green typeface. Within the center of the 'C', the word 'pay' is presented in a smaller, green typeface. While the typefaces used in 'C' and 'pay' differ, they are both standard. Underneath the 'C' is a green device element that acts as an underline to the letter. I am of the view that this will be read as 'C pay' by the average consumer. Whilst the word 'pay' has a clear and obvious meaning, 'C pay' as a whole is essentially meaningless. However, it is likely to be perceived by the average consumer of banking and financial goods and services as an allusive term that suggests some form of good used for payments or a payment service. The 'C pay' element and the underline device make up the entirety of the 567 mark. When considered as a whole, taking into account the unusual construction of the term 'C pay' in combination with the layout, colour and stylisation, the 567 mark can be said to enjoy a medium degree of inherent distinctive character.
93. In addition to the elements that make up the 567 mark, the 316 and 220 mark include the words 'by cetelem', with the 'c' underlined as it is in the larger 'C PAY' element. The word 'by' is displayed in a smaller, green typeface (similar to the word 'pay' above) whereas 'cetelem' is presented in a larger, green typeface (similar to the letter 'C' above). In the 220 mark 'by cetelem' is presented below the 'C PAY' element whereas in the 316 mark, it is presented to the right. The addition of the words 'by cetelem' will have no obvious meaning to the average consumer but will be seen as the primary indication of the identity of the trader in the goods and services, with the words 'C PAY' being seen as a further indication of origin. I find that the additional elements of the 316 and 220 marks will contribute to the distinctive character of the marks. Overall, the 316 and 220 marks can be said to enjoy at least a medium degree of inherent distinctive character.

Comparison of marks




94. 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.

95. 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.”

96. 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.

97. The respective trade marks are shown below:

BNP's marks	CL's mark
 <p data-bbox="424 524 655 562">("the 567 mark")</p>  <p data-bbox="424 781 655 819">("the 316 mark")</p>  <p data-bbox="424 1149 655 1187">("the 220 mark")</p>	<p data-bbox="1059 692 1158 730">C.PAY</p>

98. In respect of the comparison of the marks, CL submits that:

"7.8 The marks in question are entirely dissimilar.

[...]

7.10 The Applicant's trade mark is a word mark made up of one letter followed by a full stop, then three further letters. It is a short word mark, in standard characters. In contrast, the marks, the subjects of the Opponent's UK designations are entirely different as they incorporate additional elements, additional words and are displayed in a distinctive green colour, Pantone No. 7740C.

Mark 1: The letter C is underlined with the words “pay by Cetelem” to the right of the mark. Visually, phonetically and conceptually, this mark is dissimilar to the Applicant’s mark.



Mark 2: This mark uses the same additional words as Mark 1, but in a different format. Visually, phonetically and conceptually, this mark is dissimilar to the Applicant’s mark.

Mark 3: This letter C is underlined with the word “pay” within it. The format of the mark means that it is visually dissimilar to the Applicant’s mark.



7.11 All of the Opponent’s UK designations claim the colour and specifically, Pantone no. 7740C. This demonstrates that it was the Opponent’s intention to ensure that its trade marks are always associated with this colour; that consumers will see this particular colour green in the banking field and recognise it as being associated with the Opponent. The Applicant’s mark does not use any colour.”

99. BNP submits that:

“32. It is submitted that there are obvious visual, phonetic and conceptual similarities between the contested mark and the marks relied upon by BNP.

33. The mark , which forms the subject of prior right IR no. 1483567 relied upon, consists of the term CPAY in a stylisation. The stylisation applied to the mark is slight, and the phrase CPAY is clearly recognisable within it. Given that the public is more likely to remember and refer to marks by their word elements, BNP contends that its earlier mark will be remembered and referred to as CPAY. Although the mark forming the subject of the Application in suit includes a full stop between the letter C and the word PAY, this difference is likely to go unnoticed by the average consumer, and will have no or very little impact on the visual, phonetic and conceptual perception of the respective marks. For all these reasons, BNP submits that Cryptopay’s C.PAY mark is highly similar to its  mark.

