

O/1121/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003749897
IN THE NAME OF PLANE SAVER CREDIT UNION LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:**

YUZU MONEY

IN CLASS 36

**AND IN THE MATTER OF FAST TRACK OPPOSITION THERETO UNDER NO.
60002417
BY YUZZU**

BACKGROUND AND PLEADINGS

1. On 1 February 2022, Plane Saver Credit Union Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 25 February 2022 and registration is sought for the following services:

Class 36 Financial services; financial advice; providing of financial products; financial information and evaluations; financial management; financial affairs; financial consultancy to companies and individuals; loans; funding and financing of loans; arranging loans; car loans; debt consolidation loans; emergency loans; holiday loans; home improvement loans; personal loans; wedding loans; loan broking; lending against securities; mortgage services; mortgage advice; mortgage loans; mortgage lending; mortgage broking; savings; savings plans; savings schemes; financial savings services; savings accounts; insurance; insurance services; insurance broking; underwriting services; management and brokerage of funds; services relating to monetary affairs; electronic banking services via a global computer network (internet banking); interactive electronic handling of financial and banking services via global computer networks; financial transaction services; drawing up financial reports; valuation of assets; financial sponsorship; financial analysis; investment services; financial transactions; debt consolidation services; credit unions; information, advice and consultancy services in relation to the aforesaid services.

2. On 24 May 2022, the application was opposed under the fast track opposition procedure by YUZZU (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:

YUZU

UKTM no. 917886811

Filing date 12 April 2018; registration date 25 July 2018

Relying upon the following services for which the mark is registered:

Class 36 Insurance services; Accident insurance; Life insurance; Medical insurance; Insurance for legal expenses; Travel insurance; Insurance services relating to motor vehicles.

("the First Earlier Mark")

YUZZU

UKTM no. 917930060

Filing date 3 July 2018; registration date 26 October 2018

Relying upon the following services for which the mark is registered:

Class 36 Insurance services; Accident insurance; Life insurance; Medical insurance; Insurance for legal expenses; Travel insurance; Insurance services relating to motor vehicles.

("the Second Earlier Mark")

3. The opponent claims that there is a likelihood of confusion because the marks are similar, and the services are identical or similar.

4. The applicant filed a counterstatement denying the claims made.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that rule 20(4) shall continue to apply. Rule 20(4) states that:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. The applicant sought leave to file evidence in relation to the services in issue. On 5 October 2022, the Registry issued a preliminary view refusing the applicant's request to file evidence and informing the applicant that it could challenge the preliminary view by requesting a Case Management Conference ("CMC"). No CMC was requested.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate costs; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary, and only the applicant filed written submissions in lieu.

8. The opponent is represented by Albright IP Limited and the applicant is represented by Womble Bond Dickinson (UK) LLP.

9. This decision is taken following a careful perusal of the papers.

EU LAW

10. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

PRELIMINARY ISSUE

11. I note that the applicant has made various submissions about the differences between the actual services provided by the parties. However, I am required to undertake a notional assessment based on their specifications and all possible uses that fall within those specifications. Consequently, the services currently offered by the parties on the market (and any differences between them) are not relevant to my assessment.

DECISION

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

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

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

13. Section 5A of the Act reads as follows:

“5A Where the grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. The registrations upon which the opponent relies qualify as earlier registrations because they were applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. The earlier registrations had not completed their registration process more than 5 years prior to the filing date of the applicant’s mark and, consequently, are not subject to proof of use.

15. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 to mind the earlier mark, 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 services

16. The competing services are as follows:

Opponent's services	Applicant's services
<p><u>Class 36</u> Insurance services; Accident insurance; Life insurance; Medical insurance; Insurance for legal expenses; Travel insurance; Insurance services relating to motor vehicles.</p>	<p><u>Class 36</u> Financial services; financial advice; providing of financial products; financial information and evaluations; financial management; financial affairs; financial consultancy to companies and individuals; loans; funding and financing of loans; arranging loans; car loans; debt consolidation loans; emergency loans; holiday loans; home improvement loans; personal loans; wedding loans; loan broking; lending against securities; mortgage services; mortgage advice; mortgage loans; mortgage lending; mortgage broking; savings; savings plans; savings schemes; financial savings services; savings accounts; insurance; insurance services; insurance broking; underwriting services; management and brokerage of funds; services relating to monetary affairs;</p>

	<p>electronic banking services via a global computer network (internet banking); interactive electronic handling of financial and banking services via global computer networks; financial transaction services; drawing up financial reports; valuation of assets; financial sponsorship; financial analysis; investment services; financial transactions; debt consolidation services; credit unions; information, advice and consultancy services in relation to the aforesaid services.</p>
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17. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services 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.”

18. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

20. “Insurance”, “insurance services”, “insurance broking” and “underwriting services” in the applicant’s specification are plainly identical to “insurance services” in the opponent’s specifications.

21. In my view, “financial services” and “providing of financial products” are broad enough to cover the “insurance services” in the opponent’s specification. Consequently, the services are identical on the principle outlined in *Meric*.

22. The remaining terms in the applicant’s specification are all, broadly, types of financial services. However, they do not fall within the field of insurance.

Consequently, they will differ in purpose to the opponent's services and there will be no competition between them. However, there may be some overlap in user and trade channels, as financial service providers may offer both. Consequently, I consider the services to share at least a moderate degree of similarity.

The average consumer and the nature of the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

24. The average consumer will include both members of the general public and professional users in the financial sector. The applicant's specification covers a wide range of services, from internet banking (which is likely to be used by members of the general public on a frequent basis and at little or no cost) to management and brokerage of funds (which may be used by the general public or a professional user, on a less frequent basis and at a higher cost). However, in the case of all the services, given that there is likely to be a financial impact for the user, a reasonably high level of attention is likely to be paid even where the services are used frequently and attract little or no cost. Consequently, I agree with the applicant that at least a reasonably high degree of attention will be paid during the purchasing process, but in many cases the level of attention paid will be high.

25. The purchasing process is likely to be predominantly visual, with the services predominantly being purchased through websites, apps or bricks-and-mortar premises. However, as word-of-mouth recommendations may also play a part, I do not discount that there will also be an aural component to the purchase.

Comparison of trade marks

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

27. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

28. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p style="text-align: center;">YUZU (the First Earlier Mark)</p> <p style="text-align: center;">YUZZU (the Second Earlier Mark)</p>	<p style="text-align: center;">YUZU MONEY</p>

Overall Impression

29. The First Earlier Mark consists of the dictionary word YUZU. There are no other elements to contribute to the overall impression of the mark which lies in the word itself.

30. The Second Earlier Mark consists of the invented word YUZZU. The overall impression of the mark lies in the word itself.

31. The applicant's mark consists of the words YUZU MONEY. They play an equal role in the overall impression, with the word YUZU being the more distinctive element.

Visual Comparison

32. The whole of the First Earlier Mark is replicated in the applicant's mark. However, the applicant's mark also contains the word MONEY which is absent from the First Earlier Mark. I consider that this results in a reasonably high degree of visual similarity.

33. The Second Earlier Mark shares the same letter structure as the applicant's mark, but with the addition of a second letter Z i.e. YUZZU/YUZU. There is also the additional difference created by the word MONEY in the applicant's mark which is absent from the Second Earlier Mark. I consider that this results in a medium degree of visual similarity.

Aural Comparison

34. I consider that the word YUZU in the First Earlier Mark and the applicant's mark is likely to be pronounced YOU-ZOO. However it is pronounced, it will be identical for both marks. The word MONEY in the applicant's mark will be given its ordinary English pronunciation and will act as a point of aural difference. I consider that this results in a reasonably high degree of aural similarity.

35. The Second Earlier Mark is an invented word and so there may be various ways in which it could be pronounced by the average consumer. The applicant submits that it will be pronounced the same as YUZU. I accept that that may be the case, but it is more likely, in my view, that the additional Z will result in it being pronounced YUZ-ZOO. The pronunciation of the word MONEY in the applicant's mark also acts as a point of aural difference. Taking this into account, I consider there to be at least a medium degree of aural similarity.

