

O/315/17

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3138841

BY ITI GROUP LIMITED

TO REGISTER A TRADE MARK IN CLASSES 9, 36 & 42

AND

OPPOSITION No. 406484

BY ORIGO SERVICES LIMITED

Background and pleadings

1. This is an opposition by Origo Services Limited (“the opponent”) to an application by ITI Group Limited (“the applicant”) filed on 2nd December 2015 (“the relevant date”) to register the trade mark shown below.



2. The application covers the following goods/services in classes 9, 36 and 42.

Class 9: Financial management software; data processing software; downloadable computer software applications; computer software for analysing market information; computer software and downloadable computer software, including investment methodology software, financial portfolio analysis and optimisation software, financial data visualisation software, and account aggregation and personal money management software.

Class 36: Financial information and advisory services; financial investment analysis; financial information services relating to financial stock markets; financial information provided by electronic means; financial information services provided by access to a computer database; financial information processing; providing financial information on-line; providing financial information on-line including investment methodology information, financial portfolio analysis and optimisation information, financial data visualisation information, and account aggregation and personal money management information; fund management; hedge fund services.

Class 42: Computer software design and development; design and development of computer software including investment methodology software, financial portfolio analysis and optimisation software, financial data

visualisation software, account aggregation and personal money management software; providing temporary use of on-line non-downloadable software for analysing financial data; providing temporary use of on-line non-downloadable software including investment methodology software, financial portfolio analysis and optimisation software, financial data visualisation software, and account aggregation and personal money management software; software as a service.

3. The application was published for opposition purposes on 22nd January 2016.

4. The opponent opposes the application on the basis of Sections 5(2)(b), 5(3) and/or 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The s.5(2)(b) grounds are based on two earlier trade marks, UK trade marks 2582439 and 2633301, which look like this.

2582439 (“Mark A”)



2633301 (“Mark B”)



5. For convenience, I will call these marks A and B, respectively. For the benefit of anyone reading a black and white copy of this decision, mark A is registered in black and white. Mark B is registered in lilac on a white background. The opponent claims that the contested mark is similar to the earlier marks.

6. Mark A is registered in class 36 for *financial services* at large and also for various kinds of financial services. Mark B is registered for goods/services in classes 9, 16, 35, 36, 38, 41, 42 & 45. The opponent claims that the services covered by mark A are identical or similar to the services in class 36 of the opposed application. Further, the opponent claims that all the goods/services covered by the contested mark are

identical or similar to the goods/services covered by mark B. According to the opponent, there is a likelihood of confusion on the part of the public, including the likelihood of association.

7. The application to register mark A was filed on 24th May 2011 and the mark was entered in the register on 26th August 2011. The application to register mark B was filed on 30th August 2012 and the mark was entered in the register on 8th February 2013. Therefore both of the marks are 'earlier trade marks' within the meaning of s.6 of the Act. Neither of the earlier marks had been registered for 5 years at the date of publication of the opposed mark. Therefore, the earlier marks are not subject to the 'proof of use' requirements set out in s.6A of the Act.

8. The opposition under s.5(3) of the Act is based on mark A above. According to the opponent, mark A has a reputation in the UK in relation to all the financial services for which it is registered in class 36. As a consequence of the similarity between the device element of the contested mark and mark A, those consumers who are familiar with the opponent's services will think that the contested mark is a development of mark A, or a sub-brand of the opponent, or is otherwise connected with the opponent. This will lead to the contested mark 'piggy-backing' on the reputation of mark A and/or the opponent losing control of its reputation under mark A, or the dilution of the distinctiveness of mark A. This will result in a change of economic behaviour amongst the relevant public, which the opponent identifies as financial, banking and insurance businesses. In particular, the opponent may lose business to the applicant as a result of confusion between the parties' marks or the tarnishing of mark A's reputation as a result of the applicant's use of the contested mark.

9. The opposition under s.5(4)(a) is based on the opponent's use of mark A in the UK since 1990. The opponent claims that mark A is distinctive of the goodwill it has established under mark A in a business covering:

Computer software for use in the insurance, pension and financial services industry; computer software for providing secure access to computer databases; encryption software; digital security certificates; security software for websites; financial services; electronic financial trading services;

computerised financial services; provision of information relating to finance, insurance and pensions; financial transaction services; financial asset management; computerised transfer of funds; monetary transfer services; certification services; issuance of digital security certificates; data-modelling software; information and advisory services relating to all of the foregoing.