34. BNP will also argue that the mark forming the subject of Cryptopay's application, namely C.PAY, is similar to the marks forming the subject of its

prior IR nos. 1462316 and 1462220, namely  and . This is because the CPAY logo which forms the subject of its IR no. 1483567 is the dominant element of both the marks forming the subject of its IR nos. 1462316 and 1462220, and particularly so in the case of IR no. 1462220 where it appears as a separate and independent element. As a result, and for the reasons set out in paragraph 33 above, BNP submits that the marks forming the subjects of its IR nos. 1462316 and 1462220 are also similar to the mark forming the subject of Cryptopay's application, namely C.PAY."

Overall Impression

CL's mark

100. CL's mark consists of the words 'C.PAY'. I consider that the full stop will be overlooked, meaning that the overall impression of the mark will lie solely in 'C PAY'.

The 567 mark

101. The 567 mark consist of the words 'C pay' with the word 'pay' presented within the letter 'C' and a green underline device under the letter C. I note that the mark is registered in the colour green, more specifically Pantone 7740C. I am of the view that the eye is naturally drawn to the elements that can be read, meaning that 'C pay' plays the greater role in the overall impression of the mark with the underline device and the colour playing lesser roles.

The 316 mark

102. The 316 mark consists of the same elements as the 567 mark but includes the words 'by cetelem' to the right of the 'C pay' element. The 'c' in 'cetelem' is underlined. The word 'by' is presented in a smaller typeface than the word

'cetelem'. As with the 567 mark above, this mark is registered in the colour green, more specifically Pantone 7740C. For the same reason set out above, in that the eye will naturally be drawn to the parts of the mark that can be read, I find that the words 'C PAY by celetum' will play the greater role in the overall impression of the mark with the underline device and the colour playing lesser roles.

The 220 mark

103. The 220 mark contains the same elements as the 316 mark save for the placement of the words 'by cetelem' which are presented in a smaller typeface and below the 'C pay' element. Given the placement and size of the 'by cetelem' element, I consider that it will play a lesser role in the 220 mark. Therefore, I find that 'C pay' will play a greater role in the overall impression of the mark with the underline device, the colour and the words 'by cetelem' playing lesser roles.

Visual Comparison

The 567 mark and CL's mark

104. Visually, the marks share the element 'C PAY', albeit it displayed slightly differently in each mark in that the word 'PAY' in the 567 mark sits inside the letter 'C'. They will differ in the presentation of the words, the use of colour and the underline device. CL's mark is a word only mark that is registered in black and white which covers use of the mark in any standard typeface and in different colours. While I have found that the underline device in the 567 mark play a lesser role, they will still constitute a visual difference. I note that CL's mark is registered in black and white, which covers use of the mark in different colours. Taking all of this into account, I find that the marks are visually similar to a high degree.

The 316 mark and CL's mark

105. The 316 mark will share the same similarities and differences as highlighted in paragraph 104 above. There are additional differences in that the 316 marks consist of the words 'by cetelem'. I have found that, together with 'C PAY', these

words play a greater role in the 316 mark. However, as a general rule, average consumers tend to give more focus to the beginning of marks than the ends.²³ Overall, I find that the marks are visually similar to a medium degree.

The 220 mark and CL's mark

106. The 220 mark will share the same similarities and differences as highlighted in paragraph 104 above. However, given the size and placement of 'by cetelem' I have found that it plays a lesser role in the overall impression of the 220 mark. Despite this, it will still constitute a visual difference between the marks. Overall, I find that the marks are visually similar to between a medium and high degree.

Aural Comparison

The 567 mark and CL's mark

107. Both marks consist of two syllables that will be pronounced 'SEE-PAY'. There are no other elements that will impact either mark aurally. The marks are, therefore, aurally identical.

