

O/822/18

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3235321

BY FINASTRA INTERNATIONAL LIMITED

AND

OPPOSITION No. 410433

BY FENESTRAE B.V.

Background and pleadings

1. This is an opposition by Fenestrae B.V. (“the opponent”) to an application filed on 5th June 2017 (“the relevant date”) by Finastra International Limited (“the applicant”) to register FINASTRA as a trade mark for a wide range of goods/services in classes 9, 16, 35, 36, 38, 41, 42 & 45. The full list is attached at annex A.
2. The application was published for opposition purposes on 7th July 2017.
3. The opponent is the proprietor of international trade mark 1105266, which consists of the word FENESTRAE. This mark is registered for goods and services in classes 9, 38 and 42. It is protected in the EU with effect from 11th November 2011 and is therefore an ‘earlier trade mark’ for the purposes of s.6 of the Trade Marks Act 1994 (“the Act”).
4. The process for protecting the international mark in the EU was completed on 19th December 2012.¹
5. The opponent claims that the marks are similar, the respective goods/services are identical or similar, and there is a likelihood of confusion on the part of the public. Therefore, registration of the contested mark should be refused under s.5(2)(b) of the Act.
6. Additionally, or alternatively, the opponent claims that the earlier mark has a reputation in the EU for the goods/services for which it is registered and that use of the contested mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character or reputation of the earlier mark. Therefore, registration of the contested mark should be refused under s.5(3) of the Act.
7. The applicant filed a counterstatement denying the grounds of opposition. I note, in particular, that:

¹ This means that the earlier trade mark is entitled to protection in the UK without the opponent having to provide proof of use under s.6A of the Trade Marks Act 1994.

- (i) The applicant puts the opponent to proof of the claimed reputation of the earlier mark; and
- (ii) Whilst accepting that some of the goods/services in classes 9, 38 and 42 are identical, the applicant denied that the goods/services in classes 16, 35, 36, 41 & 45 of its application were similar to the goods/services covered by the earlier mark.

The evidence

8. The opponent's evidence consists of two witness statements by Willem Hogewoning, its Chief Financial Officer. The company focusses on digitalisation and exchange of documents and document flows. It has 9k customers in 40 countries, including the EU and the UK. Mr Hogewoning states that the FENESTRAE mark has been used in relation to:

“Computer programs; computer software for data processing, document exchange, document routing, document capturing, document digitalization, workflow integration on documents, faxes and emails. Integration of document flows within document management systems, banking systems, business applications and tailor-made connectors. Integrating of fax and unified communications with a computer server (on-premise and cloud) infrastructure. Fax software used for authorisation, identification and payment processing. Design and development of computer software and communication platforms.”

9. 90% of the opponent's revenue comes from what it calls its 'Faxination Platform'. This offers intelligent data capture and digitisation of paper documents, fax and email attachments. It also integrates business data into existing systems, workflows and processes. It also offers a cloud based solution called UDOCX for the automatic processing of documents. These solutions involve the provision of the software and services specified above.

10. The opponent's mark has been used in the UK since 1998. Annual turnover under the mark in the UK in 2011 was around £400k. Between 2012 and 2015

turnover in the UK varied between £300k and £600k. In 2016 turnover dropped to £123k. It went back up to £365k in 2017, although much of this would have been after the relevant date.

11. Mr Hogewoning provides copies of purchase orders from the UK covering the period 2012 to 2017.² There are 28 purchase orders prior to the relevant date. Typically, these are for thousands of pounds/Euros worth of goods/services. Some are for 10s of thousands. One (from RBS Group) is for over £300k worth of maintenance and support services (presumably for a Faxination Platform). The opponent's customers are companies and organisations in the UK. The opponent does not sell to private individuals. According to exhibit WHO7, the opponent had 76 customers in the UK between 2007 and 2016. A couple of these are financial businesses, such as RBS.

12. The opponent spends around £20 - £70k per annum on marketing its products and services in the EU. This includes social media, flyers for the products, attending exhibitions and sponsored events, some of which are in the UK.

