

O/0154/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATIONS 3668528 & 3683012

BY

YU LIFE LTD

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASSES 9, 35, 36, 41, 42 &
44

YUCOIN



AND THE OPPOSITIONS UNDER NOs. 429546 & 431692 THERETO

BY

ZUCOINS L.P.

Background and pleadings

1. YU LIFE LTD (“the applicant”) applied to register the following trade marks:

UK3668528

YUCOIN

Filing date: 14 July 2021

Publication date: 24 September 2021

UK3683012



Filing date: 18 August 2021

Publication date: 10 December 2021

The goods and services applied for, for both marks, are as follows:

Class 9: Downloadable applications for use with mobile devices, namely virtual GP, instant medical support, health check, nutritional consultation; mobile applications, tracking, tech based tools and processes, namely Computer programs for use in insurance for the purpose of transacting policyholder risk information and data between brokers and underwriters; downloadable cryptographic keys for receiving and spending cryptocurrency.

Class 35: Advertising; business management; business administration; office functions, including Generating auto insurance, health insurance, and life insurance leads; promoting the goods and services of others; promoting the goods and services of others by means of a loyalty rewards card scheme; administration of loyalty rewards programmes; administration of loyalty programs involving discounts or incentives.

Class 36: Insurance; Life insurance; life insurance brokerage; life insurance agencies; life insurance underwriting; non-life insurance underwriting; arranging of life insurance; insurance services relating to life; advisory services relating to life insurance; providing information relating to life insurance; consultancy and brokerage services relating to life insurance; group life insurance; health insurance; financial services; financial support services; Information services relating to insurance; Medical insurance; services for insurance; Financial underwriting; Insurance underwriting; Providing information in insurance matters; administration of group insurance; administration of group insurance plans; financial advice relating to wills; issuing of vouchers; issuing of travel vouchers; issuing of payment gift vouchers; issue of tokens, coupons and vouchers of value; issuing of tokens of value; issuing tokens of value in the nature of gift vouchers; issuing of tokens of value in relation to incentive schemes; virtual currency services; virtual currency transfer services; currency trading and exchange services.

Class 41: Online fitness programme; writing articles for online blogs; career counselling; career information and advisory services; career coaching; online fitness programmes; healthcare education; teaching of meditation practices; meditation training; health and wellness training.

Class 42: Providing temporary use of on-line non-downloadable software for use in insurance quoting.

Class 44: Healthcare; healthcare services; health counselling; mental health services; telehealth; clinical counselling; Telehealth services; 24/7 access to

online GP; nutrition counselling; medical advisory services; online health check; meditation services.

2. ZUCOINS L.P. (“the opponent”) opposes both trade mark applications. OP429546 and OP4321692 are both on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act) and concerns all the services in classes 35, 36 and 42 and the following goods from class 9: mobile applications, tracking, tech based tools and processes, namely Computer programs for use in insurance for the purpose of transacting policyholder risk information and data between brokers and underwriters; downloadable cryptographic keys for receiving and spending cryptocurrency.

3. The following mark is relied upon for the oppositions:

UK3619117

ZUCOIN

Filing date: 30 March 2021

Registration date: 13 August 2021

Relying on the following services:

Class 36: Financial services, namely, investment of funds in the form of cryptocurrency in technology companies.

Class 42: Software as a Service (SaaS) services featuring software for use in computer networking, data storage, and the facilitation of crypto-currency transactions, namely, virtual currency exchange transaction services for transferrable electronic cash equivalent units having a specified value.

4. The opponent argues that the marks are very similar phonetically and visually with the only difference being the initial letter. They claim that the goods and services are either identical or very similar/complementary. Further, they argue that consumers are prone to confusion as they are likely to believe that both marks in question are simply

a variation of the same brand. The two oppositions have been consolidated to be decided together.

5. The applicant filed a counterstatement denying the claims.

6. During the evidence rounds, the opponent filed written submissions; the applicant filed evidence and submissions. No hearing was requested and I take this decision following a careful perusal of all of the papers filed.

7. The applicant is represented by FRESH IP and the opponent is represented by Katarzyna Eliza Binder-Sony.

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

Evidence

9. The applicant's evidence consists of a witness statement by Sammy Rubin, who is the Chief Executive Officer of YuLife, together with ten accompanying exhibits. The main purpose of the evidence is to show the background of the company and its marks and brand.

