

O/558/21

TRADE MARKS ACT 1994

IN THE MATTERS OF

TRADE MARK APPLICATION NOS. 3303962 AND 3320966

BY SWIFFPAY LIMITED FOR

Swiffpay / SWIFFPAY

AND

SWIFFPAY / SWIFFPAY

FOR GOODS AND SERVICES IN CLASSES 9, 35, 36, 38 AND 42

AND

OPPOSITIONS THERETO UNDER NOS. 413337 AND 414049

BY SOCIETY FOR WORLDWIDE INTERBANK FINANCIAL

TELECOMMUNICATION SCRL

AND

IN THE MATTER OF UKIPO DECISION No. O/019/20

REMITTED BY APPOINTED PERSON DECISION No. O/542/20

Context of this remitted decision

1. This decision is to determine opposition proceedings brought against two trade mark applications made by Swiffpay Limited (“**the Applicant**”). The contested applications are detailed below. The oppositions have been brought by Society for Worldwide Interbank Financial Telecommunication SCRL (S.W.I.F.T.) (“**the Opponent**”), based on objections under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“**the Act**”). The UK IPO trade mark tribunal has previously issued a decision in this matter (made on the papers, without a hearing), which was published under the British Library (BL) reference number O/019/20. That decision was the subject of an appeal, which was heard by Amanda Michaels QC sitting as the Appointed Person (“**the AP**”). The appeal decision was published under BL number O/542/20. The AP upheld the Hearing Officer’s decision on the ‘proof of use’ element of the oppositions,¹ but remitted for reconsideration before a different Hearing Officer each of the three grounds claimed.

Background and pleadings

2. The Applicant applied, on 15 April 2018, to register a series of two word marks - “Swiffpay” and “SWIFFPAY” (“**the Applicant’s Word Marks**”).
3. The Applicant then applied on 27 June 2018 for a series of two stylised marks (“**the Applicant’s Stylised Marks**”):


SWIFFPAY SWIFFPAY

4. Both of the contested applications are in respect of the same goods and services specified in Classes 9, 35, 36, 38 and 42, which are as follows:

Class 9 goods

Computer software; computer hardware; computer software, hardware and systems for use in the provision of financial and investment services; computer software, hardware and systems for electronic financial and investment trading; electronic and web-based financial and investment trading systems, software and hardware; computer software, hardware and systems for virtual and crypto currency trading; software, hardware and systems enabling secure Internet access; software, hardware and systems for storage

¹ §§13-17

and transfer of data; telecommunications and communications software and systems; telecommunications and communications software and systems for transmission of data and funds; financial and investment management software and hardware; telecommunications and communications software and systems for transmission of virtual and crypto currencies; software and hardware for financial and investment management in relation to virtual and crypto currencies; software and hardware facilitating financial and investment transactions; telecommunications and communications software and systems for transmission of monetary, currency, virtual currency, crypto currency, commodities and funds transfers and payments; software and hardware facilitating financial and investment transactions in relation to virtual and crypto currencies.

Class 35 services

Professional business consultancy services; professional business consultancy services provided to financial institutions; business management assistance; business management assistance provided to financial institutions; business management consultancy services; business management consultancy services provided to financial institutions; business management and administration; business management and administration of charitable organisations; management and administration on behalf of charities; business information services; business mentoring; mentoring services for business management; provision of business training and instruction; providing business management start-up support for other businesses; providing business management and support services for start-up businesses; business incubator services; business accelerator services; maintaining and updating of computer databases; consultancy, advisory and information services relating to all the aforesaid services.

Class 36 services

Financial services; monetary affairs; electronic exchange and money market transactions; financial services enabling virtual currency and crypto currency transactions and exchanges; facilitating electronic monetary, currency, virtual currency, crypto currency, commodities and funds transfers and payments; currency management services; virtual currency and crypto currency management services; providing financial information via a secure global electronic communication network, including information on exchange and money market transactions; providing financial information relating to

virtual and crypto currencies via a secure global electronic communication network; provision of financial information via the Internet; financial advisory services; financial management; investment services; investment advice; investment management; funds management; capital management; private equity management; commodities investment and management; financial underwriting and brokerage; brokerage services in relation to currencies, virtual currencies, crypto currencies, stocks, shares, securities, commodities and other investments; financial syndicate services and management; project finance; trust fund services; foreign exchange services; banking services; bank transfer and payment services; consultancy, advisory, management and information services relating to all the aforesaid services.

Class 38 services

Provision of web-based and Internet-based financial and investment trading and transactional systems and platforms; provision of telecommunications and communications access to web-based and Internet-based financial and investment trading and transactional systems and platforms; provision of telecommunications and communications access to the Internet and the worldwide web; electronic transmission of funds and data via telecommunications and communications networks; provision of telecommunications and communications systems and networks for the transmission of funds and data; provision of internet-based systems/platforms for virtual and crypto currency trading and transactions; provision of internet-based systems/platforms for the transmission of virtual and crypto currencies; consultancy, advisory, management and information services relating to all the aforesaid services.

Class 42 services


Design and development of computer software; development and providing an online platform featuring software effecting electronic monetary, currency, virtual currency, crypto currency and funds transfers and payments; developing and/or hosting an online platform for the provision of financial services; developing and/or hosting an online platform enabling electronic monetary, currency, virtual currency, crypto currency and funds transfers and payments; providing use of online, non-downloadable computer software for financial and investment transactions; developing, hosting and/or providing electronic and web-based financial and investment trading systems/platforms, software and hardware; developing, hosting and/or providing computer software, hardware and

systems/platforms for virtual and crypto currency trading; providing use of online, non-downloadable computer software for storing and accessing financial and investment information; providing software as a service for use in connection with storage/provision of financial and investment information/data; computer software and programming services; computer services; lease, hire and rental of computer equipment, hardware, software and programs; design of web sites; hosting web sites for others; computer network services; creating and maintaining websites; encryption services; identification, authorisation, authentication and verification of data; electronic signature verification and authorisation services; digital signature verification and authorisation services; data security services; security services and consultancy, advisory and information services; computer security consultancy; internet security consultancy; data security consultancy; computerised and electronic data storage services; consultancy, advisory, management and information services relating to all the aforesaid services.

5. The applications were published for opposition purposes on 4 May 2018 and 13 July 2018 (respectively). The Opponent challenges both applications on the same grounds - sections 5(2)(b), 5(3) and 5(4)(a) of the Act – as follows.

The section 5(2)(b) claim


6. For its section 5(2)(b) claim, the Opponent relies on the following three marks:

The Opponent’s earlier marks	
 (‘the Opponent’s Device Mark’)	International Registration WE1048048 Priority date: 16 November 2009 Date of designation of the EU: 11 May 2010 Date protection granted in the EU: 21 July 2011 Registered for goods and services in Classes 9, 16, 35, 36, 38, 41 and 42
SWIFT (‘the Opponent’s Word Mark’)	EUTM No. 3838381 Filing date: 17 May 2004 Registration date: 16 October 2006 Registered for goods and services in Classes 9, 16, 35, 36, 37, 38, 41 and 42

SWIFTNet ('the SWIFTNet Mark')	EUTM No. 2168482 Priority date: 20 December 2000 Filing date: 9 April 2001 Registration date: 26 February 2003 Registered for goods / services in Classes 9, 38 and 42
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The Opponent’s goods and services in light of proof of use

7. The filing dates of all of the above marks relied on by the Opponent predate those of the contested applications and qualify as “earlier marks” under section 6(1)(a) the Act. Each of the Opponent’s earlier marks had been registered for more than five years on the date on which the contested application was published.² They are, therefore, subject to the proof of use provisions under section 6A of the Act, and the Applicant had requested such proof for all goods and services in respect of which the marks are registered and on which the Opponent relied. The Hearing Officer duly undertook the necessary assessment of the evidence filed and determined that it established genuine use of the marks during the relevant period only in respect of the following list of goods and services set out in the table below. As I mentioned in the opening paragraph of this remitted decision, the Hearing Officer’s findings on proof of use were upheld by the AP.

<p>The Opponent’s goods and services under the Opponent’s Device Mark </p> <p>for which use has been shown</p>
<p><u>Class 9:</u> <i>Computer software relating to financial communication, software relating to encryption and to identification, software relating to the equalization, compensation and reporting of financial transactions; downloadable electronic publications relating to financial communication, including publications containing guidelines and standards for the financial community.</i></p> <p><u>Class 16:</u> <i>Printed directories.</i></p> <p><u>Class 35:</u> <i>Professional business consultancy, including that provided to financial institutions; organization of exhibitions for commercial or advertising purposes, for the financial community; maintaining and updating of computer databases.</i></p> <p><u>Class 36:</u> <i>Financial information provided via a secure global electronic communication network, including information on exchange and money market</i></p>

² This was the relevant trigger date applicable at the time that these proceedings were launched.

transactions; providing financial information via a web site; advisory services in the field of financial transactions with regard to modelling, improving, harmonizing and recording standardized electronic messages.

Class 38: *Secure transmission of messages relating to financial transactions and consulting relating thereto, data transmission between financial institutions and companies by means of a secure global electronic communication network; providing user access to a secure global electronic communication network; electronic transfer of information relating to transactions involving payments, securities, commercial paper and cash flow; rental of access to a secure global electronic communication network reserved for the financial community.*

Class 41: *Training in the field of computer software, standards and installation services and to software maintenance, all relating to financial communication; organization of exhibitions and conventions for educational purposes, for the financial community; arranging of conventions for commercial or advertising purposes for the financial community.*

Class 42: *Installation, implementation, integration, design and maintenance of computer software relating to financial communication and assistance services relating thereto; providing electronic encryption services; certification services based on digital signatures.*

**The Opponent's goods and services for which use has been shown under the
Word Mark - SWIFT**

Class 9: *Apparatus for data transmission; magnetic, optical and electronic data carriers, provided with computer programs or not; computer hardware and software to enable secure e-commerce (including electronic transactions and electronic remittances); software for use in digital signatures and certification based on public key cryptography*

Class 16: *Printed matter, namely directories*

Class 37: *Maintenance and repair of computers and peripheral equipment therefor.*

Class 38: *Telecommunications; including internet-based messaging services for securing e-commerce (including electronic transactions); providing telecommunication services to business and financial institutions by means of a computer network; advice relating to telecommunication services; providing information on the identity of senders of electronic messages to enable the recipients to verify the identity of the senders.*

Class 41: *Training of computer-operators and organisation of courses and seminars, the aforesaid services relating to computers and peripheral equipment therefor, to be used in the financial telecommunication.*

Class 42: *Systems analysis and adaptation of individual computer systems to the network system; rental of computers and peripheral equipment for computers; consultancy with respect to securing e-commerce and electronic transactions; provision of digital signatures and the supporting certification services based on public key cryptography; provision of software for electronic message security*

The Opponent's goods and services for which use has been shown under the SWIFTNet Mark

Class 38: *Providing telecommunication services to financial institutions by means of a computer network.*

8. The Opponent claims that the marks are highly similar and that the goods and services covered by the Applicant's specification are the same as, or highly similar to, goods and services covered by the earlier marks, leading to a likelihood of confusion on the part of the public. Therefore, registration of the contested series of marks should be refused under section 5(2)(b) of the Act.

The section 5(3) claim


9. Additionally, or alternatively, the Opponent claims that use of the Applicant's marks for all the goods or services in the application would take unfair advantage of, and cause detriment to, the reputation of the earlier Device Mark and Word Mark.³ It claims that dilution of the distinctive character of the earlier marks will alter the perception of those marks and have an impact on the economic behaviour of the relevant public. Therefore, registration of the contested series of marks should be refused under section 5(3) of the Act.

The section 5(4)(a) claim

10. Under section 5(4)(a) of the Act, the Opponent claims that use of the Applicant's marks for all the goods and services in the application is liable to be prevented under the law of passing off, owing to its goodwill attached to two of its signs equivalent to its Word

³ The SWIFTNet Mark is not relied on for the section 5(3) claim.



Mark and its Device Mark i.e. the word SWIFT and . It claims to have used these signs throughout the UK since 1 January 1973 in respect of the goods and services in Classes 9, 16, 35, 36, 38, 41 and 42 covered by the Opponent's Device Mark.