13. According to Mr Hogewoning, the opponent's mark is pronounced FEN-IS-STRAY.

14. The applicant's evidence consists of a witness statement by Simon Dowler its Group Legal Counsel and Senior Vice President. Mr Dowler explains that the applicant offers financial services software capabilities to financial institutions, speciality lenders, community banks, credit unions, government and corporations. The company is a result of a merger. This means that the name FINASTRA was first used around the relevant date.

Representation

15. The applicant is represented by Kempner & Partners LLP. The opponent is represented by Novagraaf UK. A hearing took place on 23rd October 2018 at which

² See exhibit WHO5

Mr Simon Malynicz QC appeared on behalf of the applicant and Mr Aaron Wood appeared on behalf of the opponent.

The section 5(2)(b) ground of opposition

16. 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”.

Comparison of goods/services

17. The goods/services covered by the earlier mark are:

Class 9: Computer programs; computer software for the transmission, receipt, storage, conversion and analysis of information and for the conduct of transactions across information networks; computer software for editing and delivering textural and graphic information; computer software for authorization, identification and for payment processing; servers for web hosting; facsimile machines, scanners; photocopiers; computer hardware; computer peripheral devices; data processing equipment; magnetic and optical equipment and apparatus; modems; monitors; telecommunication apparatus including mobile, portable and permanent devices for receipt and storage of data; phones; apparatus and equipment for transmission, receipt, and storage of sound, images and other information, in digital format or otherwise.

Class 38: Telecommunications; telecommunications for transmitting, receiving, retrieving, configuring, translating, converting and organizing data via wireless and/or computer networks; electronic mail and messaging

services; providing access to local area networks (LAN), wide area networks (WAN), IP networks, wireless networks and global networks; electronic transmissions for the receipt and delivery of messages, documents, images, sound, and other data.

Class 42: Design and development of computer hardware and software; programming for electronic data processing; rental of computer hardware and software; consultancy and providing technical information in the field of computers, computer networks, software and software for digital document management; webhosting; providing computer hardware and software [cloud computing services].

18. The applicant accepts that the respective goods/services in classes 9, 38 and 42 are identical.

19. I will therefore first assess the opposition with respect to these goods/services.

Average consumer and the selection process

20. 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.³

21. In its written submissions dated 12th March 2018, the opponent's representatives submitted that *"the goods and services of both parties are technical, for the most part potentially expensive, potentially with long-term important applications and will be purchased only after exercising an above average degree of care and attention to detail so as to ensure e.g. compatibility, price, functionality, etc."*

22. In his skeleton argument Mr Wood did not appear to resile from that position. However at the hearing, whilst accepting that some of the goods/services covered by

³ *Lloyd Schuhfabrik Meyer, Case C-342/97*

the opposed trade mark application would be selected with a higher than average degree of attention, e.g. 'software for investment and stockbroking' and 'services for the design and development of software', Mr Wood submitted that other goods/services would be selected by average consumers paying only a normal level of attention, e.g. a software app' for the public to use in connection with their bank account. When Mr Malynicz complained that Mr Wood was seeking to resile from the opponent's position as set out in its earlier written submissions, Mr Wood explained that the written submissions were prepared at a time when the opponent mistakenly believed that it had to show use of the earlier mark for the purposes of s.6A of the Act. Therefore, the submission about consumers' attention level focused on the opponent's actual goods/services rather than all those goods/services covered by the earlier mark. By contrast, both parties now accepted that it is necessary to compare all the goods/services notionally covered by the marks at issue.