10. The evidence regarding the applicant's other registrations is of no relevance in my decision as my considerations must be limited to the marks at issue.

Decision

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

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

(a)...

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

12. Since it was applied for before the applicant’s contested mark, the mark relied on by the opponent qualifies as “an earlier trade mark” under the Act.¹

13. I note the applicant’s assertions within their witness statement that the opponent does not yet have a product on the market and does not appear within the life insurance industry; however, as this trade mark had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to of the use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the services it has identified.

Case law

14. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

¹ See section 6(1) of the Act

(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.

Comparison of Goods and Services

15. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

16. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

17. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. In *Gérard Meric v OHIM* (‘Meric’), Case T-133/05, the General Court (“the GC”) held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

20. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

21. I bear in mind the following applicable principles of interpretation:

“(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”²

22. Geoffrey Hobbs KC, sitting as an Appointed Person in the case of *Raleigh International Trade Mark* [2001] RPC 11:

“20. If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their "similarity" (whether or not the objection is directed to the use of an identical mark): Canon paragraph 22”

² See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms).

Applicant's contested goods and services	Opponent's services
<p>Class 9: mobile applications, tracking, tech based tools and processes, namely Computer programs for use in insurance for the purpose of transacting policyholder risk information and data between brokers and underwriters; downloadable cryptographic keys for receiving and spending cryptocurrency.</p> <p>Class 35: Advertising; business management; business administration; office functions, including Generating auto insurance, health insurance, and life insurance leads; promoting the goods and services of others; promoting the goods and services of others by means of a loyalty rewards card scheme; administration of loyalty rewards programmes; administration of loyalty programs involving discounts or incentives.</p> <p>Class 36: Insurance; Life insurance; life insurance brokerage; life insurance agencies; life insurance underwriting; non-life insurance underwriting; arranging of life insurance; insurance services relating to life; advisory services relating to life insurance; providing information relating to life insurance;</p>	<p>Class 36: Financial services, namely, investment of funds in the form of cryptocurrency in technology companies.</p> <p>Class 42: Software as a Service (SaaS) services featuring software for use in computer networking, data storage, and the facilitation of crypto-currency transactions, namely, virtual currency exchange transaction services for transferrable electronic cash equivalent units having a specified value.</p>

consultancy and brokerage services relating to life insurance; group life insurance; health insurance; financial services; financial support services; Information services relating to insurance; Medical insurance; services for insurance; Financial underwriting; Insurance underwriting; Providing information in insurance matters; administration of group insurance; administration of group insurance plans; financial advice relating to wills; issuing of vouchers; issuing of travel vouchers; issuing of payment gift vouchers; issue of tokens, coupons and vouchers of value; issuing of tokens of value; issuing tokens of value in the nature of gift vouchers; issuing of tokens of value in relation to incentive schemes; virtual currency services; virtual currency transfer services; currency trading and exchange services.

Class 42: Providing temporary use of on-line non-downloadable software for use in insurance quoting.

Mobile applications, tracking, tech based tools and processes, namely Computer programs for use in insurance for the purpose of transacting policyholder risk information and data between brokers and underwriters

23. In making my assessment, I note that the Tribunal Manual states that specifications which include the wording 'namely' should be interpreted as covering only the named goods within that specification. Therefore, the applicant's above

specification in Class 9 is limited to only those goods. I find that computer programs are a type of software and in this instance, they are limited to mobile applications that are used for transacting policyholder risk information and data between brokers and underwriters. I consider that the opponent's 'software as a service' is a type of service where a user pays a periodic licence fee in order to access software that is hosted centrally by the provider and this service is also restricted to software 'namely virtual currency exchange transaction services for transferrable electronic cash equivalent units having a specified value'. There are inherent differences in nature between goods and services. I have been provided with no evidence to explain why these services should be considered similar to the applicant's goods. It is not self-evident to me that insurance brokers or underwriters would use virtual currency. Therefore, for the user and use would differ as would their trade channels. I do not consider the goods and services to be complementary nor in competition. I therefore consider the above goods to be dissimilar to the opponent's services.