10. The applicant filed a counterstatement denying the grounds of opposition. I note in particular that the applicant says that the contested mark can be distinguished from the earlier mark(s) on the basis that it (or they) are a representation of a commonplace file loading icon and would be immediately recognised as such by those in the software and financial industries.

11. Both sides seek an award of costs.

The hearing

12. A hearing was held on 22nd June 2017 at which the opponent was represented by Ms Barbara Cookson of Lucas & Co. The applicant was represented by Mr Chris Finn of Murgitroyd & Co.

The evidence

13. The opponent's evidence consists of two witness statements by Paul Pettitt, who is Managing Director of the opponent. The second statement was made in reply to a witness statement made on behalf of the applicant by Simon Glover, chairman of the applicant.

14. In his first statement, Mr Pettitt says that marks A and B have been used in the UK since 1989 and 2009, respectively, in relation to:

“financial services relating to the setting and maintenance of standards across the financial services industry to enable different financial institutions (e.g., banks, pension funds, investment schemes, insurance and assurance companies etc.) to simply and securely integrate financial information

amongst themselves; the secure transfer of financial information; cash, pension and asset re-registration, bulk pension and asset scheme transfers; pensions registers; data matching services; homogenization and harmonisation of pensions documentation and the provision of advice to financial advisers and agents.”

15. Mark B has also been used in relation to the above services and, additionally:

“secure email services; the issuance, checking and verification of digital security certificates; and personal Identity verification services.”

16. According to Mr Pettitt, the services are *“provided to a wide range of companies, government bodies, independent financial advisers and other interested parties involved in the UK financial services, pensions and investment industry throughout the United Kingdom, as well as to similar such customers based "offshore" in the Channel Islands, Gibraltar and the Isle of Man.”* A list of the opponent’s customers is provided in exhibit PDP5. I do not recognise all of them, but the list includes many well-known pension, insurance and financial services providers. An advertorial in The Platform ‘Advisor Platform Guide’ from 2012 includes a piece written by Mr Pettitt which describes the opponent’s business like this:¹

“Established for over 20 years, Origo provides the Standards that underpin the exchange of data between organisations across the financial services industry, making it easy for platforms, providers, portals, service providers and advisors to do business with each other”

And:

“The nature of our work means much of what we do goes on behind the scenes but you may know of Origo through Unipass, our digital passport that does away with the need for multiple passwords, or indeed through Options Transfers, our ground breaking system that has reduced pension transfer

¹ See PDP13, page 209

times by 80% and has now been further developed to be a simple solution for re-registration.”

17. According to exhibit PDP4,² the Options Transfer service was introduced in 2008. The Unipass service was introduced in 2009. Unipass digital certificates appear to be *“small data files that contain the verified details of your online identity.”* To use them *“there is no need for hardware or software – all you need is an internet browser.”*³ Options re-registration service was introduced in 2012. This appears to have been an extension of the pension transfers service to cover other financial assets, such as SIPPs, stocks, shares, ISAs, GIAs and bonds. According to the advertorial from 2012,⁴ the Options Transfer is an ‘off-the-shelf’, centrally hosted, web-based service.

18. Mr Pettitt provides annual turnover figures for services provided under the earlier marks. These show that turnover of between £5.6m and £6.8m in each of the years 2012 to 2015. The figures do not break down the opponent’s turnover between that generated by its standard setting services and that generated by the other services provided under the marks.

19. The opponent spends around £500-600K per annum advertising and promoting its services. According to Mr Pettitt, the services provided by the opponent under the marks are promoted through social media sites, YouTube videos and corporate sponsorship. The marks are displayed on the opponent’s own website and on some of the websites, or social media sites, of companies with whom the opponent has partnered, such as Aviva and Royal London. Numerous examples of promotional material are in evidence, such as promotional or information booklets, stationery and hand-outs, advertisements in ‘Money Marketing and ‘Financial Advisor’ (said to date from 2011).⁵ As one would expect, the promotional material is directed at those in the financial services industry. It generally shows that mark A is used alongside the word Origo like this:

² Page 118 of the evidence.

³ See exhibit PDP3 at page 104

⁴ See page 210 of the evidence

⁵ See exhibits PDP1 –PDP4 and PDP6 – PDP13



Mark B is also used with the word ORIGO like this:



20. The opponent promotes its services by attending industry conferences and events. It attended 54 such events between 2011 and 2016, mostly with a focus on pensions.

