

O/0715/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001541304

**DESIGNATING THE UK BY
NEW HOLLAND VENTURES PTY LTD**

MARCO POLO

IN CLASS 36

AND

**AN APPLICATION FOR INVALIDITY
UNDER NO. 503859
BY PETRA FINANCIAL TECHNOLOGIES LLC**

BACKGROUND AND PLEADINGS

1. International Registration (“IR”) No. 1541304 stands in the name of New Holland Ventures Pty Ltd (“the proprietor”). The IR as shown on the cover page of this decision was registered by the proprietor on 19 June 2020. On the same date, the proprietor designated the UK territory in which it sought to protect the IR. The IR achieved protection on 31 December 2020 for the following services:

Class 36: Trade finance services; registration of securities; registration of shares; traded options brokerage; advisory services relating to (financial) risk management; advisory services relating to futures; provision of exchange rate lists; trading in bonds; provision of financial securities; provision of information relating to stock broking; provision of investment capital; trading in stocks; provision of investment savings plans; provision of online currency exchange calculators; trading in contracts on stocks; management of capital investment funds; management of financial assets; management of funds; management of securities; management of shares; management of stocks; management of unit trusts; unit trust services; trading in securities; brokerage services for bonds; brokerage services for securities; brokerage services relating to debt instruments; brokerage services relating to financial instruments; brokerage services relating to municipal bonds; brokerage services relating to mutual funds; brokerage services relating to the securities markets; advisory services relating to unit trusts; unit trust investment; trading of shares; unit trust management currencies; securities advisory services; securities analysis; securities brokerage; securities exchange services; securities investment services; securities management; securities settlement; securities trading services; securities underwriting; raising of capital; services for the consolidation of monies; trading in equities; share brokerage services; share exchange schemes; share management; share planning services; share portfolio management; share registration; share services; share underwriting; raising of finance; stock bond brokerage; quotation of stock exchange prices; trading in futures; stock brokerage services; stock debenture brokerage; stock exchange quotations; stock exchange services; stock investment management; stock market services; stock price quotation services; recording the transfer of

securities; stockbroking; stockbroking agency services; stocks and bonds brokerage; trading in options; brokerage; brokerage of bonds; brokerage of currency; brokerage of futures; brokerage of futures contracts; brokerage of securities; recording the transfer of shares; brokerage of shares; brokerage of stocks; brokerage of virtual fictional property and dwellings; brokerage or underwriting of warranties and guarantees; recording the transfer of stocks; unit trust management.

2. On 18 May 2021, Petra Financial Technologies LLC¹ (“the applicant”) applied for a declaration of invalidity against the contested IR based upon sections 47, 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The applicant relies upon the following trade mark:

MARCO POLO

UK trade mark number: 917998423

Filing date: 11 December 2018²

Registration date: 30 September 2019

For the following goods and services:

Class 9: Computer software for facilitating financial services transactions; computer software for transacting financial offers, requests, funding, payments, receipts; computer software for facilitating financial dealings between financial institutions and their corporate customers; computer software for offering, accepting, providing and obtaining working capital and trade finance; computer software for providing, viewing and exchanging financial and trade data; computer software for conducting financial diligence exercises; downloadable computer application software for facilitating financial services transactions;

¹ The earlier mark was previously owned by Tradeix Limited however, the mark was assigned to a new owner on 30 March 2023 and now stands in the name of Petra Financial Technologies LLC.

² The applicant’s mark is a comparable mark based on its EU mark. On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the Registry created comparable UK trade marks for all rights holders with existing EUTMs and IRs. As a result, at the end of the Implementation Period on 31 December 2020, comparable UK trade mark was automatically created. The comparable trade mark shown above is now recorded on the UK trade mark register and has the same legal status as if it had been applied for and registered under UK law and retains its original filing date.

downloadable computer application software for transacting financial offers, requests, funding, payments, receipts; downloadable computer application software for facilitating financial dealings between financial institutions and their corporate customers; downloadable computer application software for offering, accepting, providing and obtaining working capital and trade finance; downloadable computer application software for providing, viewing and exchanging financial and trade data; downloadable computer application software for conducting financial diligence exercises.

Class 36: Financial services; commercial investment services; commercial funding services; the provision of working capital and trade financing.