Downloadable cryptographic keys for receiving and spending cryptocurrency

24. I consider that the above goods of the applicant could overlap in user and use with the opponent's Class 42: "Software as a Service (SaaS) services featuring software for use in [...] the facilitation of crypto-currency transactions, namely, virtual currency exchange transaction services for transferrable electronic cash equivalent units having a specified value' as it seems likely that the applicant's goods could be used within the transactions named. I therefore also find them to be complementary as the use of the downloadable keys would be an intrinsic part of a crypto-currency transaction. This would also mean that there is some overlap in purpose. As I mentioned above, goods and services are inherently different in nature however, in this instance there might be an overlap in the experience of the user as they might use a cryptographic key within the transaction software. They could possibly be in competition as you could be choosing between a service that undertakes the transaction for you versus using the good to undertake the transaction yourself. I therefore find these goods and services to be similar to at least a medium (but not the highest) degree.

Advertising; business management; business administration; office functions, including Generating auto insurance, health insurance, and life insurance leads;

promoting the goods and services of others; promoting the goods and services of others by means of a loyalty rewards card scheme; administration of loyalty rewards programmes; administration of loyalty programs involving discounts or incentives.

25. The applicant's above class 35 services involve advertising and loyalty schemes, business management and administration. Applying the case law principles I set out to above, I find no evident similarity between these services and any of the opponent's financial and software services in Classes 36 and 42. The respective services are dissimilar.

Insurance; Life insurance; life insurance brokerage; life insurance agencies; life insurance underwriting; non-life insurance underwriting; arranging of life insurance; insurance services relating to life; advisory services relating to life insurance; providing information relating to life insurance; consultancy and brokerage services relating to life insurance; group life insurance; health insurance; Information services relating to insurance; Medical insurance; services for insurance; Financial underwriting; Insurance underwriting; Providing information in insurance matters; administration of group insurance; administration of group insurance plans; financial advice relating to wills; issuing of vouchers; issuing of travel vouchers; issuing of payment gift vouchers; issue of tokens, coupons and vouchers of value; issuing of tokens of value; issuing tokens of value in the nature of gift vouchers; issuing of tokens of value in relation to incentive schemes

26. I find no evident similarity these services with the opponent's services in Class 36 and 42. These services are dissimilar.

Financial services; financial support services

27. I consider that the above services are a wider category incorporating the opponent's 'financial services, namely, investment of funds in the form of cryptocurrency in technology companies'. I find them to be identical under the *Meric* principles.

Virtual currency services; virtual currency transfer services; currency trading and exchange services

28. It is likely that there will be a significant overlap in user and purpose with the above services and the opponent's 'services featuring software for use in [...] the facilitation of crypto-currency transactions, namely, virtual currency exchange transaction services for transferrable electronic cash equivalent units having a specified value' as they both involve transactions relating to virtual currency. They may also share trade channels and overlap in nature. I find that there will likely be complementarity between the services as it would be reasonable for the average consumer to believe that a company undertaking virtual currency services and transactions might also make their own software for use in doing the same tasks. It is possible that the services might be in competition - the consumer might choose between using the service directly or accessing those same services to undertake the transactions themselves. I therefore find these services to be similar to a high degree.

Providing temporary use of on-line non-downloadable software for use in insurance quoting

29. As with the class 9 mobile application goods, these services are related to insurance quoted and it is once again not self-evident to me that insurance brokers or underwriters would use virtual currency services. Therefore, for the user and use would differ as would their trade channels. I do not consider the services to be complementary nor in competition. I therefore consider the above goods to be dissimilar to the opponent's services.

30. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to

be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

31. I have found no similarity in respect of the following goods and services from the applicant’s specification:

Class 9: Mobile applications, tracking, tech based tools and processes, namely Computer programs for use in insurance for the purpose of transacting policyholder risk information and data between brokers and underwriters

Class 35: Advertising; business management; business administration; office functions, including Generating auto insurance, health insurance, and life insurance leads; promoting the goods and services of others; promoting the goods and services of others by means of a loyalty rewards card scheme; administration of loyalty rewards programmes; administration of loyalty programs involving discounts or incentives.

Class 36: Insurance; Life insurance; life insurance brokerage; life insurance agencies; life insurance underwriting; non-life insurance underwriting; arranging of life insurance; insurance services relating to life; advisory services relating to life insurance; providing information relating to life insurance; consultancy and brokerage services relating to life insurance; group life insurance; health insurance; Information services relating to insurance; Medical insurance; services for insurance; Financial underwriting; Insurance underwriting; Providing information in insurance matters; administration of group insurance; administration of group insurance plans; financial advice relating to wills; issuing of vouchers; issuing of travel vouchers; issuing of payment gift vouchers; issue of tokens, coupons and vouchers of value; issuing of tokens of value; issuing tokens of value in the nature of gift vouchers; issuing of tokens of value in relation to incentive schemes

Class 42: Providing temporary use of on-line non-downloadable software for use in insurance quoting

The opposition therefore fails in relation to those applied-for services for lack of similarity.