21. Mr Glover's statement on behalf of the applicant makes the following points.

- The applicant's business is developing data visualisation tools aimed at retail investors who today may well manage his own self invested personal pension (SIPP) fund. The purpose of the software is to help such customers find investments with the lowest costs and charges.
- The logo to which the opponent objects has been in use since early 2013 and no confusion has been reported or come to the applicant's attention.
- Prior to 2016, the applicant used the logo in a different form which looked like this:



- The applicant's logo is an original creation professionally designed by a specialist brand and corporate identity company in London.
- The overall vibrancy of the logo reflects the applicant's belief that the provision of financial guidance to retail investors can be fun, should be intuitive and can be dynamic.

- The opponent's customers appear to be investment platforms and financial management companies, not retail investors.
- Although retail investors want to be able to transfer from one platform to another, the standards and mechanics for data transfer are only of interest to the back office providers rather than the investors themselves.
- File transfer involves a transfer of data between computers. It is therefore not surprising that the opponent's logo is a familiar file loading icon.
- None of the examples of such icons shown in Mr Glover's evidence use the multi-coloured feature of the applicant's logo.⁶

22. Mr Pettitt's second witness statement responds to Mr Glover's evidence. It is comprised of arguments, which I will return to later. However, I note that Mr Pettitt disputes that the opponent's marks look like a file loading icon. He points out that the bars of the opponent's logo(s) increase in thickness from the 12 o'clock point around the circular device. In his view, the applicant's logo looks more like a file loading device.

Section 5(2)(b)

23. Section 5(2)(b) of the Act is 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".

⁶ See pages 10-18 of exhibit SG1

24. The applicant's goods/services and the most relevant of the opponent's goods/services, are set out below.

Contested mark	Earlier marks
<p>Class 9: Financial management software; data processing software; downloadable computer software applications; computer software for analysing market information; computer software and downloadable computer software, including investment methodology software, financial portfolio analysis and optimisation software, financial data visualisation software, and account aggregation and personal money management software.</p> <p>Class 36: Financial information and advisory services; financial investment analysis; financial information services relating to financial stock markets; financial information provided by electronic means; financial information services provided by access to a computer database; financial information processing; providing financial information on-line; providing financial information on-line including investment methodology information, financial portfolio analysis and optimisation information, financial data visualisation information, and account aggregation and personal money management information; fund management; hedge fund services.</p>	<p><u>Mark B</u></p> <p>Class 9: Computer software; magnetic data carriers, recording discs; data processing equipment; data transfer apparatus; data dictionaries; databases; computer data structures for electronic messages; software for electronic trading; software for use in the insurance, pension and financial services industry, computer software and publications in electronic form supplied on-line from databases or from facilities provided on the Internet; computer software to enable the searching of data; terminals for the electronic transfer of funds; software for providing secure access to the Internet and to electronic mail; software for providing secure access to computers, computer databases, computer memories, data and information; encryption software; digital security certificates; security software for websites; software for preventing unauthorised access to websites; software for preventing unauthorised access to computer source code.</p> <p><u>Marks A & B</u></p> <p>Class 36: Financial services; electronic financial trading services; computerised financial services; information services relating to finance and insurance, provided on-line from a computer database or the Internet; collection, provision and dissemination of financial information; provision of pension information; pension management services; pension planning services; arranging of annuities; services for the execution of financial transactions, financial transaction services; financial asset management; financial data base services; monitoring of financial portfolios; computerised transfer of funds, electronic funds transfer; fund transfer; monetary transfer; information, advisory and consultancy services relating to all the aforesaid services.</p>

<p>Class 42: Computer software design and development; design and development of computer software including investment methodology software, financial portfolio analysis and optimisation software, financial data visualisation software, account aggregation and personal money management software; providing temporary use of on-line non-downloadable software for analysing financial data; providing temporary use of on-line non-downloadable software including investment methodology software, financial portfolio analysis and optimisation software, financial data visualisation software, and account aggregation and personal money management software; software as a service.</p>	<p><u>Mark B</u></p> <p>Class 42: Computer programming; design, maintenance and updating of computer software; computer services, namely the issuance of digital security certificates; information provided on-line from a computer database or the Internet concerning a respiratory and data model containing all data elements with their name, description, data type, length and format relating to new system applications within the financial services industry; information, advisory and consultancy services relating to all the aforesaid services.</p>
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25. It was common ground at the hearing that the registered and applied-for services in class 36 should be considered as being identical.