23. I do not accept this explanation. Firstly, the opponent's written submissions referred to *"the goods and services of both parties"* (emphasise added). The applicant's specification could not have been thought to be subject to proof of use. Secondly, paragraph 18 of the opponent's written submissions expressly stated that the earlier trade mark *"must be considered across the notional breadth of the goods/services relied upon."*

24. Allowing a party to resile from a position that it has previously expressed in written submissions may prejudice the other party. For example, if a point is conceded before the other side files its evidence (as was the case here), that party may refrain from filing evidence that it might otherwise have filed to make the point good. However, I do not consider that there is any real prejudice in this case. Prior to the hearing, Mr Malynicz provided a fall-back specification covering the goods/services in classes 9, 38 and 42. He said that, if necessary, the applicant was prepared to qualify all the goods/services in these classes with the caveat *"for the purposes of providing banking, trading, stock broking, investment, treasury or financial services."* The purpose of this qualification was to remove any doubt that the goods/services in question were directed solely at professional specialist users and were only bought after prolonged consideration. This suggests that the applicant was not relying on the point having already been fully conceded in the opponent's

written submissions. I therefore find that it was open to Mr Wood to make the submission that the application covers a range of goods/services, some of which would be selected with only a normal level of attention.

25. Taking the applicant's specification in classes 9, 38 & 42 as it stands (i.e. without the fall-back qualification) it covers descriptions of goods/services, such as *providing online forums for communication on topics of general interest*. The average consumer in these cases could be a member of the public or a business. I see no reason to assume that average consumers will pay any more than an average degree of attention when selecting such services.

26. For the descriptions of services in class 42, the average consumer is likely to be a business or professional person. For those services, and goods in class 9, such as *computer programmes and manuals (downloadable) in electronic format for use in relation to banking, trading, stock broking, investment, treasury and/or finance*, the average consumer is likely to be a business or professional person, but could include members of the public, e.g. a person using software to access their bank account. Even in the case of a person selecting software to access their personal bank account, I find that an above average degree of care and attention will be paid during the selection process to ensure that the software is compatible and has the necessary functionality and security. Similarly, *computers* are only selected after the consumer has paid particular attention to the functionality and specification. The level of attention paid by consumers during the selection of different goods/services really covers a spectrum, which cannot always be accurately captured by the broad-brush designations 'low', 'medium' or 'high'. Even in the case of *computer software* (at large) it is necessary to keep in mind that these are not goods which can be plucked off shelves without paying attention to the compatibility and functionality of the software. Therefore, although the consumer may not be paying an unusually high degree of attention when selecting certain kinds of computers or software, his or her level of attention is always likely to be in the upper half of the possible range of attention. The point being that a computer or software of any kind is not a casual or impulse purchase.

27. The selection process for the goods/services at issue is likely to be primarily visual, e.g. selecting the goods/services from brochures, advertising materials, websites or social media sites. However, word-of-mouth orders or recommendations may also play a part in the selection process. Therefore, the sound of the marks is also a relevant factor.

Distinctive character of the earlier mark

28. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁴ the CJEU stated that:

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

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

⁴ Case C-342/97

29. The earlier mark will convey no intrinsic meaning to UK consumers. It will strike such consumers as an unusual word. The earlier mark is therefore inherently distinctive to an above average degree.

30. The opponent claims that the earlier mark is highly distinctive through use. I do not accept this. The scale of the use and promotion of the mark in the EU is not on such a scale that it would have become well-known and/or highly factually distinctive to relevant UK consumers at the relevant date. Although the opponent's turnover figures appear significant, the cost of the opponent's goods/services appears quite high. Therefore, the sales figures represent only a modest number of sales in the UK. I accept that sales under the mark throughout the EU as a whole are higher, but only a small proportion of this use would have come to the attention of UK consumers.

31. At most, the opponent had a modest reputation in a niche market for digitalisation software and related services. Even if this was sufficient to enhance the level of inherent distinctiveness of the earlier mark to a certain degree, it would only be amongst those in large businesses who are the customers for this type of solution. They are likely to pay a relatively higher degree of attention than other relevant consumers when selecting the goods/services covered by the opposed application in classes 9, 38 & 42. Therefore, this category of consumers is the least likely to be confused. Consequently, a small uplift in the level of distinctive character of the earlier mark because of its familiarity to this category of consumers is unlikely to materially increase the likelihood of confusion in this case.