11. The Applicant filed a defence and counterstatement denying all of the grounds. It also put the Opponent to proof of use of the earlier marks - hence the fair specification set out in the table at paragraph 7 above, as determined by the original Hearing Officer.
12. Both parties filed evidence, which was summarised by the original Hearing Officer at paragraphs 13 – 26 of decision O/019/20. The appeal decision found no fault with that summary. I need not repeat it in full here (partly since some of its purpose has already been served in the previous findings on proof of use), but I find it convenient to reproduce some of it below (with a few supplementary additions) to provide context for other substantive findings that I will necessarily come to later in this decision. I will refer to other aspects of the evidence and of the parties' submissions or claims where I consider it warranted to do so. An oral hearing of these remitted proceedings took place before me by video-conference on 18 February 2021. Victoria Jones attended as counsel for the Opponent, instructed by Marks & Clerk LLP; Michael Bilewycz (barrister and attorney) of Decisis Limited attended for the Applicant; both filed skeleton arguments in advance.

My approach to this decision

13. My consideration of the matters underpinning the claims and counter-positions focuses on the primary materials of the papers filed by the parties and on the lines of argument articulated by their representatives at the oral hearing and in their supporting skeleton arguments. I am also of course aware of the previous decision and of the aspects in which the AP either upheld or criticised the original findings; while I will form my own conclusions on the remitted matters in the usual way, where my findings align with the original hearing officer I will make commensurate economies and will aim to focus on points where my findings or conclusions may materially diverge from the original decision.

EVIDENCE

The Opponent's evidence in chief

14. The Opponent's evidence comes from Patrick Krekels, General Counsel for SWIFT. It is dated 21 January 2019. Attached to Mr Krekels' witness statement are 19 exhibits

comprising news articles, information from the Opponent's website about goods and services offered, invoices and financial information.

15. SWIFT was founded in 1973. Mr Krekels states that its main business is the provision of a secure interbank financial transaction messaging network. The network currently uses an internet-based platform, SWIFTNet, which went live in 2001. In 2016, more than 6.5 billion messages were transmitted.⁴ An article from The Economist on 20 November 2014 explains that:

“SWIFT does not initiate transfers, hold customers’ money, or clear or settle payments. Rather, it provides a template that helps international transfers flow smoothly and be tracked.”⁵

16. As to how the system works, in broad terms, the Opponent provides each financial organisation with a unique code that is known as a SWIFT code or SWIFT ID.⁶ If an individual wants to transfer money say, from the UK, to a friend in Italy, they can go into the branch of their bank in UK with their friend’s account number and the Italian bank’s unique SWIFT code and the UK bank will then send a payment transfer SWIFT message to the Italian bank over the secure SWIFT network (known as SWIFTNet). Once the Italian bank receives the message, it will clear and credit the money to the Italian friend’s account.⁷ In addition to this core service, the Opponent provides various associated services and hardware and software to its customers.
17. The network has 772 UK customers and is, according to Mr Krekels, used by all major banks and financial institutions in the UK. Exhibit 6 contains a list of members of the UK National Member and User group, which contains customers who are more engaged in the development of products and services. These include Barclays Bank PLC, HSBC Bank Plc and Lloyds Banking Group.
18. In his witness statement, Mr Krekels provides a table, reproduced below, showing approximate revenue figures generated by product and services sales to UK customers. The figures are divided into “NBI” (“Network Based Invoice” - revenue associated with

4 Exhibit 17, page 285

5 Exhibit 2, page 58

6 It can also be referred to as the BIC or the ISO 9362 Code.

7 Exhibit 2, page 65

use of the financial messaging service) and “non-NBI” (revenue associated with other products and services).

Year	Approximate NBI (GBP)	Approximate non-NBI (GBP)	Approximate total (GBP)
2013	37,000,000	9,500,000	46,500,000
2014	42,500,000	26,500,000	69,000,000
2015	45,500,000	30,000,000	75,500,000
2016	52,500,000	30,000,000	82,500,000
2017	54,500,000	31,000,000	85,500,000
2018	21,000,000	20,000,000	41,000,000
Grand Total	253,000,000	147,000,000	400,000,000

19. Exhibit 16 contains a more detailed breakdown of the Opponent’s revenues. This exhibit remains subject to a confidentiality order, so I shall not set out the details here. However, Mr Krekels confirms in his witness statement that the “non-NBI” services include interface sales and maintenance, cloud services, security fees, connection fees, connectivity membership, application fees, compliance products, user handbooks, SWIFTRef, MyStandards, business intelligence and income from conferences.

20. The evidence also includes invoices dating from 31 May 2014 to 31 December 2016, which show sales to customers in the UK. The goods and services sold include the following categories: conferences, connectivity membership, cloud services, security products, interface sales and maintenance, SWIFTNet Link annual fee, support, training services, SWIFTRef, sanctions screening, and “Essentials Kits”.⁸

21. At the hearing, Ms Jones highlighted points from the evidence where third parties describe aspects of the Opponent’s work. For example, Exhibit 2 includes a November 2018 online magazine article where the sub-headline reads: “Financial service provider SWIFT’s annual forum attracts business leaders from all over the world”, and the article goes on: “as SWIFT’s flagship event, SIBOS attracts more than 8,000 business leaders, decision makers and financial experts every year and serves as the financial services industry’s leading conference, exhibition and networking event. ... SIBOS started out as a banking operations seminar and has grown into the premier business forum for the

8 Exhibit 15

global financial community to debate and collaborate in the areas of payments, securities, cash management and trade."

The Applicant's evidence

22. The Applicant's evidence comes from Gideon Jacob Lyons, director and co-founder of Swiffpay Limited. It is dated 17 April 2019. There is also a witness statement from Michael Domenico Bilewycz, Managing Director of Decisis Limited, also known as Decisis Intellectual Property, the Applicant's representatives. It is dated 24 April 2019.
23. Mr Lyons states that his company facilitates financial transactions (and supplies ancillary services) involving virtual and crypto currencies. Attached to his witness statement are dictionary definitions of "swift" and "net" and the results of a search of the Financial Conduct Authority (FCA) register for "swift".

The Opponent's evidence in reply

24. The Opponent's evidence in reply comes from Mr Krekels and is dated 26 June 2019. His witness statement is a vehicle for submitting the exhibits summarised below (by the original Hearing Officer).
25. Exhibit 20 contains articles on the competition between crypto and virtual currencies and the Opponent's services, in response to Mr Lyons' assertion that the area of crypto and virtual currencies is very specialist and Mr Lyons' assertion the activities of the two parties are thus distinguishable.
26. Exhibit 21 contains articles and print-outs from banks' websites aimed at the end user and explaining how to make international payments. These are directed towards showing that the consumers of financial services are not just professionals. The articles state that the consumer needs to know the SWIFT code of the receiving bank in order to make an international payment.
27. Exhibit 22 contains search results of the FCA's register showing that there are over 1500 results for LLOYD or LLOYD'S. Mr Krekels concludes from this that the existence of many other businesses with this name does not detract from the fame of LLOYDS as a trade mark among members of the public and professionals. Moreover, Mr Krekels anyway denied that the FCA register served as reliable evidence of the state of the market. On this latter point, I note that the AP, at paragraph 44 of the appeal decision,

considered the original Hearing Officer to have correctly dismissed the evidence as failing to indicate any relevant activity of FCA-regulated firms using SWIFT as part of their names. I do not revisit these lines of argument in this decision.

DECISION OF REMITTED CLAIMS

The section 5(2)(b) grounds

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

“5. – [...]

(2) A trade mark shall not be registered if because – [...]

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

29. Determination of a section 5(2)(b) claim must be made in light of the following principles, which 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 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. The principles are:

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods and services

30. The Applicant's goods and services, under both its applied-for series of marks, are those in Classes 9, 35, 36, 38 and 42 that I set out at paragraph 4 in the background introductory part of this decision. All of those specified goods and services are contested by the Opponent. In light of the upheld previous findings as to proof of use, the Applicant's contested goods and services are to be assessed for similarity or identity as compared

with the fair specification of goods and services that I set out in the table at paragraph 7 above.

31. The decision of the previous Hearing Officer proceeded only so far as to identify the respective goods and services that she considered to be *identical*. Since the Hearing Officer found no likelihood of confusion based on identical goods or services, it was not necessary for her to identify the goods or services that she considered only similar in some degree, or not similar at all. The AP decision dealt with grounds of appeal critical of the Hearing Officer’s comparison of the parties’ goods and services. These criticisms were made in the context of the section 5(3) ground, but the AP’s comment on them, notably at paragraphs 37 – 39 of the appeal decision, must be similarly relevant for the purposes of the section 5(2)(b) ground.
32. None of the criticisms includes a suggestion that the Hearing Officer had been wrong in her conclusions that the goods and services that she set out at paragraph 74 of the original decision were identical. In the comparison table below, I take as a starting point those terms previously found to be identical, and which in that table I have underlined. However, the table also identifies the parties’ goods and services that may *additionally* be considered identical, and it also deals with which may be considered similar or dissimilar. My own findings in the table below (which are underlined and in **bold**) have taken due account of the parties’ submissions and of the AP’s critical observations in relation to the original Hearing Officer’s findings in the goods and services comparison.
33. My conclusions have also taken account of the relevant case-law guidance, which for reference I set out first. Thus, in considering the extent to which there may be similarity between goods/services, I take account of the guidance in *Canon*, where the Court of Justice of the European Union (“**the CJEU**”) stated that:

“In assessing the similarity of the goods ... all the relevant factors relating to those goods .. themselves should be taken into account. 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”.⁹
34. In *Boston Scientific*, the General Court described goods as “complementary” in circumstances where “... *there is a close connection between [the goods], in the sense*

⁹ Case C-39/97, at paragraph 23.

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".¹⁰ The principle, expressed in relation to goods, applies comparably to services. I also take note that in *Kurt Hesse v OHIM*, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.¹¹

35. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case¹² 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.

36. Moreover, the principle in *Gérard Meric* is that where goods or services designated by an earlier mark are included in a more general category designated by a trade mark application - or vice versa - such goods or services may be considered identical.¹³ That said, it is also necessary to take into account the need for specifications of services, which are inherently less precise than specifications of goods, to be "interpreted in a manner which confines them to the core of the ordinary and natural meaning rather than more broadly".¹⁴

¹⁰ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

¹¹ *Case C-50/15 P*

¹² *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

¹³ See paragraph 29 of the ruling of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, EU:T:2006:247.

¹⁴ per Arnold J in *FIL v Fidelis Underwriting* [2018] EWHC 1097 (Pat) at [86]. See too *YouView Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] where Floyd J equally cautioned (in the context of goods) against straining the language unnaturally so as to produce a narrow meaning. I note too the principles of interpretation as set out in *Sky v Skykick* [2020] EWHC 990 (Ch), at [56].

37. I also note that in *Separode Trade Mark* (BL O-399-10) Geoffrey Hobbs Q.C. as the Appointed Person in that case, confirmed that it is permissible to group goods together for the purpose of assessment, stating “The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

Opponent’s goods and services	Applicant’s goods and services
The Opponent’s Device Mark	
CLASS 9 GOODS	
<p>Class 9 <i>Computer software relating to financial communication, software relating to encryption and to identification, software relating to the equalization, compensation and reporting of financial transactions</i></p>	<p>Class 9 <u>Computer software</u> (i.e. goods previously found <u>identical</u>)</p>
<p>On behalf of the Opponent, Ms Jones submitted in a schedule to her skeleton argument, that the above Class 9 specification under the Opponent’s Device Mark gives rise not only to identity in respect of the applied-for <u>Computer software</u>, but extended further, so that the following applied-for goods should also be considered identical:</p> <p><i>computer software, hardware and systems for use in the provision of financial and investment services;</i> <i>computer software, hardware and systems for electronic financial and investment trading;</i> <i>electronic and web-based financial and investment trading systems, software and hardware;</i> <i>computer software, hardware and systems for virtual and crypto currency trading;</i> <i>software, hardware and systems enabling secure internet access;</i> <i>telecommunications and communications software and systems; telecommunications and communications software and systems for transmission of data and funds;</i> <i>telecommunications and communications software and systems for transmission of virtual and crypto currencies;</i> <i>software and hardware facilitating financial and investment transactions;</i></p>	
<p><i>telecommunications and communications software and systems for transmission of monetary, currency, virtual currency, crypto currency, commodities and funds transfers and payments;</i> <i>software and hardware facilitating financial and investment transactions in relation to virtual and crypto currencies</i></p>	

And in addition to the above claims of identical goods, Ms Jones submitted that the above Class 9 goods specified under the Opponent's Device Mark are at least **similar** to the following of the Applicant's goods:

*Computer hardware;
software, hardware and systems for storage and transfer of data;
financial and investment management software and hardware;
software and hardware for financial and investment management in relation to virtual and crypto currencies;*

In my view, the principle of inclusion expressed in *Gérard Meric*, as between broad specifications and narrower definitions of goods or services, operates to sustain a finding that most of the applied-for terms additionally identified above as identical may indeed be considered **identical**. Alternatively, all of those goods may be considered **highly similar** based for instance on shared purpose, uses, users, and trade channels. Insofar as the goods above are expressed to be hardware and 'systems' (which I take to cover hardware and software together) I consider them to be highly similar to software alone, not identical.