26. It was also common ground that the goods/services in classes 9 and 42 should also be considered as identical, except for the applicant's *software as a service* in class 42, which has no counterpart in the specification of the earlier marks. However, as Ms Cookson was constrained to accept on behalf of the applicant, *software as a service* is similar to *computer software* and *computer programming* for which mark B is protected. This is because the respective goods/services are similar in purpose. Further, they are in fact competitive alternatives, i.e. a business can buy pre-written software, have bespoke software written for it, or use pre-written or tailored software licensed from a supplier and accessed over a network. Assuming that the software is for the same purpose (as I must because the descriptions of goods/services covered by mark B are not restricted to particular purposes), I find that these goods/services are highly similar. The same applies to *computer software* and *computer programming* and the applicant's two other descriptions of services beginning with *providing temporary use of on-line non-downloadable software...*, which are other ways of describing *software as a service*.

Global comparison

27. 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.

The principles

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Average consumer and the methods of selection

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, 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: *Lloyd Schuhfabrik Meyer*.⁷

29. The average consumer of most of the goods/services set out in the application is likely to be a member of the general public or a business with a need for financial

⁷ Case C-342/97

software and/or financial services. However, the application also covers generic software as well as financial services of the kind likely to be of interest to personal investors. Accordingly, the relevant consumers are not limited to just ‘back-office’ users working for financial firms, who make up the bulk of the users of the opponent’s actual services. Nevertheless, it was common ground at the hearing that all relevant average consumers would pay a medium to high level of attention when selecting the goods/services covered by the contested mark. The goods and services covered by the contested mark are likely to be selected mainly through visual means, such as from internet sites and brochures. However, word of mouth recommendations are also likely to play an important part, particularly with regard to financial services in class 36.

Distinctive character of earlier mark

30. In *Lloyd Schuhfabrik Meyer*, the Court of Justice of the European Union (“CJEU”) stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

31. On behalf of the applicant, Ms Cookson submitted that the earlier marks have only a low degree of distinctive character. Two reasons were advanced for this submission. Firstly, that the marks, particularly mark A, were a representation of the well-known icon displayed on computer screens whilst files are loading. Second, that mark A resembled a letter ‘O’, which was a banal and everyday sign and therefore low in distinctiveness.

32. Whilst I accept that mark A could be seen as a file loading icon, I do not think it is so obviously a file loading icon that the average consumer would immediately see it as such when it is used in relation to financial services in class 36. I think that is the case whether or not the financial services concerned involve the use of computers, as I expect many of them do. It follows that I reject Ms Cookson’s first submission, insofar as marks A and B are registered for financial services in class 36. I acknowledge that mark B is also registered for software and software services in classes 9 and 42, but mark B bears virtually no resemblance to a file loading icon. I therefore also reject Ms Cookson’s first submission insofar as it is directed at mark B.

33. I also reject Ms Cookson’s second submission. It cannot be right that mark A would be immediately recognised by relevant consumers as a file-loading icon and as a letter O. Whilst recognising the possibility that some average consumers would see it one way and some the other, I consider that the difficulty Ms Cookson had in pinning down which perception of mark A was most likely betrayed the weakness of her submission on this issue. In my view, mark A would not be seen, immediately and without undue (and unlikely) analysis, as anything other than as a meaningless device. The same applies to mark B. The marks are not strikingly unusual or fancy. I therefore find that they have a ‘normal’ degree of inherent distinctive in relation to the goods/services for which they are registered.

34. The opponent claims that the earlier marks have acquired an enhanced level of distinctiveness as a result of the use made of them. The opponent has plainly used

mark A in relation to the services *execution of financial transactions, financial transaction services; financial data base services; computerised transfer of funds, electronic funds transfer and monetary transfer*, but only to the extent that these descriptions cover services for transferring financial data and funds between financial services providers. However, because there is no breakdown of the opponent's turnover, it is not clear what proportion of the opponent's turnover relates to these services rather than what appear to be its core services of setting financial data transfer standards for parts of the financial services sector.

