

O/0867/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS
IN THE MATTER OF
TRADE MARK APPLICATION NOS.
3941211 & 3938705
BY
BUY SELL PASS LTD
TO REGISTER:

BUY|SELL|PASS

AS A TRADE MARK IN CLASSES 35 & 36

AND

Buy Sell Pass

AS A TRADE MARK IN CLASSES 35 & 36

AND

TWO OPPOSITIONS THERETO
UNDER NOS. 600003144 & 600003145
BY
BUYPASS AS

BACKGROUND & PLEADINGS

1. These consolidated proceedings concern two applications by Buy Sell Pass LTD (“**the applicant**”) to register the trade marks shown on the cover of this decision in the UK for services in Classes 35 and 36, shown later in this decision. Both of the applicant’s marks were published for opposition purposes on 20 October 2023.
2. On 14 December 2023, Buypass AS (“**the opponent**”) opposed the applications under the fast track opposition procedure on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”)¹. The opponent relies on the following registration:

Trade Mark no.	UK00917972276 ²
Trade Mark	
Goods & Services Registered	Classes 9, 35, 36, 38, 42 & 45
Filing date	24 October 2018
Date of entry in register	6 June 2019
Priority details	Priority date: 18 October 2018 Priority country: Norway TM from which priority claimed: 201814007

¹ 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 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.

² On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent’s earlier EUTM was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

3. For the purpose of this opposition, the opponent, as shown above, relies on the following services:

Class 35: Advertising; business management; business administration; office functions.

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; charge card services; credit cards services; secure transaction of payments via mobile telephone, global computer networks and digital TV; electronic funds transfer based on smart cards and chip-concepts; electronic funds transfer based on electronic ID.

4. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as registration of the opponent's earlier mark was completed less than five years before the filing date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.

The Opponent's Statement of Grounds

5. In its statement of grounds, regarding the opposition nos. 600003144 and 600003145, the opponent claims that the marks are highly similar, with high visual, aural, and conceptual similarity. In addition, it asserts that the competing services are either identical or similar.

The Applicant's Defence

6. The applicant filed notices of defence in each case, with one mirroring the other, claiming that:

"Whilst both businesses are in the financial sector, which encompasses an incredibly broad range of operations, the services offered are very different.

[...]

The representative specifically mentions (in Section 4 of their 'Statement of Grounds' appended to the TM7F form) the subclasses included in the application for 'Buy Sell Pass' within Class 35 and Class 36 including 'financial services', 'financial information', 'financial data, advice and consultancy' and 'financial analysis' are problematic. These subclasses do represent aspects of the business of 'Buy Sell Pass' – which is the analysis of financial information and data, with said analysis then being provided to users as a financial service.

As such, the selection of these classes is totally legitimate and aren't classes shared by 'bypass'. The suggestion that they are too alike the subclass related to their mark - 'Financial Affairs' – seems at odds with the Intellectual Property Office's interpretation as otherwise they wouldn't have created separate and distinct subclasses.

[...]

'Buy Sell Pass' does share some common letters with 'bypass' (it doesn't share any words as 'bypass' is a single word hybrid) but the differences between them are fundamental in terms of the areas of business, the meaning expressed by the names and the presentation of the marks all of which comfortably avoids any risk of confusion to the public either visually, aurally or conceptually."

Papers Filed and Representation

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

8. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. The only exception to that

general position is that a fast track opponent who is relying on an earlier mark that is subject to proof of use must file evidence of use at the time of filing the opposition. No leave was sought to file any additional evidence in respect of these proceedings.

9. Rule 62 (5) (as amended) states that arguments in Fast Track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
10. None of the parties filed evidence in these proceedings.
11. No hearing was requested. Only the opponent filed written submissions in lieu of a hearing, which will not be summarised but will be referred to as and where appropriate during this decision. Thus, this decision is taken following a careful perusal of the papers.
12. In these proceedings, the applicant is a litigant in person and the opponent is represented by Stevens Hewlett & Perkins.

DECISION

Section 5(2)(b)

13. Section 5(2)(b) of the Act states:

“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”.

14. The principles considered in these oppositions stem from the decisions of the European 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k) if the association between the marks creates a risk that the public might wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the Services at issue

15. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned [...], 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 complementary.”

16. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

“(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.”

17. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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 für 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”.

18. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"[...] the applicable principles of interpretation are as follows:

(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."

19. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

"[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no

justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

21. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Opposition no. 600003144

22. The competing services to be compared are shown in the following table:

Opponent’s services	Applicant’s services
<p>Class 35: Advertising; business management; business administration; office functions.</p> <p>Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; charge card services; credit cards services; secure transaction of payments via mobile telephone, global computer networks and digital TV; electronic funds transfer</p>	<p>Class 35: Business information; Information (Business -); Economic information services for business purposes; Analysis of business information; Business statistics information; Provision of business statistical information; Business information services; Research of business information; Providing business information; Dissemination of</p>

based on smart cards and chip-concepts; electronic funds transfer based on electronic ID.

business information; Business research and information services; Business information and research services.

Class 36: Financial information; Information (Financial -); Financial information services; Providing financial information; Financial information and evaluations; Financial information for investors; Financial information processing; Provision of financial information; Collection of financial information; Providing investors with financial information; Financial market information services; Financial information services relating to financial stock markets; Computerised financial information services; Providing financial information on-line; Financial information management and analysis services; Financial information, data, advice and consultancy services; Financial consultancy and information services; Financial information services relating to individuals; Computerised information services relating to financial business; Computer information services relating to financial management; Provision of computerised financial information; Provision of information relating to financial services; Provision of financial information relating to shares; Providing financial information via a website; Provision of financial information relating to the stock exchange; Providing information and analysis via the Internet in the field of financial investments; Financial analysis; Analysis (Financial -); Financial data analysis; Information services

	<p>relating to finance; Financial advice relating to investment; Financial research; Research (Financial -); Financial research services; Financial information services provided by access to a computer database; Financial analysis services relating to investments; Financial analyses; Financial data base services; Financial information provided by electronic means; Financial database services relating to shares; Financial analysis and research services.</p>
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23. The opponent provided submissions as to the identity or similarity between the competing services, which I have taken into account. However, I will refer to them wherever it is deemed necessary.
24. As mentioned at the beginning of this decision, the applicant claimed that the competing services are “very different” and that “Buy Sell Pass’ provides stock information for retail traders. ‘buypass’ is a payment/authentication platform. There is no overlap at all in the services offered.” It also focused on the Classes under which the competing services are registered, claiming that “[t]hese subclasses do represent aspects of the business of ‘Buy Sell Pass’ – which is the analysis of financial information and data, with said analysis then being provided to users as a financial service.” Although the applicant states that the services that the parties actually trade in are different, this has no bearing on my decision. This is because I must consider the matter notionally based on the terms that the parties have registered or seek to register.³
25. For the purpose of considering the issue of similarity of services, it is permissible to consider groups of terms collectively where they are

³ See *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraph 22 and *Roger Maier v ASOS* [2015] EWCA Civ 220 at paragraphs 78 and 84.

sufficiently comparable to be assessed in essentially the same way for the same reasons.⁴

Class 35

Business information; Information (Business -); Economic information services for business purposes; Analysis of business information; Business statistics information; Provision of business statistical information; Business information services; Research of business information; Providing business information; Dissemination of business information; Business research and information services; Business information and research services

26. The opponent's broad terms "*business management; business administration*" are intended to help companies manage their business and therefore will be involved in activities associated with the running of a business. On this basis, I consider that these services share some similarities with the above contested services. Whilst the competing services may not overlap in methods of use, I find that they are likely to overlap in nature and purpose, as the respective services are external services offered to businesses for the purpose of increasing or maintaining success. I also find it likely the services would share the same trade channels specialising in business services and will be aimed at the same users (business). Furthermore, whilst they are not complementary, they may well be in competition as the services will all be for the purpose of improving or increasing the performance of the business. Therefore, I find the services at issue to be similar to a medium degree.

⁴ *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Class 36

27. Financial information; Information (Financial -); Financial information services; Providing financial information; Financial information and evaluations; Financial information for investors; Financial information processing; Provision of financial information; Collection of financial information; Providing investors with financial information; Financial market information services; Financial information services relating to financial stock markets; Computerised financial information services; Providing financial information on-line; Financial information management and analysis services; Financial information, data, advice and consultancy services; Financial consultancy and information services; Financial information services relating to individuals; Computerised information services relating to financial business; Computer information services relating to financial management; Provision of computerised financial information; Provision of information relating to financial services; Provision of financial information relating to shares; Providing financial information via a website; Provision of financial information relating to the stock exchange; Providing information and analysis via the Internet in the field of financial investments; Financial analysis; Analysis (Financial -); Financial data analysis; Information services relating to finance; Financial advice relating to investment; Financial research; Research (Financial -); Financial research services; Financial information services provided by access to a computer database; Financial analysis services relating to investments; Financial analyses; Financial data base services; Financial information provided by electronic means; Financial database services relating to shares; Financial analysis and research services

28. The above contested services relate at large to the provision of financial information, including via computerised systems. In *Albingia Sa v Axis Bank Limited*, BL O/253/18, Professor Phillip Johnson, sitting as the Appointed Person, held at paragraph [50] that the term 'financial affairs' is very broad and would cover services which would be called financial services. Bearing this in mind, I consider that the contested terms are

identical with the opponent's "*financial affairs*" based on the *Meric* principle.