And I find the terms identified above, that Ms Jones submits are at least similar, are indeed **similar and, in my view, to at least a medium degree**. The goods have the same distribution channels and consumers, are complementary and overlap in nature, intended purpose and method of use.

CLASS 35 SERVICES

Opponent's goods and services	Applied-for goods and services
Class 35 <i>Professional business consultancy, including that provided to financial institutions</i>	Class 35 <u><i>Professional business consultancy services; professional business consultancy services provided to financial institutions</i></u>
Class 35 <i>Maintaining and updating of computer databases</i>	Class 35 <u><i>Maintaining and updating of computer databases</i></u>

Ms Jones submitted that the above *Professional business consultancy, including that provided to financial institutions*, specified in Class 35 under the Opponent's Device Mark, gives rise not only to identity in respect of the applied-for the underlined terms alongside it, but extended further, so that the following applied-for Class 35 services, should also be considered **identical**:

*Business management assistance;
business management assistance provided to financial institutions;*

*business management consultancy services;
business management consultancy services provided to financial institutions;
business information services;
provision of business training and instruction;
consultancy services relating to all of the aforesaid services*

And in addition to the above claims of identical services, Ms Jones submitted that the same Class 35 services under the Opponent's Device Mark – namely, *Professional business consultancy, including that provided to financial institutions* - are at least **similar** to the following of the Applicant's Class 35 services:

business management and administration;
business management and administration of charitable organisations;
business mentoring;
mentoring services for business management;
providing business management start-up support for other businesses;
providing business management and support services for start-up businesses;
business incubator services;
business accelerator services;
consultancy services relating to all of the aforesaid services.

In my view, the Opponent's *Professional business consultancy* services covers most of the applied-for terms additionally identified as identical, such that the principle of inclusion expressed in *Gérard Meric* allows a finding that they may be considered **identical**.

However, having in mind that broad terms for services are to be interpreted as covering only the core of their possible meanings, and that consultancy centrally involves advice, I do not consider *business information services* or *provision of business training and instruction* to be identical services. (That said, it seems to me that other terms, which Ms Jones identifies only as similar may be considered identical to the Opponent's business consultancy services – particularly the applied-for *business mentoring; mentoring services for business management*.) At any rate, all of the applied-for services in Class 35 that are listed above (submitted to be identical or similar) are **at least highly similar** based on shared nature, purpose, uses, users, trade channels, and complementarity.

The only remaining applied-for services in Class 35 are:

management and administration on behalf of charities;
consultancy services relating to all of the aforesaid services.

Ms Jones accepted (in Schedule 3 to her Skeleton Argument) that these services may be considered as **dissimilar** to the Opponent's earlier services. It seems to me that even whilst consciously focusing on the core of services, there may be a degree of similarity between the applied-for consultancy services relating to charity management services and the Opponent's *Professional business consultancy, including that provided to financial institutions*. The presence of "*including*" means that the Opponent's term is not limited to "*financial institutions*", so there seems no reason why the *Professional business consultancy* services may not also be used to assist in the management and administration of charities, which although operate not for profit may nonetheless operate as businesses. However, in view of the Opponent's submitted position on these services, I accordingly find them to be **dissimilar** – which necessarily leads to failure of the section 5(2)(b) claim in respect of those services.

CLASS 36 SERVICES

Opponent's goods and services	Applied-for goods and services
<p>Class 36 <i>Financial information provided via a secure global electronic communication network, including information on exchange and money market transactions</i></p>	<p>Class 36 <u><i>Providing financial information via a secure global electronic communication network, including information on exchange and money market transactions</i></u></p>
<p>Class 36 <i>Providing financial information via a web site</i></p>	<p>Class 36 <u><i>Provision of financial information via the Internet</i></u></p>

Whereas the original decision found services in Class 36 under the Opponent's Device Mark identical only as indicated above, Ms Jones submitted that the applied-for services in Class 36 are additionally **identical** or **similar** to the following extents, based on the following earlier specification:

Class 36 (under the Opponent's Device Mark)

Financial information provided via a secure global electronic communication network, including information on exchange and money market transactions;

providing financial information via a web site;

advisory services in the field of financial transactions with regard to modelling, improving, harmonizing and recording standardized electronic messages.

Ms Jones submitted the following applied-for **Class 36** services to be **identical**:

Financial Services;

Monetary affairs;

electronic exchange and money market transactions;

Financial services enabling virtual currency and crypto currency transactions and exchanges;

facilitating electronic monetary, currency, virtual currency, crypto currency, commodities and funds transfers and payments;

providing financial information relating to virtual and crypto currencies via a secure global electronic network;

financial advisory services;

consultancy, advisory, management and information services relating to all the aforesaid services.

In my view, the Opponent’s services around securely providing financial information over the internet either cover or fall within all of the applied-for terms additionally identified, such that the principle of inclusion expressed in *Gérard Meric* allows a finding that they may be considered **identical**. At any rate, they are **at least highly similar** based on shared nature, purpose, uses, users, trade channels, and complementarity.

Ms Jones submitted the following applied-for **Class 36** services to be **similar**:

Currency management services;
virtual currency and crypto currency management services;
financial management;
investment services;
investment advice;
investment management;
funds management;
capital management;
private equity management;
commodities investment and management;
financial underwriting and brokerage;
brokerage services in relation to currencies, virtual currencies, crypto currencies, stocks, shares, securities, commodities and other investments;
financial syndicate service and management;
project finance;
trust fund services;
foreign exchange services;
banking services;
bank transfer and payment services;
consultancy, advisory, management and information services relating to all the aforesaid services.

I consider the above services, which Ms Jones identifies as similar, to be **similar to at least a medium degree** to the Opponent’s services around securely providing financial information over the internet – based on shared nature, users, trade channels and complementarity.

CLASS 38 SERVICES

Opponent’s goods and services	Applied-for goods and services
<p>Class 38 <i>Data transmission between financial institutions and companies by means of a secure global electronic communication network</i></p>	<p>Class 38 <u><i>Provision of telecommunications and communications systems and networks for the transmission of funds and data</i></u></p>

Whereas the original decision found services in Class 38 under the Opponent's Device Mark identical only as indicated above, Ms Jones submitted that the applied-for services in Class 38 are additionally **identical** or **similar** to the following extents, based on the following earlier specification:

Class 38 (under the Opponent's Device Mark)

Secure transmission of messages relating to financial transactions and consulting relating thereto, data transmission between financial institutions and companies by means of a secure global electronic communication network;

providing user access to a secure global electronic communication network;

electronic transfer of information relating to transactions involving payments, securities, commercial paper and cash flow;

rental of access to a secure global electronic communication network reserved for the financial community

Ms Jones submitted the following applied-for **Class 38** services to be **identical**:

Provision of web-based and Internet-based financial and investment trading and transactional systems and platforms;

provision of telecommunications and communications access to web-based and Internet-based financial and investment trading and transactional systems and platforms;

Electronic transmission of funds and data via telecommunications and communications networks;

Provision of telecommunications and communications systems and networks for the transmission of funds and data;

provision of internet-based systems/platforms for virtual and crypto currency trading and transactions;

provision of internet-based systems/platforms for the transmission of virtual and crypto currencies; consultancy, advisory, management and information services relating to all the aforesaid services

Comparing the above applied-for services in Class 38, I find the Opponent's services around, for example, *providing user access to a secure global electronic communication network* and the *secure transmission of messages relating to financial transactions* **similar to a high degree** based on shared nature, purpose, users, trade channels and complementarity.

Ms Jones submitted the following applied-for **Class 38** services to be **similar**:

provision of telecommunications and communications access to the Internet and the worldwide web; consultancy, advisory, management and information services relating to all the aforesaid services

In my view, there is a clear overlap with the Opponent's (Device Mark) services of *rental of access to a secure global electronic communication network reserved for the financial community* and I therefore consider the above services (submitted to be similar) **similar to a medium degree** based on shared nature, purpose, users and trade channels.

CLASS 42 SERVICES

Opponent's goods and services	Applied-for goods and services
<p>Class 42 <i>Installation, implementation, integration, design and maintenance of computer software relating to financial communication and assistance services relating thereto</i></p>	<p>Class 42 <u>Computer software and programming services;</u> <u>computer services</u></p>
<p>Class 42 <i>Providing electronic encryption services</i></p>	<p>Class 42 <u>Encryption services</u></p>
<p>Class 42 <i>Certification services based on digital signatures</i></p>	<p>Class 42 <u>Identification, authorisation, authentication and verification of data;</u> <u>electronic signature verification and authorisation services;</u> <u>digital signature verification and authorisation services</u></p>

Whereas the original decision found services in Class 42 under the Opponent's Device Mark identical only as indicated above, Ms Jones submitted that the applied-for services in Class 42 are additionally **identical** or **similar** to the following extents, based on the combined above three aspects of the earlier specification (i.e. *Installation, implementation, integration, design and maintenance of computer software relating to financial communication and assistance services relating thereto; providing electronic encryption services; certification services based on digital signatures*)

Ms Jones submitted the following (additional) applied-for **Class 42** services to be **identical**:

Design and development of computer software;
Development and providing an online platform featuring software effecting electronic monetary, currency, virtual currency, crypto currency, and funds transfers and payments;
developing and/or hosting an online platform for the provision of financial services;
developing and/or hosting an online platform enabling electronic monetary, currency, virtual currency, crypto currency, and funds transfers and payments;
providing use of online, non-downloadable computer software for financial and investment transactions;
developing, hosting and/or providing electronic and web-based financial investment trading systems/platforms, software and hardware;
developing, hosting and/or providing computer software, hardware and systems/platforms for virtual and crypto currency trading;
providing software as a service for use in connection with storage/provision of financial and investment information/data;
data security services;
security services and consultancy, advisory and information services;
computer security consultancy;
internet security consultancy;
data security consultancy;
consultancy, advisory, management and information services relating to all the aforesaid services.

In my view, the Opponent's services around *Installation, implementation, integration, design and maintenance of computer software relating to financial communication* either cover or fall within all of the applied-for terms additionally identified, such that the *Meric* principle allows that they may largely be considered **identical** and the consultancy services similar. At any rate, these services are **highly similar** based on shared nature, purpose, uses, users, trade channels and complementarity.

Ms Jones submitted the following applied-for **Class 42** services to be **similar**:

providing use of online, non-downloadable computer software for storing and accessing financial and investment information;
computer network services;
computerised and electronic data storage services;
consultancy, advisory, management and information services relating to all the aforesaid services.

In my view, the Opponent's services around *implementation, integration and design of computer software and electronic encryption and certification based on digital signatures* overlap with the above services (submitted to be similar) and I find them to be **similar to at least a medium degree** based on shared nature, purpose, users, trade channels and complementarity.

The only remaining services in Class 42 are:

Lease, hire and rental of computer equipment, hardware, software and programs;
design of websites;
hosting websites for others;
creating and maintaining websites;
consultancy, advisory, management and information services relating to all the aforesaid services

Ms Jones indicated in her Schedule 3 to her skeleton that these services may be considered as **dissimilar** to the Opponent's earlier services, and I accordingly find likewise.