The 316 and 220 marks and CL's mark

108. CL's mark will be pronounced as per paragraph 107 above. The 316 and 220 marks will be pronounced identically and consist of six syllables that will be pronounced 'SEE-PAY-BY-SET-ELL-EMM'. The first two syllables of the marks are identical and make up the entirety of the aural element of CL's marks. The remaining syllables of the 316 and 220 marks are different. Given that the average consumer tends to give more focus to the beginning of the marks, I find that these marks are aurally similar to a medium degree.

²³ *El Corte Inglés, SA v OHIM* Cases T-183/02 and T-184/02

Conceptual Comparison

The 567 mark and CL's mark

109. While the word 'PAY' in both marks creates a certain degree of conceptual similarity, neither of the marks, when considered as wholes, have a recognisable meaning. Therefore, I find that the marks are conceptually similar to between a low and medium degree.

The 316 and 220 marks and CL's mark

110. I find that the addition of the words 'by cetelem' in the 316 and 220 marks will convey no obvious meaning to the average consumer but will be seen as the primary indication of the identity of the trader in the goods and services, with the words 'C PAY' being seen as a further indication of origin. This means that, as wholes, both the 316 and 220 marks convey no obvious meanings. While these marks share the same conceptual similarities as set out in paragraph 109 above, the shared element forms a smaller part of the conceptual message of both the 316 and 220 marks. Therefore, I find that the marks are conceptually similar to a low degree.

Likelihood of confusion

111. 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.

112. I have found that the goods and services range from being identical to being similar to a medium degree. I have found the average consumer to be a business user or a member of the general public who will select the goods and services primarily by visual means, although I do not discount an aural element factoring into the process. I have concluded that a medium degree of attention will be paid in respect of a majority of the goods and services at issue although I recognise that for some of the services, a higher degree of attention may be paid. I have found the 567 mark to have a medium degree of inherent distinctive character and the 316 and 220 marks have at least a medium degree of inherent distinctive character. In respect of the similarity of the marks, I have found the following:

- a. CL's mark and the 567 mark are visually similar to a high degree, aurally identical and conceptually similar to between a low and medium degree;
- b. CL's mark and the 316 mark are visually similar to a medium degree and aurally and conceptually similar to a low degree; and
- c. CL's mark and the 220 mark are visually similar to between a medium and high degree, aurally and conceptually similar to a low degree.

113. Firstly, I consider that the visual and aural differences between the 316 and 220 marks and CL's mark are sufficient enough to offset any likelihood of direct confusion between those marks. In respect of the 567 mark, I have found that the 'C PAY' plays a greater role in both that mark and CL's mark. I consider that the differences between the marks, being the presentation of the 567 mark, the underline device in the 567 mark and the full stop in CL's mark, will be overlooked. Taking all of the above factors into account together with the principle of imperfect recollection, I consider that the average consumer is likely to mistake the 567 mark and CL's mark for one another. Further, the fact that the 567 mark and CL's mark are aurally identical is likely to give rise to confusion on the part of the consumer

when encountering these marks aurally. Consequently, I consider that there is a likelihood of direct confusion between the 567 mark and CL's mark. I consider that this finding will apply to those goods and services that I have found to be identical or similar to a medium degree and higher. However, if I am wrong on my finding of direct confusion, I will proceed to consider indirect confusion.