Opposition no. 600003145

29. The competing services to be compared are shown in the following table:

Opponent's services	Applicant's services
<p>Class 35: Advertising; business management; business administration; office functions.</p> <p>Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; charge card services; credit cards services; secure transaction of payments via mobile telephone, global computer networks and digital TV; electronic funds transfer based on smart cards and chip-concepts; electronic funds transfer based on electronic ID.</p>	<p>Class 35: Business information; Information (Business -); Economic information services for business purposes; Analysis of business information; Business statistics information; Provision of business statistical information; Business information services; Research of business information; Providing business information; Dissemination of business information; Business research and information services; Business information and research services.</p> <p>Class 36: Financial information; Information (Financial -); Financial information services; Providing financial information; Financial information and evaluations; Financial information for investors; Financial information processing; Provision of financial information; Collection of financial information; Providing investors with financial information; Financial market information services; Financial information services relating to financial stock markets; Computerised financial information services; Providing financial information on-line; Financial information management and analysis services; Financial information, data, advice and consultancy services; Financial consultancy</p>

	<p>and information services; Financial information services relating to individuals; Computerised information services relating to financial business; Computer information services relating to financial management; Provision of computerised financial information; Provision of information relating to financial services; Provision of financial information relating to shares; Providing financial information via a website; Provision of financial information relating to the stock exchange; Providing information and analysis via the Internet in the field of financial investments; Financial analysis; Analysis (Financial -); Financial data analysis; Information services relating to finance; Financial advice relating to investment; Financial research; Research (Financial -); Financial research services; Financial information services provided by access to a computer database; Financial analysis services relating to investments; Financial analyses; Financial data base services; Financial information provided by electronic means; Financial database services relating to shares; Financial analysis and research services.</p>
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30. Although the contested specification at hand is slightly different from the first contested mark, I note that the comparison of services is not materially different from the assessment I conducted previously. Therefore, I adopt the same findings in paragraphs 25-26 above.

Average Consumer and the Purchasing Act

31. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

“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.”

32. The average consumer for the services will be either businesses or professionals, for example, in the financial sector, without excluding entirely members of the general public. The consumers will select such services by looking through brochures, websites, or signs on a physical property so the visual element will be important. However, I do not discount the aural element, as word-of-mouth recommendations may influence consumers’ decisions. The cost of the services will be relatively significant, contributing to the selection process of the service provider. Given the more specialist nature of the services in play, especially those selected by business users, I consider that members of the general public will pay a slightly higher than medium degree of attention, with business users and professionals paying a higher degree of attention in choosing the service provider to ensure that the services meet their particular needs, both in terms of immediate cost and future expectations. Typically, for all the above services, prior consultation or research is conducted before purchase.

Comparison of the Trade Marks

33. 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.”

34. 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.

Opposition no. 600003144

35. The marks to be compared are:

Applicant's Mark
BUY SELL PASS
Opponent's Mark
buypass

Overall Impression

36. The applicant's mark consists of the word elements "BUY SELL PASS" with each word separated by a grey vertical line (pipe symbol). Although all the words are of the same size and appear in upper case and a standard typeface, I note that the words "BUY" and "PASS" are in bold, with the latter appearing striped, while "SELL" is in a regular font. I consider that the word elements are highly suggestive of the services. Nevertheless, the words "BUY SELL PASS" contribute roughly equally to the mark's overall impression, with the figurative elements (vertical lines) playing a minimal role.
37. The earlier mark features the conjoined word elements "bypass" in lower case, standard typeface, and blue hue. I also note that the word component "buy-" appears in a bolder typeface than the word component "-pass". Thus, the average consumer will see the earlier mark as being coined from two words juxtaposed. The mark's overall impression lies in the combined words, with neither word component dominating the other. I also note that the word elements are highly suggestive of the services offered by the opponent.

Visual comparison

38. Bearing in mind that the beginnings of words tend to have more impact than the ends,⁵ the competing marks share the common word elements "BUY/buy-" and "PASS/-pass". There are, though, various visual differences between the marks. In particular, the contested mark contains the word element "SELL" with no counterpart in the earlier mark. I also consider that the stylisation, if noticed, would create another point of difference between the marks. Taking into account the above factors, including the overall impression of the competing marks, I find that the degree of visual similarity is medium.