35. When I asked Mr Finn at the hearing which of the opponent's registered services covered its core data standard setting services, he suggested that such services were covered by *information, advisory and consultancy services relating to* [financial services]. In *Avnet Incorporated v Isoact Limited*,⁸ Jacob J. (as he then was) said that specifications of services should not be given an over-broad interpretation and should be limited to the core of their possible meanings. In *YouView TV Ltd v Total Ltd*,⁹ Floyd J. (as he then was) said that terms should be given their natural meaning, without straining the language to cover, or exclude, goods or services which naturally fall within the terms used. The standard setting services which the opponent provides appear to aimed at standardising the way that financial data is held and/or transmitted so as to ease the transfer of data between financial services providers. The data standard setting services the opponent provides to financial firms therefore appear to be literally *information services relating to* [financial services]. On the other hand, this would be an odd and rather opaque way of describing the services. On balance, and with some hesitation, I am prepared to accept that the financial standard setting services fall within this description.

36. However, as the applicant points out, mark A has mostly been used in conjunction with the word ORIGO. This makes it harder to infer that mark A alone has become materially more than 'normally' distinctive of the opponent's services through use in the niche market in which the opponent currently operates.

⁸ [1998] F.S.R. 16




⁹ [2012] EWHC 3158 (Ch)

37. I therefore find that, at the relevant date, mark A had a ‘normal’ degree of distinctive character to users of the services covered by the registration of mark A.

38. So far as mark B is concerned, I find that the nature of the use of this mark – wrapped around the letter ‘O’ in ORIGO – makes it impossible to infer that mark B alone has become distinctive of the opponent’s services to anyone. It follows that the opponent has not shown that the use of the composite mark, an example of which is shown in paragraph 19 above, resulted in any enhancement of the ‘normal’ level of inherent distinctive character of mark B at the relevant date.

Comparison of marks

39. For convenience, the marks at issue are set out below.

Contested mark	Marks A & B
	 

40. The CJEU stated in *Bimbo SA v OHIM*,¹⁰ 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

¹⁰ See paragraph 34 of the judgment in Case C-591/12P

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.”

It would be wrong, therefore, artificially to 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.

41. The opponent claims that, despite differences of colour, mark A is visually very similar to the contested mark. This is said to be because *“the proportions of the individual rectangular elements to each other, and the curve they follow to make the circle”* in the contested mark *“are virtually identical to those appearing in the opponent’s mark”*. Additionally, the appearance of the device element of the contested mark, and of mark A, is broadly that of a letter ‘O’.

42. I earlier found that mark A would not be seen by relevant average consumers as a letter ‘O’, but rather as a meaningless device. The same applies to the contested mark. To my eye, the proportions of the individual trapezoid elements of mark A are not the same as those in the contested mark. The former are irregular in width and relatively closely spaced on the left hand side of the mark. By contrast, the trapezoid elements of the contested mark have a regular width and are evenly spaced and slightly farther apart. Consequently, the device in the contested mark is composed of 20 elements, compared to the 25 elements making up mark A. Examined at this level of detail there are significant visual differences between the marks. However, I remind myself that the case law states that *“the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details”*. It is therefore inappropriate to conduct a forensic analysis of the marks. Considered as they would strike an average consumer, even one paying a medium to high level of attention, the device in the contested mark and mark A would create similar impressions of circular devices made up of multiple trapezoid segments. The irregular thickness of the segments making up mark A would also make some impression on such consumers, but probably not a strong or lasting one.

43. There was some discussion at the hearing as to the significance of colour. Ms Cookson took issue with the suggestion in the opponent's skeleton argument that registration in black and white covered all colours. However, at the hearing Mr Finn accepted that considering mark A in a similar rainbow of colours as the device element of the contested mark would be going too far. This is because such use would not represent a 'normal and fair' use of mark A as registered. In any event, that is my finding. I did not understand Ms Cookson to dispute that normal and fair use of mark A could include use in colours other than black on white, such as lilac segments on a white background (as in mark B). Again, for the avoidance of doubt, that is my finding. On this footing, the colour difference between mark A and the device in the contested mark could, in normal use of the marks, be less stark than it appears from the way the marks appear in the table in paragraph 38 above. However, the 'rainbow' effect of the device in the contested mark would still have no counterpart in mark A and this would make some difference to the effect the marks create on relevant average consumers.¹¹

44. The contested mark also includes the letters 'ITI'. These are arranged to the right of the device element and are somewhat smaller than the device. The opponent submits that the letters are *de minimis* in the contested mark. I reject this submission. Although somewhat smaller than the device, the letters ITI are clearly not a negligible element of the contested mark. They would make some visual impression on relevant average consumers. It follows that the absence of these letters (or any letters) from mark A is another visual distinction between the marks.

