SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3061613
BY ERIS FX LIMITED TO REGISTER THE TRADE MARK

eris fx

IN CLASS 36

AND IN THE MATTER OF OPPOSITION
THERETO UNDER NO 403491
BY ERIS INNOVATIONS, LLC

1) Following my decision BL 0-503-15, issued on 27 October 2015, I was made aware of an error, namely, that it failed to take account of the applicant's written submissions insofar as there was an indication that it was willing to restrict its specification.

2) I invited the parties to comment on how best to proceed. The applicant requested that its fall-back position be taken into account and that the "hearing be re-run". No hearing has been held in these proceedings and I take the applicant's comment as being a request for the decision to be amended to take account of the restricted specification.

3) The opponent submitted that there was no procedural error because the applicant had not actually made an offer to amend but, rather, it had used the phrase "...we are willing to amend ...". Whether it was an offer to amend the specification or not does not change the question of whether it was a procedural error to not deal with the applicant's submission, but rather, it goes to the question of the nature of the procedural error. I will return to the issue of the nature of the error later. Firstly, I consider whether it was a procedural error to omit dealing with the amended specification (whether a formal fall-back position or not).

4) Rule 74 of the Trade Mark Rules 2008 provides as follows.

> **Correction of irregularities in procedure**
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> 74.-(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.
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> (2) Any rectification made under paragraph (1) shall be made-
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> (a) after giving the parties such notice; and
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> (b) subject to such conditions,
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> as the registrar may direct.

5) The main decision was incomplete because it failed to consider the applicant's submission regarding an amended specification. This is clearly an irregularity in procedure. Rule 74 provides the necessary power and I give notice that I intend to correct the irregularity by considering the impact of the submission upon the outcome of the proceedings.

6) There is some room for interpretation of the phrase used by the applicant when introducing the amended specification, namely "...we are willing to amend..." and whether it is an offer to amend the specification. Regardless of the answer to this, clarification as to the status of the offer should and would have been considered if the submission was dealt with in the decision. However, the applicant, in its response to my invitation to comment on the omission clarified any ambiguity by stating:

> *"In light* of *the fact that the decision does not take into account the amended specification* ***offered*** **as a *fallback*** [my emphasis] *in out written submissions,* we *would like to request that .... the amended specification is taken into account."*

7) Such clarification would have been requested if the decision had considered the amended specification. Therefore, I will proceed with consideration of the amended specification on the basis that it is offered as a fall-back.

8) The amended specification is:

> *Currency exchange services, namely, non-cash spot and forward transactions and onward delivery of funds; but not including trading* of *or providing information about trading* of *futures and options, the exchange of financial derivatives and interest rate products, future exchange services or financial transactions relating to any* of *these excluded services.*

9) Currency exchange services were contained within the original specification and the amended specification is a subset of these original services. However, I do not consider that the applicant's position is materially improved with its offer to limit its specification. The amendment does not exclude the trading of currency, and *non-cash spot and forward transactions* appear to include services used to hedge against changes in the exchange rates of currency. Therefore my comments made in paragraph 32 of my original decision still apply, namely that whilst:

> "[i]t is not clear to me that both commodities and currency would be traded at the same exchange or that financial instruments related to commodities and currency would be traded by the same", "[t]here is some similarity in terms of the nature and methods of use of these services and they may also be in competition because a financial investor/speculator may choose between trading commodities or in currency".

I concluded that there is a "medium level of similarity between the majority of the opponent's Class 36 services and those of the applicant".

10) The one part of the applicant's amended specification that is not covered by these original comments is *Currency exchange services, namely, ... onward delivery* of *funds ...".* The *onward delivery* of *funds* is' now included as a subset of *currency exchange services.* Whilst the term is not explained by the applicant, I understand it as being the service of forwarding funds that originate in one territory and in one currency, to another territory and in a different currency. The type of financial services covered by the opponent's mark are international in nature and whilst currency exchange services are not covered by its registration, it is likely that international customers of the opponent may have to utilise such services in order to access the opponent's services from a territory that operates a different currency to that in which the opponent's services are conducted. Consequently, there is some similarity between the opponent's services and the applicant's *Currency exchange services, namely, ... onward delivery* of *funds.*

11) Having found that there is some similarity between these services, I must factor this into the global assessment of the likelihood of confusion. Customers of the opponent that need to utilise the service of onward delivery of funds converted to another currency in order to access the opponent's services will, upon seeing a mark incorporating ERIS, assume that the service is provided by the opponent or a linked company to the opponent. The additional descriptive element of each party's mark will be perceived as designating the services provided under the marks and not as designating unconnected traders. There will be a likelihood of confusion.

12) In summary, the fall-back specification offered by the applicant is not sufficient for me to find that there is no likelihood of confusion and the opposition is successful in respect of all the services originally applied for and also in respect of all the services covered by the fall-back specification.

13) Finally, further to the response from the opponent to my request for comments, the applicant has provided a second fall-back specification. The main decision was a final decision and may only be amended to correct a procedural error. As this second fall-back specification was not before me at the time the decision was issued, the fact that it was not dealt with in the decision cannot be a procedural error. Therefore, the Registry has no power to consider the merits of the proposal. However, I observe that this second fall-back specification would be likely to be unacceptable for the same reasons I have provided in respect of the first fall-back specification.

14) In accordance with Rule 74(2)(b), the period allowed for appealing this supplementary decision will begin on its date of issue. The appeal period in respect of the main decision is extended to mirror the appeal period of this supplementary decision.

Dated this 11TH day of November 2015

Mark Bryant
For the Registrar,