Indirect Confusion

114. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.). BL O/375/10 Page 15 of 16

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

115. I have borne in mind that the examples given by Mr Purvis QC are not exhaustive. Rather, they were intended to be illustrative of the general approach.²⁴

116. I must now consider the possibility of indirect confusion and whether average consumers would believe that there is an economic connection between the marks or that they are alternative marks from the same undertaking as a result of the shared common elements of the mark. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. It is not sufficient that a mark merely calls to mind another mark. This is mere association, not indirect confusion.²⁵

117. In respect of the 567 mark, I am of the view that, in the event that the differences in presentation of the marks are noticed, they will simply be seen as an alternative mark being used by the same or economically undertakings. For example, the marks may be used as alternatives used by the same undertaking in different contexts (such as the word only mark being used in promotional text and the device mark being used on company signage, packaging and/or promotional materials). Consequently, I consider there to be a likelihood of indirect confusion between the 567 mark and CL’s mark in respect of those goods and services that I have found to be identical and those I have found to be similar to a medium degree or higher.

²⁴ L.A. Sugar Limited v By Back Beat Inc, Case BL-O/375/10

²⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

118. I am of the view that the average consumer will notice the words ‘by cetelem’ in the 316 and 220 marks. These words are likely to be seen as an indication of an entity that provides a product or service called ‘C PAY’. When a trader uses a sub-brand, it can use it jointly and autonomously, with or without the name of the entity that produced it. Therefore, it is likely that the average consumer will see the goods and services offered by the 316 and 220 marks and assume that the responsible entity sometimes uses ‘C PAY’ with ‘by cetelem’, and sometimes without it. The colour/stylisation is likely to be seen as different presentation being used by the same or economically linked undertakings. In that event, it is likely that the average consumer would think that the user of the 316 and 220 marks and CL’s marks were one and the same undertaking, or economically related undertakings. Consequently, I consider there to be a likelihood of indirect confusion between the 316 and 220 marks and CL’s mark in respect of those goods and services that I have found to be identical and those I have found to be similar to a medium degree or higher.

CONCLUSION

119. CL’s oppositions against BNP’s marks under section 5(4)(a) of the Act fail in their entirety and BNP’s marks can, therefore, proceed to registration. BNP’s opposition against CL’s mark under section 5(2)(b) of the Act succeeds in its entirety and, therefore, CL’s application is refused.

COSTS

120. The outcome of these proceedings is that BNP has been successful in defending CL’s oppositions and in opposing CL’s mark. BNP is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award BNP the sum of £1,400 as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering CL’s counterstatement:

£200

Reviewing CL's three notices of opposition and preparing counterstatements:	£300
Preparing evidence and considering CL's evidence:	£500
Preparing written submissions in lieu:	£300
Official fees:	£100
Total:	£1,400

121. I therefore order CL to pay BNP the sum of £1,400. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of December 2020

A COOPER

For the Registrar

Annex 1

The 316 and 220 Marks

- Class 9: Publications in electronic format intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty schemes and customer loyalty; downloadable electronic publications intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable computer software applications intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable software applications for mobile communication devices intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable computer software applications intended exclusively for the aggregation of bank accounts; downloadable software applications for mobile communication devices intended exclusively for the aggregation of bank accounts; chip, memory or microprocessor cards for commercial and financial use; magnetic coded cards for commercial and financial use; smart, memory or microprocessor loyalty cards; magnetic encoded loyalty cards; fixed and portable computer and electronic apparatus and instruments for payment and collection; electronic wallets; radio frequency identification readers.
- Class 16: Brochures and newsletters intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; forms; printed matter; printed gift vouchers; printed coupons; printed tokens of value; non-magnetic cards for commercial and financial use; non-magnetic loyalty cards.
- Class 35: Organization, conducting (hosting) and management of consumer loyalty programs; commercial customer loyalty services (for others),