45. Overall, I find that there is a medium degree of visual similarity between the marks.

46. Despite the relatively smaller size of the letters ITI compared to the device element of the contested mark, average consumers are more likely to verbalise the letters than the device. The contested mark is mainly a visual mark, but to the extent

¹¹ The position of the parties at the hearing makes it unnecessary to examine the law on the significance of colour to marks registered in black and white, on which there is some conflicting authority. See *Pico Food GmbH v OHIM*, General Court, T-623/11 and, on the other hand, *Specsavers v Asda Stores Ltd*, CJEU Case C-252/12 and the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294, at paragraph 5.

it is verbalised, it will be as 'ITI'. Mark A is unlikely to be given any verbal expression. It is purely a visual mark. Therefore, there is no aural similarity between the marks.

47. I do not consider that the contested mark as a whole, or mark A, has any concept that is likely to be immediately grasped by average consumers paying a medium to high degree of attention. Therefore the marks are conceptually neutral.

48. Overall, I find that there is a medium degree of similarity between the contested mark and mark A.

49. Turning to the comparison between the contested mark and mark B, I find that there is a lower degree of visual similarity between them than in the case of mark A. This is because the circular nature of the device element of the contested mark is absent from mark B. Otherwise, my findings as regards mark A also apply to mark B.

50. Overall, I find that there is only a low to very low degree of similarity between the contested mark and mark B.

Likelihood of confusion

51. It is necessary to consider the earlier marks to have been used in relation to all the goods/services covered by the registered specifications. In *Roger Maier and Another v ASOS*,¹² Kitchen L.J. stated that:

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a

¹² [2015] EWCA Civ 220

small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

52. Similarly, when assessing the likelihood of confusion under s.5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.¹³

53. However, matter used with, but extraneous to, the marks themselves should not be included in the assessment of the likelihood of confusion.¹⁴ Thus the opponent’s word mark ORIGO has no part to play in my assessment of the likelihood of confusion under s.5(2)(b).

54. Turning first to mark A, I earlier found that the opposed services in class 36 are identical to the services covered by the registration of mark A. This means that a lesser degree of similarity between the marks may be sufficient to create a likelihood of confusion. I found that mark A is similar to a medium degree to the contested mark and has a ‘normal’ degree of distinctive character. In principle, these factors are sufficient to justify a finding of a likelihood of confusion. However, I must also take into account other relevant factors, particularly that average consumers of the goods/services at issue are likely to pay a medium to high degree of attention during the selection process. Is this sufficient to avoid a likelihood of confusion?

55. In my judgment it is not. I find that the differences between the marks are not sufficient to exclude the likelihood of confusion through imperfect recollection of one or other of the marks. Further, I consider that there is a likelihood of indirect confusion. Specifically, that those average consumers of financial services who realise that the marks are different will nevertheless believe that the similarity between the device element of the contested mark and mark A signifies that these are variant marks likely to be used by one and the same undertaking, or by economically related undertakings. The higher-than-average level of attention paid

¹³ See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, CJEU, at paragraph 66 of the judgment.

¹⁴ See *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, at paragraphs 46 and 47 where Floyd L.J. considered the CJEU’s judgment in *Specsavers*, Case C-252/12.

by consumers of financial services is unlikely to be sufficient to counter this perception.

56. This means that the opposition under s.5(2)(b) based on mark A succeeds against the opposed services covered by class 36 of the applicant's application.

57. In reaching this conclusion, I have placed no weight on the applicant's evidence of having traded under a variant mark for a number of years with no evidence of confusion.¹⁵ As the opponent rightly says, this was a different mark with less similarity to mark A than the contested mark in this opposition.

58. Turning to mark B, the respective goods/services are again (mostly) identical. The earlier mark again has a 'normal' degree of distinctiveness. However, mark B has only a very low, or at most a low, degree of similarity to the contested mark. This factor is sufficient, in my view, to rule out any likelihood of confusion in this case. In particular, the resemblance between mark B and the contested mark is so low that relevant average consumers would have no reason to assume that they are variant marks used by the same undertaking, or related undertakings.

59. This means that the opposition under s.5(2)(b) based on mark A succeeds, but the opposition based on mark B fails. As the opposition based on mark A was only directed at class 36 of the application, the goods/services covered by classes 9 and 42 of the application are free from all opposition under s.5(2)(b).