⁵ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Aural comparison

39. The applicant's mark is three syllables long, which will be articulated as "BYE-SEL-PAHSS". The opponent's mark is a two-syllable mark, "BYE-PAHSS". The competing marks share the same phonetic beginnings ("BYE-") and endings ("-PAHSS"). However, there is no phonetic counterpart for the word element "SEL" in the earlier mark. I find that there is a between a medium and high degree of aural similarity.

Conceptual comparison

40. The applicant claims that:

"The name 'Buy Sell Pass' is indicative of the three activities traders may want to engage in based on the information provided by us - to Buy, to Sell or to Pass on a trading opportunity. The usage is not ambiguous.

Comparatively the 'bypass' name either refers to the ability to buy a pass to something or is a pun on the existing word 'bypass', suggesting they will help their customers get around things."

41. The opponent submits that:

"13. Conceptually, the marks are highly similar, sharing the meaning of BUY and PASS: the word BUY meaning "to purchase" and the word PASS meaning (i) "to move in a specified direction" or (ii) "to move past" an object. In the context of the services subject of the Applications and the Opponent's Registration in Classes 35 and 36, the word 'PASS' is likely to be interpreted as a synonym for 'turn down'.

14. In the Applicant's marks, the word "SELL", meaning "to give or hand over something in exchange for money", also contributes to the overall conceptual impression but does not serve to distinguish the marks conceptually given the shared meaning of BUY and PASS.

15. In the context of the services subject of the Applications and the Opponent's Registration in Classes 35 and 36, the consumer is most likely to understand the marks to allude to their ability to decide whether to buy, (sell) or pass on (turn down) certain business opportunities, investments or investment opportunities as a consequence of the 'business' and 'financial' services provided.

16. The Applicant has argued that the mark subject of the Opponent's Registration means the ability to "buy a pass" to something or is a reference to the dictionary word 'bypass'. In the former case, the Opponent does not deny that it is possible that the consumer could interpret the meaning of the word "PASS" to be the noun (meaning 'ticket') but, this meaning is equally attributable to the word within the marks subject of the Applications, such that the degree of conceptual similarity is unaltered.


17. With regard to the potential link between the mark subject of the Opponent's Registration and the dictionary word 'bypass', it is submitted that the relevant public will appreciate the deliberate choice of the word "BUY" rather than "BY" such that an immediate association with the word 'bypass' is highly unlikely. In any event, the fact that a mark has the potential to have more than one meaning is irrelevant to the assessment of conceptual similarity with another mark: it is sufficient if only one of the possible meanings of a mark evokes the same idea or concept as the other mark for a finding of conceptual similarity.”

42. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.
43. The earlier mark consists of the conjoined and ordinary dictionary word components “buy-” and “-pass”. In the absence of evidence, I am not

convinced that the entirety of the general public will grasp the play on words and the reference to the word “bypass” as the applicant claims. Given the registered services, I agree with the opponent that a significant proportion of consumers will interpret the word components “buy-” and “-pass” separately as meaning ‘to purchase’ and ‘to turn down’, respectively. As to the contested mark, the average consumer will attribute the same meaning to the words “BUY” and “PASS” as in the earlier mark. However, there is a conceptual difference stemming from the word “SELL” which will be understood as such. Taking into account all the above and the marks as a whole, including the overall impressions, I find that the marks are conceptually similar to at least a medium degree based on the common elements.

Opposition no. 600003145

44. The marks to be compared are:

Applicant’s Mark	Opponent’s Mark
Buy Sell Pass	

Overall Impression

45. For the earlier mark, I adopt the same analysis as in my paragraph 37 above.

46. The contested word mark consists of the words “Buy Sell Pass” capitalised and in a bold standard typeface. Registration of a word mark protects the word itself presented in any regular font and irrespective of capitalisation.⁶ The overall impression of the mark lies in the words themselves.

⁶ See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

Visual comparison

47. The competing marks share the common word elements “Buy/buy-” and “Pass/-pass”. However, there is a difference stemming from the word “Sell” in the contested mark for which there is no counterpart in the earlier mark. The font, case and colour divergence of the word elements in the competing marks will play no material role due to the notional and fair use⁷ of the contested word mark covering use in the same font, colour, and case as that used in the opponent’s mark. Taking into account the above factors, including the overall impression of the competing marks, I find that the degree of visual similarity is between medium and high.

Aural comparison

48. I adopt the same analysis as in my paragraph 39 above.

Conceptual comparison

49. I adopt the same analysis as in my paragraphs 42-43 above.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARK

50. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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

⁷ 2 Paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).

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).”

51. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
52. The opponent has not shown use of its mark and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the earlier mark to consider. The opponent’s mark consists of the word elements “buypass”, which is an invented word consisting of the conjunction of the very commonplace words “buy-” and “-pass”, conveying the meaning described earlier in this decision. Although the mark as a whole may be considered “invented”, the conjoining of those words is not highly fanciful. I note that the verbal elements are highly suggestive of the services relied upon in this opposition. On balance, the presentation of the mark will add to the distinctiveness. Bearing in mind when making my assessment that a registered trade mark must be

considered to have at least a minimum degree of distinctive character,⁸ and weighing all the factors, I find the earlier mark is inherently distinctive to a low degree.

LIKELIHOOD OF CONFUSION

53. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.⁹ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.¹⁰
54. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
55. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC, sitting 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

⁸ *Formula One Licensing BV v OHIM*, Case C-196/11P.

⁹ See *Canon Kabushiki Kaisha*, paragraph 17.

¹⁰ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example).”

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹¹

¹¹ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O/440/14 at paragraph 29.

56. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC, sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

57. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

58. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC (as he then was) as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This

is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

59. Earlier in this decision I have concluded that:

- the services at issue range from identical to similar to a medium degree;
- the average consumer for the services are businesses/professionals as well as members of the general public. The level of attention paid will be slightly higher than a medium degree of attention for the members of the general public and higher for the business users/professionals. The selection process is predominantly visual without discounting aural considerations;
- re opposition 600003144, the competing marks are visually similar to a medium degree, aurally to between a medium and high degree, and conceptually to at least a medium degree;
- re opposition 600003145, the competing marks are visually and aurally similar to between a medium and high degree, and conceptually to at least a medium degree;
- the earlier mark is inherently distinctive to a low degree.

60. Although I have found earlier in this decision that the inherent distinctiveness of the earlier mark is of a low degree, this does not prevent a likelihood of confusion.¹²

¹² See *L'Oréal SA v OHIM*, Case C-235/05 P.

Opposition no. 600003144

61. Taking into account the above factors, I am persuaded that there is no likelihood of direct confusion for identical services. Notwithstanding the principle of imperfect recollection and the shared common elements “BUY” and “PASS”, the average consumer would not overlook the presence/absence of the word “SELL” in the competing marks. Therefore, the average consumer paying slightly a higher than a medium or a higher degree of attention will not mistakenly recall or misremember the competing marks as each other.
62. Nevertheless, having identified that the marks are different, the consumers will assume that the respective marks originate from the same or economically linked undertakings. This is because the marks share common beginnings and endings, namely “BUY” and “PASS”, creating a conceptual hook between the marks. The addition of “SELL” in the applicant’s mark could lead the average consumer to consider the contested mark as a sub-brand or a logical brand extension of the opponent’s, with the addition of a highly suggestive word element. As the vertical lines in the contested mark play a lesser role in the overall impression, the consumers would overlook these due to imperfect recollection. In these circumstances, I find that there is a likelihood of indirect confusion. This finding extends to the competing services, which I found to be similar to a medium degree.

Opposition no. 600003145

63. Weighing up all the factors, I am satisfied that there is no likelihood of direct confusion for identical services. Similarly, in this case, there are sufficient differences between the marks (buypass v Buy Sell Pass) to guard against the average consumer mistaking one mark for the other, even where the services are identical. I find that there is no likelihood of direct confusion.

64. Turning to indirect confusion, there is a likelihood of indirect confusion for the respective identical services. In particular, while the average consumer will identify the difference in the marks, they will identify the common word elements “buy” and “pass” shared in the respective marks. Given the identity of the services and the notional and fair use of the contested mark in question, it is likely that the average consumer would perceive the competing marks as sub-brands or brand extensions, with the addition of a highly suggestive word element, namely “Sell”. Therefore, I find that the average consumer would assume a commercial association between the parties, believing that the respective services come from the same or economically linked undertakings. As a result, I find there is a likelihood of indirect confusion. This finding extends to the competing services, which I found to be similar to a medium degree.

OUTCOME

65. Both of the oppositions have been successful in full. **There is likelihood of confusion.** Therefore, subject to appeal, the application will be refused.

COSTS

66. The opponent has been successful and is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs as follows:

Official opposition fee x2	£200
Preparing a statement and considering the counterstatement x2	£500
Preparing and filing submissions in lieu of a hearing ¹³	£350
Total	£1,050

¹³ Since the submissions for both oppositions are mirroring each other, I will apply a single award in this case.

67. I, therefore, order Buy Sell Pass LTD to pay to Buypass AS the sum of £1,050. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 9th day of September 2024

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General