Class 42: Providing temporary use of non-downloadable computer software for facilitating financial services transactions; providing temporary use of non-downloadable computer software for transacting financial offers, requests, funding, payments, receipts; providing temporary use of non-downloadable computer software for facilitating financial dealings between financial institutions and their corporate customers; providing temporary use of non-downloadable computer software for offering, accepting, providing and obtaining working capital and trade finance; providing temporary use of non-downloadable computer software for providing, viewing and exchanging financial and trade data; providing temporary use of non-downloadable computer software for conducting financial diligence exercises; technical services for providing a website for facilitating financial services transactions; technical services for providing a website for transacting financial offers, requests, funding, payments, receipts; technical services for providing a website for facilitating financial dealings between financial institutions and their corporate customers; technical services for providing a website for offering, accepting, providing and obtaining working capital and trade finance; technical services for providing a website for providing, viewing and exchanging financial and trade data; technical services for providing a website for conducting financial diligence exercises; software as a service (SaaS) for facilitating financial services transactions; design, maintenance and updating of computer

software for facilitating financial services transactions; consultancy and advisory services in relation to all the aforesaid services.

3. In the statement of grounds, under section 5(1) the applicant argues that the proprietor's IR should be declared invalid on the basis that it is identical to the applicant's mark and is registered for identical services. Alternatively, under section 5(2)(a), the applicant's position is that the marks at issue are identical and that the goods and services at issue are either identical or similar, and as such, there exists a likelihood of confusion between the marks.
4. The proprietor failed to file a counterstatement within the two months specified by Rule 41(6) of the Trade Marks Rules 2008, and a decision was issued on 29 March 2022 declaring the IR invalid, and directing that it be removed from the register and deemed never to have been made.
5. Following a successful appeal to that decision,³ Mr Geoffrey Hobbs QC (as he then was) sitting as the Appointed Person directed that the decision dated 29 March 2022 be set aside and that the applicant's claim for invalidity be remitted to the registrar for further processing in accordance with the provisions of the Act.
6. The proprietor subsequently filed a counterstatement denying the claims made under sections 5(1) and 5(2)(a) and denying that there will exist a likelihood of confusion.
7. The applicant is represented by Baron Warren Redfern and the proprietor is represented by Marks & Clerk LLP. Neither party filed evidence nor did they file any submissions. No hearing was requested, so this decision is taken following a careful perusal of the papers.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the

³ See decision BL O/681/22

Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Decision

9. The application to invalidate the proprietor's mark is based on sections 5(1) and 5(2)(a), pursuant to section 47 of the Act. So far as is relevant, section 47 is as follows:

"47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) [...]

(2D)-(2DA) [Repealed]

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

10. Section 5(1) of the Act states:

"A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

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

"(2) A trade mark shall not be registered if because - (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the trade mark is protected."

(b) [...]

12. By virtue of its earlier filing date, the trade mark upon which the applicant relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the application date of the mark in issue it is not subject to proof of use pursuant to section 47(2A) of the Act.

Identity of the marks

13. It is a prerequisite of sections 5(1) and 5(2)(a) that the respective trade marks are identical.

14. The competing marks each comprise the same two words "MARCO POLO", presented in a standard typeface in capital letters. The respective marks are self-evidently identical.

Comparison of goods and services

15. The proprietor's services are outlined in paragraph 1 of this decision and the applicant's goods and services are outlined in paragraph 2 of this decision.

16. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market* ("OHIM"), Case T-133/05, that, even if goods are not

worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

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

17. The applicant’s earlier services in class 36 include the term *Financial services*. It is my view that this broad term encompasses all of the terms in the proprietor’s specification. These services are therefore identical in accordance with the principles set out in *Meric*.

18. For the avoidance of doubt, there is no need to consider the applicant’s goods and services in classes 9 and 42, as they take the applicant’s case no further.

CONCLUSION

19. As the marks and the services are identical, the application based upon section 5(1) succeeds in its entirety.

20. The application for invalidation is successful and the holder’s IR is hereby declared invalid in respect of all services for which it is registered. Under section 47(6) of the Act, the registration is deemed never to have been made.

COSTS

21. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 July 2016 and before 1 February 2023 are governed by Annex A of Tribunal Practice Notice (‘TPN’) 2 of 2016. Taking account of that scale, I award the applicant the sum of **£400**. The sum is calculated as follows:

Official fee:	£200
Considering the counterstatement and Preparing an application for invalidity:	£200
Total:	£400

22.I therefore order New Holland Ventures Pty Ltd to pay Petra Financial Technologies LLC the sum of £400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of July 2024

Catrin Williams
For the Registrar