38. This table continues to compare the applied-for goods and services with those under the fair specification of the **Opponent's Word Mark**:

CLASS 9 GOODS	
The Opponent's Word Mark (SWIFT)	Applied-for goods / services
<p>Class 9 <i>Computer ... software to enable secure e-commerce (including electronic transactions and electronic remittances); software for use in digital signatures and certification based on public key cryptography</i></p>	<p>Class 9 <u><i>Computer software</i></u></p>

<p>Class 9 <i>Apparatus for data transmission</i></p>	<p>Class 9 <u><i>Computer hardware</i></u></p>
<p>Class 9 <i>Magnetic, optical and electronic data carriers, provided with computer programs or not</i></p>	<p>Class 9 <u><i>Software, hardware and systems for storage and transfer of data</i></u></p>
<p>The Class 9 fair specification available to the Opponent under its Word Mark is:</p> <p><i>Apparatus for data transmission; magnetic, optical and electronic data carriers, provided with computer programs or not; computer hardware and software to enable secure e- commerce (including electronic transactions and electronic remittances); software for use in digital signatures and certification based on public key cryptography</i></p> <p>Ms Jones submitted that those earlier services may properly be considered identical not only to <i>Computer software; Computer hardware; Software, hardware and systems for storage and transfer of data</i> (as found originally), but also to the following applied-for goods:</p> <p><i>software, hardware and systems enabling secure internet access; telecommunications and communications software and systems; telecommunications and communications software and systems for transmission of data and funds; telecommunications and communications software and systems for transmission of virtual and crypto currencies; software and hardware facilitating financial and investment transactions; telecommunications and communications software and systems for transmission of monetary, currency, virtual currency, crypto currency, commodities and funds transfers and payments; software and hardware facilitating financial and investment transactions in relation to virtual and crypto currencies.</i></p>	
<p>And in addition to the above claims of identical goods, Ms Jones submitted that the Class 9 goods above under the fair specification for the Opponent's Word Mark are at least similar to the following of the Applicant's goods:</p> <p><i>computer software, hardware and systems for use in the provision of financial and investment services; computer software, hardware and systems for electronic financial and investment trading; electronic and web-based financial and investment trading systems, software and hardware; computer software, hardware and systems for virtual and crypto currency trading;</i></p>	
<p><i>financial and investment management software and hardware; software and hardware for financial and investment management in relation to virtual and crypto currencies.</i></p>	
<p>In my view, under the <i>Meric</i> principle all of the applied-for terms additionally identified above as identical may indeed be considered so. At any rate all of those goods are at least highly similar based on shared nature, uses, users, trade channels and complementarity.</p>	

I also find the terms that Ms Jones submits are at least similar (identified above) are **highly similar** on the basis that they have the same distribution channels and consumers, are complementary and overlap in nature, intended purpose and method of use.

CLASS 38 SERVICES

The Opponent's Word Mark (SWIFT)	Applied-for goods / services
<p>Class 38 <i>Telecommunications</i></p>	<p>Class 38 <u><i>Provision of telecommunications and communications access to web-based and internet-based financial and investment trading and transactional systems and platforms; provision of telecommunications and communications access to the Internet and the worldwide web; provision of telecommunications and communications systems and networks for the transmission of funds and data</i></u></p>
<p>Class 38 <i>Providing telecommunication services to business and financial institutions by means of a computer network</i></p>	<p>Class 38 <u><i>Provision of telecommunications and communications access to the Internet and the worldwide web</i></u></p>
<p>Class 38 <i>Advice relating to telecommunication services</i></p>	<p>Class 38 <u><i>... advisory ... services relating to all the applicant's Class 38 telecommunications services</i></u></p>

As the AP noted at paragraph 38 of her appeal decision, the term *telecommunications* present in the Opponent's Class 38 fair specification under the Word Mark, encompasses all of the Applicant's Class 38 specification, save perhaps for the consultancy services at the end of the list, and that applying *Meric*, those services are identical.

Thus, according Ms Jones, the applied-for services in Class 38 are identical not only as underlined above, but additionally as follows:

Provision of web-based and Internet-based financial and investment trading and transactional systems and platforms;
Electronic transmission of funds and data via telecommunications and communications networks; provision of internet-based systems/platforms for virtual and crypto currency trading and transactions; provision of internet-based systems/platforms for the transmission of virtual and crypto currencies; consultancy, advisory, management and information services relating to all the aforesaid services

I find the applied-for Class 38 services to be **identical**, or else that the related consultancy, advisory, management and information services are **highly similar** based on shared purpose, uses, users, trade channels and complementarity.

CLASS 42 SERVICES

The Opponent's Word Mark (SWIFT)

Applied-for goods / services

Class 42

Provision of digital signatures and the supporting certification services based on public key cryptography; provision of software for electronic message security

Class 42

Data security services

The Class 42 fair specification available to the Opponent under its Word Mark is:

*Systems analysis and adaptation of individual computer systems to the network system;
rental of computers and peripheral equipment for computers;
consultancy with respect to securing e-commerce and electronic transactions;
provision of digital signatures and the supporting certification services based on public key cryptography;
provision of software for electronic message security*

Ms Jones submitted that those earlier Class 42 services may be considered **identical** not only to *Data security services* (as found originally and underlined above), but also to the following applied-for services:

*Design and development of computer software;
computer software and programming services;
computer services;
lease, hire and rental of computer equipment, hardware, software and programs;
encryption services;
identification, authorisation and authentication and verification of data;
electronic signature verification and authorisation services;
digital signature verification and authorisation services;
data security services;*

*security services and consultancy, advisory and information services;
computer security consultancy;
internet security consultancy;
data security consultancy;
consultancy, advisory, management and information services relating to the aforesaid services*

I note that the above contested services include very broad terms such as *computer services*, which on a plain interpretation covers all of the earlier Class 42 services. Moreover, the Opponent's earlier Word Mark covers, for example, *rental of computers and peripheral equipment for computers* and the applied-for mark covers *lease, hire and rental of computer equipment, hardware, software and programs*. Consequently, I find that either by virtue of the *Meric* principle and/or on the basis of directly equivalent terms in both specifications, all of the applied-for terms additionally identified above as **identical** may indeed be considered so. If the term *rental of computers and peripheral equipment for computers* does not cover *lease of software and programs* then those services, if not identical are at least **similar to a medium degree** based on shared purpose, users, trade channels and complementarity.

Ms Jones submitted that the Class 42 services above under the fair specification for the Opponent's Word Mark are at least **similar** to the following of the Applicant's Class 42 services:

Development and providing an online platform featuring software effecting electronic monetary, currency, virtual currency, crypto currency and funds transfers and payments;
developing and/or hosting an online platform for the provision of financial services;
developing and/or hosting an online platform enabling electronic monetary, currency, virtual currency, crypto currency and funds transfers and payments;
providing use of online, non-downloadable computer software for financial and investment transactions;
developing, hosting and/or providing electronic and web-based financial and investment trading systems/platforms, software and hardware;
developing, hosting and/or providing computer software, hardware and systems/platforms for virtual and crypto currency trading;
Providing use of online, non-downloadable computer software for storing and accessing financial and investment information;
providing software as a service for use in connection with storage/provision of financial and investment information/data;
computer network services;
consultancy, advisory, management and information services relating to the aforesaid services

In my view, the Opponent's Class 42 fair specification of services - which involve, for example, network integration, consultancy on securing ecommerce and providing software for secure electronic messaging - overlap significantly with the above services (submitted to be similar) and I find them to be **similar to at least a medium degree** based on shared nature, purpose, users, trade channels and complementarity.

The only remaining services in Class 42 are:

*Design of websites;
hosting websites for others;
creating and maintaining websites;
computerised and electronic data storage services;
consultancy, advisory, management and information services relating to the aforesaid services*

Ms Jones submitted that these services may be considered as **dissimilar** to the Opponent's earlier services under the Word Mark. I am content to agree and I accordingly find these services to be **not similar**. Where there is no similarity at all between services, a claim based on section 5(2)(b) cannot succeed; however, in this case I note that earlier in this decision, I have found, based on the Opponent's Device Mark, a degree of similarity for all of these Class 42 services, even if only to a very low degree (although I found the above applied-for *computerised and electronic data storage services* similar to a medium degree to services under the Opponent's Device Mark).

39. This table continues to compare the applied-for services with those under the fair specification of the **SwiftNet Mark**:

The SwiftNet Mark	Applied-for services
<p>Class 38 <i>Providing telecommunication services to financial institutions by means of a computer network</i></p>	<p>Class 38 <u><i>Provision of telecommunications and communications access to the Internet and the worldwide web</i></u></p>
<p>Under the SwiftNet Mark the fair specification of services in Class 38 is not expressed as "telecommunications" at large. However, I find that the AP's comment as to the reach and effect of the <i>Meric</i> principle applies comparably in the circumstances of the SwiftNet Mark specification. Taking account of submissions from Ms Jones (in the Schedule 3 to her skeleton argument) I find the Opponent's services of <i>Providing telecommunication services to financial institutions by means of a computer network</i> encompass not only the applied-for services underlined above, but also the following services:</p>	
<p>Class 38 <i>provision of telecommunications and communications access to web-based and Internet-based financial and investment trading and transactional systems and platforms;</i></p> <p><i>Provision of telecommunications and communications systems and networks for the transmission of funds and data;</i></p> <p>I accordingly find that the additional above services may be considered identical.</p> <p>The related consultancy, advisory, management and information services are highly similar based on shared purpose, uses, users, trade channels and complementarity.</p>	

The remaining applied-for services in Class 38 are:

Provision of web-based and Internet-based financial and investment trading and transactional systems and platforms;

electronic transmission of funds and data via telecommunications and communications networks;

provision of internet-based systems/platforms for virtual and crypto currency trading and transactions;

provision of internet-based systems/platforms for the transmission of virtual and crypto currencies;

consultancy, advisory, management and information services relating to all the aforesaid services

Ms Jones submits that each of these remaining applied-for services in Class 38 is **similar** to the Opponent's services of *Providing telecommunication services to financial institutions by means of a computer network* under the SwiftNet Mark.

In my view, the respective services have the clear potential to overlap significantly and I find them to be **similar to at least a medium degree** based on aspects of shared nature, method of use purpose, users, trade channels and complementarity.

I note that the *electronic transmission of funds and data via telecommunications and communications networks* differs from the other services listed above, which are about providing the means rather than electronic transfer as such, but such services could still be offered to financial services customers alongside access to a secure network and I still consider them similar to a medium degree.

40. Before leaving this section of my decision, which focuses on the goods and services at issue, here may be a sensible place to note one of the central positions maintained on behalf of the Opponent as to the interaction and connectedness of the goods and services at issue. Ms Jones emphasised that the whole purpose of the Opponent's core service is to facilitate financial transactions, securely providing financial information, and that it comprises both a telecommunications service and a financial service. This is supported by the evidence, for example at Exhibit 1 (page 15) which refers to "1973 - SWIFT is born - SWIFT starts the mission of creating a shared worldwide data-processing and communications link and a common language for international financial transactions". Given the development of an underpinning "common language", I agree with the submission of Ms Jones that to describe the Opponent's services simply as a messaging network is far too simplified – it provides not just a messaging network but the language of the decoding that is necessary for those financial transactions to take place.

41. It is also clear from the evidence that the Opponent provides many other services that are incorporated within or provided as part of this messaging service. Mr Krekels states: "The Opponent's business was widened to provide IP-based financial messaging services and related software, consultancy and other services". This includes the SWIFTNet internet-based platform via which users may access the messaging service. The Opponent also provides associated hardware such as a VPN (Virtual Private Network) and provides consultancy services, replacing systems relating to the processing of financial transactions.¹⁵
42. The evidence also sets out that from 1987 (paragraph 15 Exhibit 1) SWIFT goes into "securities" – in other words, tradable financial assets. Exhibit 2 (page 48) shows an article from 2017 which refers to "SWIFT building a block chain app" – in other words "a digital ledger of transactions" which is the technological basis on which crypto-currencies (such as Bitcoin) depend. I will return to this when I consider the likelihood of confusion.

The average consumer and the purchasing process

43. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select them. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.¹⁶ In *Hearst Holdings Inc*,¹⁷ 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 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 word "average" denotes that the person is typical... [it] does not denote some form of numerical mean, mode or median."

44. The decision of by the original Hearing Officer had found that all but two of the goods and services that she identified as identical to one another would be purchased by "businesses and professionals, in many cases working in the financial sector". (I'll come

¹⁵ Paragraph 15 of First Witness Statement of Mr Krekels

¹⁶ *Lloyd Schuhfabrik Meyer*, Case C-342/97

¹⁷ *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)

back to the exceptions below.) The original Hearing Officer made the following findings in relation to the engagement of such businesses and professionals with the marks:

- i. They are likely to see the marks on product literature, websites and exhibitions.
- ii. While they may hear the marks spoken – for example, in meetings – it is unlikely that this type of customer would choose such goods and services purely on the basis of word-of-mouth recommendation.
- iii. In the view of the Hearing Officer, the visual element will be the most important.
- iv. These are significant purchasing decisions: the goods and services will be acquired infrequently and are likely to be relatively expensive. This suggests that the average consumer will be paying a high level of attention.