Comparison of the marks

32. The respective trade marks are shown below:

FENESTRAE	FINASTRA
<u>Earlier trade mark</u>	<u>Contested trade mark</u>

33. The opponent submits that the marks are visually similar because they are made up of single words of similar lengths (8 versus 9 letters) and the beginnings of the marks are similar (FINA v FENE), as are the ends (STRA v STRAE). The applicant argues that the prefixes of the marks are different (FIN v FEN), as are the endings (RA v RAE).

34. As to the way that the marks sound, the opponent submits that different average consumers may pronounce the marks in different ways and that it is “*possible*” that some consumers could pronounce the earlier mark as FEE-NE-STRAYY and the contested mark as FEE-NAY-STRAYY. I note that this does not accord with the experience of the opponent’s witness Mr Hogewoning, who says that its mark is pronounced FEN-IS-STRAY.

35. I accept that different members of the public could pronounce the marks at issue differently. However, in my view, average consumers are most likely to pronounce the earlier mark as FENN-IS-STRAYY (i.e. with the letters RAE in -STREA verbalised as in BRAE) or FEE-NE-STRAYY. The applicant’s mark is most likely to be pronounced as FINN-AST-RAA, although I accept that some average consumers could pronounce it as FENN-AST-RAA. I do not accept that average consumers are likely to pronounce the contested mark as FEE-NAY-STRAYY.

36. It is common ground that neither mark will convey any meaning to average consumers, so conceptual similarity is not relevant.

37. I accept that the use of the common consonants F-N-STR-(-) creates a certain degree of visual similarity between the marks. However, the differences between the vowels (and/or the order in which they appear) appears to me to counteract the visual similarity created from using the same consonants. In particular, the fact that the opponent’s mark contains three letters ‘E’, whereas the contested mark has none, makes quite a difference to the look of the marks. The extra letter in the earlier mark, whilst not particularly important in itself, adds to the visual distinction between them. Overall, I find that there is a low-to-medium degree of visual similarity between the marks.

38. If the contested mark is pronounced as FINN-AST-RAA, I find that there is very little aural similarity between the marks. If it is pronounced as FENN-AST-RAA, then I accept that there will be a higher degree of aural similarity, but still to only a low-to-medium degree.

Likelihood of Confusion

39. 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;

(e) 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.

40. Despite the identity of the goods/services under consideration and the above average degree of distinctive character of the earlier mark, I find that there is no likelihood of confusion. This is because in the context of the goods/services at issue, all of which are selected with at least a normal degree of attention, the different overall impressions created by the look and sound of the marks is sufficient, in my judgement, to avoid a likelihood of direct confusion amongst relevant average consumers. In making this assessment I have kept in mind that the consumer may not see (or hear) the marks side-by-side, and I have therefore made some allowance for imperfect recollection.

41. I acknowledge that the matter is more arguable where every day telecommunications services are concerned, such as “*providing online forums for communication on topics of general interest; providing online chat rooms, email and instant messaging services, and electronic bulletin boards.*” However, on balance, I have decided that the differences between the marks is still sufficient to avoid a likelihood of direct confusion.

42. I find that there is no likelihood of indirect confusion either. Once an average consumer recognises that the marks are different, I see nothing about them that would cause such a consumer to believe that they are likely to be used by the same or related undertakings. For example, there is no ‘family’ resemblance between them, nor any common distinctive element.

43. Having rejected the opposition in classes 9, 38 and 42 where the respective goods/services are identical, I find that the opposition to the applicant’s goods/services in classes 16, 35, 36, 41 & 45 also fails. If anything, the opponent’s case in these classes is weaker because the respective goods/services are (at the most) only similar.

Applicant’s fall-back specification

44. As I mentioned above, prior to the hearing the applicant put forward a fall-back specification in classes 9, 38 and 42. According to this all the respective goods/services would be subject to the qualification:

“for the purposes of providing banking, trading, stock broking, investment, treasury or financial services.”

45. The applicant only relies on this fall-back position if I am against it based on the specification as it stands. The purpose of the fall-back seemed to be linked to Mr Malynicz’s reliance on the judgment of the High Court in *FIL Ltd v Fidelis Underwriting*.⁵ In that case the judge decided that despite the trade marks FIDELITY and FIDELIS being highly similar, there no likelihood of confusion in relation to the insurance specialist services provided under the latter mark. This was because of the high level of attention paid by users of such services.