namely, promotional and advertising operations with a view to increasing customer loyalty; commercial promotion at points of sale (within companies or online through national and international communication networks such as the Internet, Intranet and Extranet); sales promotion for others; presentation of goods and services on any communication media for retail sale; arranging subscriptions to loyalty programs; loyalty card services not associated with a payment, credit or debit function, providing commercial or financial benefits; administrative and commercial management services regarding customer relations; market research and studies; opinion polls, surveys and customer satisfaction surveys; analysis and processing of data obtained during market studies and consumer behavior studies; statistical information; newspaper subscription services (for third parties); organization and conducting (animation) of congresses, colloquiums, seminars, conferences, exhibitions, contests intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs, for commercial or advertising purposes; rental of advertising time, advertising space and advertising material on all communication media; publication of advertising texts; dissemination of advertisements and advertising material; business information and consultancy services concerning the rental, purchase and sale of motor vehicles, land motor vehicles, recreational vehicles, motorcycles, scooters for transportation purposes; business information and consultancy services relating to the rental, purchase and sale of equipment and accessories for motor vehicles, land motor vehicles, recreational vehicles, motorcycles, scooters for transportation purposes; rental of typewriters and photocopiers; rental of office machines and equipment.

Class 36: Financial advisory services; financing advice services; banking advice services; stock exchange consulting services; Insurance consultancy services; real estate consulting services; financial services; financing services; banking services; stock exchange services; bank card, payment card, debit and credit card services; issuance of bank cards,

payment cards, debit and credit cards; services provided by loyalty cards associated with a payment, credit or debit function, providing commercial or financial benefits; issuing of gift vouchers, reduction vouchers and tokens of value; financial loan services; credit services; hire-purchase financing services; credit consolidation services; financial estimates (insurance, moveable and real property assets); surety services (guarantees); insurance services; insurance services with respect to purchase protection, price protection and extended warranty for products and services purchased by credit cards, payment cards, credit or debit cards; financial management of customer relations; financial management services; estate management services; real estate services relating to purchase, sale and leasing of real estate; real estate management services; contactless payment services; payment services via fixed and portable (mobile) telecommunication apparatus; financial pre-payment services; financial transactions; electronic funds transfer; fund investment; mutual funds; capital investment; financial sponsorship

Class 37: Installation, deployment (configuration), updating (installation and updating of new components), servicing, maintenance, repair and technical assistance (relating thereto), on-site or remotely relating to apparatus for collection and/or payment; rental of dishwashers; rental of dish dryers; rental of washing machines; rental of laundry dryers; rental of clothes spin dryers; rental of electric washing machines; rental of cleaning machines; rental of vacuum cleaners; rental of spectacles; rental of tools.

Class 38: Telephone rental services; rental of smart phones; rental of mobile telephones; rental of facsimile machines; rental of telecommunication apparatus, equipment and installations; rental of telecommunication equipment and devices for connecting to networks; rental of message sending apparatus; rental of image transmission apparatus; leasing access time to computer data bases; rental of access time to a database server; leasing access time to global computer networks; rental of

electronic objects connected wirelessly, sharing information with a computer, tablet or mobile phone.

Class 39: Travel ticket booking services; rental of motor vehicles, land motor vehicles, recreational vehicles, motorcycles, scooters for transportation purposes; bike rental services; rental of equipment and accessories for motor vehicles, land motor vehicles, recreational vehicles, motorcycles, scooters for transportation purposes; lease-to-purchase of motor vehicles, land motor vehicles, recreational vehicles, motorcycles, scooters for transportation purposes; lease-to-purchase services for equipment and accessories of motor vehicles, land motor vehicles, recreational vehicles, motorcycles, scooters for transportation purposes; rental of freezing machines and apparatus; freezer locker rental services; rental of freezing machines and apparatus; rental of cooling and freezing machines and apparatus; rental of navigation systems; rental of baby strollers.

Class 41: Organization and conducting (animation) of congresses, symposiums, seminars, conferences, exhibitions, competitions intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs, for entertainment, pedagogical, educational or awareness purposes; theoretical and practical training (demonstration) services; editing and publication of brochures and newsletters intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; editing and publishing of forms, printed matters, gift certificates, coupons and vouchers; online electronic editing and publishing of brochures and newsletters intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; on-line electronic publication of forms, printed matters, gift certificates, coupons and vouchers; rental of audio equipment; rental of audio speakers; rental of video cameras; rental of sound and video recording apparatus; rental of radio sets; rental of

television sets; rental of cameras; rental of photographic equipment; rental of movie apparatus and accessories; rental of video game machines; rental of game equipment; rental of educational apparatus and material; rental of musical instruments; rental of sports equipment other than vehicles; rental of electronic book readers.