The original Hearing Officer identified only two exceptions to this analysis:

- i. Firstly “*computer software*” – which was noted to be a broad category and encompasses complex business-critical software and also the programs and applications, such as word processors and calendars, that are used by the general public. Software is purchased from bricks-and-mortar retailers, downloaded from the internet, and, in the case of some business software, bought from specialist suppliers. Price varies. In the case of software, therefore, the original Hearing Officer found that the average consumer would pay **at least a medium level of attention**.
 - ii. The second exception identified was “*computer hardware*”. This category encompasses goods that are aimed at a wide range of different consumers, from members of the general public to business. The goods are purchased from the same type of outlets as software: physical stores, internet retailers and specialist suppliers. Again, the price varies, but will generally be higher than software. The Hearing Officer found that the average consumer will pay a **medium to high level of attention**.
45. The AP dealt with the appeal grounds around identification of the average consumer at paragraph 19 of her decision. The AP agreed with submissions on the part of the Opponent, that a member of the general public may also purchase the services of providing financial information online and “*encryption services*” in **Class 36** and “*telecommunications services*” in **Class 38**. However, the AP also gave her view that a

member of the **general public** would still choose such services with a **medium to high level of attention**, mitigating any impact of this gap in the decision.

46. I largely agree (subject to the comments I make at paragraph 52 below) with the points that I have reproduced above both from the original Hearing Officer and from the AP. However, since the previous analysis was limited to only the goods and services found by the Hearing Officer to be identical, it is necessary for me to make findings about the average consumer and the purchasing process in relation to the full range of goods and services at issue, both similar and identical. I shall also clarify what I consider the earlier reproduced findings to cover in terms of the parties' respective goods and services.
47. The Applicant's goods in **Class 9** cover not simply "*Computer software*" and "*computer hardware*", expressed in just precisely those terms, but also includes the specification of numerous other goods, which are various types of software and hardware, generally with a trading, investment or other financial focus. Some of those goods may be additionally, or even primarily, of interest and relevance to businesses and professionals – for instance "*telecommunications and communications software and systems for transmission of monetary, currency, virtual currency, crypto currency, commodities and funds transfers and payments*"; however, even for such goods, specified in relatively rarefied terms, it seems to me that it would not be unreasonable to consider that they may be purchased in some form – as an app perhaps - by a member of the general public, albeit a minority section of the public who may take an interest early engagement with the field of modern and emerging forms of currency – although the "transmission of payments", which appears within that specified term, would anyway be a commonplace service. I therefore consider all of the applied-for Class 9 goods to include an average consumer based in the general public (as well as the business public) - with levels of attention and the purchasing process as previously stated. The Opponent's goods in Class 9 likewise entail an average consumer drawn from a mix of general and business publics.
48. The **Class 35** services are in the nature of business consultancy, management and administration and care of databases, such that average consumer may fairly be considered to be exclusively a business public.
49. The applied-for **Class 36** services include broad and commonplace services such as *financial services; investment advice; banking services; bank transfer and payment services*. I find the majority of the services in Class 36 may include amongst the average

consumer, members of the general public (as well as businesses). I find this extends, even to those referencing seemingly specialised services, such as *brokerage services in relation to currencies, virtual currencies, crypto currencies, stocks, shares, securities, commodities and other investments* – certainly accessing a brokerage service for investment purposes is not exclusive to a business consumer. That said, the applied-for services of “*financial syndicate services and management*,” and “*project finance*,” appear to me less likely apt to engage the general public, so the average consumer for those services may be only businesses or professional users. The Opponent’s services in Class 36 likewise entail an average consumer drawn from a mix of general and business publics. However, whether purchased by a member of the general public or the business public, in line with the AP findings, the Class 36 services will be purchased with not lower than a **medium to high level of attention**.

50. The applied-for **Class 38** telecommunication-based services will be of primary interest to professionals in the fields of trading and investment. However, in my view, there will be a relevant portion of the general public who will also be interested in such forms of online trading and who may wish to transmit electronic funds and so on. The Opponent’s services in Class 38 likewise entail an average consumer drawn from a mix of general and business publics. Again, whether purchased by a member of the general public or the business public, in line with the AP findings, the services will be purchased with not lower than a **medium to high level of attention**.
51. The **Class 42** services include mostly services that will be of primary interest to businesses, but the services also include terms that would also cover services of interest to a general public such as the applied-for “*computer services*” or the Opponent’s “*provision of software for electronic message security*”. Again, whether purchased by a member of the general public or the business public, the services will be purchased with not lower than a **medium level of attention**.
52. At paragraph 46 above I have indicated my agreement with the earlier findings, but I note that insofar as the goods and services include many that may be purchased by the general public, recommendations and oral requests may involve significant oral/aural use of the marks at issue.
53. At the hearing, Ms Jones emphasised various points around who should properly be considered a consumer of the goods or services in this case, especially taking account of

the real-world circumstances in which the goods and services are shown in the evidence to be offered. I shall refer further to such submissions by Ms Jones when I come to my assessment of a likelihood of confusion. For the purposes of this section of my decision, concerned with matters of the average consumer for the range of goods and services at issue and of the purchasing implications around such goods and services, I note the following points raised by Ms Jones.

54. Ms Jones highlighted paragraph 5 of the first Witness Statement of Mr Krekels, where he states:

"The main business of my company lies in the provision of a secure and market-leading interbank financial transaction messaging network. This facilitates payments sent by customers of my company and is designed to increase security around completion of payments and transactions sent between different banks to the benefit of banks and their customers" (my emphasis).

55. Ms Jones acknowledged the findings, accepted in the appeal decision, that many of the goods and services would be purchased by "businesses and professionals, in many cases working in the financial sector" and also acknowledged the points made in paragraph 45 above, where the AP found that a member of the general public when purchasing the services of providing financial information online and "*encryption services*" in **Class 36** and "*telecommunications services*" in **Class 38** would do so with a **medium to high level of attention**. However, Ms Jones gave her view – which in my view is correct - that those assessments are in relation to the *direct* consumer of the goods or services. Whilst, in this case, the direct consumer will often be a business/professional user, most likely, a bank, Ms Jones emphasised that it is also important to take into account the 'end user'.¹⁸ In this case, the end user could typically be the individual or company who wishes to make the financial transfer/transaction.¹⁹ In order to make a transfer/transaction using the Opponent's services, the customer is expressly directed to enter a 'SWIFT code'. Ms Jones submitted that the attention paid to the brand name by these end-users is likely to be very different from that of the businesses/professionals who are purchasing the services directly from the Opponent (or the Applicant as the case

¹⁸ *London Taxi Corp'n Ltd v Frazer-Nash Research Ltd* [2018] FSR 7 at §§34-35

¹⁹ [see Exhibit 2, p.65]

may be) and may be much lower, certainly enough to give rise to the possibility of imperfect recollection.²⁰

56. Ms Jones further argued that the end user's ability to be able to readily recognise and distinguish the service they are using from other services (and therefore their ability to input the correct code in order to successfully carry out the transaction) is crucial. She argued that it is for this reason that the end-user must also be taken into account when considering who is the average consumer as confusion on their part would be just as harmful to the Opponent (or the Applicant as the case may be) as confusion by the direct consumer.

57. In support of the importance of the end-user, Ms Jones referred me to the following passages from the judgment of Floyd LJ in the *London Taxi* case:

“34. As with all issues in trade mark law, the answer to disputed questions is normally provided by considering the purpose of a trade mark which, broadly speaking, is to operate as a guarantee of origin to those who purchase or use the product. In principle, therefore, and in the absence of any authority cited to us which is directly in point, I would consider that the term average consumer includes any class of consumer to whom the guarantee of origin is directed and who would be likely to rely on it, for example in making a decision to buy or use the goods.”
(emphasis added)

58. Ms Jones also referred to another case that was cited within the *London Taxi* case, the *Schütz* case,²¹ where Briggs J (as he then was) rejected the argument that end users were not "consumers" in the relevant sense, finding on the facts of that case, that “the end-user is therefore a person to whom the trade mark, as a badge of origin or authenticity of the IBC as a product, may well have significance.” I find that end users must be taken into account in the circumstances of the present case.

Comparison of the marks


59. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that

²⁰ Where particular goods/services are purchased by a number of different average consumers, the likelihood of confusion must be judged in light of the lowest level of attention that would be paid to the purchasing act: *Andre Deray v EUIPO* T-105/18 at §39.

²¹ *Schütz (UK) Limited and another v Delta Containers Limited and another* [2011] EWHC 1712 (Ch)

the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* 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.”²²

60. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

The Opponent’s marks:	 (‘the Opponent’s Device Mark’)
	SWIFT (‘the Opponent’s Word Mark’)
	SWIFTNet (‘the SWIFTNet Mark’)

²² *Bimbo SA v OHIM*, Case C-591/12P (paragraph 34)

<p>The Applicant's contested trade marks:</p>	<p style="text-align: center;">Swiffpay / SWIFFPAY ('the Applicant's Word Marks')</p> <p style="text-align: center;">SWIFFPAY / SWIFFPAY ('the Applicant's Stylised Marks')</p>
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Overall impressions of the marks

61. Neither the AP nor Ms Jones disagreed with the Hearing Officer's analysis of the overall impressions the parties' marks, and this section of my decision closely reflects the previous findings accordingly. However, the Opponent did take issue with the weight to be attached to the element "PAY" in the contested marks, and the conclusions as to the degree to which the marks are similar.
62. The **Opponent's Device Mark** is in black and white and consists of a circular device, on which can be seen horizontal straight lines and curved vertical lines. In the middle of the circle the word SWIFT is presented, in italicised capital letters. The eye is drawn to the word "SWIFT", although the device also makes a contribution to the overall impression of the mark.
63. The **Opponent's Word Mark** consists of the word "SWIFT" in capital letters in a standard font. The overall impression of this mark lies in the word itself.
64. The **SWIFTNet Mark** consists of the word "SWIFTNet", with all but the last two letters in capitals. The mark is shown in a standard font. The use of capitals and lower-case letters suggest that these are two separate words which have been joined together. The overall impression of the mark rests in this juxtaposition.
65. The **Applicant's Word Marks** are a series, with the word "SWIFFPAY" shown in capitals and then in lower case, with an upper-case first letter. Nothing turns on this difference, as registration of a word in capital letters would cover its use in any standard font or format. The mark will be seen as the joining of two words "SWIFF" and "PAY".
66. The Hearing Officer found that the component "PAY" will be descriptive "for many of the goods and services in the specification" - she did not say which – and that for those goods

and services, “SWIFF” is likely to be the dominant element of the mark, although the juxtaposition with “PAY” to make a new word will also contribute to the overall impression of the mark. The Hearing Officer found that for the goods and services where the component “PAY” is not a descriptive word, the overall impression of the mark lies in the word as a whole. This is one of two points where the Opponent took issue with the earlier findings. In the proceedings before me, Ms Jones submitted that the word “PAY” is in fact descriptive for all goods and services in the Applicant’s specifications, arguing that “PAY” is a very simple word that has a very clear meaning and is by its inherent nature a very basic descriptive term. Ms Jones argued that to go through the Applicant’s specification reveals that the nature of all of those goods and services is such that PAY could be a descriptive element for all of them.

67. The contested goods and services are in Classes 9, 35, 36, 38 and 42; I note that very many are explicitly specified by reference to terms such as “monetary”, “currency” and “financial”, such that it is immediately clear that Ms Jones is correct in her submissions as to the descriptive potential of the element “PAY”. Moreover, even where the contested goods and services are specified in terms which are not expressly concerned with monetary or financial matters – for example, simply as “Computer software; computer hardware; computer software and programming services; computer services; lease, hire and rental of computer equipment, hardware, software and programs; design of web sites; business mentoring” etc – it is equally clear that fair and normal use of such goods and services could arise in a context where “PAY” becomes a descriptive element. I therefore agree with Ms Jones on her characterisation of “PAY” as descriptive. At any rate, I find the word could potentially be at least *highly allusive* in the case of most of the goods and services, with the result that SWIFF would be the dominant element of the Applicant’s marks. Even in instances where it is not clearly descriptive/allusive, SWIFF remains the dominant element of the mark by virtue of its position and relative size compared to PAY.
68. The **Applicant’s Stylised Marks** are also a series. All the letters of the word “SWIFFPAY” are presented in black capital letters in a standard font, except that the central “FF” are italicised and surrounded by shading and where the lines of the lettering bleed out slightly. In the first mark of the series these letters are shown in black; in the second, they are dark blue and so give a (slight) degree of contrast with the rest of the letters. “SWIFF” is the dominant element of this mark, although as with the Applicant’s

other mark the juxtaposition of the two words makes a contribution to the overall impression.