Section 5(3)

60. The opposition under this section is based on the claimed reputation of mark A in relation to the financial services for which it is registered. It is directed at the services covered by class 36 of the application. As I have already found that the opposition under s.5(2)(b) succeeds in relation to the services in class 36, I do not find it necessary to assess the s.5(3) ground in relation to these services.

¹⁵ See paragraph 21 above.

Section 5(4)(a)

61. Section 5(4)(a) states:

“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 of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

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

62. The opposition under this section is directed at all the goods and services in classes 9, 36 and 42. As I have already found that the opposition under s.5(2)(b) succeeds in relation to the services in class 36, I do not find it necessary to assess the s.5(4)(a) ground in relation to these services. I will therefore limit my enquiry under s.5(4)(a) to the applicant’s software/software related services in classes 9 and 42.

63. The basic requirements to establish a passing off right are well established. They are, essentially, (1) goodwill in a business identified by a sign, (2) a misrepresentation (or prospective misrepresentation) by the defendant through the use of a sign similar enough to the claimant’s sign to deceive (intentionally or otherwise) a substantial number of the claimant’s customers or potential customers into believing that the defendant’s goods or services are those of the claimant, or are connected with the claimant, and (3) damage to the claimant’s goodwill caused by the defendant’s misrepresentation.

Relevant date

64. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*,¹⁶ Mr Daniel Alexander QC, as the Appointed Person, approved of the following passage from my decision in *SWORDERS TM* about the relevant date for the purpose of proceedings under s.5(4)(a):

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

65. So the relevant date, at least in the first instance, is the date of filing of the opposed application. Therefore, in order to establish a passing off right, the opponent must show that it had customers or clients in the UK who regarded mark A as distinctive of the opponent’s business as at 2nd December 2015.

Goodwill

66. Mr Pettitt claims that mark A has been used in relation to *“financial services relating to the setting and maintenance of standards across the financial services industry to enable different financial institutions (e.g., banks, pension funds, investment schemes, insurance and assurance companies etc.) to simply and securely integrate financial information amongst themselves; the secure transfer of financial information; cash, pension and asset re-registration, bulk pension and asset scheme transfers; pensions registers; data matching services; homogenization and harmonisation of pensions documentation and the provision of advice to financial advisers and agents.”*

¹⁶ BL O-410-11

67. The documentary evidence provides support for Mr Pettitt's claims, except insofar as they cover "*pensions registers*". This does not appear to be a service as such. I am not sure what it means. Further, "*data matching services; homogenization and harmonisation of pensions documentation and the provision of advice to financial advisers and agents*" do not appear to be self-standing services, but aspects of the preceding services.

68. Subject to these qualifications, I do not think that there can be any doubt that the opponent has a protectable goodwill in relation to the business described in Mr Pettitt's evidence.

69. For the applicant, Ms Cookson submitted that mark A was a 'limping' trade mark. She meant that ORIGO is the primary sign which distinguishes the opponent's services. Mark A is usually a supporting or secondary mark. I accept that the opponent's services are likely to be distinguished first and foremost by the word ORIGO. However, I do not think that means that mark A alone cannot be distinctive of the opponent's services. In my judgment, mark A is also likely to be distinctive to a significant number of providers of financial services, particularly amongst pension and insurance providers. If another undertaking started offering competing services under mark A alone, I consider that it would amount to a misrepresentation capable of damaging the opponent's goodwill. I therefore find that mark A is distinctive to a material extent of the opponent's goodwill.

Misrepresentation

70. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) provides the following guidance as to the courts' approach to the assessment of a likelihood of confusion and deception. It is as follows:

"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.”

The nature and extent of the reputation relied upon

71. Mark A had been used for a significant period in relation to the opponent’s services, particularly its data standard setting services. On the other hand, the opponent’s turnover is modest in the context of the financial services sector. I find that the opponent had a significant but not exceptional reputation at the relevant date. Further, mark A had generally been used as a secondary mark to the word ORIGO. I doubt that mark A would have been as widely known and remembered as the word ORIGO. For these reasons, I find that mark A alone was distinctive, but not strongly distinctive, of the opponent’s reputation at the relevant date amongst providers of financial services products, such pension and insurance providers.

The closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business

72. Both parties provide goods and/or services for financial uses. As I have already noted, the opponent's services are specialist services provided to providers of financial services rather than to the general public. However, many of the applicant's software products and services are described so generally that they too could be intended for the same niche market, e.g. *data processing software* and *software as a service*. I must therefore consider the possibility that the parties are in the same field of activity.