Class 42: Software as a Service (SaaS); updating services (installation and updating of software), on site or remotely, relating to cashing and/or payment apparatus; computer rental; rental of computer hardware; rental of computer peripherals; rental and maintenance of computer software and programs; rental of Internet access software; rental of Internet security programs; rental services for electronic/computer apparatus, equipment and installations for home automation (control).

Class 43: Rental services for furniture, linens and cutlery; rental of lighting apparatus; rental of cooking apparatus; rental of glassware; rental of tents; rental of mats; rental of catering equipment.

Class 45: Advice, information and assistance with respect to legal matters; clothing rental services sharing information with a computer, tablet or cell phone; shoe rental services sharing information with a computer, tablet or cell phone; spectacle rental services sharing information with a computer, tablet or cell phone; watch rental services sharing information with a computer, tablet or cell phone; bracelet rental services sharing information with a computer, tablet or cell phone; rental of alarms sharing information with a computer, tablet or cell phone; rental of CCTV apparatus, equipment and installations sharing information with a computer, tablet or cell phone.

The 567 Mark

Class 9: Publications in electronic format intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty schemes and customer loyalty; downloadable electronic publications intended exclusively for the promotion and/or

marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable computer software applications intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable software applications for mobile communication devices intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable computer software applications intended exclusively for the aggregation of bank accounts; downloadable software applications for mobile communication devices intended exclusively for the aggregation of bank accounts; chip, memory or microprocessor cards for commercial and financial use; magnetic coded cards for commercial and financial use; smart, memory or microprocessor loyalty cards; magnetic encoded loyalty cards; fixed and portable computer and electronic apparatus and instruments for payment and collection; electronic wallets; radio frequency identification readers.

Class 16: Brochures and newsletters intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; forms; printed matter; printed gift vouchers; printed coupons; printed tokens of value; non-magnetic cards for commercial and financial use; non-magnetic loyalty cards.

Class 35: Organization, conducting (hosting) and management of consumer loyalty programs; commercial customer loyalty services (for others), namely, promotional and advertising operations with a view to increasing customer loyalty; commercial promotion at points of sale (within companies or online through national and international communication networks such as the Internet, Intranet and Extranet); sales promotion for others; presentation of goods and services on any communication media for retail sale; arranging subscriptions to loyalty programs; loyalty card services not associated with a payment, credit or debit function, providing commercial or financial benefits; administrative and

commercial management services regarding customer relations; market research and studies; opinion polls, surveys and customer satisfaction surveys; analysis and processing of data obtained during market studies and consumer behavior studies; statistical information; newspaper subscription services (for third parties); organization and conducting (animation) of congresses, colloquiums, seminars, conferences, exhibitions, contests intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs, for commercial or advertising purposes; rental of advertising time, advertising space and advertising material on all communication media; publication of advertising texts; dissemination of advertisements and advertising material; commercial information and advisory services concerning the rental, purchase and sale of motor vehicles, land motor vehicles, recreational vehicles, motorcycles, scooters for transportation purposes; commercial information and advisory services relating to the rental, purchase and sale of equipment and accessories for motor vehicles, for land motor vehicles, for recreational vehicles, for motorcycles, for scooters for transportation purposes; rental of typewriters and photocopiers; rental of office machines and equipment.