32. I will continue to consider the opposition in respect of the following goods and services:

Class 9: Downloadable cryptographic keys for receiving and spending cryptocurrency

Class 36: 'financial services; financial support services; virtual currency services; virtual currency transfer services; currency trading and exchange services'.

Average consumer and the purchasing act

33. 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*, Case C-342/97.

34. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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

35. I consider that the average consumer of the class 9 goods and class 42 services could be members of the public or professionals/business. The costs of these goods are likely to vary greatly between low and high cost. I would consider that these goods and services will be purchased relatively infrequently although there is potential for the class 9 goods to be more frequent. The average consumer will need to take into consideration the cost and suitability of these goods in accordance with their needs. I therefore consider that the average consumer would pay a higher than average level of attention during the purchasing process particular where money/cryptocurrency is featured.

36. In relation to the class 36 services, the average consumer will include members of the public and professionals/businesses. The services cover a broad spectrum in the area of finance and currencies. Some of the services are more specialist than the others, but they all relate to finance/monetary considerations. For the most part the purchases will be fairly infrequent and have varying costs (as well as the usual possible risks involved with investing and financial affairs). I find that the average consumer will be paying a higher than average level of attention.

37. The above goods and services are likely to be selected from specialist retailers, websites, advertisements and signs on a physical property. I therefore believe that visual considerations will dominate the selection process. However, I do not discount the possibility that there could be aural considerations from word of mouth recommendations or advice from a sales assistant.


Comparison of the marks

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

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

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

40. The respective trade marks are shown below:

Contested marks	Earlier mark
<p data-bbox="411 1133 576 1173">YUCOIN</p> 	<p data-bbox="995 1272 1198 1317">ZUCOIN</p>

41. The earlier mark comprises of one word and therefore, the overall impression lies in the word itself. The same applies for the applicant's word mark.

42. For the applicant's figurative mark, it comprises of a coin-like device, a cartoon giraffe and the word 'YUCOIN'. I consider that given the central sizing and placement of the giraffe (and its lack of association with the wording in the mark) that it is at least equal in distinctiveness to the wording underneath it. The background being shaped like a coin is a less distinctive element but still plays a role in the overall impression of the mark - that is that it identifies the mark as a whole as a type of coin. I believe that none of the elements are notably more dominant than the others.

43. Visually, the earlier mark contains six letters as does the contested word mark. The marks both share the letters 'UCOIN', and the difference lies solely in the first letter. I find the marks to be visually similar to a high degree.

44. The contested figurative mark is presented in the shape of a circle which features shadows that make the circle look like a 3D coin. The circle is grey with slightly darker grey spots around the edge. In the centre of the coin is a line cartoon giraffe in a side profile. Underneath the giraffe is the word 'YUCOIN' in lower case letters presented in an upwards curve. The letters 'YU' are shown in a slightly bolder font than the letters 'COIN'. Even though both marks share the presence of the letters 'UCOIN', the further elements making up the contested figurative mark and the placement and smaller sizing of those letters within the figurative mark lead me to find the marks to be visually similar to a low degree.

45. Aurally, the earlier mark is made up of two syllables and will be pronounced *zoo/coin*. The contested word mark will also be said as two syllables, with the second syllable being pronounced identically to the second syllable of the earlier mark. The first syllable will likely be pronounced as *you*. The beginnings of those syllables are quite different- a closed 'zz' sound compared to a more open 'yuh'. However, given the overlap of the later part of the mark, I find them to be aurally similar to a high degree.

46. As the figurative mark contains a word within it, that is what will be spoken by the average consumer and because that word is identical to the contested word mark, my aural comparison above will apply in the same manner here.

47. Next, I turn to the conceptual comparison. I keep in mind the comments made by Phillip Harris, as the Appointed Person in *Retail Royalty Company v Harringtons Clothing Limited O/593/20*:

“75. In contrast, conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trade mark acknowledgement) or a level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken...”