Comparison with the Opponent's Device Mark

69. The verbal element of the Opponent's Device Mark shares its first four letters with the applied-for marks. I take into account the dominant role of the SWIFF element and the lower distinctiveness of PAY element in the applied-for marks, the attention typically paid to the start of marks, and the principle that verbal elements tend to be more distinctive than figurative elements within composite marks. I also note that the difference between the terminal letters "FT" in the Opponent's Device Mark and the FF in the applied-for marks is not especially prominent given the similarities in the structure of the letters F and T. Ms Jones also highlighted a more subtle similarity between the Opponent's Device Mark and the Applicant's Stylised Marks in that the blurring of the "Fs" and the lines up and down which come out of the "Fs" on the SWIFFPAY mark have at least a resonance of the lines in the circle on the Opponent's Device Mark. I do not find Ms Jones's observations on those lines enough to generate any real similarity with the device itself – however, I do find that the italicisation of the capitals, the blurring and the bleeding out of the lines in the **FF** in the Applicant's Stylised Mark, where top of the letters more or less touch, may have the effect of reducing still further the visual difference between the SWIFT and SWIFF elements. Consequently I find the Applicant's Stylised Marks has a marginally greater degree of visual similarity to the Opponent's Device Mark than does the Applicant's Word Marks, though taking account of the visual impact of the globe device, which will not go unnoticed by the average consumer, the **visual similarity is lower than medium** in each case (though not much lower).
70. The word "SWIFT" is the only part of the Device mark that can be spoken. The sound is highly similar to the first syllable of the applied-for marks; indeed the final "T" may not be clearly articulated by the average consumer. The applied-for marks consist of two syllables, both of which will be spoken, but when I take into account the non-distinctive potential of the PAY element, I conclude that the parties' marks are **aurally similar to a high degree**. For instance, SWIFT software, where the software is for the purpose of transferring funds, may be referred to as 'SWIFT pay software'.
71. Just as the original Hearing Officer agreed with the Opponent's submission that the average consumer will attribute the same meaning to "SWIFF" as they do to "SWIFT", so

too do I agree. This is because even if SWIFF is distinguished from SWIFT, it is likely to be seen as a mis-spelling of SWIFT, or alluding to SWIFT, particularly in the context of goods/services where speed is as important characteristic. I have noted no resistance by the Applicant to the finding by the original Hearing Officer that SWIFF is likely to be interpreted as a fanciful version of “SWIFT”; that original finding is in my view fair and correct. In both instances, the marks will bring to mind quick and efficient services, and the goods that are used in providing such services. In the case of the applied-for mark, the consumer will think of payment services. The device in the Opponent’s Device mark resembles a stylised image of a globe, which will make the consumer think the services cover the whole, or a substantial part of, the world – and the device is therefore clearly allusive in nature. I find that the marks may be **considered conceptually similar to a degree between medium and high.**

Comparison with the Opponent’s Word Marks

72. Visually, there is a greater degree of similarity between the applied-for marks and the Opponent’s plain word mark. While the Applicant’s marks are longer, both parties’ marks begin identically and taking account of the factors I indicated above - the dominant role of the SWIFF element, the lower distinctiveness of PAY element in the applied-for marks, and the attention typically paid to the start of marks - I find, as did the original Hearing Officer, that in relation to the Applicant’s Word Mark the visual similarity is medium to high. Turning to the Applicant’s Stylised Marks, the original Hearing Officer observed that the double F is highlighted and gave her view that this emphasises a point of difference between the two marks and draws the consumer’s attention to the fanciful spelling of the word, concluding that the Applicant’s stylised mark has a medium degree of visual similarity to the Opponent’s Word Mark. My own view of the visual similarity with the Applicant’s Stylised Marks is that the **visual similarity** is not materially different from the assessment for the Applicant’s Word Mark, **remaining between medium and high.** This is because the shading, while “emphasising” the FFs, also has a blurring and bleeding effect which, coupled with the italicisation arguably makes a misreading (as FT) no less likely.
73. As the Opponent’s Word Mark will be articulated in the same way as its Device Mark, I reach the same conclusion that the parties’ marks are **aurally similar to a high degree.** Without the globe device, the word “SWIFT” stands alone, so that the mark conveys a simple message, without the additional idea of an international scope. Taking account of

the low distinctiveness of the PAY component I find a **high degree of conceptual similarity** given the impression created by the “SWIFF” part of the applied-for marks.

Comparison with the SWIFTNet Mark

74. The original Hearing Officer found a high degree of visual similarity between the SWIFTNet Mark and the Applicant’s Word Mark on the basis that the marks have same number of letters and begin identically, and a medium degree of visual similarity with the Applicant’s Stylised Marks. I am content to agree in the original assessment and that the **visual similarity is no lower than medium**.
75. Phonetically, both marks have two syllables and the first one is highly similar. Indeed, if the marks are spoken quickly the first syllables may be heard as identical, with the “T” of the opponent’s mark articulated indistinctly, if at all. The second syllables are different. Taking each of the marks as a whole, I agree in the original assessment that there is a **medium to high degree of aural similarity** between them.
76. Conceptually, the SWIFTNet Mark will also bring to mind speedy and efficient services. The word “Net” is often used in connection with computer networks, and in my view the average consumer will interpret the word in this way. I agree in the original assessment that there is a **medium to high degree of conceptual similarity** between the marks.

Distinctive character of the Opponent’s Marks

77. The distinctive character of the earlier mark must be considered. The more distinctive an earlier mark, either by inherent nature or by use, the greater the potential for a likelihood of confusion (*Sabel*). In *Lloyd Schuhfabrik*²³ 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 ...

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)."

78. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services specified in the registration and, secondly, by reference to the way it is perceived by the relevant public.²⁴
79. I note that as part of its grounds of appeal, the Opponent criticised the level of distinctiveness attributed to the earlier marks and that the AP agreed that the Hearing Officer's finding that the Opponent had made widespread use of its marks and had a strong reputation for its core business, at least amongst the professional public, was difficult to square with the Hearing Officer's finding that the inherent distinctiveness of the earlier Device and Word marks had been enhanced only to a medium or slightly higher than medium level. The AP found that this underlying flaw in the reasoning around this aspect of the original decision fed into the assessment of the likelihood of confusion, where again the AP concluded that the Hearing Officer had fallen into material error of principle.²⁵

Inherent distinctiveness:

80. *The Opponent's Word Mark:* The word 'SWIFT' (although in fact an acronym) presents as a word that alludes to a quality of speediness that a consumer might expect to find in the goods or services to which the mark. Ms Jones submitted that "the articles at Exhibit 2 clearly show that word 'SWIFT' can and does function as a trade mark by which the Opponent is widely recognised. This mark is not one in relation to which the Registry has to afford it a low level of distinctiveness purely because it has made it on to the register despite its descriptive nature. Instead, it falls well within the range, which many successful trade marks fall within, namely, a brand name which is distinctive of a single entity, which successfully serves to denote the origin of goods and services and which

²⁴ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91

²⁵ See §§23-25 and §30 of the AP's decision

may also be allusive of a particular characteristic or quality of the goods or services.” I accept that the word is allusive and not descriptive and may be considered to have, on an inherent basis, a moderate level of distinctiveness.

81. *The Opponent’s Device Mark:* the above points about the word element likewise feed into the assessment of the Opponent’s Device Mark, and I accept that the figurative element of the globe (albeit clearly allusive) adds to the distinctiveness, such that the Opponent’s Device Mark may, on an inherent basis, be considered to have a slightly higher than moderate degree of distinctiveness.
82. *The SWIFTNet Mark:* This earlier mark is a composite mark made up of two words, each of which will be recognised by the average consumer, namely ‘SWIFT’ and ‘Net’. The Opponent acknowledged that “Net” may well be understood as referring to a computer network and therefore may be descriptive of some of the goods/services for which the mark is registered. Nevertheless, given the use of ‘SWIFT’ as the dominant element of the mark and the conjoined nature of the two words, I find that the mark achieves a moderate inherent level of distinctiveness.

Enhanced distinctiveness:

83. *The Opponent’s Device Mark and Word Mark:* The evidence shows that the Opponent’s business has been operating since 1973 and is the global leader for the services which it provides. Both the Word Mark and the Device Mark are used extensively by the Opponent. In the provision of its services, the use of the mark ‘SWIFT’ is a vital element, this being used as the name for the codes necessary to execute a financial transaction. The Opponent’s annual revenues, based on a range of goods and services, are shown to be in the tens of millions of pounds. It is involved in public-policy making at regulatory and government level, and its leadership role in the field accounts for why SWIFT’s annual forum is seen as the financial service industries’ leading conference.²⁶ Ms Jones argued that the matrix of facts in evidence has two consequences: firstly, the enhanced distinctiveness of each mark is considerable - rendering the distinctiveness of its marks as **high, if not very high**; and secondly that such enhanced distinctiveness applies in relation to all of the goods and services which the Opponent provides, which are all closely related to its core service of providing a secure financial transaction messaging network. While I am mindful that services are to be interpreted in line with their core function and

²⁶ Exhibit 3, and paragraph 7 of Mr Krekels his witness statement. See too Exhibit 2.

should not be permitted undue sprawl, I find in this case that I am persuaded that it would be difficult to segregate any part of the goods and services, for which use has been shown, and to deny such goods and services the benefit of the enhancement. I therefore accept that enhanced distinctiveness applies in relation to all such goods and services. The effect of the enhancement is that amongst the relevant professional public, the marks are distinctive to **a high degree**. Indeed, since it appears from the evidence that SWIFT codes have been used on a substantial scale by the general public, it follows that the mark has also become more distinctive to the general public in relation to secure payment services.

84. *The SWIFTNet Mark*: The original Hearing Officer found that this mark had been used less widely than the other two marks and that the distinctiveness of the mark was therefore not enhanced the distinctiveness of the mark. Ms Jones submitted that this analysis was flawed in the following context. The mark ‘SWIFTNet’ describes the platform which is used by those who access the Opponent’s messaging system. Extracts from the Opponent’s website at Exhibit 1 to the statement of Mr Krekels details how SWIFTNet went live in 2001 and how by 2004, the entire community i.e. all of the Opponent’s customers had migrated to SWIFTNet. Accordingly, whilst it may not appear in marketing/other written materials as frequently as the Device and Word Mark, there is little question that the consumer’s exposure to it has been just as high. Ms Jones argued that further, and in any event, it is simply an extension of the SWIFT brand and therefore ought to enjoy and share the enhanced distinctiveness of that Word Mark. Given its central underpinning of the services, as the platform on which the financial information is transmitted, I accept that the SWIFTNet Mark also enjoys a high level of enhanced distinctiveness on the basis that all of the Opponent’s direct customers will inevitably have been exposed to the Mark for over 15 years.

Conclusion as to likelihood of confusion

85. In my global assessment of likelihood of confusion, I take account of my findings set out in the foregoing sections of this decision and of the case law principles outlined in paragraph 29 above. Central points from my analysis above may be summarised broadly as follows:

- i. Comparing the applied-for goods and services with the fair specifications established by the original Hearing Officer under each of the three earlier marks relied on by the

Opponent has led to findings that many of the goods and services at issue are identical or highly similar and that others are similar to medium degree - only a minority are similar to a low degree or not similar at all. The following broad indications serve as a reminder of those findings:

Applied-for CLASS 9 GOODS (e.g. software and hardware, including for financial investment, facilitation of financial transactions, trading cryptocurrency, secure internet access, telecommunications and data storage and transfer)

Mostly **identical/highly similar**, others similar to at least a medium degree on basis of Device Mark specification, and highly similar on basis of Word Mark specification.

Applied-for CLASS 35 SERVICES (e.g. business consultation, management, administration, mentoring, training and advisory services)

Mostly **identical/highly similar** on basis of Device Mark specification, with the exception of “*management and administration on behalf of charities*” and related “*consultancy, advisory and information services*, which the Opponent has conceded to be **dissimilar**.

Applied-for CLASS 36 SERVICES (e.g. financial services, monetary affairs, money market transactions, currency management, secure financial information, shares brokerage, trust fund services, banking and payment transfer services, related advisory services)

Some **identical/highly similar**, others similar to at least a **medium** degree on basis of Device Mark specification

Applied-for CLASS 38 SERVICES (e.g. providing web-based financial and investment trading platforms, including for cryptocurrency, telecommunications access, transmission of funds and data, related advisory services)

On basis of Device Mark specification, some highly similar, others to a medium degree, but on basis of Word Mark specification the parties' services are **identical**, or else the related consultancy, advisory, management and information services are **highly similar**. SWIFTNet specification also identical, highly similar and similar to at least a medium degree.

Applied-for CLASS 42 SERVICES (e.g. providing web-based financial and investment trading platforms, software design, software as a service, website design,

computer rental, computer services, data security and storage, related consultancy, advisory, management and information services)

The specifications under the Device and Word Marks find many services that are **identical or highly similar**, others that are **similar to at least a medium degree**.

However, the following services achieved are accepted to be **dissimilar**: *Design of websites; hosting websites for others; creating and maintaining websites; consultancy, advisory, management and information services relating to the aforesaid services.*

ii. The average consumer presents a mixed picture.