46. Mr Wood objected that the proposed qualification lacked the legal certainty required by the CJEU’s judgment in the well-known *Postkantoor* case.⁶

⁵ [2018] EWHC 1097 (Pat)

⁶ For the application of this case in the UK, see *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), Arnold J. at paragraphs 43 – 57.

47. As I have found that the opposition fails against the existing specification there is no need to deal with this issue. I will therefore restrict myself to the observation that the proposed limitation would not, in some cases, make sense, e.g. *providing online forums for communication on topics of general interest...“for the purposes of providing banking, trading, stock broking, investment, treasury or financial services.”*

48. *FIL Ltd v Fidelis Underwriting* is simply an example of the application of the well-established principle that in assessing the likelihood of confusion it is necessary to consider that consumers' level of attention may vary according to the type of goods/services at issue.⁷ I have done that. I accept that most of the goods/services covered by classes 9, 38 and 42 of the opposed application are not as specialist as the services in the *Fidelis* case. However, the marks in this case are not as similar as those in *Fidelis* either. And in the end each case must be decided on its own facts.

The section 5(3) ground of opposition

49. Section 5(3) states:

“(3) A trade mark which-

(a) 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 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.”

50. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

⁷ *Lloyd Schuhfabrik Meyer*

- (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*).

Reputation

51. For the reasons given in paragraph 30 above, I am doubtful that the opponent's mark has a qualifying reputation in the EU. At most, the earlier mark has a modest reputation in a niche market for digitalisation software and related services.

Link

52. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

53. I earlier found that there is a low-to-medium degree of visual similarity between the marks and that, if anything, the degree of aural similarity between them is lower.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

54. Some of the descriptions of goods/services in classes 9 and 42 (e.g. *computer software* and *design and development of computer software*) of the opposed application cover identical goods and services to those of for which the earlier mark has been used. The actual software and systems for which the earlier mark is known are highly technical and only likely to be selected after careful consideration.

The strength of the earlier mark's reputation

55. Modest, particularly when considered in relation to UK consumers.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

56. The earlier mark has an above-average degree of inherent distinctive character. I am doubtful whether that has been materially enhanced to UK consumers as a result of the modest number of sales and the amount spent promoting the earlier mark.

Whether there is a likelihood of confusion

57. There is no likelihood of confusion.

58. Taking all these factors into account, I find that the average UK consumer of the goods/services covered by classes 9 and 42 of the opposed application would not make a link between the marks. It follows that this is also the case in the other

classes of the application where the respective goods/services are less similar, or not similar.

Unfair advantage/Detriment to distinctive character

59. If I am right that there is no link, then the conditions set out in s.5(3) cannot arise. However, even if I am wrong about the link, meaning that the contested mark would bring the earlier mark to mind, I do not consider that such a link would give the contested mark an unfair advantage or be detrimental to the reputation or distinctive character of the earlier mark. At most, the contested mark may remind some consumers of the earlier mark. However, the nature and strength of any such link would be insufficient to give rise to any of the consequences covered by s.5(3).

Outcome

60. The opposition fails.

Costs

61. The applicant has been successful and is entitled to a contribution towards its costs. I assess these as follows.

£300 for considering the notice of opposition and filing a counterstatement;
£900 for considering the opponent's evidence and filing evidence in response;
£900 for attending a hearing and filing a skeleton argument.