48. It was submitted by the applicant that the average consumer would believe that ‘ZU’ would refer to a zoo however, I find this argument to be unconvincing. Whilst they might sound the same, the spelling does differ and ‘ZU’ is presented together as one word with ‘COIN’. I apply the same reasoning to the applicant’s assertions that the average consumer will see ‘YU’ as meaning ‘you’. I do not believe either to be a natural meaning or graspable concept. Even taking into account the word ‘COIN’ being present in both marks, and having an ordinary dictionary definition, I believe the average consumer will believe the terms to be made up and therefore, as there is no immediate clear meaning, the conceptual comparison is more or less neutral.

49. The word part of the figurative mark will again be conceptually neutral as above. The shape of the mark as a coin serves to reinforce the ‘COIN’ within the word. There is a clear conceptual difference between the giraffe on the figurate mark and the opponent’s mark.

Distinctive Character of the Earlier Mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).”

51. The opponent made no claim and put forward no evidence relating to an enhanced level of distinctiveness of their earlier marks. I will therefore consider the position based solely on its inherent distinctiveness.

52. Although the mark as a whole is invented, the average consumer will be able to identify the normal dictionary term ‘COIN’ in it. In relation to the opponent’s services, a coin would be allusive as their services are financial and crypto currency related. However, the beginning ‘ZU’ appears to be made up. Therefore, I find the mark to be inherently distinctive to a medium degree.

Likelihood of Confusion

53. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

54. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the

earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

55. I have reached the following conclusions above regarding the marks:

- For the word marks the overall impression lies in the words themselves. For the figurative mark the cartoon giraffe and the word are equally distinctive. The coin device will have some impact on the overall impression but this will be less than the other elements. I found that none of the elements are more dominant than the other.
- The word marks are visually similar to a high degree. The figurative mark is similar to a low degree to the opponent's mark.
- The contested marks are aurally similar to the opponent's mark to a high degree.
- I have found the concepts to be neutral or more dissimilar for the figurative mark.
- The earlier mark is inherently distinctive to a medium degree.
- The remaining goods and services are between identical and similar to at least a medium degree.
- The average consumer will be paying a higher than average degree of attention.

56. For the contested word mark, I consider that the only difference between it and the opponent's mark is the first letter. They share five out of six letters and even though it can be said that the word 'COIN' within the marks is allusive to some of the financial/cryptocurrency services registered, the high levels of similarities between the remaining goods and services together with the high levels of visual and aural similarity, I believe, means there is a chance the average consumer may mistake one mark for the other (even when that consumer is paying a higher than average attention). There is also no strong conceptual difference to prevent the average consumer from imperfectly recalling the marks. I therefore find there is a likelihood of direct confusion.

57. For the contested figurative mark, I consider that there are much greater visual differences and the contested mark includes a cartoon giraffe that shares the overall impression with the word itself and affects the concept of the mark. Therefore, I do not believe the average consumer will mistake one mark for the other and subsequently, there will be no likelihood of direct confusion.

58. Moving on to indirect likelihood of confusion, I do not find that there is any “proper basis” why the average consumer would consider the contested mark to be another brand of the owner of the earlier mark, so no indirect confusion arises either.³ A finding of indirect confusion should not be made merely because the two marks share a common element.⁴ The common element between the marks differs by the beginning letter. There are features within the contested figurative mark that have no counterpart in the opponent mark, and the cartoon giraffe is an equally distinctive and dominant element to the word part of the mark that has no relation to any goods or services or even to the concept of the word part of the mark. Due to this, I am not convinced that there is enough between the marks to call one to mind when encountering the other. If they did call the marks to mind it would be mere association and not indirect confusion.

Conclusion

59. OP429546 is successful in respect of

Class 9: Downloadable cryptographic keys for receiving and spending cryptocurrency

Class 36: ‘financial services; financial support services; virtual currency services; virtual currency transfer services; currency trading and exchange services’.

³ See Arnold LJ at [13] of the judgement in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

⁴ As noted, for instance, by James Mellor Q.C. (as he then was), as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

60. Subject to any successful appeal, the application for UK3668528 will proceed to registration in respect of all goods and services except those listed in the above paragraph.

61. OP431692 fails in its entirety.

Costs

62. The guidance for awards of costs are set out in TPN 2/2016.

63. On reviewing the matters at hand, I consider that both parties have had some level of success and some failure. It is my view that on this occasion, the fairest basis to deal with costs is for each party to bear their own in this matter.

64. I therefore make no award of costs in this matter.

Dated this 13th day of February 2023

L Nicholas

For the Registrar