- The average consumer for some of the applied-for Class 9 goods includes businesses and professionals, but also members of the general public. Businesses will pay a higher level of attention, but even the general public will pay **at least a medium level of attention** in relation to software, and a **medium to high level** of attention for hardware.
- The average consumer for the applied-for **Class 35** services is a business public (who again, as a general position, will pay a higher degree of attention).
- The average consumer for most of the applied-for **Class 36** services includes both businesses and the wider general public, but in any event the services will be purchased with not lower than a **medium to high level of attention**.
- The average consumer for the applied-for **Class 38** telecommunication-based services will be professionals in the fields of trading and investment, although the general public may be relevant. In any event, in line with the AP findings, the services will be purchased with not lower than a **medium to high level of attention**;
- The average consumer for most of the applied-for Class 42 services will be businesses and professionals, but for some of the services the average consumer may also be a member of the general public. Businesses will pay a higher degree of attention, but even the general public will pay **not lower than a medium level of attention**.

iii. Visual considerations predominate in the selection of the goods and services and the marks are visually similar in the following degrees:

- Compared with the Opponent's Device Mark, the applied-for marks are in each case visually similar to a degree that is **lower than medium**, though not much lower;

- Compared with the Opponent's Word Mark, the applied-for marks are in each case visually similar to a degree that is **between medium and high**;
 - Compared with the Opponent's SWIFTNet Mark, the applied-for marks are visually similar to no lower than a **medium degree**;
- iv. Aural considerations are a factor in the way that the average consumer will encounter the marks and in my assessment of likelihood of confusion, and one that warrants elaboration in this part of my decision, as I will come on to, but for now I note simply the degrees to which I have found aural similarity, namely:
- Compared with the Opponent's Word Mark and the Opponent's Device Mark, the applied-for marks are **aurally similar to a high degree**
 - Compared with the Opponent's SWIFTNet Mark, the applied-for marks are **aurally similar to a medium to high degree**
- v. Between the Opponent's Word Mark and the applied-for marks there is **high conceptual similarity**, and compared with the other earlier marks the conceptual similarity is **between medium and high**.
- vi. On an inherent basis, the Opponent's Word Mark and its SWIFTNet Mark are distinctive to a moderate degree, and the Opponent's Device Mark is distinctive to a slightly higher than moderate degree. I do not overlook, however, that even though the globe device may add to the distinctiveness of the Opponent's Device Mark, the applied-for marks have no equivalent device, since I am unpersuaded by Ms Jones' submissions as to the subtle resonance brought by the lines in the Applicant's Stylised Marks. Nonetheless, long-standing, widespread use has led to **enhancement of the distinctiveness of all of the marks to a high degree among the relevant professional public and for all of the goods and services for which use has been established**. This is a significant factor in my view.
86. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public.²⁷ The relative weight of the factors is not laid down by law, but is a matter of judgment for the tribunal on the particular facts of each case.²⁸ Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises

²⁷ Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at §34

²⁸ See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O-079-17, (*Rochester Trade Mark*).

that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.

87. Evaluating a likelihood of confusion implies some interdependence between the relevant factors and, in particular, between the degree of similarity between the marks and that between the goods or services. *Canon* expressly steers that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the services and vice versa.²⁹ Clearly the identity /high similarity and at least medium degrees of similarity prevalent in the goods and services in this case weigh in the scale towards a likelihood of confusion. As a counterweight, the levels attention likely to apply in the purchase of the goods and services are generally at least medium or higher. However, I also take into account the high degree of distinctiveness that attaches to the Opponent's marks, and too the possibility of imperfect recollection.
88. I return now to elaborate both on the implications of the aural similarity and of foreseeable real-world consequences.
- i. I have earlier stated that I agree with the findings from the original Hearing Officer that businesses and professionals, typically working in the financial sector, will be unlikely to choose such goods and services purely on the basis of word-of-mouth recommendation (at least for the vast majority of the goods). At the same time, it is undoubtedly the case that such consumers would hear the marks spoken in the course of their work – not only in meetings (as was noted in the original decision) but also in the day-to-day conduct of the services of the relevant businesses. It seems to me that in circumstances where there is aural similarity between competing marks, used in reference to the goods and services at issue, which is apt to cause to misunderstandings or miscommunications amongst the potentially large workforce of an institution such as a bank, because those users mistake one mark for the other, such confusion is not irrelevant, despite being post-sale (or contract). This is the case even though the smaller cohort of procurement personnel within that institution may not have relied purely on an oral recommendation in their decision to have purchased the goods or contracted the services. If the confusion in the financial organization led to an end user being given a SWIFFPAY code rather than SWIFT pay code this would

²⁹ Case C-39/97 cited above.

have an economic effect capable of damaging the earlier mark's functions. I therefore ascribe a greater significance to the aural similarity in such circumstances.

- ii. I have also found that insofar as the goods and services include many that may be purchased by the general public, it cannot be ruled out that that type of customer (as a direct consumer) may indeed choose such goods and services on the basis of word-of-mouth recommendation (whilst nonetheless factoring in the levels of attention indicated above). A greater significance may be ascribed to the aural similarity for such consumers. Confusion often comes about through an interplay of visual, aural and conceptual similarities; in the present case there is a strong possibility of initial aural confusion being compounded by the apparent conceptual similarity between SWIFF/SWIFT, which the greater (but still not strong) visual differences will not enough to counter.
- iii. It is clear that the end user of goods or services can be relevant in the assessment required under section 5(2)(b) of the Act of whether "there exists a likelihood of confusion on the part of the public...". Although the *London Taxi* and *Schütz* cases involve factual circumstances different from the present case, I find that I agree with Opponent's position in relation to confusion on the part of a customer who is accessing the payment transfer services. There is a clear and significant potential for aural confusion, because, as Ms Jones submitted, the distinction between a person saying 'SWIFF' and 'SWIFT' is not always an easy one. If one takes the example of a customer making a financial transaction over the telephone and being asked for their 'SWIFT' or 'SWIFFPAY' code, not only may they mishear 'SWIFF' for 'SWIFT', they might not readily recognise the word 'PAY' as forming part of the brand name. Again, the aural similarity is more significant in such circumstances, and that the earlier marks may have no enhanced distinctiveness amongst the general public does not materially reduce this risk of direct confusion. The attention of the end-user would likely be lower than a direct purchaser (of the underpinning goods or services) making confusion still more likely. As Ms Jones submitted, even if the direct consumer (such as the bank) were not confused, there would be no value to its mark if all of its consumers were then confused and the mark did not perform the function which it ought to, which is that of guaranteeing the origin of its goods and services. The correct mark is crucial because if the end user were confused and provided (to the bank or a friend) a SWIFFPAY code in error, then the transaction would not be effected.

89. I note too that the evidence shows that the Opponent uses various signs that comprise of the word 'SWIFT' followed by another word/abbreviation, such as SWIFTNet, SWIFTRef, SWIFTSmart.³⁰ Given the benefit to the Opponent of earlier marks that are highly distinctive amongst the relevant professional public, I find that despite a higher degree of attention on the part of those consumers, there is a likelihood of confusion. I do not rule out that such confusion may be direct (especially in the scenarios postulated at paragraph 88 above, where the aural impact is more significant); indirect confusion is also possible – for example that the mark is a variant to cover a new offering of goods or services within the orbit of the Opponent's business. Indeed, Mr Lyons' evidence states that the Applicant company facilitates financial transactions (and supplies ancillary services) involving virtual and crypto currencies, and the applied-for trade mark specification includes an emphasis on cryptocurrency. Since, as I indicated at paragraph 42 above, the evidence shows that the Opponent has long operated in the realm of tradable financial assets, and has more recently developed block chain software, the use of the applied-for marks may be misconstrued – both visually and aurally - as a sub-brand variation of the Opponent's marks for deployment in relation to cryptocurrency services.
90. The net effect of the various points of analysis above is that I find that were the parties' marks were used concurrently as trade marks for the goods or services at issue which are identical or similar to no lower than a medium degree, there exists a likelihood of confusion, which may be direct or indirect, and may be on the part of the general public and/or on the part of the professional public. However, for there to be a likelihood of confusion under section 5(2)(b) requires at least some similarity between the relevant goods or service; consequently the claim must fail to the extent set out in the following outcome paragraph.

OUTCOME under the section 5(2)(b) claim:

91. The opposition based on section 5(2)(b) therefore **succeeds in respect of all of the applied-for goods and the great majority of the applied-for services**. The opposition on this ground fails only in relation to the following services:

Class 35: *management and administration on behalf of charities and their related consultancy, advisory and information services.*

³⁰ Excerpts from the Opponent's website show variously branded offerings to customer - Exhibit 11, pp.173-174.

Class 42: *Design of websites; hosting websites for others; creating and maintaining websites; consultancy, advisory, management and information services relating to the aforesaid services.*

The section 5(3) claim

92. Section 5(3) of the Act (as applicable at the commencement of these opposition proceedings) states that a trade mark which is identical with or similar to an earlier trade mark “shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community/European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

The law and principles applicable to section 5(3) grounds

93. Relevant case law was set out in the original decision, but for ease of reference I repeat it here. The legal principles can be found in the following judgments of the CJEU: Case C-375/97, *General Motors Corp v Yplon SA* [2000] RPC 572; (CJEU), Case 252/07, *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15; Case C-408/01, *Adidas-Salomon AG v Fitnessworld Trading Ltd*. [2004] ETMR 10, Case C-487/07, *L’Oreal SA and others v Bellure NV and others* - C-487/07 and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:
- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
 - (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
 - (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas-Saloman, paragraph 29* and *Intel, paragraph 63*.
 - (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between

the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark

with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

94. In order to succeed with a claim under section 5(3) a party must establish (i) a reputation, (ii) similar or identical marks, (iii) a link with the earlier mark in the mind of the relevant public, (iv) in consequence of the link, a finding that the use of the mark will take unfair advantage of the distinctive character or repute of the earlier mark or is detrimental to that distinctive character or repute, and (v) that the mark is applied for and to be used without due cause.³¹

Reputation

95. It is sufficient for an EUTM to be known by a significant part of the public concerned by the goods/services of the mark in a substantial part of the territory of the EU, where the territory of a Member State may be considered to constitute a substantial part of the relevant territory.³² The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I “take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”
96. In this case a reputation is claimed in respect of the Opponent's Word Mark (SWIFT) and of its Device Mark. The original decision found that both marks had “a strong reputation for goods and services related to the financial messaging system”, but the AP accepted the Opponent's criticism on appeal that the Hearing Officer did not clearly identify the financial messaging services and associated goods and services for which the Opponent has a reputation. In my own assessment of the level and extent of reputation shown in the evidence, I note, for example: (i) the European and global reach of the Opponent's business (ii) that the Opponent has offered its services in the UK since 1973 (iii) that all major banks and financial institutions in the UK use the Opponent's secure interbank financial transaction messaging network, transmitting billions of messages and generating tens of millions of pounds of revenue each year, and (iv) its role of influence and leadership in the financial sector. In line with my findings as to the enhanced distinctiveness that attaches to the Opponent's Word and Device Marks, I find that the

³¹ *Intel Corp Inc v CPM United Kingdom Ltd* (C-252/07) [2009] R.P.C. 15

³² PAGO C-301/07 [2010] E.T.M.R. 5

reputation attaches to all of the goods and services which the Opponent provides (for which proof of use has been found), which are all closely related to its core service of providing a secure financial transaction messaging network. The reputation therefore directly covers the hardware, software, encryption and telecommunication services, training and consultancy associated with the transmission of data transmission between financial and companies. The reputation is substantial and strong among the relevant section of the public as regards the goods or services for which the mark is registered, which in this case includes financial institutions and businesses. Given its long use in the UK and the very numerous messages evidenced the mark may also be considered to have a reputation among end users in the context of the making secure money transfers.

Similarity of the Marks

97. The marks satisfy the requirement for a certain similarity, and to the extents that I set out in my analysis for the purposes of the section 5(2)(b) claim.