62. I therefore order Fenestrae B.V. to pay Finastra International Limited the sum of £2100. This sum to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 20th day of December 2018

**Allan James
For the Registrar**

Annex A

Class 9: Computers, data processing and computer apparatus; apparatus for use with the aforesaid computers or computing apparatus; data storage apparatus; computer software and computer programs; computer software, computer programmes and manuals (downloadable) in electronic format for use in relation to banking, trading, stock broking, investment, treasury and/or finance; computer software in the field of banking and financial risk management, the management of financial transactions and evaluating the prices of financial products; computer software for database integration; computer software for creating searchable databases of information and data relating to banking, trading, stock broking, investment, treasury and/or finance; computer software to enable database management and the development and hosting of Internet Websites for use in the field of finance and trading; computer software to act as an Internet based platform for the sharing of information and to allow the modification thereof and for the creation of interoperability capabilities to enable the connection of banking information systems; computer software providing Web hosting facilities; computer software for use in the development and hosting of Internet Web-sites; computer software to enable network-based alerts; computer software to enable Internet-based alerts; collaborative software; apparatus for the processing, recordal, storage, retrieval, transmission, reception, display and printing of data; communications and networking apparatus and instruments for use in relation to banking, trading, stock broking, investment, treasure and/or finance; electronic publications provided online from databases or the Internet; computer software and telecommunications apparatus to enable connection to databases and the Internet; parts and fittings for the aforesaid goods.

Class 16: Printed matter; manuals, instructional and teaching material (except apparatus); data storage and data presentation manuals; computer software manuals for use in relation to e-commerce software and financial software; all of the aforesaid relating to banking, trading, stock broking, accounting, investment and/or finance.

Class 35: Operational business assistance to enterprises and business consultancy; compilation and provision of business information; provision and analysis of business advice and information; data processing; provision of information relating to business consultancy via a helpline; information, consultancy and advice in relation to the foregoing services; the provision of the foregoing services and information relating thereto on-line, from a computer database or via any other communications; all of the aforesaid in relation to the fields of software, banking, trading, stock broking, accounting, investment, treasury and/or finance.

Class 36: Financial services; banking; stock broking; financial services provided via the Internet; provision of financial information; electronic compilation and provision of financial information and banking advisory services; financial information distribution and management; computerised banking, trading, stock broking, investment and other financial services; quotation of stock exchange prices; information, consultancy and advice in relation to the foregoing services; the provision of the foregoing services and information relating thereto on-line, from a computer database or via any other communications.

Class 38: Telecommunications; electronic bulletin board services (telecommunication services) in relation to banking, trading, stock broking, investment, treasure and/or finance; providing online forums for communication on topics of general interest; providing online chat rooms, email and instant messaging services, and electronic bulletin boards; electronic mail; electronic text transmission; message sending; transmission of messages and images (computer aided) in relation to banking, trading, stock broking, investment, treasure and/or finance; providing access to databases; providing access to computer databases relating to cloud computing and computer software design and development providing user access to a global computer network (service providers); providing internet chatrooms; information, advice and consultancy services relating to all the aforesaid.

Class 41: Education; providing of training; education services; education services provided online; provision of online training; provision of interactive information provided on-line from computer databases or the Internet; provision of information

provided on-line from computer databases or the Internet; provision of information for accessing via communication and computer networks.

Class 42: Design and development of computer software; design and development of computer systems; design and development of data processing programs and systems; computer programming; computer systems and software analysis and consultancy; computer and technical consultancy; installation, maintenance and support of computer software and systems; computer software project management services; information distribution and management services; creating, maintaining and hosting Web sites; hosting software and databases for others; providing an online website featuring and providing temporary use of non-downloadable computer software and software applications; software as a service (SaaS) services, including the provision of online software; online data storage; electronic data storage; hosting of software as a service (SaaS); platform as a service (PaaS) services; providing virtual computer systems and virtual computer environments through cloud computing; online provision of web-based software; rental, design, creation and updating of computer software and computer databases; computer consultancy services; provision of information relating to computer software and computer systems via a helpline; information, consultancy and advice in relation to the foregoing services; the provision of the foregoing services and information relating thereto on-line, from a computer database or via any other communications; electronic data storage; all of the aforesaid in relation to the field of banking, trading, stock broking, accounting, investment, treasury and/or finance.

Class 45: Granting licences to others for the use of technologies, computer software and information in the field of banking, trading, stockbroking, accounting, investment and/or finance; information, consultancy and advice in relation to the foregoing services; the provision of the foregoing services and information relating thereto on-line, from a computer database or via any other communications.