Class 36: Financial advisory services; financing advice services; banking advice services; stock exchange consulting services; insurance advisory services; real estate consulting services; financial services; financing services; banking services; stock exchange services; bank card, payment card, debit and credit card services; issuance of bank cards, payment cards, debit and credit cards; services provided by loyalty cards associated with a payment, credit or debit function, providing commercial or financial benefits; issuing of gift vouchers, reduction vouchers and tokens of value; financial loan services; credit services; hire-purchase financing services; credit consolidation services; financial estimates (insurance, moveable and real property assets); surety services (guarantees); insurance services; insurance services with respect to purchase protection, price protection and extended warranty for

products and services purchased by credit cards, payment cards, credit or debit cards; financial management of customer relations; financial management services; estate management services; real estate services relating to purchase, sale and leasing of real estate; real estate management services; contactless payment services; payment services via fixed and portable (mobile) telecommunication apparatus; financial pre-payment services; financial transactions; electronic funds transfer; fund investment; raising capital; capital investment; financial sponsorship.

Class 37: Installation, deployment (configuration), updating (installation and updating of new components), servicing, maintenance, repair and technical assistance (relating thereto), on-site or remotely relating to apparatus for collection and/or payment; rental of dishwashers; rental of dish dryers; rental of washing machines; rental of laundry dryers; rental of clothes spin dryers; rental of electric washing machines; rental of cleaning machines; rental of vacuum cleaners; construction tool rental services; rental of electronic home-automation appliances, equipment and installations.

Class 38: Telephone rental services; rental of smart phones; rental of mobile telephones; rental of facsimile machines; rental of telecommunication apparatus, equipment and installations; rental of telecommunication equipment and devices for connecting to networks; rental of message sending apparatus; rental of image transmission apparatus; leasing access time to computer data bases; rental of access time to a database server; leasing access time to global computer networks; rental of electronic objects connected wirelessly, sharing information with a computer, tablet or mobile phone.

Class 39: Travel ticket booking services; rental of motor vehicles, land motor vehicles, recreational vehicles, motorcycles, scooters for transportation purposes; bike rental services; rental of equipment and accessories for motor vehicles, land motor vehicles, recreational vehicles, motorcycles,

scooters for transportation purposes; lease-to-purchase of motor vehicles, land motor vehicles, recreational vehicles, motorcycles, scooters for transportation purposes; lease-to-purchase services for equipment and accessories of motor vehicles, land motor vehicles, recreational vehicles, motorcycles, scooters for transportation purposes; rental of freezing machines and apparatus; freezer locker rental services; rental of freezing machines and apparatus; rental of cooling and freezing machines and apparatus; rental of navigation systems; rental of baby strollers.

Class 41: Organization and conducting (animation) of congresses, symposiums, seminars, conferences, exhibitions, competitions intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs, for entertainment, pedagogical, educational or awareness purposes; theoretical and practical training (demonstration) services; editing and publication of brochures and newsletters intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; editing and publishing of forms, printed matters, gift certificates, coupons and vouchers; online electronic editing and publishing of brochures and newsletters intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; on-line electronic publication of forms, printed matters, gift certificates, coupons and vouchers; rental of audio equipment; rental of audio speakers; rental of video cameras; rental of sound and video recording apparatus; rental of radio sets; rental of television sets; rental of cameras; rental of photographic equipment; rental of movie apparatus and accessories; rental of video game machines; rental of game equipment; rental of educational apparatus and material; rental of musical instruments; rental of sports equipment other than vehicles; rental of electronic book readers.

- Class 42: Software as a Service (SaaS); installation and updating of software, on site or remotely, relating to cashing and/or payment apparatus; computer rental; computer hardware rental services; rental of computer peripherals; rental and maintenance of computer software and programs; rental of Internet access software; rental of Internet security programs.
- Class 43: Rental services for furniture, linens and cutlery; rental of lighting apparatus; rental of cooking apparatus; rental of glassware; rental of tents; rental of mats; rental of catering equipment.
- Class 44: Rental of spectacles; spectacle rental services sharing information with a computer, tablet or cell phone.
- Class 45: Advice, information and assistance with respect to legal matters; clothing rental services sharing information with a computer, tablet or cell phone; shoe rental services sharing information with a computer, tablet or cell phone; spectacle rental services sharing information with a computer, tablet or cell phone; watch rental services sharing information with a computer, tablet or cell phone; bracelet rental services sharing information with a computer, tablet or cell phone; rental of alarms sharing information with a computer, tablet or cell phone; rental of CCTV apparatus, equipment and installations sharing information with a computer, tablet or cell phone.