The similarity of the mark, name etc. used by the defendant to that of the plaintiff

73. I earlier found that there is a medium degree of similarity between mark A and the contested mark. However, the assessment required under s.5(4)(a) requires me to take into account all the factors relevant to the opponent's goodwill that a court would take into account in assessing its passing off right claim. This means that I should attach some weight (but not necessarily decisive weight) to the fact that the opponent's customers are generally accustomed to seeing mark A used in conjunction with the word ORIGO. Clearly, the combination of ORIGO and mark A is less similar to the contested mark than is mark A alone.

The manner in which the defendant makes use of the name, mark etc. complained of and collateral factors

74. The opponent's use of mark A (normally) in conjunction with the word ORIGO is plainly relevant.

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.

75. The section of the relevant public among whom mark A has a reputation is a specialist public. When selecting complementary financial software or software services, average consumers in that group are likely to pay a level of attention that is

towards the upper end of the 'medium to high' range of levels of attention paid by consumers of financial software and software services at large.

Finding on misrepresentation

76. The opponent's primary case appears to be that those aware of the reputation of mark A will believe that the contested mark is either the same mark, or a variant mark used by the same or a related undertaking. I earlier found that the opponent's concern was justified when it came to the [notional] use of the marks in relation to identical financial services. However, I do not consider mark A alone to be sufficiently distinctive of the opponent's goodwill that use of the contested mark would result in a substantial number of the opponent's customers or potential customers being deceived into believing that the opponent is responsible for, or connected with, the applicant's software and/or software related services, including financial software products/services.

77. In particular, I do not think it likely that the opponent's (potential) customers would come to this belief despite:

- The absence of the word ORIGO from the contested mark;
- The presence of the letters ITI in the contested mark;
- The use of a 'rainbow' colour scheme for the contested mark, which is not typical of the way that mark A has been used;
- The difference between the opponent's services and the applicant's (albeit closely related) goods and services in classes 9 and 42;
- The relative sophistication and high-ish level of attention likely to be paid by the opponent's (potential) customers during the selection process for financial software and software services.

78. In the absence of misrepresentation, the passing off right ground must be rejected. I find accordingly.

Fall-back specification

79. The skeleton argument served on behalf of the applicant indicated that it was prepared to offer a limitation that none of its goods/services related to *provision of software for transfer of investment portfolios or setting and maintenance standards across the financial services industry*. The applicant's offer does not appear to me to be an unconditional request to amend the specification of the opposed application. I have reached my decision without needing to take account of the applicant's offer. Consequently, I need say no more about it. The applicant can restrict its specification at any time. If it wishes to do so it should make an application on Form TM21B.

Overall outcome

80. The opposition succeeds in class 36 but fails in classes 9 and 42.

Costs

81. The opposition has succeeded in class 36, but failed in classes 9 and 42. The ground of opposition under s.5(2)(b) succeeded in full, but the ground of opposition under s.5(4)(a) failed. Therefore both parties have had a roughly equal measure of success and subject to the following point, should bear their own costs.

82. The parties attended a case management conference ("CMC") on 21st October 2016 at which another Hearing Officer granted the opponent a retrospective extension of time to file its evidence in chief. The request for a one month extension had been filed in September 2016. On 18th October 2016 the opponent filed its evidence. Thus by the date of the CMC the opponent's evidence had been filed. This was a factor that the Hearing Officer took into account in his decision to retrospectively grant the opponent an extension of time. According to the applicant, the opponent did not inform the opponent prior to the CMC that it had filed its evidence. The applicant's representative – Ms Cookson – therefore spent time preparing to resist the application for an extension, which turned out, as she saw it, to be wasted time. Ms Cookson told me that it had been agreed at the CMC that the opponent would have its costs for the CMC. She provided me with a schedule

showing that 8.7 hours were spent preparing for the CMC. At £300 per hour, this equated to £2610.

83. For the opponent, Mr Finn did not dispute Ms Cookson's understanding of the outcome of the CMC or the reasonableness of the applicant's estimate of costs.

84. I will therefore give effect to the decision taken at the CMC. I order Origo Services Limited to pay ITI Group Limited the sum of £2610. This should be paid within 14 days of the end of the period allowed for appeal.

Dated this 7th day of July 2017

**Allan James
For the Registrar**