Link

98. The AP (at paragraph 41 of her appeal decision) found that the original Hearing Officer had applied too high a bar when considering whether a link would be made by the average consumer. As noted above in the summary of relevant case-law principles “It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind.” As the AP observed, this does not set a high bar for the owner of the earlier mark. Again, as the AP highlighted, in *Adidas-Salomon* the CJEU explained (at paragraph 29) that the link arose from “a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them.” And as Floyd LJ said more recently in *Argos Ltd v Argos Systems Inc*: “It is sufficient for such a link that the sign will call the trade mark to the mind of the average consumer.”³³
99. Taking account of the similarity of the respective marks, the similarity and identity between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation, I find that the

³³ [2018] EWCA Civ 2211; [2019] F.S.R. 3 at paragraph 82

necessary mental link will arise. I readily find that a link will be made at least in so far as the goods and services in respect of which I have found a likelihood of confusion under the section 5(2)(b) claim. I will first set out my decision of section 5(3) ground in relation to those goods and services. Once I have done that, I will return to consider whether a link is likely to arise in respect of the applied-for services that I found similar only to a low (or very low degree) and indeed, which Ms Jones accepted may be “dissimilar”.

Serious likelihood of injury

100. Since I have found the two earlier marks have the necessary reputation and that a link will arise, I must determine whether there is a serious likelihood of one or more of the types of injury set out in section 5(3) of the Act.

Unfair advantage

101. As set out in the case law above, unfair advantage covers situations where the user of a junior mark may be considered to trade upon the reputation of a senior mark, ‘free-riding on its coat-tails’. This is to say that there is a risk that the repute of the earlier mark is transferred to the goods/services covered by the Applicant’s mark, with the result that the Applicant unfairly benefits from the marketing efforts of the earlier mark and its own marketing will be made easier as a result of the association with that earlier mark.
102. In this case I find that in relation to any of the Applicant’s goods or services under consideration, there is a serious likelihood that use of either the word or stylised versions of SWIFFPAY would take unfair advantage of the reputation of the Opponent’s Marks. The image and reputation of those marks and the characteristics which they project – for example, a long-standing, dominant presence on the market and association with secure, reliable and effective goods and services - will be transferred to the Applicant’s goods and services if they are marketed under the contested signs. SWIFFPAY is likely to benefit from the powers of attraction of the earlier SWIFT marks which have achieved considerably enhanced distinctiveness and strong reputation in the field of payment services.

Detriment to distinctive character or repute of the earlier mark

103. In view of the potential for the parties to be operating in directly overlapping spheres of trade, and in view of the similarity between the respective marks, I find that use of the applied-for marks would cause detriment to the distinctive character of the Opponent’s

reputed marks, diluting and blurring the enhanced (high) distinctiveness achieved over the decades of use and promotion. This weakening of the reputed marks' ability to identify the goods or services for which they are registered creates a serious risk of a change in the economic behaviour of the average consumer of those goods/services, through the consumer's selection of provider. I reach this conclusion notwithstanding that the similar component "SWIFT" in earlier marks is not inherently unique or highly distinctive.

104. With regard to risk of detriment to the repute of the mark, there is no evidence of the Applicant having traded in the goods or services that it has applied for, so there is no suggestion that it has offered sub-standard goods or services, and nor are the goods and services for which it seeks registration inherently disreputable. However, in the present case, I again take into account that the parties may prospectively operate in the same field, and that there is a likelihood of (at least) indirect confusion such that the average consumer may perceive an association or business connection such as the contested marks being a new brand or division and/or sub-division of the Opponent's business (for instance, facilitating financial transactions specifically involving virtual and crypto currencies). I also take into account the particular importance of considerations such as trust and accuracy, the security and reliability of the goods and services, and the serious consequences (reputationally and commercially) of a failure in any such elements. In these circumstances, I find there is a clear, future, non-hypothetical risk of detriment to the repute of the earlier mark were there, for example, any shortcomings in the information technology underpinning the applied-for goods and services.

Without due cause

105. I find that there is no due cause for use of the applied-for marks in this case. This is not a case where the Applicant asserts an earlier right to the marks, or any necessity to use the marks. Nor is it an example of fair competition given the high degree of recognition of the Opponent's Marks and the close alignment between the Applicant's and Opponent's businesses.

106. On the basis of the above findings, the section 5(3) claim succeeds to the same extent that the opposition succeeded under the section 5(2)(b) ground. I now turn to the remaining minority of applied-for services and to consider, firstly, whether a mental link will arise i.e. whether, a significant part of the relevant public (who know of the earlier reputed Marks) on encountering the applied-for marks used in relation to the following

services, will call to mind the earlier reputed Marks; secondly, to consider whether such link would lead to one of the required types of injury; and thirdly whether use of the applied-for Marks in relation to those services would be without due cause.

107. Those remaining applied-for services that I found similar to no more than a low degree, such that no likelihood of confusion arose, are as follows:

Class 35: *management and administration on behalf of charities*

consultancy, advisory, management and information services relating to management and administration on behalf of charities.

Class 42: *design of websites;*

hosting websites for others;

creating and maintaining websites;

consultancy, advisory, management and information services relating to the aforesaid services.

108. I have found that the above Class 35 services give rise to a low degree of similarity with the Opponent's *Professional business consultancy* in that same class under the Opponent's Device Mark. For the above applied-for Class 42 services, I found no similarity with services under the Opponent's Word Mark, but under the Opponent's Device Mark found a low / very low degree of similarity with the Opponent's services in Class 42: *implementation, integration and design of computer software.*

109. On the one hand, Ms Jones accepted that the above applied-for services may be considered *dissimilar* to any of the services registered under the Opponent's earlier marks, and for which proof of use had been found. On the other hand, Ms Jones argued that a link will still be formed because, in her submission, "it cannot be said that the nature/type of those services is wholly different from those relied upon by the Opponent." I should say that I take Ms Jones's characterisation of these few services as "dissimilar" as meaning that they are merely not similar – rather than something more emphatically to the contrary of similar. It is with that view in mind that I conclude that there is no fundamental contradiction between the two positions of Ms Jones that I have mentioned in this paragraph.

110. Ms Jones referred to the words of James Mellor QC, sitting as the Appointed Person in *Duebros Ltd v Heirler Cenvois GmbH* BL O/547/17, where, commenting on the two types of likelihood of confusion, distinct from merely calling to mind, he then gave this fourth option:

“81.3.4. For completeness, the conclusion that the various factors result in the average consumer making no link at all between the marks, but this will only be the case where either there is no or very low similarity between the marks and/or significant distance between the respective goods and services.”

111. It was in response to the above that Ms Jones submitted “it cannot be said that the nature/type of those services is wholly different from those relied upon by the Opponent.” I must therefore consider whether, taken with all other relevant factors around establishing a mental link, the distance between the services for which the Opponent may be said to have a reputation and the few remaining applied-for services in Classes 35 and 42 above, is significant such that no link will arise. I also bear in mind that success under section 5(3) of the Act does not require similarity between the respective goods and services. This is now stated in section 5(3A) of the Act, which has come into force since these opposition proceedings started, but that legislative provision only makes express what was already the legal position. Nonetheless, the distance between the goods and services is certainly a relevant consideration.

112. In line with my earlier findings as to similarity, I agree with Ms Jones that these are not “wholly different” services – as would be the case between secure payment services and, say, skip hire or landscaping services. The Class 35 services on behalf of charities would be likely to involve as a central business consideration the facilitation of payments from donors and the transmission to intended beneficiary organisations. And likewise, the Opponent’s services around facilitating secure payments involves (as shown in the proof of use findings) providing access to a secure global electronic communication network and the installation, implementation, integration, design and maintenance of computer software relating to financial communication and assistance services relating thereto.

113. In considering the link factors, I take into account that the similar common element, “SWIFT”, is an ordinary word and is allusive in relation to the services (suggesting speed). I recognise that care is needed in the assessment of a link so that the Opponent does not enjoy exclusive rights around that ordinary word in circumstances that do not warrant it.

However, I of course take into account the enhancement of the distinctiveness of the earlier marks and the strong reputation generated among the relevant public; moreover, in the present circumstances, despite the distance that exists between the services remaining at issue, the significance of that distance is reduced by virtue of the nature of the applied-for marks themselves. By this I mean, that the “PAY” component directly refers to payment services, thereby linking to the type of services for which the Opponent enjoys a reputation. I therefore find that even for the remaining services in Classes 35 and 42, the necessary link will arise.

114. I also find that there is a likelihood of one of the necessary types of injury flowing from that link, inasmuch as the later marks would gain unfair commercial advantage through the transfer of image that characterises the reputation of the Opponent’s Marks, whereby the applied-for mark could free-ride on the long-standing exposure of the Opponent’s Marks which have led to a dominant presence on the market and an association with secure, reliable and effective goods and services. Again, I find no due cause for use of the applied-for mark.

Outcome under the section 5(3) claim:

115. The section 5(3) claim succeeds in full against the application.

The section 5(4)(a) claim

116. For reasons that I shall come to, I can deal with this ground briefly. Section 5(4)(a) of the Act states that:

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

a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

117. As noted in the decision by the original Hearing Officer, it is settled law that for a successful finding of passing off, three factors must be present: goodwill, misrepresentation and damage. Her Honour Judge Melissa Clarke, sitting as Deputy Judge of the High Court, conveniently summarised the essential requirements of the law

in *Jadebay Limited, Noa and Nani Limited (trading as The Discount Outlet) v Clarke-Coles Limited (trading as Feel Good UK)* [2017] EWHC 1400 IPEC

“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 these 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).”

118. *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.”

Goodwill

119. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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 distinguished an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

120. For there to be goodwill, there must be customers in the UK. As the original Hearing Officer found, the evidence shows that this is the case and the opponent has a protectable goodwill in relation to the goods and services for which it has shown use.

Misrepresentation

121. The relevant test was set out by Morritt LJ in *Neutrogena Corporation and another v Golden Limited and another* [1996] RPC 473:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is: is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].’ [*my underlining*]

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC. 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 RPC 97 at page 101.”

122. Although they are different, the test for misrepresentation tends to have the same results as the test for confusion under trade mark law. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchin L.J. concluded:


“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

123. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

124. The original Hearing Officer had concluded that there was no likelihood of confusion and she followed that rationale to find that no misrepresentation arises for the section 5(4)(a) claim. Although the AP also remitted the section 5(4)(a) ground, the AP acknowledged that it probably adds nothing to the 5(2)(b) objection. That is my view too. The Opponent's section 5(4)(a) ground is based on claimed unregistered earlier rights founded on goodwill in two signs directly equivalent to Word Mark and its Device Mark i.e. the



word SWIFT and  and in respect of the goods and services in Classes 9, 16, 35, 36, 38, 41 and 42 covered by the Device Mark. While it is not a requirement that the parties share a common field of activity for passing off, I find that the section 5(4)(a) ground produces no stronger basis for opposition than does its claims founded on its registered rights for the purposes of section 5(2)(b). I am not satisfied that deception based on a misrepresentation would extend to the services which I found additionally to fall within the extended protection of the section 5(3) grounds. Since I find the Opponent can be in no better position based on its unregistered rights, it is unnecessary for me to make further findings as to the section 5(4)(a) claim.

Overall Outcome

125. The opposition has succeeded fully on the basis of the Opponent's registered rights under sections 5(2)(b) and 5(3) of the Act.

COSTS

126. The Opponent has been successful and is entitled to a contribution towards its costs, in line with the scale set out in Tribunal Practice Notice 2/2016. In the original decision, determined from the papers, costs of £2000 were awarded to the Applicant, but following the appeal hearing the AP set aside that original costs award. The AP remitted the costs of the initial hearing and also reserved the costs of the appeal to be dealt with as part of this remitted decision.

127. These proceedings were consolidated at an early stage, and the notices of opposition were the same in both cases. In the circumstances I award the Opponent the sum of **£6600**, which is calculated as follows:

In respect of the initial proceedings:

<i>Form TM7 fee (x2)</i>	<i>£400</i>
<i>Preparing a statement and considering the other side's statement:</i>	<i>£350</i>
<i>Preparing evidence and considering and commenting on the other side's evidence:</i>	<i>£1500</i>
<i>Preparation of submissions in lieu of a hearing:</i>	<i>£450</i>

In respect of the appeal proceedings:

<i>Fee for appeal:</i>	<i>£250</i>
<i>Preparing a grounds of appeal and considering other side's position:</i>	<i>£650</i>
<i>Preparing evidence and considering and commenting on the other side's evidence:</i>	<i>Nothing further</i>
<i>Preparation for and attending hearing:</i>	<i>£1500</i>

In respect of the remitted proceedings:

<i>Preparing a statement and considering the other side's statement:</i>	<i>Nothing further</i>
<i>Preparing evidence and considering and commenting on the other side's evidence:</i>	<i>Nothing further</i>
<i>Preparation for and attending hearing</i>	<i>£1500</i>

Total: £6600

128. I order Swiffpay Limited to pay Society for Worldwide Interbank Financial Telecommunication SRC the sum of £6600. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of July 2021

Matthew Williams
For the Registrar