Conceptual Comparison

36. As noted by the applicant, the word YUZU refers to a citrus fruit.¹ In my view, there will be a significant proportion of average consumers who will be aware of this meaning. However, I also recognise that there may be a significant proportion of average consumers who are not aware of this and may view it simply as an invented word. If the meaning is known, then the First Earlier Mark and the applicant's mark will share a reasonably high degree of conceptual similarity, with only the word MONEY to differentiate between them. However, where the services are financial in nature this will not be a distinctive point of conceptual difference. For those who view it as an invented term, the conceptual position will be neutral, with the word MONEY in the applicant's mark acting as a non-distinctive point of difference.

37. For those who view YUZU as an invented word, the comparison will be neutral in relation to the Second Earlier Mark and the applicant's mark, given that YUZZU will also be viewed as invented, with the word MONEY acting as a non-distinctive point of

¹ <https://www.collinsdictionary.com/dictionary/english/yuzu>

difference. For those who are aware of the ordinary meaning of YUZU the marks will be conceptually different, as one will have a meaning and one will be viewed as an invented word.

Distinctive character of the earlier marks

38. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

39. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

40. The opponent has filed no evidence and so I have only the inherent position to consider. The Second Earlier Mark is an invented word and will be inherently of high distinctive character. The same will be true of the First Earlier Mark for those that view it as an invented word. For those that view it as an ordinary dictionary word the distinctiveness will be lower, although given that its meaning is unusual in relation to the services, it will still be reasonably high.

Likelihood of confusion

41. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

42. As I have found the First Earlier Mark to share the greater degree of similarity with the applicant's mark, I will assess likelihood of confusion on the basis of that mark, referring to the Second Earlier Mark only if it is necessary to do so.

43. I have concluded as follows:

- a. The services are either identical or share at least a moderate degree of similarity.

- b. The average consumer will include both members of the general public and professional users, who will both pay at least a reasonably high level of attention during the purchasing process (but in many cases the level of attention paid will be high).
- c. The purchasing process will be predominantly visual, although I do not discount an aural component.
- d. The applicant's mark and the First Earlier Mark are visually and aurally similar to a reasonably high degree
- e. For those consumers who know the meaning of the word YUZU, there will be only a non-distinctive conceptual difference between the applicant's mark and the First Earlier Mark (i.e. the word MONEY).
- f. For those consumers who view the word YUZU as an invented word, the conceptual position will be neutral, with a non-distinctive point of difference created by the presence of the word MONEY in the applicant's mark.
- g. The First Earlier Mark is of at least a reasonably high level of distinctive character.

44. In my view, taking all of the above factors into account, I consider it likely that the First Earlier Mark and the applicant's mark will be mistakenly recalled or misremembered as each other. The common presence of the word YUZU, with only a non-distinctive additional word (MONEY) in the applicant's mark to differentiate between them, will result in consumers directly mistaking the marks. This will apply whether or not the average consumer attributes a conceptual meaning to the word YUZU. I recognise that the higher degree of attention paid in the purchasing process is a factor against this conclusion, however, in my view it is offset by the similarity between the marks and the distinctiveness of the First Earlier Mark. I consider that this will apply to all services in the application bearing in mind the interdependency principle.

45. It is also possible, in my view, for there to be indirect confusion. Given that the word YUZU is at least reasonably high in distinctive character, it is likely, in my view, that the addition of the word MONEY in the applicant's mark may be seen as simply indicating an alternative arm of the same business i.e. that the opponent has branched out into other types of financial services. This will result in consumers being indirectly confused between the First Earlier Mark and the applicant's mark. As above, I consider that this applies to all services in the application.

46. I note that the applicant has provided a fall-back specification in its written submissions in lieu. I have reviewed this, but as it simply identifies certain terms that could be deleted from the applicant's specification, it does not avoid the likelihood of confusion finding that I have made in relation to all of the applicant's services. Consequently, I do not consider that this assists the applicant.

CONCLUSION

47. The opposition succeeds in full and the application is refused.

COSTS

48. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice 2/2015 ("TPN"). Using that TPN as a guide and as the opponent has been successful, I award costs to the opponent on the following basis:

Filing a notice of opposition	£200
Opposition fee	£100
Total	£300

49. I order Plane Saver Credit Union Limited to pay YUZZU the sum of £300. This sum is to be paid within 21 days of the expiry of the appeal decision or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 19th day of December 2022

S WILSON

For the Registrar