Annex 2

The 200 and 316 marks

Class 9: Publications in electronic format intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty schemes and customer loyalty; downloadable electronic publications intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable computer software applications intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable software applications for mobile communication devices intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable computer software applications intended exclusively for the aggregation of bank accounts; downloadable software applications for mobile communication devices intended exclusively for the aggregation of bank accounts; chip, memory or microprocessor cards for commercial and financial use; magnetic coded cards for commercial and financial use; smart, memory or microprocessor loyalty cards; magnetic encoded loyalty cards; fixed and portable computer and electronic apparatus and instruments for payment and collection; electronic wallets; radio frequency identification readers.

Class 36: Financial advisory services; financing advice services; banking advice services; stock exchange consulting services; Insurance consultancy services; real estate consulting services; financial services; financing services; banking services; stock exchange services; bank card, payment card, debit and credit card services; issuance of bank cards, payment cards, debit and credit cards; services provided by loyalty cards associated with a payment, credit or debit function, providing commercial or financial benefits; issuing of gift vouchers, reduction vouchers and

tokens of value; financial loan services; credit services; hire-purchase financing services; credit consolidation services; financial estimates (insurance, moveable and real property assets); surety services (guarantees); insurance services; insurance services with respect to purchase protection, price protection and extended warranty for products and services purchased by credit cards, payment cards, credit or debit cards; financial management of customer relations; financial management services; estate management services; real estate services relating to purchase, sale and leasing of real estate; real estate management services; contactless payment services; payment services via fixed and portable (mobile) telecommunication apparatus; financial pre-payment services; financial transactions; electronic funds transfer; fund investment; mutual funds; capital investment; financial sponsorship.

The 567 mark

Class 9: Publications in electronic format intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty schemes and customer loyalty; downloadable electronic publications intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable computer software applications intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable software applications for mobile communication devices intended exclusively for the promotion and/or marketing of financial products, credit products, insurance products and loyalty and customer retention programs; downloadable computer software applications intended exclusively for the aggregation of bank accounts; downloadable software applications for mobile communication devices intended exclusively for the aggregation of bank accounts; chip, memory or microprocessor cards for commercial and financial use; magnetic coded cards for commercial and financial use; smart, memory or microprocessor loyalty cards; magnetic

encoded loyalty cards; fixed and portable computer and electronic apparatus and instruments for payment and collection; electronic wallets; radio frequency identification readers.

Class 36: Financial advisory services; financing advice services; banking advice services; stock exchange consulting services; insurance advisory services; real estate consulting services; financial services; financing services; banking services; stock exchange services; bank card, payment card, debit and credit card services; issuance of bank cards, payment cards, debit and credit cards; services provided by loyalty cards associated with a payment, credit or debit function, providing commercial or financial benefits; issuing of gift vouchers, reduction vouchers and tokens of value; financial loan services; credit services; hire-purchase financing services; credit consolidation services; financial estimates (insurance, moveable and real property assets); surety services (guarantees); insurance services; insurance services with respect to purchase protection, price protection and extended warranty for products and services purchased by credit cards, payment cards, credit or debit cards; financial management of customer relations; financial management services; estate management services; real estate services relating to purchase, sale and leasing of real estate; real estate management services; contactless payment services; payment services via fixed and portable (mobile) telecommunication apparatus; financial pre-payment services; financial transactions; electronic funds transfer; fund investment; raising capital; capital investment; financial sponsorship.